

## ADMINISTRATIVE PANEL DECISION

### Dansko, LLC v. Client Care, Web Commerce Communications Limited Case No. D2023-2372

#### 1. The Parties

The Complainant is Dansko, LLC, United States of America (“United States”), represented by Cozen O’Connor, United States.

The Respondent is Client Care, Web Commerce Communications Limited, Malaysia.

#### 2. The Domain Names and Registrar

The disputed domain names <dansko-danmark.com>, <danskooutletitalia.com>, <danskoschoenennederland.com>, <danskoschuhedeutschland.com>, <danskoschuheoesterreich.com>, and <danskosireland.com> (“Disputed Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

#### 3. Procedural History

The Complaint<sup>1</sup> was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 1, 2023. On June 1, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On June 9, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent (Unknown Registrant c/o ALIBABA.COM SINGAPORE ECOMMERCE PRIVATE LIMITED) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 9, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on June 13, 2023.

The Center verified that the Complaint, together with the amended Complaint, satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

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<sup>1</sup> The Complaint was originally filed regarding seven domain names, and the Complainant removed one domain name during the proceeding.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 13, 2023.

The Center appointed Peter Wild as the sole panelist in this matter on August 28, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

The Complainant owns registered trademark rights in the term DANSKO (in different combinations), which it has used since 1990 for footwear. The Complainant's trademarks and products are well known in the United States, in particular for comfortable shoes used in the healthcare industry. The Complainant owns a number of United States trademarks with the element DANSKO, such as United States Trademark Registration No. 3854991 (registered on September 28, 2010) and No. 2712957 (registered on May 6, 2003). The oldest trademark DANSKO (and design) seems to go back to a registration date of May 6, 2003. The Complainant also owns and uses the domain name <dansko.com>.

The Disputed Domain Names were registered on the following dates:

- <dansko-danmark.com>, September 27, 2022;
- <danskooutletitalia.com>, September 27, 2022;
- <danskoschoennederland.com>, September 27, 2022;
- <danskoschuhedeutschland.com>, September 27, 2022;
- <danskoschuheoesterreich.com>, October 25, 2022;
- <danskosireland.com>, September 27, 2022.

They all resolve to almost identical websites which offer products which look exactly like the Complainant's products and which use the photographic pictures from the Complainant's website. The websites also shows direct copies of pictures and logos of the Complainant's website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it is the owner of a number of trademarks consisting of its name "Dansko" (in various combinations) and that it has a strong reputation for the products under this trademark. The Complainant asserts that the Disputed Domain Names are confusingly similar to the above-mentioned DANSKO trademark and that the Respondent has made every effort to confuse consumers into believing the Disputed Domain Names are related to the Complainant by offering footwear and footwear products via websites that are confusingly similar to the Complainant's *bona fide* website. The Complainant alleges that the Respondent has no rights or legitimate interests in the Disputed Domain Names, which were registered and are being used in bad faith.

##### **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Complainant owns registered trademark rights in the term DANSKO (word, but also with various elements). The trademarks clearly predate the Disputed Domain Names. The dominant element of the trademarks, DANSKO, is fully integrated in the Disputed Domain Names. The dominant element DANSKO is clearly recognizable in the Disputed Domain Names. The Disputed Domain Names differ from the Complainant's trademark as following:

- <dansko-danmark.com>: the element "danmark" (Denmark in Danish) as a geographic element;
- <danskoutletitalia.com>: the element "italia" (Italy in Italian) as a geographic element, and "outlet" as a description of a sales channel;
- <danskoschoenennederland.com>: the element "nederland" (Netherlands (Kingdom of the) in Dutch) as a geographic element, and "schoenen" (shoes in Dutch) as a description of the products;
- <danskoschuhedeutschland.com>: the element "deutschland" (Germany in German) as a geographic element, and "schuhe" (shoes in German) as a description of the products;
- <danskoschuheoesterreich.com>: the element "oesterreich" (Austria in German) as a geographic element, and "schuhe" (shoes in German) as a description of the products;
- <danskosireland.com>: the element "ireland" as a geographic element, and an additional letter "s".

Further to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, "[w]here the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements". Accordingly, the Disputed Domain Names, consisting of the DANSKO mark in its entirety, are confusingly similar to the Complainant's trademark regardless of the added terms. The addition of the terms as outlined above does not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant's trademarks.

Therefore, the Panel is satisfied that the first element of the Policy is met.

### B. Rights or Legitimate Interests

The Complainant must establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Names. Once such *prima facie* case is made, the Respondent carries the burden of demonstrating its rights or legitimate interests in the Disputed Domain Names. If the Respondent fails to do so, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the UDRP.

The Respondent is not commonly known under the Disputed Domain Names and has no connection with or authorisation from the Complainant. The Respondent's activity under the websites to which the Disputed Domain Names resolve is infringing the copyright and other rights of the Complainant. The evidence provided by the Complainant shows that the Disputed Domain Names resolve to almost identical websites allegedly selling the Complainant's goods and displaying the Complainant's copyrighted images. See, along these lines, *Bottega Veneta SA v. Demp Cross*, WIPO Case No. [D2013-1534](#).

The Respondent therefore cannot show a *bona fide* offering of goods or a legitimate noncommercial or fair use of the Disputed Domain Names. See *Eli Lilly and Company and Novartis Tiergesundheits AG v. Manny Ghuman / Mr. NYOB / Jesse Padilla*, WIPO Case No. [D2016-1698](#).

Moreover, the construction of the Disputed Domain Names, consisting of the DANSKO mark along with the descriptive or geographical terms, is even apt to increase confusion since users could believe the Disputed Domain Names are used by the Complainant or, at least, by the Complainant's affiliated entity, in connection with its web portal. [WIPO Overview 3.0](#), section 2.5.1.

In the absence of any explanation by the Respondent, the Complainant's establishment of the *prima facie* case is sufficient.

With the evidence on file, this Panel is satisfied that the second element of the Policy is met.

### **C. Registered and Used in Bad Faith**

The Disputed Domain Names are being used to offer products which look identical to the products which the Complainant offers on its website under "www.dansko.com". Given the use of the Complainant's trademark, identical photos from the Complainant's website, and the confusingly similar Disputed Domain Names, it is established that the Respondent knew the Complainant and its trademark and business line. In consideration of the totality of factors compared to factors that panels have consistently held to be relevant in finding bad faith, namely the Respondent's concealing of its identity, the current bad faith use, and the implausibility of any good faith to which the Disputed Domain Names may be put, this Panel comes to a bad faith finding in this instance. See "*Dr. Martens*" *International Trading GmbH and "Dr. Maertens" Marketing GmbH v. Godaddy.com, Inc.*, WIPO Case No. [D2017-0246](#).

Taking into account the strength of the Complainant's trademark DANSKO and the context which the Disputed Domain Names create, it is obvious that the Respondent was and is aware of the Complainant's trademark, its products and website, elements of which it has copied directly. By using the Disputed Domain Names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites, by creating a likelihood of confusion with the Complainant's mark. In this Panel's view, this establishes bad faith registration and use of the Disputed Domain Names.

This Panel therefore comes to the conclusion that the third element of the Policy is met.

### **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Disputed Domain Names <dansko-danmark.com>, <danskoooutletitalia.com>, <danskoschoenennederland.com>, <danskoschuhedeutschland.com>, <danskoschuheoesterreich.com>, and <danskosireland.com> be transferred to the Complainant.

*/Peter Wild/*

**Peter Wild**

Sole Panelist

Date: September 11, 2023