

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Web Commerce Communications Limited, Client Care
Case No. D2024-0493

1. The Parties

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

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

2. The Domain Names and Registrar

The disputed domain names <danskoaustraliaau.com>, <danskoclogsukonline.com>, <danskodanmark-dk.com>, <dansko-mexico.com>, <dansko-schweiz.com>, <danskosverige.com>, and <danskozapatosmexico.com> are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 1, 2024. On February 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names and the domain name <dansko-france.com>. On February 5, 2024, 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 (not available) and contact information in the Complaint.

The Center sent an email communication to the Complainant on February 7, 2024, with the registrant and contact information of nominally multiple underlying registrants revealed by the Registrars, requesting the Complainant to either file separate complaints for the disputed domain names associated with different underlying registrants or alternatively, demonstrate that the underlying registrants are in fact the same entity. The Complainant filed an amended Complaint on February 9, 2024, requesting the partial withdrawal of the Complaint in regard to the domain name <dansko-france.com>.

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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 4, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 5, 2024.

The Center appointed Dr. Clive N.A. Trotman as the sole panelist in this matter on March 8, 2024. 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, which has been in business since 1990, sells shoes including clogs, boots, sandals, flats, and sneakers, and related items. The Complainant also sells comfortable shoes in styles chosen by medical professionals.

The Complainant holds a number of trademarks for DANSKO standing alone or in combination of which the following are representative for this proceeding:

DANSKO, United States Patent and Trademark Office ("USPTO"), registration number 2712957, registered May 6, 2003, in class 25;

DANSKO, USPTO, registration number 3265194, registered July 17, 2007, in class 25;

DANSKO, USPTO, registration number 4229847, registered October 23, 2012, in classes 3, 18, 25, and 35.

The Complainant also uses for its website and email address the domain name <dansko.com>.

The Respondent has not replied with any background information. The Whois information in respect of each of the seven disputed domain names did not show a registrant name, however the Registrar has disclosed that they have in common the same registrant organization name "Web Commerce Communications Limited", and contact person "Client Care". Their registration dates were:

<danskozapatosmexico.com>	registered on September 27, 2022
<danskoclogsukonline.com>	registered on September 27, 2022
<danskoaustraliaau.com>	registered on September 27, 2022
<danskodanmark-dk.com>	registered on October 25, 2023
<dansko-mexico.com>	registered on January 17, 2022
<dansko-schweiz.com>	registered on January 17, 2022
<danskosverige.com>	registered on January 17, 2022

Each of the disputed domain names has resolved to a website featuring the Complainant's trademark and advertising shoes, mainly in casual styles, purportedly for sale.

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain names.

The Complainant contends that the disputed domain names are controlled by a single person or entity and requests the consolidation of the Complaint against the multiple registrants pursuant to paragraph 10(e) of

the Rules. The Complainant's reasons include: the similarity and overall timeframe of the respective dates of registration; the commonality of the registrant organization; the similarity of the websites to which the disputed domain names resolve; and the similarity of the disputed domain names in consisting of the Complainant's trademark followed by a geographical term.

The Complainant contends that each disputed domain name is confusingly similar to a trademark in which the Complainant has prior rights. The additional elements present in the disputed domain names do not eliminate confusing similarity.

The Complainant further contends that it is not affiliated with the Respondent, which has no legitimate interests in the disputed domain names. The Respondent has not been authorized by the Complainant to use the Complainant's trademark. The use of the disputed domain names to feature the Complainant's trademark in connection with the sale of unauthorized or counterfeit goods. There is no evidence the Respondent has been commonly known by any of the disputed domain names or that these have been used for any fair or legitimate noncommercial purpose.

The Complainant contends that the disputed domain names have been registered and are being used in bad faith. The Respondent has attempted to trade off the Complainant's goodwill.

The Complainant states that the Respondent had constructive and actual knowledge of the Complainant's trademark rights, which is demonstrated by the nature of the Respondent's websites in imitating the Complainant's website. Furthermore, the Respondent has concealed its contact details by registering the disputed domain names through a privacy service. The Respondent has acted in bad faith under paragraph 4(b)(iv) of the Policy.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name: WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy: [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain names. Accordingly, the disputed domain names are confusingly similar to the mark for the purposes of the Policy: [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, geographical or regional terms such as "mexico", "uk", "australia", "au", "danmark", "dk", "schweiz" and "verige", or the words "clogs", "zapatos" or "online") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element: [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain names. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain names such as those enumerated in the Policy or otherwise.

The Panel notes the composition of the disputed domain names and that such were all being used to resolve to a website impersonating the Complainant and purportedly offering for sale the Complainant’s products. The Complainant has not authorized such use of the disputed domain name and the Panel further notes that such websites do not disclose the relation (or lack thereof) with the Complainant.

Panels have held that the use of a domain name for illegal activity (here, impersonation or the alleged sale of counterfeit or similar goods under the Complainant’s trademark and logo), can never confer rights or legitimate interests on a respondent: [WIPO Overview 3.0](#), section 2.13.1.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. Paragraph 4(b)(iv) of the Policy reads:

“(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location”.

The Panel has examined the screen captures produced in evidence by the Complainant of the websites to which the disputed domain names have resolved. All seven websites have a high degree of similarity. In particular, each displays at top left the Complainant’s trademark in a distinctive logo form with lower case characters surmounted by a device, identical to the logo appearing on the Complainant’s own website. Some of the websites display the same logo much larger, together with the registered trademark symbol ® (which is present in the smaller logos but almost invisible). The Complainant has stated that it has not authorized the Respondent to use the Complainant’s trademark.

The Respondent’s websites proceed to show, in common style, a variety of shoes for sale, generally with prices, with model-style photographs. At the top are the words “women” and “men” in the language appropriate to the target region of the respective disputed domain name.

The Panel finds on the evidence that the Respondent has targeted the Complainant when registering the disputed domain names and has used the disputed domain names with intent to confuse Internet users into believing that the goods offered for sale through the corresponding websites were the products of, or were endorsed by, the Complainant, and the Respondent has done so for commercial gain.

The Panel notes that the Respondent has previously been involved as Respondent in numerous UDRP cases in which transfer has been issued and that such pattern of abusive conduct of registering trademark-abusive domain names constitutes further evidence of bad faith.

On the evidence and on the balance of probabilities, the Panel finds the Respondent to have registered and used the disputed domain names in bad faith under paragraphs 4(b)(iv) and 4(a)(iii) of the Policy. The Panel finds that the Complainant has established the third element of the Policy.

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 <danskoaustraliaau.com>, <danskoclogsukonline.com>, <danskodanmark-dk.com>, <dansko-mexico.com>, <dansko-schweiz.com>, <danskosverige.com> and <danskozapatosmexico.com> be transferred to the Complainant.

/Dr. Clive N.A. Trotman/

Dr. Clive N.A. Trotman

Sole Panelist

Date: March 20, 2024