

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Oliver Finch
Case No. D2024-1023

1. The Parties

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

The Respondent is Oliver Finch, Germany.

2. The Domain Name and Registrar

The disputed domain name <dansko-france.com> is registered with Key-Systems GmbH (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 7, 2024. On March 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 11, 2024, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 March 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 2, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 4, 2024.

The Center appointed Anna Carabelli as the sole panelist in this matter on April 15, 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 is a US based producer of footwear. Established in 1990, the Complainant designs, manufactures, and sells various types of shoes designed for long wear and comfort, under the trademark DANSKO. The Complainant sells its footwear to customers around the world, especially through its official website under the domain name <dansko.com>.

The Complainant owns several trademark registrations consisting of or including the mark DANSKO, and among others the following US registered trademarks:

- DANSKO (word), Reg. No. 2,712,957, registered May 6, 2003, in class 25,
- DANSKO (fig.), Reg. No. 3,265,196, registered on July 17, 2007, in class 25,
- DANSKO (word), Reg. No. 3,265,194, registered July 17, 2007, in class 25,
- DANSKO (word), Reg. No. 4,229,847, registered October 23, 2012, in classes 3, 18, 25, 35, and
- DANSKO NATURAL ARCH (word), Reg. No. 5,638,606, registered on December 25, 2018, in class 25

The disputed domain name was registered on May 14, 2022. As per the evidence submitted with the Complaint, the disputed domain name resolved to a website prominently featuring the Complainant's DANKO mark and purportedly offering footwear goods that appear identical or related to those protected by the Complainant's mark. At the time of filing the Complaint, the disputed domain name was inactive.

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 name.

Notably, the Complainant contends that:

- it has established rights in the DANSKO trademark by virtue of longstanding use worldwide and several registrations in the United States Patent and Trademark Office;
- The disputed domain name is confusingly similar to a trademark in which the Complainant has right, since it consists of the Complainant's DANSKO mark. The addition of the geographical element "France" does nothing to distinguish the disputed domain name from the Complainant's DANSKO mark;
- The Respondent has no rights or legitimate interests in the disputed domain name since: (i) the Complainant has not authorized or somehow given consent to the Respondent to register and use the disputed domain name, (ii) the Respondent is not commonly known by the disputed domain name, and (iii) the Respondent's use of the disputed domain name is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use. In this connection the Complainant points out that the disputed domain name redirects to a website that prominently displays the Complainant's DANSKO mark in connection with the sale of unauthorized products;
- The disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name having in mind the Complainant's DANSKO trademark, with the clear intention to trade-off of the reputation and goodwill of the Complainant's mark, by diverting Internet users seeking the Complainant's website to its own website for commercial gain.
- Bad faith is further evidenced by the Respondent concealing its true identity by registering the disputed domain name through a privacy service.

Based on the above the Complainant requests the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the panel to decide the complaint based on the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and
- (ii) the respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

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 Panel finds the entirety of the Complainant's registered trademark DANSKO is reproduced and recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7. The addition of the generic Top-Level Domain such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

Although the addition of other terms, here "-france", may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name 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 name. 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 name such as those enumerated in the Policy or otherwise.

Moreover, as noted in section 6(A) above, the disputed domain name is confusingly similar to the Complainant's DANSKO mark and carries a risk of implied affiliation with the Complainant. Indeed, as per the uncontested evidence submitted with the Complaint, the Respondent has used the disputed domain name to deliberately cause consumer confusion through operating a website which prominently displays the Complainant's mark DANSKO and offers products identical or related to those protected by the Complainant's mark. This cannot constitute fair use. [WIPO Overview 3.0](#), section 2.5.1.

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.

In the present case, the Panel notes that the Complainant's DANSKO trademark has been continuously and extensively used for many years and has as a result acquired reputation and goodwill worldwide. It is difficult to believe that the Respondent did not have in mind the Complainant's DANSKO trademark when registering the disputed domain name especially noting the Complainant operates its business via the domain name <dansko.com> for decades. Prior panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

The fact that the Respondent has used the disputed domain name following registration, to resolve to a website featuring the Complainant's DANSKO trademark and purportedly offering identical/competing footwear products, establishes both the Respondent's actual knowledge of the Complainant's rights as at the date of registration of the disputed domain name and the Respondent's intention to take unfair advantage of those rights. Indeed, the Respondent has used the disputed domain name to capitalize on the goodwill of the Complainant's DANSKO trademark, and has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website.

The above conduct constitutes bad faith registration and use of the disputed domain name under the Policy. The subsequent non-use of the disputed domain name does not prevent a finding of bad faith under the passive holding doctrine given the totality of the circumstances in the present case. [WIPO Overview 3.0](#), section 3.3.

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 name <dansko-france.com> be transferred to the Complainant.

/Anna Carabelli/

Anna Carabelli

Sole Panelist

Date: April 26, 2024