

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. tanjiancong tanjiancong, tanjiancong
Case No. D2024-1507

1. The Parties

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

The Respondent is tanjiancong tanjiancong, tanjiancong, United States.

2. The Domain Name and Registrar

The disputed domain name <danskoparadise.com> (“Domain Name”) is registered with Web Commerce Communications Limited dba WebNic.cc (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 9, 2024. On April 10, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 11, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Unknown Registrant/Domain Admin, Whoisprotection.cc) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 17, 2024 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 April 18, 2024.

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 April 19, 2024. In accordance with the Rules, paragraph 5, the due date for Respondent to file a response was May 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the parties of the Respondent’s default on May 17, 2024.

The Center appointed Marylee Jenkins as the sole panelist in this matter on May 27, 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

Based on a review of the uncontested evidence submitted by the Complainant in the Amended Complaint, the Panel finds that the Complainant is the owner of numerous registrations for DANSKO and DANSKO-formative marks in the United States, including, inter alia:

Mark	Reg. No.	Jurisdiction	Reg. Date	Class(es)
 DANSKO & Design	2712953	United States	May 6, 2003	25
DANSKO	2712957	United States	May 6, 2003	25
DANSKO	3265194	United States	July 17, 2007	25
 DANSKO & Design	3265196	United States	July 17, 2007	25
DANSKO	3265194	United States	July 17, 2007	25
DANSKO	3854991	United States	September 28, 2010	25
DANSKO XP	4172633	United States	July 10, 2012	25
DANSKO	4229847	United States	October 23, 2012	3, 18, 25, and 35
 DANSKO & Design	4229969	United States	October 23, 2012	3, 18, 25, and 35
DANSKO NATURAL ARCH	5638606	United States	December 25, 2018	25
DANSKO NATURAL ARCH PLUS	6540779	United States	October 26, 2021	25

(individually and collectively referred to as the “Complainant’s Marks”). In addition, the Complainant owns the domain name <dansko.com>, which incorporates the Complainant’s trademark DANSKO, and which directs to the Complainant’s official website offering for sale the Complainant’s products, including footwear and athletic apparel.

The Respondent registered the Domain Name <danskoparadise.com> on March 22, 2024. The undisputed evidence indicates that the Domain Name resolved to a website purporting to offer the sale of apparently counterfeit or unauthorized versions of the Complainant’s products. The Domain Name currently does not resolve to an active web page.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy to warrant a transfer of the Domain Name, summarized as follows:

The Complainant states that it is the owner of the Complainant’s Marks, as established via, inter alia, submitted evidence of its trademark registrations for the Complainant’s Marks. In addition, the Complainant states that it has offered footwear products under the Complainant’s Marks to consumers worldwide, and that the Complainant has gained significant common law rights as a result of its efforts, including through use,

advertisement, and promotion of the Complainant's Marks in connection with footwear products, since at least as early as 1990.

The Complainant argues that the Domain Name is confusingly similar to the Complainant's Marks because the Domain Name incorporates the Complainant's trademark DANSKO in its entirety. The Complainant also asserts that the addition of the "non-distinctive, descriptive" term "paradise" in the Domain Name and the ".com" generic Top-Level Domain ("gTLD") do not avoid a finding of confusing similarity.

The Complainant further states that the Respondent has no rights or legitimate interests in respect of the Domain Name given that there is no affiliation between the Parties, no association with the Domain Name per the Whois record, and no authorization to use the Complainant's Marks. Moreover, the Complainant asserts that the Respondent is using the Domain Name to deceive consumers via registering the Domain Name anonymously, and hosting a website that displays unauthorized content that infringes upon the Complainant's Marks and purports to offer identical footwear products.

The Complainant alleges that the Respondent has registered and is using the Domain Name in bad faith because the Domain Name is confusingly similar to the Complainant's Marks, which are well known marks that the Complainant first used and registered many years prior to the registration of the Domain Name. Further, the website, to which the Domain Name resolves, imitates the Complainant's website, displays the Complainant's Marks, and purports to offer unauthorized and/or counterfeit versions of the Complainant's products at discounted prices, while likely attempting to fraudulently collect personal information from individuals believing that the Domain Name is related to the Complainant.

Thus, the Respondent intended to syphon the Complainant's goodwill and reputation to create confusion and moreover, to gain commercially by purportedly selling unauthorized or counterfeit versions of the Complainant's products via the confusingly similar Domain Name.

The Complainant requests the transfer of the Domain Name.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a domain name holder is to submit to a mandatory administrative proceeding in the event that a third party (i.e., complainant) asserts to an ICANN-approved dispute resolution service provider that:

(i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and

(ii) the domain name holder has no rights or legitimate interests in respect of the domain name; and

(iii) the domain name has been registered and is being used in bad faith.

The burden of proof of each element is borne by the Complainant. The Respondent's default does not by itself mean that the Complainant is deemed to have prevailed. Under paragraph 14(b) of the Rules, the Panel shall draw such inferences from the Respondent's default as the Panel considers appropriate. Nevertheless, the Panel may rule in the Complainant's favor only after the Complainant has proven that the above elements are present.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has provided sufficient evidence demonstrating ownership of and rights in and to the Complainant's Marks for the purposes of the Policy.

The Domain Name reproduces the Complainant's trademark DANSKO in its entirety with the addition of the term "paradise." Although the addition of other terms in general may influence the assessment of the second and third elements under the Policy, the Panel finds that the addition of such term, here "paradise", does not prevent a finding of confusing similarity between the Domain Name and the Complainant's Marks for the purposes of the Policy.

Based on the above and submitted evidence, the Panel finds that the Domain Name is confusingly similar to the Complainant's Marks in which the Complainant has rights. Paragraph 4(a)(i) of the Policy has been satisfied.

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 the Domain Name.

Although the overall burden of proof in UDRP proceedings is on a 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.

Upon review of the submitted evidence, the Panel finds that the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the 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 Domain Name, such as those enumerated in the Policy or otherwise.

In particular, there is no evidence that the Complainant has at any time ever licensed, sponsored, endorsed, or authorized the Respondent to use the Complainant's Marks in any form. Furthermore, there is no evidence of record indicating, before notice to the Respondent of the dispute, that the Respondent was using or was making demonstrable preparations to use the Domain Name in connection with any type of bona fide offering of goods or services or that the Respondent is commonly known by the Domain Name, as an individual, business, or otherwise. Instead, the undisputed evidence shows, inter alia, that the Domain Name resolved to a website that featured unauthorized uses of the Complainant's Marks and purported to sell what appeared to be counterfeits of the Complainant's products at discounted prices. Given the composition of the Domain Name, which combines the Complainant's Marks with the term "paradise", it is apparent that the Respondent sought to mislead Internet users that the Domain Name was somehow affiliated with or endorsed by the Complainant and further attempting to suggest a possible online shopping location for the Complainant's products.

Based on the above, the Panel concludes that the Complainant has established that the Respondent lacks rights or legitimate interests in the Domain Name. The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

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.

Based upon the undisputed evidence submitted by the Complainant, the Panel finds that the Respondent had actual knowledge of the Complainant and the Complainant's Marks, along with the Complainant's products, when registering the Domain Name. This finding is supported by the uncontested evidence showing that the Respondent's recent registration of the Domain Name in no way pre-dates the Complainant's significantly earlier registration dates for the Complainant's Marks. Indeed, the review of the Complainant's trademark registrations for the Complainant's Marks shows that such registrations well pre-date the Respondent's registration of the Domain Name.

Furthermore, the undisputed evidence shows that the Respondent has not made any legitimate noncommercial or fair use of the Domain Name. For instance, the undisputed evidence demonstrates that the Domain Name is confusingly similar to the Complainant's trademark DANSKO and resolved to a website that, inter alia: (i) contained false contact and ownership details (including, as observed by the Panel, a non-existent address in "Philadelphia, Florida 33146"); (ii) featured unauthorized uses of the Complainant's Marks; and (iii) purported to sell what appeared to be counterfeits of the Complainant's products at discounted prices for the Respondent's apparent financial gain and benefit.

In addition, the Respondent's failure to provide a response or evidence of actual or contemplated good faith use, and the Respondent's obscuring of its identity, all support a finding of bad faith registration and use of the Domain Name by the Respondent.

Despite the Domain Name not currently resolving to an active webpage, the Panel does not find such non-use of the Domain Name as preventing a finding of bad faith in the circumstances of this proceeding. Specifically, the unchallenged evidence, which includes, inter alia, the distinctiveness of the Complainant's Marks, the composition of the Domain Name, the Respondent's failure to provide a response or evidence of actual or contemplated good faith use, and the Respondent's obscuring of its identity, all support a finding of bad faith registration and use of the Domain Name by the Respondent.

In light of the above, the Panel concludes that the Respondent registered, had used and uses the Domain Name to intentionally attract, for commercial gain, consumers of goods of the Complainant to the Respondent and its Internet activities by creating a likelihood of confusion with the Complainant and the Complainant's Marks as to the source, sponsorship, affiliation, or endorsement thereof and the goods offered thereon.

The Panel finds that the Respondent registered and is using the Domain Name in bad faith. Paragraph 4(a)(iii) of the Policy has been satisfied.

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 <danskoparadise.com> be transferred to the Complainant.

/Marylee Jenkins/

Marylee Jenkins

Sole Panelist

Date: June 10, 2024