

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. BostonJohn
Case No. D2024-1752

1. The Parties

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

The Respondent is BostonJohn, United States.

2. The Domain Name and Registrar

The disputed domain name <danskodeals.com> (the “Domain Name”) is registered with Realtime Register B.V. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2024. On April 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 29, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name that differed from the named Respondent (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 30, 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 30, 2024.

The Center verified that 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 May 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2024. The Respondent did not submit a response. Accordingly, the Center notified the Respondent’s default on May 27, 2024.

The Center appointed A. Justin Ourso III as the panelist in this matter on June 3, 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, an American limited liability company, is a manufacturer and international seller of comfort footwear, including clogs, boots, sandals, flats, and sneakers, and related goods, which has operated since 1990 under the name and mark DANSKO.

The Complainant owns United States registration, No. 2,712,957, for its DANSKO trademark, issued on May 6, 2003, for footwear in Class 25, namely, "casual outdoor shoes and work shoes for use in the health care, food service, equestrian, and general service industries"; United States registration, No. 2,712,953, for its DANSKO + design figurative trademark, issued on May 6, 2003, for the same goods in Class 25; and other registrations for its DANSKO mark and its DANSKO + design figurative trademark for related goods and for retail store services and on-line retail store services featuring footwear and apparel in Class 35.

The Complainant also owns the domain name <dansko.com>, which resolves to a web site from which it markets and sells its goods.

The Respondent registered the Domain Name, using a privacy service, on March 4, 2024, without any authorization from the Complainant. Prior to and just after the filing of the Complaint, and during the preparation of this Decision, the Domain Name resolved to a web site that offered competing footwear products and mimicked the Complainant's site, including branding the Respondent site with the Complainant's DANSKO + design figurative trademark.

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 Domain Name. Notably, the Complainant contends that the Complainant used and registered its distinctive trademarks long before the Respondent registered the Domain Name; the Domain Name resolves to a web site with infringing content, purporting to offer identical footwear, but in fact selling unauthorized or counterfeit footwear; the infringing site mimics the Complainant's site, including prominently displaying the Complainant's trademarks; and the Respondent is deliberately using the site to mislead Internet users for the Respondent's commercial gain, to profit from a likelihood of confusion with the Complainant, all of which establish that the Respondent registered and is using the Domain Name in opportunistic bad faith.

B. Respondent

The Respondent did not submit a response to the Amended Complaint.

6. Discussion and Findings

A complainant must prove three elements to obtain relief: (i) the domain name is identical or confusingly similar to a trademark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in the domain name; and (iii) the respondent registered and is using the domain name in bad faith. Policy, paragraph 4(a).

A. Identical or Confusingly Similar

On the first element, the Panel finds that the Domain Name is confusingly similar to the Complainant's registered DANSKO trademark. The trademark is readily recognizable within the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.7 and 1.8. Accordingly, the Panel concludes that the Complainant has proven the first element: the Domain Name is confusingly similar to a trademark in which it has rights.

B. Rights or Legitimate Interests

The Respondent has not claimed the existence of any circumstance under the Policy, paragraph 4(c), that demonstrates that a respondent has rights to, or legitimate interests in, a domain name. The Complainant, on the other hand, has shown that it established its trademark rights long before the Respondent registered the Domain Name; it has not authorized the Respondent to use its trademark; and the record contains no evidence that the Respondent is commonly known by the Domain Name. These constitute prima facie a showing that the Respondent lacks any rights or legitimate interests in the Domain Name under the Policy, paragraph 4(a)(ii), shifting the burden of production on this second element to the Respondent to come forward with relevant evidence proving rights or legitimate interests in the Domain Name.

[WIPO Overview 3.0](#), section 2.1. The Respondent has not submitted any evidence to rebut the prima facie showing.

Additionally, the Panel finds that the Respondent masked its identity by using a privacy service and the Registrar identified the Respondent with a name that does not resemble the Domain Name; the Respondent failed to respond to the Complaint; the Domain Name resolves to a web site that not only competes with the Complainant's web site, but also mimics it, including using its trademarks, which is not a bona fide commercial use, a noncommercial use, or a fair use of the Domain Name; and no other evidence exists of a bona fide commercial, noncommercial, or fair use of the Domain Name. To the contrary, the evidence shows an intended deceptive use for commercial gain. [WIPO Overview 3.0](#), sections 2.13.2 and 2.5.3.

Accordingly, the Panel concludes that the Complainant has proven the second element: the Respondent lacks rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

The Policy provides that the following circumstance is "evidence of the registration and use of a domain name in bad faith: [. . .] by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site . . ., by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site." Policy, paragraph 4(b)(iv).

The Complainant has proven that the Domain Name resolves to a web site that is designed to give the impression that it is the Complainant's, on which the Respondent offers for sale competing goods for commercial gain, under the Complainant's registered trademarks, including its figurative trademark, in effect passing off the site as associated with the Complainant, without disclosing or disclaiming any relationship with the Complainant. The Panel finds this conclusive evidence that the Respondent must have been aware of the Complainant's highly specific trademarks and of its rights in its marks at the time that the Respondent registered the Domain Name; the Respondent's registration and use of the Domain Name targeted the Complainant; and the Domain Name and the site are intended to attract, misleadingly and deceptively, customers and potential customers of the Complainant for the Respondent's commercial gain. Policy, paragraph 4(b)(iv); [WIPO Overview 3.0](#), sections 3.1.4, 3.2.1, and 3.2.2.

These findings compel the Panel to conclude that the Respondent intentionally registered the Domain Name in bad faith to take unfair advantage of the Complainant's trademarks and that the Respondent is using the Domain Name in bad faith intentionally to attract Internet users to its site for commercial gain by creating a likelihood of confusion with the Complainant's trademarks as to the source of the site or the source of the

goods offered on the site, in violation of the Policy, paragraph 4(b)(iv). Accordingly, the Panel concludes that the Complainant has proven the third element: the Respondent registered and is using the Domain Name in bad faith.

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 Domain Name <danskodeals.com> be transferred to the Complainant.

/A. Justin Ourso III/

A. Justin Ourso III

Panelist

Date: June 9, 2024