

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Henry Walsh
Case No. D2024-2117

1. The Parties

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

The Respondent is Henry Walsh, Germany.

2. The Domain Name and Registrar

The disputed domain name <dansko-schuhe-schweiz.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 May 22, 2024. On May 23, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 24, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named The Respondent (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 29, 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 May 30, 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 May 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was June 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 21, 2024.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on June 26, 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

According to information in the Complaint, the Complainant has provided since 1990 comfort footwear to customers around the world. The Complainant offers various footwear including boots, sandals, flats, and sneakers, all designed for long-wear and comfort. As testament to their comfort, the Complainant's footwear has been a top choice of medical professionals for over two decades.

The Complainant has registered several trademarks in the United States consisting of or including DANSKO, such as the word mark DANSKO, registration No. 3854991, registered as of September 28, 2010, and the device mark DANSKO, registration No. 2712953, registered as of May 6, 2003.

The registrations will jointly be referred to, in singular, as the "Trademark".

The Complainant also owns and uses the domain name <dansko.com>, registered on August 23, 1996.

The disputed domain name has been registered on May 9, 2024.

At the time the Complaint was filed the disputed domain name resolved to a website that prominently displays the above-mentioned device mark DANSKO and on the website footwear goods were offered purportedly identical to products offered by the Complainant.

5. Parties' Contentions

A. The 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 the disputed domain name is virtually identical to the Trademark apart from the descriptive terms "schuhe" (German for "shoes") and "schweiz" (German for "Switzerland"), which do nothing to distinguish the disputed domain name from the Trademark, and in fact increases the likelihood of confusion. This is especially true as the one additional term directly describes the Complainant's products and the second term is a country name. In fact, the addition of such a term in the disputed domain name has the potential to increase consumer confusion, as the term "shoes" is directly related to the Complainant's business and sale of the Complainant's shoes.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not affiliated with the Complainant, and there is no evidence to suggest that the Respondent has registered the disputed domain name to advance legitimate interests for the bona fide offering of legitimate goods or services.

The Respondent has been identified as "Henry Walsh". The Respondent is not commonly known as "Dansko", or any of the terms in the disputed domain name. Moreover, there presently is no evidence of any connection between the Respondent and the disputed domain name. The Complainant has not authorized, licensed, or endorsed the Respondent's use of its Trademark in the disputed domain name. Thus, there is no basis to find that the Respondent is commonly known by the disputed domain name.

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 fact, the disputed domain name resolves to a website with infringing content, prominently featuring the Trademark and purporting to offer identical footwear goods. The Respondent has made every effort to confuse consumers into believing the disputed domain name is related to the Complainant by offering footwear and footwear products via websites that are confusingly similar to the Complainant's bona fide website.

Because the Respondent anonymously registered the disputed domain name and the website displays unauthorized content infringing on the Complainant's DANSKO Trademark, the Respondent cannot claim to be commonly known by the disputed domain name or similar names related thereto. The Respondent has clearly made no effort to associate himself or herself with the disputed domain name and instead attempts to confuse consumers into believing the Respondent is associated with the Complainant.

Given the prominent use of DANSKO in the disputed domain name with the additional nondistinctive, descriptive elements of "schuhe" (shoes) and "schweiz" (Switzerland), consumers are likely to believe that the disputed domain name is related to, affiliated with, or otherwise sponsored by the Complainant and its DANSKO Trademark and this is not the case.

The Respondent's registration and its current use of the disputed domain name is in bad faith.

The Respondent registered the disputed domain name long after the Complainant first began advertising and using its Trademark in connection with its aforementioned goods and services, and after the Complainant obtained United States trademark registrations for its DANSKO Trademark.

The Respondent clearly had the Complainant in mind when registering the disputed domain name, because the Respondent had constructive notice of the Trademark. Upon viewing the website located at the disputed domain name, it becomes even more apparent that the Respondent had full knowledge of the Complainant's rights in the Trademark. This is evidenced not only by the confusingly similar disputed domain name which uses the DANSKO Mark in its entirety, but also by the fact that the Respondent imitates the Complainant as the website prominently displays the Complainant's DANSKO Mark in connection with the sale of unauthorized or counterfeit goods.

Moreover, it is apparent that the Respondent registered and uses the disputed domain name to trade-off of the Complainant's goodwill in its Trademark and to confuse consumers into believing that the Respondent's disputed domain name is affiliated or associated with the Complainant when that is not the case. Given that the Respondent also chose to attach descriptive terms at the end of the Complainant's federally registered DANSKO Mark in the disputed domain name, it is likely that the Respondent planned to use this domain name in attempts to fraudulently obtain personally identifiable information from individuals believing that the disputed domain is actually related to the Complainant. The Respondent has attempted to take commercial advantage of the Trademark and commercial reputation and to trade off the Complainant's goodwill. Bad faith is further evidenced by the Respondent concealing its true identity by registering the disputed domain name through a privacy service. Considered in light of the illegitimate selection and limited use of the disputed domain name, this supports the inference that the Respondent has knowingly engaged in the registration and use of the disputed domain name in bad faith.

The Complainant requests that the disputed domain name be transferred to the Complainant.

B. The Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a Complainant prove each of the following three elements in order to succeed in its Complaint:

- (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.

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. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.3.

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 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 name. Accordingly, the disputed domain name is confusingly similar to the Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, the descriptive terms "schuhe" (German for "shoes") and "schweiz" (German for "Switzerland")), 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 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.

There is no evidence that the Respondent is known by the “Dansko” designation or any similar designation. The Respondent used the disputed domain name for a website with apparently infringing content, prominently featuring the Trademark and purporting to offer identical footwear goods. Given the prominent use of DANSKO in the disputed domain name with the additional nondistinctive, descriptive elements of “schuhe” (shoes) and “schweiz” (Switzerland), consumers are likely to believe that the disputed domain name is related to, affiliated with, or otherwise sponsored by the Complainant and its DANSKO Trademark, and this is not the case. The Respondent therefore uses the disputed domain name to deliberately cause consumer confusion with the Complainant and its goods. Accordingly, the Respondent cannot establish any rights or legitimate interests in the disputed domain name that incorporate the Trademark and cannot prevail under the Policy.

For legitimate noncommercial or fair use, the record showed nothing.

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 Respondent registered the disputed domain name long after the Complainant first began advertising and using its Trademark in connection with its aforementioned goods and services, and after the Complainant obtained U.S. trademark registrations for the Trademark. The Respondent’s registration of a domain name that is identical to the Complainant’s Trademark with the addition of additional nondistinctive, descriptive terms (“schuhe” (German for “shoes”) and “schweiz” (German for “Switzerland”), referring to goods that the Complainant offers and sells and a country name, strongly suggests that the Respondent was aware of the Complainant and its Trademark. Therefore, the Panel finds that the disputed domain name was registered in bad faith.

The website to which the disputed domain name resolves, imitates the Complainant as the website prominently displays the Complainant’s DANSKO Trademark in connection with the sale of footwear goods that are identical to products offered by the Complainant. It is apparent that the Respondent registered and uses the disputed domain name to trade-off of the Complainant’s goodwill in its Trademark and to confuse consumers into believing that the disputed domain name is affiliated or associated with the Complainant which is not the case.

The Respondent has attempted to take commercial advantage of the Complainant’s Trademark and commercial reputation and to trade off the Complainant’s goodwill.

Bad faith is further evidenced by the Respondent concealing its true identity by registering the disputed domain name through a privacy service.

In this case, a consideration of the totality of factors compared to factors that Panels have consistently held to be relevant in finding bad faith, leads to a bad faith finding in this instance: including the degree of distinctiveness or reputation of the Complainant’s Trademark, the Respondent’s concealing its identity, the current bad faith use, and the implausibility of any good faith to which the Respondent registered or would use this domain name.

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-schuhe-schweiz.com> be transferred to the Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: July 3, 2024