

## **ADMINISTRATIVE PANEL DECISION**

Dansko, LLC v. Fashion Style Way  
Case No. D2024-2625

### **1. The Parties**

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

Respondent is Fashion Style Way, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <danskoco.com> is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 26, 2024. On June 27, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 28, 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 Respondent (Domain admin, Privacy Protect, LLC (PrivacyProtect.org)) and contact information in the Complaint. The Center sent an email communication to Complainant on July 2, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on the same date.

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 Respondent of the Complaint, and the proceedings commenced on July 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 30, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on July 31, 2024.

The Center appointed R. Eric Gaum as the sole panelist in this matter on August 9, 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

Complainant owns multiple U.S. trademark registrations for the mark DANSKO, including those shown in the chart below:

Mark	Reg. Date	Goods and Services
<b>DANSKO</b> RN: 3854991 SN: 77913037	September 28, 2010	(Int'l Class: 25) Socks
<b>DANSKO</b> RN: 4229847 SN: 85572046	October 23, 2012	(Int'l Class: 03) leather and suede cleaning and protecting preparations; shoe creams; shoe cleaner; sponges impregnated with shoe polish; shoe care cleaning kits comprised of shoe cleaners and shoe
<b>DANSKO</b> RN: 3265194 SN: 78974374	July 17, 2007	(Int'l Class: 25) footwear; component parts of footwear, namely, tips and heel pieces; and leather shoes and imitation leather shoes

Complainant also owns the domain name <dansko.com>. Complainant has provided certain of the goods and services described under the DANSKO mark since at least as early as 1990. Through use, advertisement, and promotion Complainant also has common law trademark rights in the DANSKO mark.

The disputed domain name was registered on May 29, 2024, and was used in connection with a website that imitates Complainant by prominently displaying Complainant's DANSKO marks in connection with the sale of unauthorized or counterfeit goods.

#### 5. Parties' Contentions

##### A. Complainant

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

Notably, Complainant contends that it has provided comfort footwear to customers around the world since 1990. Beginning with clog sales, Complainant now offers other footwear including boots, sandals, flats, and sneakers, all designed for long-wear and comfort. Complainant has gained significant common law trademark rights in its DANSKO marks, through the use, advertisement, and promotion of such marks in connection with its footwear goods. Complainant has also protected its DANSKO marks by filing for and obtaining trademark registrations in the United States Patent and Trademark Office.

Complainant has also spent significant resources protecting its DANSKO marks from infringement, including obtaining victories in other UDRP proceedings and the transfer to Complainant of other domain names incorporating DANSKO or a variation thereof.

Complainant contends that Respondent registered the disputed domain name in May 2024, long after Complainant first used and registered the DANSKO Marks. The disputed domain name is virtually identical to Complainant's DANSKO Marks and to the domain name, apart from the descriptive additional of "co", which does nothing to distinguish the disputed domain name from Complainant's DANSKO Marks, and in fact increases the likelihood of confusion. Complainant contends that the foregoing was done in an apparent attempt to trade off of Complainant's goodwill in its above-referenced DANSKO Marks and in complete disregard to Complainant's rights.

Complainant also contends that Respondent has no rights or legitimate interests in respect of the disputed domain name. Respondent is not affiliated with Complainant, and there is no evidence to suggest that Respondent has registered the disputed domain name to advance legitimate interests for the bona fide offering of legitimate goods or services. Respondent has anonymously registered the disputed domain name in an effort to evade the consequences of registering the disputed domain name for which he/she has no rights or legitimate interests.

Respondent has been identified as "Fashion Style Way". 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 Respondent and the disputed domain name. Complainant has not authorized, licensed, or endorsed Respondent's use of its DANSKO Marks in the disputed domain name .

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

Respondent registered the disputed domain name for what appears to be an attempt to syphon the goodwill and reputation from Complainant and its DANSKO Marks for commercial gain and to profit from the resulting consumer confusion. Such registration and use of the disputed domain name is in and of itself a form of opportunistic bad faith.

## **B. Respondent**

Respondent did not reply to 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.

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. One of the marks is DANSKO, U.S. Reg. No. 3854991. The entirety of this mark is reproduced 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 only difference between the mark that is reproduced within the disputed domain name is that it includes the descriptive additional of "co", whereas Complainant's trademark does not. The Panel finds that this difference is insignificant and irrelevant to the analysis.

Furthermore, although the addition of other terms, here “co”, 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 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 Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted 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.

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 disputed domain name resolves to a website with infringing content, prominently featuring Complainant’s DANSKO Marks and purporting to offer identical footwear goods. Respondent’s efforts to confuse consumers into believing the disputed domain name is related to Complainant by offering footwear and footwear products via websites that are confusingly similar to Complainant’s bona fide website is clearly a bad faith use of the domain name.

Panels have held that the use of a domain name for illegal activity here, claimed as applicable to this case: sale of counterfeit goods, impersonation/passing off, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds Respondent’s registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that 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 <danskoco.com> be transferred to Complainant.

*/R. Eric Gaum/*

**R. Eric Gaum**

Sole Panelist

Date: August 23, 2024