

## ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. 朱杰  
Case No. D2024-3051

### 1. The Parties

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

The Respondent is 朱杰, China.

### 2. The Domain Name and Registrar

The disputed domain name <danskoon.com> (the “Disputed Domain Name”) is registered with Xiamen 35.Com Technology Co., Ltd. (the “Registrar”).

### 3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on July 25, 2024. On July 26, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 29, 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 (Unknown) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 31, 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 in English on August 1, 2024.

On July 31, 2024, the Center informed the Parties in Chinese and English, that the language of the Registration Agreement for the Disputed Domain Name is Chinese. On August 2, 2024, the Complainant requested English to be the language of the proceeding. The Respondent did not submit any comment on the Complainant’s submission.

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 in English and Chinese of the Complaint, and the proceedings commenced on August 8, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 28, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 29, 2024.

The Center appointed Rosita Li as the sole panelist in this matter on September 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 is a United States company providing comfort footwear to worldwide customers since 1990. The Complainant initially sold clogs, and now offers a variety of footwear for long-wear and comfort including boots, sandals, flats, and sneakers. As submitted by the Complainant, its footwear has been preferred by medical professionals for more than two decades.

The Complainant submitted that it has acquired significant common law trademark rights in its DANSKO trademarks through use, advertisement, and promotion of such marks in connection with its footwear products.

The Complainant owns a number of United States trademark registrations featuring DANSKO as the dominant portion of the mark. The Complainant submitted a list of its DANSKO trademarks registered with the United States Patent and Trademark Office, as follows:

- 1) No. 3854991 for DANSKO, registered on September 28, 2010, covering class 25;
- 2) No. 4229847 for DANSKO, registered on October 23, 2012, covering classes 3, 18, 25, and 35;
- 3) No. 3265194 for DANSKO, registered on July 17, 2007, covering class 25;
- 4) No. 2712957 for DANSKO, registered on May 6, 2003, covering class 25;

(collectively, the "DANSKO Marks");

- 5) No. 4229969 for  , registered on October 23, 2012, covering classes 3, 18, 25, and 35;
- 6) No. 3265196 for  , registered on July 17, 2007, covering class 25;
- 7) No. 2712953 for  , registered on May 6, 2003, covering class 25;
- 8) No. 5638606 for DANSKO NATURAL ARCH, registered on December 25, 2018, covering class 25;
- 9) No. 6540779 for DANSKO NATURAL ARCH PLUS, registered on October 26, 2021, covering class 25; and
- 10) No. 4172633 for DANSKO XP, registered on July 10, 2012, covering class 25.

(together with DANSKO Marks, collectively, the "DANSKO Trademarks").

The Complainant submitted that it has spent significant resources to protect its DANSKO Trademarks from infringement. For instance, it has obtained favourable results in other UDRP proceedings and the transfer to the Complainant of other domains incorporating DANSKO or a variation.

The Disputed Domain Name was registered on July 10, 2024. At the time of filing the Complaint, the Disputed Domain Name resolved to a website prominently featuring the Complainant's DANSKO Trademarks and purporting to offer identical footwear goods.

As of the date of this Decision, the Disputed Domain Name resolved to an error page.

## 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:

- (i) The Disputed Domain Name is confusing similar to trademarks or service marks in which the Complainant has prior rights. The Complainant contends that:
  - the Disputed Domain Name incorporates the Complainant's registered DANSKO Marks;
  - the Disputed Domain Name is virtually identical to the Complainant's DANSKO Marks with the mere descriptive addition of the word "on". The addition of such term is insufficient to distinguish the Disputed Domain Name from the Complainant's DANSKO Marks, but further increases the likelihood of confusion;
  - the Disputed Domain Name's generic Top-Level Domain ("gTLD") ".com" failed to create a meaningful distinction from the Complainant's DANSKO Marks; and
  - consumers are likely to mistakenly believe the Disputed Domain Name is related, affiliated with, or otherwise sponsored by the Complainant and its DANSKO Marks.
  
- (ii) The Respondent has no legitimate interests in the Disputed Domain Name. The Complainant contends that:
  - the Respondent is not affiliated with the Complainant;
  - the Respondent has not registered the Disputed Domain Name to advance legitimate interests for the bona fide offering of legitimate goods or services;
  - the Respondent anonymously registered the Disputed Domain Name;
  - the Respondent is not commonly known as "Dansko" or any of the terms in the Disputed Domain Name;
  - there is no connection between the Respondent and the Disputed Domain Name;
  - the Complainant has never authorized the Respondent to use the DANSKO Trademarks; and
  - the Disputed Domain Name resolves to a website with infringing content, prominently featuring the Complainant's DANSKO Trademarks and purporting to offer identical footwear goods. The Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name as the Respondent's use of the Disputed Domain Name is to confuse consumers into believing the Disputed Domain Name is related to the Complainant by offering footwear products via websites that are confusingly similar to the Complainant's bona fide website.
  
- (iii) The Disputed Domain Name has been registered and is being used in bad faith. The Complainant contends that:
  - the Respondent has constructive knowledge of the DANSKO Trademarks as the Complainant owns trademark registrations of the DANSKO Trademarks and the Disputed Domain Name contains the identical DANSKO Marks in their entirety;
  - the Respondent has full knowledge of the Complainant's rights in the DANSKO Trademarks as the Disputed Domain Name uses the DANSKO Marks which is confusingly similar, and the Respondent imitates the Complainant as the website prominently displays the Complainant's DANSKO Trademarks in connection with the sale of unauthorized or counterfeit goods;
  - the Respondent concealed its true identity by registering the Disputed Domain Name through a privacy service;
  - the Respondent registered the Disputed Domain Name long after the Complainant first began advertising and using its DANSKO Trademarks in connection with its goods and services and after the Complainant obtained United States trademark registration for its DANSKO Trademarks; and

- the Respondent registered to draw off of the Complainant's goodwill in its DANSKO Trademarks and to confuse consumers to believe the Disputed Domain Name is affiliated or associated with the Complainant albeit it is not the case.

## **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 complainant must satisfy each of the following three elements in a 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.

### **6.1 Language of the Proceeding**

The language of the Registration Agreement for the Disputed Domain Name is Chinese. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint was filed in English. The Complainant requested that the language of the proceeding be English for several reasons, including the fact that there is evidence of the Respondent's ability to understand English. It was submitted that the website at the Disputed Domain Name is entirely in English, and the Respondent also advertises its products in English, including descriptive phrases with all prices listed in USD. The Complainant further submitted that the Respondent purposefully uses English on its site to benefit from the Complainant's DANSKO Trademarks' reputation, potentially misleading consumers.

The Respondent did not make any submissions with respect to the language of the proceeding.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1).

Having considered the above circumstances and the fact that:

- (i) According to the screenshot of the webpage under the Dispute Domain Name provided in the Complaint, English is the only language for the content displayed on the webpage under the Disputed Domain Name; and
- (ii) Even though the Center has used English and Chinese in the relevant correspondences with the Respondent, the Respondent has not filed any response and did not indicate preference on the language of the proceeding.

The Panel determines under paragraph 11(a) of the Rules that the language of the proceeding shall be English.

## 6.2 Substantive Issues

### 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 DANSKO Marks are reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the DANSKO Marks for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms, in this case, "on", 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 DANSKO Marks 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 a complainant, UDRP 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.

In accordance with [WIPO Overview 3.0](#), section 2.5.1, where a domain name consists of a trademark plus an additional term (at the second or top level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. The Disputed Domain Name has included the Complainant's DANSKO Marks in their entirety, the additional term "on" does not help eliminate the likelihood of confusion. The Complainant did not authorize, licence, or endorse the Respondent to use its DANSKO Trademarks, yet, the Respondent reproduced the Complainant's DANSKO Trademarks on the website under the Disputed Domain Name purporting to offer identical footwear goods. Such action together with the choice of words in the Dispute Domain Name suggest that the Respondent was trying to impersonate or suggest sponsorship or endorsement by the Complainant. Such use of the Disputed Domain Name by the Respondent cannot be regarded as any legitimate noncommercial or fair use.

The Panel accepts the Complainant's submissions that the Respondent does not appear to be commonly known by the Disputed Domain Name. The Panel notes that the Respondent is not affiliated with the

Complainant nor has the Complainant licensed or authorized the Respondent to use the Complainant's DANSKO Trademarks.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 time of registration of the Disputed Domain Name in 2024 is well after the registration of the Complainant's DANSKO Trademarks. The Complainant has accrued substantial goodwill and recognition over the years since its establishment, and has been renowned for its footwear designed for long-wear and comfort. In particular, the Complainant has produced evidence that its footwear is preferred by medical professionals. The Panel agrees that the Complainant's well-known reputation has been considered and acknowledged by earlier UDRP proceedings and domain name disputes decision as provided by the Complainant to the Panel in its submissions.

Considering the reputation of the Complainant and the Complainant's DANSKO Trademarks, it would not be plausible for the Respondent to claim that it was unaware of the Complainant and the DANSKO Trademarks. The Panel is prepared to infer that the Respondent knew or should have known that its registration of the Disputed Domain Name would be confusingly similar to the DANSKO Trademarks. ([WIPO Overview 3.0](#), section 3.2.2.). Accordingly, the Panel finds that the Respondent's registration of the Disputed Domain Name, which is confusingly similar to the DANSKO Trademarks, which are well-known and registered earlier, is a clear indication of bad faith.

UDRP panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off, constitutes bad faith. ([WIPO Overview 3.0](#), section 3.1.4.) Considering the appearance and use of the Disputed Domain Name website to sell goods purporting to be under the DANSKO brand, the Panel is prepared to find that the Respondent has attempted to pass off as an official website of the Complainant and/or pass off as being affiliated with the Complainant, to benefit from the reputation and goodwill of the Complainant's DANSKO brand and trademarks. The Panel considers that the Respondent registered and used the Disputed Domain Name primarily for the purpose of attempting to attract, for commercial gain, Internet users to the Disputed Domain Name website by creating a likelihood of confusion with the Complainant's DANSKO Trademarks as to the source, sponsorship, affiliation, or endorsement of the Disputed Domain Name website or of the product(s) on the Disputed Domain Name website. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

In light of the above, 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 <danskoon.com> be transferred to the Complainant.

*/Rosita Li/*

**Rosita Li**

Sole Panelist

Date: September 17, 2024