

## **ADMINISTRATIVE PANEL DECISION**

Dansko, LLC v. DODSONCLAYTON

Case No. D2024-3130

### **1. The Parties**

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

The Respondent is DODSONCLAYTON, United States.

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

The Disputed Domain Name <danskofootwearhub.shop> 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 July 30, 2024. On July 31, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 1, 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 Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 6, 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 August 6, 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 August 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 27, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 28, 2024.

The Center appointed Colin T. O'Brien as the sole panelist in this matter on September 4, 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**

Since 1990, Complainant offers footwear including boots, sandals, flats, and sneakers.

Complainant has 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 ("USPTO") including but are not limited to the following:

DANSKO (Reg. No: 3854991, Registered September 28, 2010) for "socks" in Class 25; DANSKO RN: 4229847, Registered October 23, 2012 for "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 brushes" in Class 03; "all purpose carrying bags; handbags" in Class 18; "clothing, namely shirts in Class 25 "retail footwear store services; on-line retail store services featuring footwear and apparel" in Class 35; and DANSKO (Reg. No. 3265194, Registered July 17, 2007) for "footwear; component parts of footwear, namely, tips and heel pieces; and leather shoes and imitation leather shoes" in Class 25. (collectively "DANSKO Marks")

The Disputed Domain Name was registered on July 19, 2024, and it resolves to a website prominently featuring Complainant's DANSKO Marks and purporting to offer identical footwear goods.

#### **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 the Disputed Domain Name is virtually identical to Complainant's DANSKO Marks and domain name apart from the descriptive phrase "footwear hub", which does nothing to distinguish the Disputed Domain Name from Complainant's DANSKO Marks, and in fact increases the likelihood of confusion, as it directly describes Complainant's goods – footwear.

Respondent is not sponsored by or affiliated with Complainant in any way. Nor has Complainant given Respondent permission, license or authorization to use Complainant's trademarks in any manner, including in domain names. Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests.

Respondent registered the Disputed Domain Name on July 19, 2024, which is significantly after Complainant's registrations of its DANSKO trademarks with the USPTO, Complainant's first use in commerce of the DANSKO trademark in 1990, and Complainant's registration of its domain name in 1996. Thus, by the time Respondent registered the Disputed Domain Name, Complainant had already established goodwill and reputation on the DANSKO trademarks.

As a result, the Disputed Domain Name, which is a supplemented version of Complainant's trademarks, effectively impersonates or suggests sponsorship or endorsement by Complainant.

Given the Disputed Domain Name's composition and references to the goods and services description of its trademark, it is not possible to conceive of a plausible situation in which Respondent would have been unaware of Complainant's brands at the time the Disputed Domain Name was registered.

The Disputed Domain 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 long after Complainant first began advertising and using its DANSKO Marks in connection with its aforementioned goods and services, and after Complainant obtained United States trademark registrations for its DANSKO Marks.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

The Complainant has demonstrated it owns registered trademark rights in its DANSKO mark. The additions of the phrase "footwearhub" does not prevent the Complainant's trademark from being recognizable in the Disputed Domain Name. The generic Top-Level Domain ("gTLD") ".shop" is viewed as a standard registration requirement and as such may be disregarded under the first element confusing similarity test.

See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8, and *Hoffmann-La Roche AG v. Domain Admin, Privacy Protection Service INC d/b/a PrivacyProtect.org / Conan Corrigan*, WIPO Case No. [D2015-2316](#).

Accordingly, the Disputed Domain Name is confusingly similar to a mark in which the Complainant has rights.

### **B. Rights or Legitimate Interests**

The Complainant has presented a prima facie case that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name and has not been commonly known by the Disputed Domain Name. The fact that the Respondent obtained the Disputed Domain Name years after the Complainant started selling its goods under the DANSKO mark and <danskofootwearhub.shop> domain name indicates that the Respondent sought to piggyback on the DANSKO mark for illegitimate reasons.

After a complainant has made a prima facie case, the burden of production shifts to a respondent to present evidence demonstrating rights or legitimate interests in the domain name. See, e.g., *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#).

Here, the Respondent has provided no evidence of any rights or legitimate interests in the Disputed Domain Name.

Moreover, the evidence provided by the Complainant shows that the Disputed Domain Name resolves to an active website featuring the Complainant's trademark and what purport to be the Complainant's goods. While resellers and distributors may have limited rights to use a complainant's trademark for nominative purposes, the lack of any authorization by the Complainant and similarly, the lack of any information on the Disputed Domain Name as to the website's lack of authorization or relation to the Complainant which creates an impression of some kind of official affiliation with the Complainant, renders any fair use safe haven inapplicable in this instance. See section 2.8 of the [WIPO Overview 3.0](#).

Above all, the nature of the Disputed Domain Name incorporating the Complainant's trademark in its entirety, carries a high risk of implied affiliation, especially when considering the impersonating nature of the content exhibited at the Disputed Domain Name, and as such cannot constitute fair use. See section 2.5.1 of the [WIPO Overview 3.0](#).

While circumstantial, the lack of authorization and the discounted prices found at the Disputed Domain Name suggest that, should any products be sold at the Disputed Domain Name, they may be counterfeit. Noting the above considerations, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant. The Panel finds that such use cannot be qualified as a bona fide offering of goods or services or legitimate noncommercial or fair use (see section 2.13 of the [WIPO Overview 3.0](#)). Rather, such illegal use can never confer rights or legitimate interests upon a respondent.

In the absence of any evidence rebutting the Complainant's prima facie case indicating the Respondent's lack of rights or legitimate interests in respect of the Disputed Domain Name, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

The Panel finds that the Complainant has established the Respondent's bad faith registration and use of the Disputed Domain Name. Paragraph 4(b)(iv) of the Policy states that evidence of bad faith may include a respondent's use of a domain name to intentionally attempt to attract Internet users, for commercial gain.

Due to the incorporation of the DANSKO mark, the Disputed Domain Name resolving to an active website seemingly impersonating the Complainant by featuring the Complainant's trademark and images of the Complainant's trademarked goods, it is inconceivable that the Respondent registered the Disputed Domain Name adding the phrase "footwearhub" without knowledge of the Complainant. The Disputed Domain Name was used for a website which allegedly claimed to sell products identical to those offered by the Complainant and bearing its trademarks, establishing that the Respondent knew of and targeted the Complainant with the intention of misleading unsuspecting Internet users for its presumed commercial gain.

The facts establish a deliberate effort by the Respondent to cause confusion with the Complainant for commercial gain. Such an impersonation of the Complainant is sufficient to establish the Respondent's bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)). Under these circumstances, the Panel finds no plausible good faith reason for the Respondent's conduct and concludes that the Disputed Domain Name was registered and used in bad faith.

While circumstantial, the lack of authorization and the severely discounted prices found at the Disputed Domain Name suggest that, should any products be sold at the disputed domain names, they are likely to be counterfeit. Noting the above considerations, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows the Respondent has attempted to pass itself off as the Complainant.

The Panel finds that the Complainant has satisfied paragraph 4(a)(iii) 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 <danskofootwearhub.shop> be transferred to the Complainant.

*/Colin T. O'Brien/*

**Colin T. O'Brien**

Sole Panelist

Date: September 18, 2024