

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. KathleenCarter
Case No. D2024-3248

1. The Parties

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

Respondent is KathleenCarter, US.

2. The Domain Name and Registrar

The disputed domain name <danskodiscount.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 August 7, 2024. On August 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 9, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to Complainant on August 13, 2024, providing the registrant and contact information disclosed by the Registrar and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 14, 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 Respondent of the Complaint, and the proceedings commenced on August 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was September 9, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on September 17, 2024.

The Center appointed Jeffrey D. Steinhardt as sole panelist in this matter on September 23, 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 has marketed and sold footwear and other apparel under its well-known DANSKO trademarks since the early 1990s.

Complainant's many trademark registrations for the DANSKO mark include US Trademark Registration No. 3,854,991, registered September 28, 2010, in class 25 with a first use in commerce date of June 2010 and US Trademark Registration No. 4,229,847, registered October 23, 2012, in classes 3, 18, 25, and 35 with a first use in commerce date of 1998.

The disputed domain name was registered on July 31, 2024, and resolves to a website displaying Complainant's DANSKO trademarks and offering purchases of footwear.

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.

Complainant avers that the disputed domain name resolves to a website with infringing content which prominently features Complainant's DANSKO marks and purports to offer identical footwear goods. The Complaint annexes screen captures to the Complaint supporting these allegations. Complainant further alleges that it is likely that Respondent plans to use the disputed domain name fraudulently to obtain personally identifiable information from individuals believing that the disputed domain name is related to Complainant.

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.

The entirety of the 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.

Although the addition of other terms may bear on assessment of the second and third elements (here, the term “discount”), the Panel finds the addition of the 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 that the first element of Policy paragraph 4(a) 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 that 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 accepts Complainant’s evidence that the disputed domain name resolves to a website impersonating Complainant’s website and offering likely counterfeit or unauthorized products using Complainant’s DANSKO trademarks.

Panels have held that the use of a domain name for illegal activity (in this case, the sale of counterfeit goods, 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 paragraph 4(a) 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 Respondent registered a domain name that included the long-established DANSKO trademark. Without authorization, Respondent uses the disputed domain name to route to a website that impersonates Complainant’s business, offering likely counterfeit and unauthorized goods.

The Panel finds that Respondent intentionally attempted to attract Internet users to Respondent’s website for commercial gain, by creating a likelihood of confusion with Complainant’s mark. See Policy paragraph 4(b)(iv).

Panels have held that the use of a domain name for illegal activity such as the 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 paragraph 4(a) 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 <danskodiscount.shop> be transferred to Complainant.

/Jeffrey D. Steinhardt/

Jeffrey D. Steinhardt

Sole Panelist

Date: October 4, 2024