

## **ADMINISTRATIVE PANEL DECISION**

Dansko, LLC v. Bergeron Richard  
Case No. D2024-3667

### **1. The Parties**

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

Respondent is Bergeron Richard, United States.

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

The disputed domain name <danskowomensfootwear.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 September 10, 2024. On September 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 12, 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 Complainant on September 16, 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 September 16, 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 September 20, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 11, 2024.

The Center appointed Frederick M. Abbott as the sole panelist in this matter on October 17, 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 is a limited liability company organized in the State of Delaware, United States. It is owned by its employees. Complainant markets and sells various footwear products around the world. Among its product lines are shoes designed for healthcare professionals. Complainant operates a commercial website at “www.dansko.com” where it advertises and sells its footwear products.

Complainant is the owner of registrations for its word, and word and design, trademark DANSKO on the Principal Register of the United States Patent and Trademark Office (USPTO), including word registration number 4,229,847, registration dated October 23, 2012, in International Classes (ICs) 3, 18, 25 and 35, covering, inter alia, leather and suede cleaning protection preparations; carrying bags and handbags, hats and shirts, retail footwear and apparel store services, and online retail store services, as further specified; word registration number 3,854,991, registration dated September 28, 2010, in IC 25, covering socks, and; word and design registration number 4,229,969, registration dated October 23, 2012, in ICs 3, 18, 25 and 35, covering, inter alia, leather and suede cleaning protection preparations; carrying bags and handbags, hats and shirts, retail footwear and apparel store services, and online retail store services, as further specified.<sup>1</sup>

According to the registrar’s verification, Respondent is registrant of the disputed domain name. According to the Whois report, the disputed domain name was registered on August 8, 2024. There is no indication on the record of this proceeding that any party other than Respondent has owned or controlled the disputed domain name since its initial creation date.

Respondent has directed the disputed domain name to a website at which it offers for sale items purported to be Complainant’s branded footwear products. The home page of Respondent’s website prominently displays Complainant’s trademark, along with photographs (and prices) of shoes identified as DANSKO products. Respondent’s website does not seek to replicate the appearance of Complainant’s “official” site (i.e., it is not a clone). Footwear identified with Complainant’s brand and displayed on the screenshot of Respondent’s website furnished by Complainant is listed at a 30% discount as a “flash sale” promotion. Respondent’s website provides information regarding checkout and related payment options. There is no evidence on the record of this proceeding regarding whether Respondent is delivering products that Internet users order. Complainant indicates that it has no relationship, commercial or otherwise, with Respondent, and Complainant states that the products being offered for sale by Respondent are “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 alleges that it owns rights in DANSKO trademarks and that the disputed domain name is confusingly similar to its trademarks.

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<sup>1</sup> Complainant has provided evidence of additional registrations at the USPTO including several owned by a Delaware corporation, Dansko, Inc. The Delaware corporation is likely an affiliated entity to the LLC that is Complainant. For purposes of this Decision it is not necessary for the Panel to refer to the trademark registrations owned by this other entity.

Complainant argues that Respondent lacks rights or legitimate interests in the disputed domain name because: (1) Respondent registered the disputed domain name using a privacy service in an attempt to disguise its identity; (2) Respondent is not commonly known by Complainant's trademarks or any of the terms in the disputed domain name; (3) Complainant has not authorized, licensed or endorsed Respondent's use of its trademarks in the disputed domain name; (4) Respondent's creation of a confusingly similar website with infringing content is evidence of lack of rights or legitimate interests, and; (5) Respondent is not making a bona fide offer of goods or services using the disputed domain name, nor is its use a legitimate noncommercial or fair use.

Complainant contends that Respondent registered and is using the disputed domain name in bad faith because: (1) Respondent's website is being used for fraudulent activity; (2) Respondent registered and used the disputed domain name with full knowledge of Complainant's rights in its trademarks; (3) Respondent attempted to disguise its identity by using a privacy service, and; (4) it is likely that Respondent plans to use the disputed domain name to fraudulently obtain personally identifiable information from individuals using its website.

Complainant requests the Panel to direct the Registrar to transfer the disputed domain name to Complainant.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

The Center formally notified the Complaint to Respondent at the email and physical addresses provided in its record of registration. Courier delivery to the address provided by Respondent in its record of registration was successful. There is no indication of difficulties regarding email transmission. The Center took those steps prescribed by the Policy and the Rules to provide notice to Respondent, and those steps are presumed to satisfy notice requirements.

Paragraph 4(a) of the Policy sets forth three elements that must be established by a complainant to merit a finding that a respondent has engaged in abusive domain name registration and use and to obtain relief. These elements are that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights;
- (ii) 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.

### **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 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. Complainant has referred to its various trademark registrations, including for certain DANSKO-formative trademarks, as the "DANSKO marks". For purposes of this proceeding, the Panel need only consider and refers hereinafter only to the registered word trademark DANSKO.

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, here “womens”, “footwear” and the generic top-level domain (gTLD) “.shop”, 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 Complainant, panels have recognized that proving 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 Respondent. As such, where Complainant, as here, makes out a prima facie case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on Complainant). If Respondent, as here, fails to come forward with such relevant evidence, 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.

Complainant’s DANSKO-branded footwear products appear to be offered through a variety of online and other retail outlets separate from Complainant’s “official” DANSKO website.<sup>2</sup> Representative vendors include Zappos and The Walking Company, each a major United States footwear retailer. The Panel assumes that the other online (and physical) retailers offering Complainant’s branded products are doing so under legal authorization from Complainant or are otherwise securing their inventory of Complainant’s branded products through legitimate means.<sup>3</sup> Respondent, by using the disputed domain name incorporating Complainant’s trademark, without authorization from Complainant, and by prominently displaying Complainant’s trademark at the top of its website, creates the appearance -- unlike the other presumably authorized third-party retailers -- that its website is owned and/or operated by Complainant, and that the products displayed on its website are being offered by Complainant<sup>4</sup>. There is no evidence on Respondent’s website to indicate that Respondent is not affiliated with Complainant. In sum, use of Complainant’s trademark by Respondent to create the false impression that it is owned, controlled and/or affiliated with Complainant takes unfair advantage of Complainant’s goodwill and the value of its trademark rights. This does not constitute fair use of Complainant’s trademark or a bona fide offering of goods.

As noted previously, Respondent has not responded to the Complaint and has not attempted to legitimize its use of Complainant’s trademark in the disputed domain name.

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<sup>2</sup>The Panel identified various other retail websites offering Complainant’s product in a routine search undertaken to compare Complainant’s “official” website with Respondent’s website identified by the disputed domain name.

<sup>3</sup>The Panel notes by way of illustration that under US law a party that first sells a trademarked good in commerce no longer controls subsequent downstream sales. Sale of a “branded” product in a secondary market may be legitimate provided that the seller does not hold itself out as the trademark owner.

<sup>4</sup> The source of the products being offered by Respondent is not identified in the Complaint.

Complainant has established that Respondent lacks rights or legitimate interests in the disputed domain name.

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 Respondent was manifestly aware of Complainant's trademark when it registered and used the disputed domain name as it is purporting to offer footwear under Complainant's brand on its website.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Respondent registered and used the disputed domain name confusingly similar to Complainant's trademark to direct Internet users to a website where Respondent is offering footwear products identified by Complainant's brand for sale without authorization from Complainant. Although there are circumstances in which third parties may legitimately offer branded goods for sale without authorization from the trademark owner, they may not do so in a way that gives the false impression that the goods are being offered for sale by the trademark owner. That is what Respondent has done in this case, whether such goods are "counterfeit" or not. Respondent has not attempted to justify its conduct.

Such use by Respondent constitutes registering and using for commercial gain the disputed domain name by creating Internet user confusion regarding Complainant acting as source, sponsor, affiliate or endorser of Respondent's website. Such conduct constitutes abusive domain name registration and use within the meaning of paragraph 4(b)(iv) of 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 <danskowomensfootwear.shop> be transferred to Complainant.

*/Frederick M. Abbott/*

**Frederick M. Abbott**

Sole Panelist

Date: October 28, 2024