

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. wang han
Case No. D2024-3668

1. The Parties

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

The Respondent is wang han, U.S.

2. The Domain Name and Registrar

The disputed domain name <danskowomenshoes.shop> (the “Disputed Domain Name”) is registered with Spaceship, Inc. (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 14, 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 September 16, 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 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 the Respondent of the Complaint, and the proceedings commenced on September 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 14, 2024.

The Center appointed Purvi Patel Albers as the sole panelist in this matter on October 24, 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 U.S. limited liability company organized in the state of Pennsylvania. It has been selling footwear since 1990. The Complainant began by exclusively selling clogs, but it has expanded its offerings to include boots, sandals, flats, sneakers, and more. The Complainant operates an online retail store for its shoes at the domain name <dansko.com>.

The Complaint includes evidence of ownership of U.S. trademark registrations for DANSKO, including:

- U.S. Registration No. 4,229,847 for DANSKO (registered October 23, 2012) for use in connection with, inter alia, “on-line retail store services featuring footwear and apparel,”
- U.S. Registration No. 3,265,194 for DANSKO (registered July 17, 2007) for use in connection with, inter alia, “footwear,” and
- U.S. Registration No. 2,712,957 for DANSKO (registered May 6, 2003) for use in connection with “footwear, namely, casual outdoor shoes and work shoes for use in the health care, food service, equestrian, and general service industries.”

The Disputed Domain Name was created on August 6, 2024. It resolves to a website purportedly selling footwear products that are identical to those sold by the Complainant. The website also features prominent use of the DANSKO mark to identify the source of the goods and the online retail store.

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 it has rights in the DANSKO mark due in part to the registrations cited above. The Complainant further asserts that the Disputed Domain Name is confusingly similar to the DANSKO mark because it incorporates the mark and merely adds the descriptive phrase “women shoes.”

The Complainant also contends that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Complainant asserts that the Respondent is not affiliated with the Complainant and is not commonly known by the terms in the Disputed Domain Name. The Complainant further asserts that the Respondent is not using the Disputed Domain Name in connection with a bona fide offering of goods or services nor in a legitimate non-commercial or fair manner because the Respondent is using the Disputed Domain Name to confuse consumers by suggesting it is affiliated with the Complainant.

Finally, the Complainant contends that the Disputed Domain Name was registered and is being used in bad faith because, among other things, the Respondent attempted to trade off of the Complainant’s goodwill by confusing consumers into believing that the Disputed Domain Name and its content are somehow affiliated with the Complainant.

B. Respondent

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

6. Discussion and Findings

In accordance with paragraph 4(a) of the Policy, to succeed in this dispute, the Complainant must establish that:

- i. the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights,
- 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.

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.

The Complainant has shown rights in respect of a trademark for purposes of the Policy through various trademark registrations, including those cited above. Thus, the Complainant has provided prima facie evidence of trademark rights. [WIPO Overview 3.0](#), section 1.2.1.

The Panel also finds that the Disputed Domain Name is confusingly similar to the Complainant's DANSKO mark. Where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing. [WIPO Overview 3.0](#), section 1.7. Here, the entirety of the mark is reproduced within the Disputed Domain Name, with the addition of the terms "women shoes." The Panel finds that the mark is clearly recognizable within the Disputed Domain Name and the Disputed Domain Name is thus confusingly similar to the mark.

Although the addition of the other terms, namely, "women shoes," 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 DANSKO mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8 ("Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element").

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 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 the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name. The Disputed Domain Name was registered long after the Complainant received its registrations for the DANKSO mark, and the

Complainant has not authorized the Respondent to use said mark or register a domain name incorporating it. There is also no evidence showing that the Respondent is, or has been, known as “danskowomenshoes” or similar.

Furthermore, the Complainant has shown that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Respondent appears to be using the Complainant’s mark in an effort to imitate the Complainant and trick consumers into believing that the Respondent’s site is affiliated with the Complainant. Panels have held that the use of a domain name for illegitimate activity, such as claimed impersonation, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

While there are circumstances in which a reseller or distributor of another’s goods could have a legitimate interest in a confusingly similar domain name, the fact that the Disputed Domain Name was registered using a privacy shield and there is no evidence of any relationship between Respondent and Complainant supports Complainant’s contentions. [WIPO Overview 3.0](#), section 2.8.1 (iii) (“the site must accurately and prominently disclose the registrant’s relationship with the trademark holder”).

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.

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 non-exhaustive circumstances 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 particular, paragraph 4(b)(iv) of the Policy provides that the intentional use of a domain name to attract users to a website for commercial gain, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the website, establishes bad faith in the registration and use of the domain name. In the present case, the Panel notes that the Respondent is using the Disputed Domain Name for its own commercial gain by creating a likelihood of confusion as to the source or affiliation of its website. The Respondent appears to be using the Complainant’s DANSKO mark to trick consumers into believing the Disputed Domain Name is somehow associated with the Complainant. The Respondent attempts to profit off the Complainant’s reputation by purporting to sell identical goods in connection with an online site featuring the Complainant’s mark.

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 <danskowomenshoes.shop> be transferred to the Complainant.

/Purvi Patel Albers/

Purvi Patel Albers

Sole Panelist

Date: November 7, 2024