

## **ADMINISTRATIVE PANEL DECISION**

Dansko, LLC v. Dominik Walter, Muhammad Gardner, Web Commerce Communications Limited, Client Care  
Case No. D2023-1559

### **1. The Parties**

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

The Respondents are Dominik Walter, Germany, Muhammad Gardner, Germany, and Web Commerce Communications Limited, Malaysia.

### **2. The Domain Names and Registrars**

The disputed domain names are <dansko-ca.com>, <danskoclogscanada.com>, and <danskosandalsoutlet.com> (collectively, the "Disputed Domain Names").

The Disputed Domain Name <dansko-ca.com> is registered with Key-Systems GmbH.

The Disputed Domain Name <danskoclogscanada.com> is registered with Mat Bao Corporation.

The Disputed Domain Name <danskosandalsoutlet.com> is registered with Alibaba.com Singapore E-Commerce Private Limited.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 10, 2023. On April 11, 2023, the Center transmitted by email to the Registrars its requests for registrar verification in connection with the Disputed Domain Names. On April 12 and April 13, 2023, the Registrars transmitted by email to the Center their verification responses disclosing the registrants and contact information for the Disputed Domain Names which differed from the named Respondent (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 14, 2023 providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 18, 2023.

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 Respondents of the Complaint, and the proceedings commenced on April 21, 2023. In accordance with the Rules, paragraph 5, the due date for a Response was May 11, 2023. The Respondents did not submit any response. Accordingly, the Center notified the Respondents’ default on May 15, 2023.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on May 31, 2023. 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 comfort footwear corporation based in the U.S. founded in 1990. It produces footwear including clogs, boots, sandals, flats, and sneakers, all designed for long-wear and comfort.

According to the Complaint, the Complainant has used word and figurative trademarks for or containing DANSKO (“the Complainant’s Trademark”) in the U.S.

The relevant trademarks include, *inter alia*, U.S. Trademark Registration No. 2712953 for the figurative mark DANSKO and U.S. Trademark Registration No. 2712957 for the word mark DANSKO in Class 25, both registered on May 6, 2003. The Panel notes that these figurative and word marks are also registered under International Registration No. 899916 and 899917 in Class 25 as of September 22, 2006.

The Complainant’s Trademark is also fully incorporated in the Complainant’s domain name <dansko.com> which resolves to the Complainant’s website at “www.dansko.com” (the “Complainant’s Website”).

The Disputed Domain Names <danskoclogscanada.com>, <dansko-ca.com>, and <danskosandalsoutlet.com> were registered on May 13, May 14, and September 27, 2022 respectively, almost 20 years after the Complainant first registered the Complainant’s Trademark. The Disputed Domain Names used to resolve to websites featuring the Complainant’s Trademark and purporting to offer DANSKO products for sale (the “Websites”). Currently, the Disputed Domain Names do not resolve to any active websites.

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant’s primary contentions can be summarized as follows:

- (a) The Disputed Domain Names are identical or confusingly similar to the Complainant’s Trademark. The Complainant’s Trademark is reproduced in its entirety in each of the Disputed Domain Names. Apart from the Complainant’s Trademark, the only elements in the Disputed Domain Names are the word(s) “ca”, “clogs”, “Canada”, “sandals”, and “outlet” respectively, which do not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant’s Trademark.
- (b) The Respondents have no rights or legitimate interests in the Disputed Domain Names. The Respondents have not obtained any authorization from the Complainant to use the Complainant’s Trademark as part of a domain name or otherwise. The Respondents have shielded their identities and the particulars provided to the Registrars appear to be fictitious. Furthermore, the Complainant believes that the Respondents have been passing off the Websites as belonging to the Complainant

by using the Complainant's Trademark and purporting to offer identical footwear goods. There is a clear intent to confuse consumers into believing that the Respondents and the Disputed Domain Names are associated with the Complainant. Such use of the Disputed Domain Names cannot be considered as legitimate non-commercial or fair use without the intent for commercial gain.

- (c) Both the Respondents' registration and use of the Disputed Domain Names establish their bad faith. Given the history of the DANSKO brand and the goodwill and reputation that the Complainant has acquired in the Complainant's Trademark, the Respondents must have been fully aware of the existence of the Complainant's rights in the Complainant's Trademark when the Respondents registered and used the Disputed Domain Names. Before the Websites became inactive, the Respondents attempted to pass off the Websites as the Complainant's Website in order to attract Internet users to the Websites for the sale of competing and suspected counterfeit goods. Moreover, the Respondents registered the Disputed Domain Names using a privacy shield to conceal their identities.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **6.1 Multiple Respondents**

Section 4.11.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) provides that where a complaint is filed against multiple respondents, panels will take into account whether (i) the domain names or corresponding websites are subject to common control, and (ii) the consolidation would be fair and equitable to all parties.

In this case, the Panel notes, amongst others, that:

- (i) <dansko-ca.com> and <danskoclogscanada.com> were registered within one day of each other, and <danskosandalsoutlet.com> was registered three days before <dansko-ca.com> was updated.
- (ii) The Disputed Domain Names used to resolve to the Websites which contained nearly identical content and layout and had a very familiar look and feel as the Complainant's Website. Moreover, the Websites shared the same "About Us" page.
- (iii) The Disputed Domain Names have the same Autonomous System Number and the same, or very similar, IP addresses.

The Panel also notes that the Respondents did not provide any substantive Response to the Complaint. In light of the above, the Panel accepts the Complainant's contentions and finds that the Complainant has established that the Disputed Domain Names are more likely than not under the common control of the Respondents, and it would be fair and equitable to all Parties and procedurally efficient to have the Complainant's claims consolidated against all Respondents.

As such, the Panel allows the consolidation as requested by the Complainant.

### **6.2 Substantive Issues**

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (i) the Disputed Domain Names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondents have no rights or legitimate interests in respect of the Disputed Domain Names; and
- (iii) the Disputed Domain Names have been registered and are being used by the Respondents in bad faith.

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

The Panel accepts that the Complainant has rights in the Complainant's Trademark, based on its various trademark registrations such as, *inter alia*, the U.S. and International trademarks listed in Section 4. The Complainant's Trademark is also used as the domain name of the Complainant's Website.

It is well established that in making an enquiry as to whether a trademark is identical or confusingly similar to a domain name, the addition of a descriptive, geographical, pejorative, or meaningless term would not prevent a finding of confusing similarity under the first element. See section 1.8 of the [WIPO Overview 3.0](#). The Panel therefore finds that the mere addition of the generic and descriptive terms "sandals", "outlet", and "clogs", as well as the geographical terms "ca" and "Canada", does not prevent a finding of confusing similarity between the Disputed Domain Names and the Complainant's Trademark. Furthermore, it is well established that the generic Top-Level Domain ("gTLD"), ".com" in this case, may be disregarded. See 1.11 of the [WIPO Overview 3.0](#).

As such, the Panel finds that the Disputed Domain Names are confusingly similar to the Complainant's Trademark, and accordingly, paragraph 4(a)(i) of the Policy is satisfied.

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

The Panel accepts that the Complainant has not authorized the Respondents to use the Complainant's Trademark. There is no relationship between the Complainant and the Respondents, which would otherwise entitle the Respondents to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondents to show rights or legitimate interests in the Disputed Domain Names.

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondents did not submit formal Responses. The fact that the Respondents did not submit formal Responses does not automatically result in a decision in favor of the Complainant. However, the Respondents' failure to file formal Responses may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(c) of the Policy, the Respondents may establish rights or legitimate interests in the Disputed Domain Names by demonstrating any of the following:

- (i) before any notice to the Respondents of the dispute, the Respondents' use of, or demonstrable preparations to use the Disputed Domain Names or names corresponding to the Disputed Domain Names in connection with a *bona fide* offering of goods or services; or

- (ii) the Respondents have been commonly known by the Disputed Domain Names, even if the Respondents have acquired no trademark or service mark rights; or
- (iii) the Respondents are making a legitimate non-commercial or fair use of the Disputed Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel agrees with the Complainant that there is no evidence to show that the Respondents have trademark rights corresponding to the Disputed Domain Names, or that the Respondents have become known by the Disputed Domain Names.

There is no evidence to suggest that the Respondents' use of, or demonstrable preparations to use the Disputed Domain Names or names corresponding to the Disputed Domain Names, is in connection with a *bona fide* offering of goods or services. First, the goods that used to be offered for sale on the Websites, while clearly unauthorized by the Complainant, are suspected to be counterfeit products of the Complainant's genuine DANSKO products and seek to take unfair advantage of the Complainant's Trademark and reputation (see *Prada S.A. v. Chen Mingjie*, WIPO Case No. [D2015-1466](#); *Valentino S.p.A. v. Qiu Yufeng, Li Lianye*, WIPO Case No. [D2016-1747](#)). Even if the goods were genuine DANSKO products, the Websites did not display any disclaimer of a lack of relationship between the Complainant and the Respondents. Second, as of the date of this Decision, the Disputed Domain Names now resolve to inactive websites. Such use of the Disputed Domain Names does not confer rights or legitimate interests on the Respondents.

Accordingly, the Panel agrees with the Complainant that the Respondents' use of the Disputed Domain Names cannot constitute a *bona fide* offering of goods or be regarded as legitimate non-commercial or fair use. In particular, the Respondents would likely not have adopted the Complainant's Trademark in the Disputed Domain Names and on the Websites, if not for the purpose of creating an impression that the Websites and the goods offered on the Websites are associated with the Complainant, or otherwise taking advantage of the goodwill and/or reputation in the Complainant's Trademark. The reinforcement of Internet users' impression that a domain name belongs to the complainant or that a website is presented as if it is the official website of the complainant cannot be a *bona fide* offering of goods and service (See *L'Oréal SA v. PrivacyProtect.org/ WangShanShan*, WIPO Case No. [D2014-0295](#)). In this regard, the Panel also notes that the nature of the Disputed Domain Names, which incorporates the Complainant's Trademark in its entirety with the addition of the generic, descriptive, or geographical terms, carries a risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Accordingly, the Panel finds that the Respondents have no rights or legitimate interests in the Disputed Domain Names and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

The Disputed Domain Names incorporate the Complainant's Trademark in its entirety. After reviewing the supporting evidence submitted by the Complainant, the Panel agrees with the Complainant that the Complainant's Trademark appears to be well-known. A quick Internet search conducted by the Panel shows that the top search results returned for the keyword "dansko" are the Complainant's Website and third-party websites providing information about the Complainant and/or its products. Therefore, the Panel agrees that the Respondents must have been aware of the Complainant and its rights in the Complainant's Trademark when registering and using the Disputed Domain Names.

As of the date of this Decision, the Disputed Domain Names resolve to inactive websites; however, this does not prevent a finding of bad faith under the doctrine of passive holding. See section 3.3 of the [WIPO Overview 3.0](#). In addition, the Panel finds that the following factors support a finding that the Disputed Domain Names were registered and have been used by the Respondents in bad faith:

- (i) The Respondents registered and were using the Disputed Domain Names to mislead and divert Internet users to the Websites for commercial gain by creating a likelihood of confusion with the Complainant's Trademark as to the source, the Complainant's sponsorship, affiliation, or endorsement of the Websites. See section 3.1 of the [WIPO Overview 3.0](#). The fact that the Respondents added the terms "ca", "Canada", "clogs" and "sandals outlet" which are commonly used in the retail business to categorize products by location, model, and discount, supports this finding.
- (ii) The incorporation of the Complainant's Trademark with suffixes which clearly refer to the Complainant's business and products (especially "clogs" and "sandals") indicated that the Respondents must have been aware of the Complainant's business and trademark when registering the Disputed Domain Names (see *Dansko, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2023-0425](#)).
- (iii) It is difficult to conceive of any plausible use of the Disputed Domain Names that would amount to good faith use, given that the Disputed Domain Names are confusingly similar to the Complainant's Trademark and that the Websites had been used to sell suspected counterfeit DANSKO products. Without any form of disclaimer or other mention of a lack of connection with the Complainant, the Websites have applied the Complainant's Trademark).
- (iv) The Respondents registered the Disputed Domain Names using a privacy shield to conceal their identities (see *Primonial v. Domain Administrator, PrivacyGuardian.org / Parla Turkmenoglu*, WIPO Case No. [D2019-0193](#)).

The Panel also notes that the Respondents failed to respond to the Complainant's contentions and have provided no evidence of any actual or contemplated good faith use of the Disputed Domain Names. This further supports a finding of bad faith registration and use of the Disputed Domain Names.

In the circumstances, the Panel finds that the Respondents registered and are using the Disputed Domain Names in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

## 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 Names, <dansko-ca.com>, <danskoclogscanada.com>, and <danskosandalsoutlet.com> be transferred to the Complainant.

/Gabriela Kennedy/

**Gabriela Kennedy**

Sole Panelist

Date: June 14, 2023