

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Qiu Xiaofeng
Case No. D2023-3370

1. The Parties

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

The Respondent is Qiu Xiaofeng, China.

2. The Domain Name and Registrar

The disputed domain name <danskosuisse.com> is registered with Paknic (Private) Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 4, 2023. On August 7, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 9, 2023, 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 9, 2023 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 11, 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 Respondent of the Complaint, and the proceedings commenced on August 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 5, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 6, 2023.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on September 19, 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 footwear company incorporated in the USA providing comfort footwear designed for long-wear and comfort to customers around the world since 1990. The Complainant's footwear claims to be a top choice of medical professionals for over two decades.

It results from the Complainant's documented allegations, which remained undisputed, that it holds USA trademark registration no 3265194, DANSKO (the "DANSKO Mark") registered on July 17, 2007 for goods in class 25, with first use in commerce in 1991 and which is in force.

The disputed domain name was registered on July 8, 2023. The language of the Registration agreement is English.

The Complainant has provided – undisputed – evidence demonstrating that the disputed domain name resolves to a website purporting to sell DANSKO footwear and prominently featuring the Complainant's DANSKO Mark.

5. Parties' Contentions

A. Complainant

Firstly, the Complainant contends that the disputed domain name is virtually identical to the Complainant's mark apart from the additional descriptive "Suisse" element which does nothing to distinguish the disputed domain name from the Complainant's DANSKO Mark. Such descriptive or geographic terms do not eliminate the confusing similarity with the Complainant's mark.

The Complainant, secondly, submits that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not a licensee of the Complainant, and the Complainant has not given the Respondent any permission to register the trademark as a domain name, nor is there any evidence that the Respondent has been commonly known by the disputed domain name. According to the Complainant, the Respondent is neither making a noncommercial fair use of the disputed domain name, nor is the Respondent making a *bona fide* offering of goods or services. Rather, the disputed domain name's composition, and the Respondent's use of the corresponding site, gives Internet users the false impression that it is endorsed, authorised or otherwise connected to the Complainant.

Thirdly, the Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. It is obvious for the Complainant that the Respondent was well aware of the Complainant's trademarks and business when registering the disputed domain name and this must be interpreted as an attempt to mislead the public into believing that the disputed domain name is linked to the Complainant's trademarks. Finally, the Complainant informs that the Respondent has been involved in multiple UDRP decisions wherein the domain at issue was transferred to the respective the Complainants, showing the Respondent's history.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”.

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

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

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will, therefore, proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and secondly establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

It results from the evidence provided that the Complainant is the registered owner of USA trademark registration no 3,265,194, DANSKO registered on July 17, 2007 for goods in class 25, which is in force.

Many UDRP panels have found that a disputed domain name is confusingly similar to a complainant’s trademark for purposes of the first element where the relevant trademark is recognizable within the disputed domain name. Under such circumstances, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element (*cf.* section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). This Panel shares the same view and notes that the disputed domain name contains the Complainant’s registered trademark DANSKO, which is placed at the beginning of the disputed domain name. In particular, the Panel considers the addition of the geographic term “suisse” (which means “swiss” or “Switzerland” in French language) to the Complainant’s trademark in the disputed domain name would not prevent a finding of confusing similarity under the first element of the UDRP. The Panel has no doubts that in a side-by-side comparison of the disputed domain name and the relevant trademark DANSKO, the latter mark remains clearly recognizable within the disputed domain name.

Finally, the generic Top-Level Domain (“gTLD”) “.com” of the disputed domain name may be disregarded under the first element confusing similarity test (see section 1.11.1 of the [WIPO Overview 3.0](#)).

In light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent’s rights or legitimate interests to the disputed domain name. In the Panel’s view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name:

According to the Complaint, which has remained unchallenged, the Complainant has not authorized the Respondent's use of the DANSKO Mark, e.g., by registering the disputed domain name comprising said mark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Finally, it results from the Complainant's undisputed allegations that the disputed domain name resolves to a website purporting to sell DANSKO footwear and prominently featuring the Complainant's DANSKO Mark. The Panel assesses this use as being commercial, so that it cannot be considered a legitimate, noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue pursuant to paragraph 4(c)(iii) of the Policy.

Furthermore, such use as described above cannot be qualified as a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy. In fact, this Panel considers that a registrant has no legitimate interest in a domain name that identically includes to a third party's mark, where the composition of the domain name is associated to the business of the trademark holder, and that is being used to address consumers in the same business as the trademark holder operates ([WIPO Overview 3.0](#) at section 2.5).

Finally, previous UDRP panels have found that once the panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

One of these circumstances is that the respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy).

It is the view of this Panel that these circumstances are met in the case at hand. It results from the Complainant's documented allegations that the disputed domain name resolves to a website purporting to sell DANSKO footwear and prominently featuring the Complainant's DANSKO Mark. For the Panel, it is therefore evident that the Respondent positively knew the Complainant's DANSKO Mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the Respondent also knew that the disputed domain name included the Complainant's trademark when it registered the disputed domain name, having registered it due to its similarity with the Complainant's DANSKO Mark. Registration of the disputed domain name which contains a third party's mark, in awareness of said mark, to take advantage of its similarities with the mentioned mark, and in the absence of rights or legitimate interests amounts to registration in bad faith.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith:

- (i) the fact that the disputed domain name identically includes the sign DANSKO which has been used in commerce for more than three decades;
- (ii) the Respondent originally masked its identity behind a privacy shield;
- (iii) the Respondent did not provide any formal response with conceivable explanation of its behavior within these proceedings so that, in light of the overall circumstances of the case, no legitimate use of the disputed domain names by the Respondent is actually conceivable for the Panel;
- (iv) the Respondent is engaged in a pattern of conduct since it did not only register the disputed domain name but has additionally been recognized by several Panels to have registered other domain names including third party marks without right/legitimate interest and in bad faith so that the transfer has been ordered (see e.g., *Alpargatas S.A., ALPARGATAS EUROPE, S.L.U v. Qiu Xiaofeng*, WIPO Case No. [D2022-4299](#); *Perrigo Pharma International DAC v. Qiu Xiaofeng*, WIPO Case No. [D2022-4960](#)).

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, <danskosuisse.com> be transferred to the Complainant.

/Tobias Malte Müller/

Tobias Malte Müller

Sole Panelist

Date: October 4, 2023