

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Web Commerce Communications Limited, Client Care Case No. D2023-4308

1. The Parties

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

The Respondent is Web Commerce Communications Limited, Client Care, Malaysia.

2. The Domain Names and Registrar

The disputed domain names <danskocanads.com>, <dankosandalscanada.com>, and <danskoshoes-outlet.com> (“Domain Names”) are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 17, 2023. On October 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On October 20, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 October 20, 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 amendment to the Complaint on the same day.

The Center verified that the Complaint together with the amendment to the 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 October 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 13, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 14, 2023.

The Center appointed Tommaso La Scala as the sole panelist in this matter on November 16, 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 U.S. company manufacturing and selling footwear since the early 1990s, which owns several U.S. registrations consisting of / comprising the DANSKO trademarks (see, among others, U.S. trademark reg. no. 2712957, granted in 2003 for class 25). In addition, the Complainant also owns (and is using) the domain name <dansko.com>, which it registered in 1996.

The Domain Names were registered between August 12, and September 6, 2023. The Domain Names resolve to websites featuring the Complainant's DANSKO trademarks (with no authorization from the latter) and purporting to sell the Complainant's footwear goods.

5. Parties' Contentions

A. Complainant

The Complainant submits that the Domain Names are identical and confusingly similar to the Complainant's DANSKO trademarks, as they incorporate the trademark in its entirety.

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Names. The Respondent is not commonly known by the Domain Names, nor has been licensed by the latter, nor is it making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain, to misleadingly divert consumers or to tarnish the trademarks of another.

The Domain Names currently resolve to websites with infringing content, prominently featuring the Complainant's DANSKO trademark and purporting to offer its footwear goods.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

- (i) the Domain Names are 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 Domain Names; and
- (iii) the Domain Names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has established its registered rights in the DANSKO trademarks. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.2.1.

The Domain Names wholly incorporate the Complainant's trademark. As indicated in *LEGO Juris A/S v. Ma Ying Jo /Domain Admin, Privacy Protection Service INC d/b/a <PrivacyProtect.org>*, WIPO Case No. [D2014-0743](#), "where a domain name includes an identical match to a complainant's mark, a complainant has satisfied the burden of proving that the domain name is identical or confusingly similar under paragraph 4(a)(i) of the Policy".

Furthermore, the additional terms (e.g., "Canada", "sandals", "shoes", "outlet") definitely does not prevent a finding of confusing similarity between the Domain Names and the Complainant's trademarks: see, in this regard, *DHL Operations B.V. v. Serkan Dikmen*, WIPO Case No. [D2006-1426](#) ("It is well established that the addition of a country name is not per se enough to produce distinctiveness."); *Harrods Limited v. Simon Harkin Travel*, WIPO Case No. [D2004-0546](#); [WIPO Overview 3.0](#) sections 1.7 and 1.8.

The Panel finds that the Domain Names are confusingly similar to the Complainant's trademarks. The condition of paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

The Panel finds the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests in the Domain Names. [WIPO Overview 3.0](#) section 2.1. The Complainant has not licensed or otherwise permitted the Respondent to use any of its trademarks or to register the Domain Names comprising its trademarks. The Respondent did not respond nor provide any evidence showing that it is making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademarks of the Complainant.

Accordingly, and based on the Panel's further findings below, the Panel finds that the condition of paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

The Panel finds that the Domain Names have been registered and are being used in bad faith. First of all, the Complainant's DANSKO trademarks and its <dansko.com> domain name have been registered well before the Domain Names and – also considering their quite distinctive nature – the Panel finds that the Respondent knew or should have known of these trademarks at the time of registration of the Domain Names. In this regard, the fact that the Respondent registered domain names including both DANSKO and additional terms such as "sandals" and "shoes", clearly suggest that the Respondent actually knew of the Complainant's business activity carried out under the DANSKO brand.

In addition, the Domain Names resolve to websites imitating the Complainant's website is per se evidence of such knowledge. It is quite clear that the Respondent carried out the above conduct in order to impersonate the Complainant for financial gain, which is a fraudulent use of the Domain Names clearly constituting use in bad faith (see, among others, *See Comerica Bank v. Micheal Ard*, WIPO Case No. [D2017-1487](#) (concluding that the respondent had full knowledge of the complainant's right in the mark because the respondent "directly mimick[ed] [the complainant] on its website" where it "excessively" displayed the complainant's mark); see also *Trip.com, Inc. v. Daniel Deamone*, WIPO Case No. [D2001-1066](#) (finding bad faith where respondent had actual and constructive notice of complainant's trademarks registered in the United States); and [WIPO Overview 3.0](#) section 3.4.

In the absence of any response by the Respondent, the Panel has no reason to doubt that the Respondent tried to mislead Internet users into believing that the Domain Names are somehow connected with the Complainant.

The Panel finds that the condition of 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 Domain Names <danskocanads.com>, <danskosandalscanada.com>, and <danskoshoes-outlet.com> be transferred to the Complainant.

/Tommaso La Scala/

Tommaso La Scala

Sole Panelist

Date: November 28, 2023