

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Client Care, Web Commerce Communications Limited Case No. D2022-1257

1. The Parties

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

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

2. The Domain Names and Registrar

The disputed domain names <danskocanadaca.com>, <danskodanmark.com>, <danskojapansale.com>, <dansko-zoccoli.com> (hereafter referred to as the “Disputed 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 April 8, 2022. On April 11, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Names. On April 12, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Disputed Domain Names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on April 12, 2022, 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 April 15, 2022.

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 April 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 12, 2022.

The Center appointed Flip Jan Claude Petillion as the sole panelist in this matter on May 20, 2022. 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, Dansko, LLC, is an American footwear company. The Complainant holds various trademarks consisting of or including the sign DANSKO, such as the following:

- DANSKO, word mark registered in the USA under No. 2712957 on May 6, 2003 in class 25;
- below figurative mark registered in the USA under No. 2712953 on May 6, 2003 in class 25:



The Disputed Domain Names have been registered on the following dates:

- <danskocanadaca.com>: January 28, 2022;
- <danskodanmark.com>: January 17, 2022;
- <danskojapansale.com>: January 17, 2022;
- <dansko-zoccoli.com>: January 28, 2022.

The Disputed Domain Names <danskocanadaca.com> and <danskojapansale.com> refer to websites purporting to sell footwear which appears to be identical or at least similar to the Complainant's products. The Disputed Domain Names <danskodanmark.com> and <dansko-zoccoli.com> appear to be inactive or suspended.

5. Parties' Contentions

A. Complainant

The Complainant considers the Disputed Domain Names to be confusingly similar to trademarks in which it claims to have rights. The Complainant further claims that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names. According to the Complainant, the Respondent is not commonly known by the Disputed Domain Names and the Complainant has not authorized, licensed, or endorsed the Respondent's use of its DANSKO marks in the Disputed Domain Names. The Complainant claims that the Respondent's use of the Disputed Domain Names is neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use. Finally, the Complainant claims that the Disputed Domain Names were registered and are being used in bad faith. The Complainant contends that the Respondent was aware of the Complainant's marks when it registered the Disputed Domain Names. According to the Complainant, some of the Disputed Domain Names are used for commercial gain and to promote competing goods by creating a likelihood of confusion with the Complainant's mark, and the passive use of the other Disputed Domain Names also amounts to bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 15 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules, and any rules and principles of law that it deems applicable.

The onus is on the Complainant to make out its case and it is apparent, both from the terms of the Policy and the decisions of past UDRP panels, that the Complainant must show that all three elements set out in paragraph 4(a) of the Policy have been established before any order can be made to transfer the Disputed Domain Names. As the proceedings are administrative, the standard of proof is the balance of probabilities.

Thus, for the Complainant to succeed, it must prove, within the meaning of paragraph 4(a) of the Policy and on the balance of probabilities that:

- (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 Respondent has 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 in bad faith.

The Panel will deal with each of these requirements in turn.

A. Identical or Confusingly Similar

To prove this element, the Complainant must first establish that there is a trademark or service mark in which it has rights. The Complainant has clearly established that there are trademarks in which it has rights. The Complainant's DANSKO trademarks have been registered and used in connection to the Complainant's footwear business.

The Panel observes that the Disputed Domain Names all incorporate the Complainant's DANSKO trademark in its entirety, simply adding terms such as "canada", "ca", "danmark", "japan", "sale", or "zoccoli" and a hyphen.

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 (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#))).

Additionally, it is well established that generic Top-Level-Domains ("gTLDs"), here ".com", may be disregarded when considering whether a disputed domain name is confusingly similar to a trademark in which a complainant has rights.

In light of the above, the Panel considers the Disputed Domain Names to be confusingly similar to the Complainant's DANSKO trademark.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Names.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* showing that the Respondent has no rights or legitimate interests in the Disputed Domain Names in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

The Panel observes that the Respondent does not appear to be commonly known by the Disputed Domain Names and that the Respondent does not seem to have acquired trademark or service mark rights (there being no Response or evidence of any such rights). According to the information provided by the Registrar, the Respondent is named “Client Care” from the organization “Web Commerce Communications Limited”. There are no indications that a connection between the Complainant and the Respondent exists.

Where a domain name consists of a trademark plus an additional term, UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner (see section 2.5.1 of the [WIPO Overview 3.0](#)). The Disputed Domain Names incorporate the Complainant’s DANSKO trademark in its entirety and either add geographical terms such as “japan”, “danmark”, “canada” or the abbreviation “ca”, or descriptive words such as “sale” or “zoccoli”. The latter is the Italian word for “clogs”, one of the main products sold by the Complainant. In these circumstances, the Panel finds that the Disputed Domain Names carry a risk of implied affiliation with the Complainant and cannot constitute fair use.

Beyond looking at the domain name(s) and the nature of any additional terms appended to it, UDRP panels assess whether the overall facts and circumstances of the case, such as the content of the website linked to the disputed domain name and the absence of a response, support a fair use or not (see sections 2.5.2 and 2.5.3 of the [WIPO Overview 3.0](#)).

The Complainant provides evidence showing that the Disputed Domain Names <danskocanadaca.com> and <danskojapansale.com> refer to websites purporting to sell footwear which appears to be identical or at least similar to the Complainant’s products. Moreover, the Panel observes that these websites not only include the Complainant’s word mark but also its figurative trademark as depicted above under section 4. Noting, *inter alia*, the failure of the websites to accurately and prominently disclose the Respondent’s (lack of) relationship with the Complainant, and the Respondent’s apparent attempt to “corner the market” by registering four Disputed Domain Names reflecting the Complainant’s mark, any potential use for reselling or distribution purposes would not constitute a fair use (see section 2.8 of the [WIPO Overview 3.0](#)).

Further, in the Panel’s view, the above elements are indications of illegal activity using the Disputed Domain Names. UDRP panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods, phishing, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent (see section 2.13 of the [WIPO Overview 3.0](#)).

The Panel observes that the Disputed Domain Names <danskodanmark.com> and <dansko-zoccoli.com> appear to be inactive, and neither the Respondent nor the facts of the case indicate any demonstrable preparations to a good faith use of the Disputed Domain Names. The passive holding or non-use of domain names is, in appropriate circumstances, evidence of a lack of rights or legitimate interests in the domain names (see *Red Bull GmbH v. Credit du Léman SA, Jean-Denis Deletraz*, WIPO Case No. [D2011-2209](#); *Facebook, Inc. v. Mirza Azim*, WIPO Case No. [D2016-0950](#); *American Home Products Corporation v. Ben Malgioglio*, WIPO Case No. [D2000-1602](#); *Vestel Elektronik Sanayi ve Ticaret AS v. Mehmet Kahveci*, WIPO Case No. [D2000-1244](#)).

The Respondent had the opportunity to demonstrate rights or legitimate interests but did not do so. In the absence of a Response from the Respondent, the *prima facie* case established by the Complainant has not been rebutted.

Therefore, the Panel finds that the Complainant has established that the Respondent has no rights or legitimate interests in the Disputed Domain Names. In light of the above, the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

The Complainant must prove on the balance of probabilities both that the Disputed Domain Names were registered in bad faith and that these are used in bad faith (see section 4.2 of the [WIPO Overview 3.0](#) and,

for example, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) and *Control Techniques Limited v. Lektronix Ltd*, WIPO Case No. [D2006-1052](#)).

Paragraph 4(b) of the Policy provides a non-exhaustive list of factors, any one of which may demonstrate bad faith. Among these factors demonstrating bad faith registration and use is the use of a domain name to intentionally attempt to attract, for commercial gain, Internet users to a 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 the website or location or of a product or service on the website or location.

In the present case, the Panel finds it inconceivable that the Respondent was unaware of the Complainant and its rights in the DANSKO mark when it registered the Disputed Domain Names. Some of the Complainant's DANSKO marks predate the registration of the Disputed Domain Names by almost 20 years, and all Disputed Domain Names include the Complainant's distinctive mark in its entirety. Moreover, the websites linked to the Disputed Domain Names <danskocanadaca.com> and <danskojapansale.com> appear to copy elements from the Complainant's official website including the Complainant's word and figurative marks, and purport to sell products identical or at least similar to the Complainant's products. As a result, the Respondent must have had knowledge of the Complainant's rights at the time of registering the Disputed Domain Names. The Panel finds that the Respondent's awareness of the Complainant's trademark rights at the time of registration suggests bad faith.

By redirecting Internet users to websites resembling the Complainant's official website and offering for sale products similar to the Complainant's products using the Complainant's marks, the Respondent intentionally aimed to attract Internet users to visit these websites 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 or location and of the products advertised on the website (see *Simyo GmbH v. Domain Privacy Service FBO Registrant / Ramazan Kayan*, WIPO Case No. [D2014-2227](#)). Moreover, as discussed above, the Panel finds that there are indications that these websites are being used for illegitimate activities, such as the sale of counterfeit goods or phishing. In the Panel's view, such illegal activity is manifestly considered evidence of bad faith (see section 3.1.4 of the [WIPO Overview 3.0](#)).

The Panel observes that the Disputed Domain Names <danskodanmark.com> and <dansko-zoccoli.com> are either inactive or suspended. However, in the circumstances of the present case, the non-use of these Disputed Domain Names does not prevent the Panel's finding of bad faith given the following factors:

- the degree of distinctiveness of the Complainant's mark;
- the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good-faith use; and
- the implausibility of any good faith use to which the Disputed Domain Names <danskodanmark.com> and <dansko-zoccoli.com> may be put (see section 3.3 of the [WIPO Overview 3.0](#)).

By failing to respond to the Complaint, the Respondent did not take any initiative to contest the foregoing. Pursuant to paragraph 14 of the Rules, the Panel may draw the conclusions it considers appropriate.

Therefore, the Panel finds that, on the balance of probabilities, it is sufficiently shown that the Disputed Domain Names were registered and are being used in bad faith. In light of the above, the Complainant also succeeds on the third and last 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 Names, <danskocanadaca.com>, <danskodanmark.com>, <danskojapansale.com>, and <dansko-zoccoli.com>, be transferred to the Complainant.

/Flip Jan Claude Petillion/

Flip Jan Claude Petillion

Sole Panelist

Date: June 3, 2022