

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Kenneth CNicoletti

Case No. D2024-4716

1. The Parties

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

Respondent is Kenneth CNicoletti, United States.

2. The Domain Name and Registrar

The disputed domain name <danskousstore.com> (the “Domain Name”) is registered with Realtime Register B.V. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 14, 2024. On November 15, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 18, 2024, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Unknown Registrant / REDACTED FOR PRIVACY) and contact information in the Complaint.

The Center sent an email communication to Complainant on November 19, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on November 19, 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 Respondent of the Complaint, and the proceedings commenced on November 25, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 15, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on December 16, 2024.

The Center appointed John C. McElwaine as the sole panelist in this matter on December 20, 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

4. Factual Background

Complainant is a provider of footwear that began operations in 1990. Relevant to this matter, Complainant owns numerous trademark registrations including:

- DANSKO, U.S. Registration No. 3854991, registered September 28, 2010 for socks in International Class 25;
- DANSKO, U.S. Registration No. 4229847, registered October 23, 2012 for various goods and retail services in International Classes 3, 18, 25 and 35; and
- DANSKO, U.S. Registration No. 3265194, registered July 17, 2007 for footwear in International Class 25.

Collectively, these registered trademark rights are referred to as the "DANSKO Marks."

The Domain Name was registered on October 28, 2024. The Domain Name resolves to a website that prominently displays Complainant's DANSKO Marks and logo and copies the look and feel of Complainant's legitimate website to sell footwear products (that contain Complainant's DANSKO mark in the product description).

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

As background, Complainant alleges that since 1990, Complainant has provided comfort footwear to customers around the world. Beginning with clog sales, Complainant now offers other footwear including boots, sandals, flats, and sneakers, all designed for long-wear and comfort. As testament to their comfort, Complainant's footwear has been a top choice of medical professionals for over two decades.

With respect to the first element of the Policy, Complainant asserts that the Domain Name is confusingly similar to its DANSKO Marks as it incorporates the marks in their entirety with only the addition of the descriptive terms "us" and "store". Complainant contends these additions increase confusion by suggesting the website is Complainant's United States store.

With respect to the second element of the Policy, Complainant alleges that Respondent has no rights or legitimate interests in the Domain Name. Complainant further asserts it has not authorized Respondent to use its marks. Moreover, Complainant contends that Respondent is using the Domain Name for a website that copies Complainant's website design and trademarks to sell unauthorized or counterfeit goods. The website prominently displays Complainant's DANSKO Marks and purports to offer identical footwear goods.

With respect to the third element of the Policy, Complainant asserts bad faith registration and use based on Respondent's creation of a copycat website that attempts to deceive consumers. The website displays unauthorized content infringing on Complainant's DANSKO Marks and copies Complainant's website design to confuse consumers into believing that Domain Name is affiliated or associated with Complainant .

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Even though Respondent has defaulted, paragraph 4(a) of the Policy requires that, in order to succeed in these UDRP proceedings, Complainant must still prove its assertions with evidence demonstrating:

(i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

(ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and

(iii) the Domain Name has been registered and is being used in bad faith.

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows.

A. Identical or Confusingly Similar

The Panel finds that Complainant has established rights in the DANSKO trademark through its multiple trademark registrations made record in this matter. Section 1.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") instructs that ownership of a trademark registration is sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy.

The Domain Name incorporates Complainant's DANSKO trademark in its entirety, with the addition of the terms "us" and "store". As noted in section 1.8 of the [WIPO Overview 3.0](#), 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 that the trademark DANSKO is clearly recognizable within the Domain Name.

Therefore, the Panel concludes that the Domain Name is confusingly similar to Complainant's DANSKO Marks in which Complainant has rights, satisfying the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name, after which the burden of production shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests. See section 2.1 of the [WIPO Overview 3.0](#).

Here, Complainant has stated that it has not licensed or otherwise authorized Respondent to use its DANSKO Marks or to register domain names incorporating "DANSKO" or "DANSKO us." There is no evidence that Respondent has been commonly known by the Domain Name or that Respondent has acquired any trademark rights in the terms "dansko" or "dansko us shop".

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy¹ or otherwise.

Moreover, Respondent cannot claim that its operation of the website at the Domain Name provides legitimate interests. Respondent is using the Domain Name to resolve to a website displaying Complainant's DANSKO Marks and logo, copying the look and feel of Complainant's legitimate website and offering for sale identical goods to those of Complainant (which, moreover, contain Complainant's DANSKO trademark in the product description) which, Complainant alleges, might be counterfeit. [WIPO Overview 3.0](#), section 2.13.1 ("Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent."). In addition, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the evidence clearly shows Respondent has attempted to pass itself off as Complainant. The Panel notes that the composition of the Domain Name incorporating Complainant's trademark with the terms "us" and "store" suggesting a connection to Complainants' sale efforts in the United States itself carries a risk of implied affiliation. Furthermore, the use of the inherently misleading Domain Name to divert Internet traffic to a webpage impersonating Complainant is not a bona fide offering of goods or services. See *Chicago Mercantile Exchange Inc., CME Group Inc. v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Nikolay Korobeynikov*, WIPO Case No. [D2016-0654](#) (finding no legitimate interests in a website resolving from the disputed domain name, which mirrored, and purported to be, the website of "CME Group" and which provided information relating to the trading of futures and options). Even if the products sold on the website are genuine, there is no disclosure of Respondent's lack of relationship with Complainant on the website, and thus, the Oki Data test cannot be met. See *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

Lastly, Respondent's use of the Domain Name is not noncommercial or fair use under paragraph 4(c)(iii) of the Policy, given that Respondent is allegedly selling counterfeit or competing products from an online retail website impersonating Complainant. Such activity is not considered noncommercial or fair use.

Accordingly, the Panel finds that Complainant has made a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name, which Respondent has not rebutted. The Panel concludes that Complainant has satisfied the second element of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can be found where a respondent "knew or should have known" of a complainant's trademark rights and nevertheless registered a domain name in which it had no rights or legitimate interests. See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). As detailed above, Respondent registered the Domain Name which is confusingly similar to DANSKO Marks. There is no explanation for Respondent to have chosen to register the Domain Name other than to intentionally trade off the goodwill and reputation of

¹ The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a disputed domain name: "(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue."

Complainant's trademark or otherwise create a false association with Complainant. With no response from Respondent, this claim is undisputed.

As discussed herein, Respondent registered the Domain Name and linked it to a website using Complainant's DANSKO Marks and logo, including use of Complainant's trademark in the product description to mimic the look and feel of Complainant's website. Complainant further alleges that Respondent is selling counterfeit shoes at discounted prices. As noted above, it is not necessary for the Panel to make any ultimate determination as to the nature of the goods, as the Panel is satisfied that the use of the Domain Name by Respondent amounts to bad faith use. See *Identigene, Inc. v. Genetest Labs*, WIPO Case No. [D2000-1100](#) (finding bad faith where the respondent's use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site); and *MathForum.com, LLC v. Weiguang Huang*, WIPO Case No. [D2000-0743](#) (finding bad faith under paragraph 4(b)(iv) of the Policy where the respondent registered a domain name confusingly similar to the complainant's mark and the domain name was used to host a commercial website that offered similar services offered by the complainant under its mark).

As detailed above, the Panel finds on the record before it that Respondent's intention in registering the Domain Name was to attract, for commercial gain, Internet users to Respondent's website by creating a likelihood of confusion with DANSKO Marks as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location. Thus, the Panel holds that Complainant has met its burden of providing sufficient evidence that Respondent registered and is using the Domain Name in bad faith under paragraph 4(b)(iv) of the Policy.

For the reasons set forth above, the Panel holds that Complainant has met its burden under paragraph 4(a)(iii) of the Policy and has established that Respondent registered and is using the Domain Name in bad faith.

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 Name, <danskousstore.com>, be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: January 3, 2025