

## **ADMINISTRATIVE PANEL DECISION**

Dansko, LLC v. Client Care, Web Commerce Communications Limited  
Case No. D2023-0886

### **1. The Parties**

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

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

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

The disputed domain names <danskooutletstore.com>, <danskooutletuk.com>, and <dansko-uk.com> 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 February 28, 2023. On February 28, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 2, 2023, 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 (Unknown Registrant c/o ALIBABA.COM SINGAPORE E-COMMERCE PRIVATE LIMITED) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 6, 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 March 8, 2023.

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 March 10, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 30, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 31, 2023.

The Center appointed Gareth Dickson as the sole panelist in this matter on April 11, 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 provides comfort footwear to customers around the world under its DANSKO trade mark (the "Mark"). It is the owner of a number of trade mark registrations for the Mark in the United States, including:

- Registration number 2712957, registered on May 6, 2003;
- Registration number 3265194, registered on July 17, 2007;
- Registration number 3854991, registered on September 28, 2010; and
- Registration number 4229847, registered on October 23, 2012.

Each of the disputed domain names was registered on January 30, 2023. The disputed domain names <dansko-uk.com> and <danskoutletstore.com> currently direct Internet users to webpages which appear to offer footwear, which reproduce the Mark. The disputed domain name <danskoutletuk.com> directs Internet users to a webpage with links to sales for items other than footwear.

Prior to obtaining registrant and contact information for the disputed domain names, the Complainant requested that its Complaints against the three disputed domain names be "consolidated" into a single Complaint under paragraph 3(c) of the Rules.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant argues that it has rights in the Mark by virtue of its ownership of various trade mark registrations for the Mark. It contends that the disputed domain name is confusingly similar to the Mark since it incorporates the Mark with the addition of terms which merely describe or allude to retail services ("outlet" and "store") and/or a location in which it operates ("UK"), all under the generic Top-Level Domain ("gTLD") ".com".

The Complainant confirms that the disputed domain names were registered by the Respondent without its permission and that the Respondent is not a licensee of the Complainant. It alleges that there is no evidence to suggest that the Respondent: has been commonly known by the disputed domain names or any of them; is making, or intends to make, a legitimate noncommercial or fair use of the disputed domain names; or has ever used the disputed domain names in connection with a *bona fide* offering of goods or services.

The Complainant submits that the Respondent must have known of the Complainant and the Mark when it registered the disputed domain names. The Respondent's own use of the disputed domain names (and of the Complainant's Mark on two of its websites) to offer goods in competition with the Complainant further confirms that the Respondent knew of the Mark and the Complainant's interest in it when it registered the disputed domain name and that it registered it in bad faith.

Finally, the Complainant argues that the Respondent has used the disputed domain names to attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Mark, contrary to the Policy. Together, the Complainant submits that the disputed domain names have been registered and are being used in bad faith, and notes that the Respondent has used a privacy service to conceal its identity for as long as possible.

Together, the Complainant submits that the Respondent is using the disputed domain name in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Since making its request that its Complaint against all three of the disputed domain names be consolidated into a single proceeding, the Registrar concerned has revealed that the registrant and contact information for each of the disputed domain names, which were registered on the same day using the same Registrar, is identical. Accordingly, the Panel is satisfied that all three of the disputed domain names were registered by the same domain name holder and that it is appropriate for the Complainant's Complaint against all three of the disputed domain names to be determined in a single proceeding.

As to the merits of the Complaint, paragraph 4(a) of the Policy requires the Complainant to prove that:

- a) the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- b) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- c) the disputed domain name has been registered and is being used in bad faith.

These criteria are cumulative. The failure of the Complainant to prove any one of these elements means the Complaint must be denied.

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

The Panel accepts that the Complainant is the owner of, and therefore has rights in, the Mark. Section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)) provides that: "[I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing".

Section 1.8 of the [WIPO Overview 3.0](#) further provides that: "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 therefore finds that the disputed domain names are confusingly similar to the Mark, since they each incorporate the Mark in its entirety. The use of the gTLD ".com" does not prevent a finding of confusing similarity, nor does the addition of the words "outlet" and/or "store", and/or of the geographically descriptive letters "UK".

Accordingly, the Panel finds that each of the disputed domain names is confusingly similar to a trade mark in which the Complainant has rights.

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

Although a complainant is required to demonstrate that a respondent has no rights or legitimate interests in respect of the domain name, as explained in section 2.1 of the [WIPO Overview 3.0](#), the consensus view of previous UDRP panels is that where a complainant establishes a *prima facie* case that the respondent lacks rights or legitimate interests the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the

respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The use of a third party's trade mark to offer genuine goods or services can in some circumstances be evidence of a *bona fide* offering of goods and services and thus constitute rights or legitimate interests in a domain name (also see section 2.8.1 of the [WIPO Overview 3.0](#)). For the purposes of the Policy, those circumstances have been set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) ("*Oki Data*"), which sets out four requirements which must all be met for the use to be considered legitimate. These requirements may be stated briefly as follows:

- The Respondent must actually be offering the goods or services at issue;
- The Respondent must use the site to sell only the trade marked goods;
- The site must accurately disclose the registrant's relationship with the trade mark owner; and
- The Respondent must not try to corner the market in all domain names, thus depriving the trade mark owner of reflecting its own mark in a domain name.

The question of the possible resale of genuine goods does not arise under the third of the three disputed domain names. However, even assuming that the goods offered by the Respondent via the disputed domain names <dansko-uk.com> and <danskoutletstore.com> are genuine goods first put on the market by the Complainant or with its consent, the Respondent cannot benefit from *Oki Data* since the Respondent does not appear to have accurately disclosed the lack of any relationship between it and the Complainant, notwithstanding that a commercial relationship will be inferred as a result of the Respondent's use of the Complainant's trade marks in the disputed domain names.

In the current proceeding, the Complainant has established its *prima facie* case in respect of all three disputed domain names. The Complainant states that it has not given the Respondent permission to use the Mark, in a domain name or otherwise, and submits that the Respondent has not been commonly known by the disputed domain names.

There is no evidence that the Respondent has acquired any common law rights to use the Mark, is commonly known by the Mark or has chosen to use the Mark in the disputed domain names in any descriptive manner or is making any use of the disputed domain names that would establish rights or legitimate interests as a result of a noncommercial or fair use of it.

By not participating in these proceedings, the Respondent has failed to refute the Complainant's *prima facie* case that it has met its burden under the second UDRP element.

As clearly stated in section 2.1 of the [WIPO Overview 3.0](#), "a panel's assessment will normally be made on the basis of the evidence presented in the Complaint and any filed response. The panel may draw inferences from the absence of a response as it considers appropriate, but will weigh all available evidence irrespective of whether a response is filed". Having reviewed and weighed the available evidence, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

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

The Panel notes that the disputed domain names were registered many years after the Mark was registered and accepts that they were chosen by reference to the Mark. The Panel is satisfied that all three of the disputed domain names were registered by the Respondent as part of a single campaign to take advantage of the Complainant's rights in the Mark and without its consent, not least because of the similarity of the websites accessible via two of the disputed domain names and the similarity in how the Mark is used in all three of them.

The Panel therefore finds that the Respondent's registration of the disputed domain names was in bad faith.

The disputed domain names are also being used in bad faith. The disputed domain names <dansko-uk.com> and <danskooutletstore.com> are being used for a commercial purpose that involves directing Internet users (in particular those seeking the Complainant) to websites which make unauthorised use of the Mark and does so to sell goods in competition with the Complainant. Although the third of the three disputed domain names, <danskooutletuk.com>, does not involve the sale of goods in obvious competition with the Complainant, the fact that it too was registered as part of the same campaign by the Respondent to misuse the Complainant's Mark and to misdirect Internet users seeking the Complainant for the Respondent's own commercial gain, is sufficient evidence that it too was registered in bad faith.

Therefore, and on the basis of the information available to it, the Panel finds that the Respondent has registered and is using the disputed domain names 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 disputed domain names <danskooutletstore.com>, <danskooutletuk.com>, and <dansko-uk.com> be transferred to the Complainant.

*/Gareth Dickson/*

**Gareth Dickson**

Sole Panelist

Date: May 2, 2023