

ADMINISTRATIVE PANEL DECISION

Dansko, LLC v. Client Care, Web Commerce Communications Limited Case No. D2023-1738

1. The Parties

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

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

2. The Domain Names and Registrar

The disputed domain names <danskoshoeretailers.com> and <danskoshoe-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 April 19, 2023. On April 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 21, 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) and contact information in the Complaint. The Center sent an email communication to Complainant on May 1, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on May 1, 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 Respondent of the Complaint, and the proceedings commenced on May 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 25, 2023.

The Center appointed Beatrice Onica Jarka as the sole panelist in this matter on June 17, 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

Complainant, Dansko, LLC, is an American footwear company, providing comfort footwear to customers around the world.

Complainant has gained significant common law trademark rights in its DANSKO Marks, through the use, advertisement, and promotion of such marks in connection with its footwear goods. Complainant holds various trademarks consisting of or including the sign DANSKO.

These registrations include, but are not limited to the following: DANSKO, word mark registered in the United States under No. 2712957 registered on May 6, 2003 in class 25; and DANSKO, word mark registered in the United States under No. 4229847 registered on October 23, 2012 in class.

Beyond registering its DANSKO Marks, Complainant has also spent significant resources protecting its DANSKO Marks from infringement, including obtaining victories in other UDRP proceedings and the transfer to Complainant of other domain names incorporating DANSKO or a variation thereof.

The disputed domain names were registered on March 3, 2023, and March 22, 2023. The disputed domain names resolve to similar websites to Complainant's website, and purportedly offering for sale identical or similar footwear goods to Complainant.

5. Parties' Contentions

A. Complainant

By its Complaint, Complainant contends:

- The disputed domain names are virtually identical to Complainant's DANSKO Marks apart from descriptive elements which do nothing to distinguish the disputed domain names from Complainant's DANSKO marks. Respondent only adds the descriptive terms "shoe" and "retailers" to Complainant's DANSKO Marks, and only adds the descriptive and geographic elements "shoe" and "uk". Such descriptive and geographic terms in the disputed domain names do not eliminate the confusing similarity with Complainant's DANSKO Marks.
- Such additions of descriptive and geographic terms in the disputed domain names have the potential to increase consumer confusion.
- Given the prominent use of DANSKO in the disputed domain names with additional non-distinctive and geographic elements, consumers are likely to believe that the disputed domain names are related to, affiliated with, or otherwise sponsored by Complainant and its DANSKO Marks, and this is not the case.
- Because the disputed domain names incorporate Complainant's federally registered DANSKO Marks, individuals could easily be led to believe the disputed domain names are intended to be used in connection with identical services covered by Complainant's registered Marks.
- The disputed domain names include infringing content in the attempt to confuse consumers.
- Respondent has no rights or legitimate interests in respect of the disputed domain names.

- Respondent is not affiliated with Complainant, and there is no evidence to suggest that Respondent has registered the disputed domain names to advance legitimate interests for the *bona fide* offering of legitimate goods or services.
- The use of a privacy or proxy service to register a domain name has led numerous Panels to take the registrant's anonymity into account and draw adverse inferences.
- The disputed domain names resolve to confusingly similar websites to Complainant's website in that they prominently feature Complainant's DANSKO Marks and purport to offer identical footwear goods.
- Respondent registered the disputed domain names in bad faith and willfully infringes on Complainant's prior rights and Respondent has attempted to take commercial advantage of Complainant's trademarks and commercial reputation and to trade off Complainant's goodwill. Respondent's registration and its current use of the disputed domain names are in bad faith.
- Respondent has "registered the domain name primarily for the purpose of disrupting the business of a competitor"; and/or "by using the domain names, [Respondent] ha[s] intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with [C]omplainant's mark as to the source, sponsorship, affiliation, or endorsement of [Respondent's] web site or location or of a product or service on [Respondent's] web site or location."
- The disputed domain names resolve to infringing websites containing Complainant's DANSKO Marks, and Respondent likely conducts fraudulent activity through its use of the disputed domain names.
- In fact, numerous web browsers warn Internet users of the disputed domain names likely fraudulent and phishing activity.
- Respondent clearly had Complainant in mind when registering the disputed domain names, and it had constructive notice of the DANSKO Marks as Complainant owns numerous trademark registrations for DANSKO and the domain name registrations containing the identical DANSKO Marks.
- Respondent had full knowledge of Complainant's rights in the DANSKO Marks. This is evidenced not only by the confusingly similar disputed domain names which use the DANSKO Marks in their entirety, but also by the fact that Respondent imitates Complainant on the website where the disputed domain names resolve, which prominently display Complainant's DANSKO Marks.
- Respondent's use and registration of the disputed domain names further constitute bad faith inasmuch as the disputed domain names are designed for commercial gain and to promote counterfeit goods, thereby raising a likelihood of consumer confusion.
- Through the websites, Respondent solicits business from Internet users while deceptively and fraudulently appearing as Complainant.
- Moreover, it is apparent that Respondent registered the disputed domain names to trade off Complainant's goodwill in its DANSKO Marks and to confuse consumers into believing that Respondent's disputed domain names are affiliated or associated with Complainant when that is not the case. Respondent registered the disputed domain names for what appears to be an attempt to siphon the goodwill and reputation from Complainant and its DANSKO Marks for commercial gain and to profit from the resulting consumer confusion. Such registration and use of the disputed domain names are in and of itself a form of opportunistic bad faith.

B. Respondent

Although properly summoned, Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

This Panel finds the contentions of Complainant in relationship to the holding of the Mark DANSKO registrations accurate and documented and considers that Complainant is holder of the said Mark.

In regards of the identity/confusing similarity requirement of the first element related to the disputed domain names, this Panel finds that it incorporates Complainant's distinguished DANSKO Mark in full followed by the terms "shoe" and "retailers" to Complainant's DANSKO Marks or adding the terms "shoe" and "uk", the said requirement is therefore fulfilled.

Such additional terms in the disputed domain names do not prevent a finding of confusing similarity with Complainant's DANSKO Marks.

The Panel notes that it is a long established UDRP practice (see section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") according to which the test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name, which is the case in these proceedings. 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 3.0](#)).

Accordingly, this Panel finds that Complainant's Mark is recognizable in the disputed domain names which makes the disputed domain names confusingly similar to the Mark and as such, the first element under of paragraph 4(a) of the Policy is accordingly established.

B. Rights or Legitimate Interests

In relation to the second element of the Policy, the UDRP practice provides that Complainant has to show that Respondent lacks rights or legitimate interests in respect of the disputed domain names. If Complainant makes that *prima facie* showing, the burden of production shifts to Respondent, according to the section 2.1 of the [WIPO Overview 3.0](#).

In these proceedings, this Panel finds that Complainant has made a *prima facie* showing that Respondent lacks rights or legitimate interests in respect of the disputed domain names and such showing has not been rebutted by Respondent, as it did not reply to Complainant's contentions.

In this case, the Panel considers within the unrebutted *prima facie* showing of Complainant the following:

- The disputed domain names resolve to websites purportedly offering for sale identical or similar footwear goods to Complainant.
- Respondent (as an individual, business, or other organization) cannot claim to be commonly known by the disputed domain names or similar names related thereto. Respondent has clearly made no effort to associate himself or herself with the disputed domain names.
- There is no evidence that Respondent is: (i) using the disputed domain names for a *bona fide* offering of goods or services; (ii) known by the "Dansko" designation or anything similar; or (iii) making any legitimate noncommercial or fair use.
- Respondent uses the disputed domain names to deliberately cause consumer confusion with Complainant and its goods.

- The entirety of the evidence demonstrates Respondent illegitimately registered the disputed domain names in an apparent attempt to syphon off Complainant's goodwill in its above-referenced DANSKO Marks.

Accordingly, this Panel finds that the second element under of paragraph 4(a) of the Policy is established.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy expressly provides a non-exhaustive list of circumstances, when present, evidences that the registration of a domain name was in bad faith, including, "circumstances indicating that [a respondent has] registered or [the respondent has] acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of that complainant, for valuable consideration in excess of [respondent's] documented out-of-pocket costs directly related to the domain name;"

This Panel finds that the disputed domain names resolve to websites containing Complainant's DANSKO Marks, and likely conducts fraudulent activity through its use of the disputed domain names. As the disputed domain names are designed for commercial gain and to promote counterfeit goods, thereby raising a likelihood of consumer confusion with Complainant. It is apparent for the Panel as for any third party users that through the websites, Respondent solicits business from Internet users while deceptively and fraudulently appearing as Complainant. In fact, numerous web browsers warn Internet users of the disputed domain names likely for fraudulent and phishing activity.

Moreover, it is obvious for this Panel that Respondent clearly had Complainant in mind when registering the disputed domain names and as a consequence it had constructive notice of the DANSKO Marks. Such conduct is amplified by the fact that Respondent imitates Complainant on the websites where the disputed domain names resolve, which prominently display Complainant's DANSKO Marks which indicates also Respondent registered the disputed domain names for what appears to be an attempt to syphon the goodwill and reputation from Complainant and its DANSKO Marks for commercial gain and to profit from the resulting consumer confusion. The Respondent's use and registration of the disputed domain names further constitute bad faith inasmuch as the disputed domain names are designed for commercial gain, thereby raising a likelihood of consumer confusion with Complainant DANSKO Marks.

Accordingly, this Panel finds that the third element under of paragraph 4(a) of the Policy is established.

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, <danskoshoeretailers.com> and <danskoshoe-uk.com>, be transferred to Complainant.

/Dr. Beatrice Onica Jarka/

Dr. Beatrice Onica Jarka

Sole Panelist

Date: July 1, 2023