

## **ADMINISTRATIVE PANEL DECISION**

Dansko, LLC v. Nadison Cherish  
Case No. D2024-4915

### **1. The Parties**

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

The Respondent is Nadison Cherish, United States.

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

The disputed domain name <dansko-footwear-us.com> is registered with Gname.com Pte. Ltd. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 27, 2024. On November 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 29, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 2, 2024, 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 December 2, 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 the Respondent of the Complaint, and the proceedings commenced on December 3, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 23, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 27, 2024.

The Center appointed Gary Saposnik as the sole panelist in this matter on January 6, 2025. 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 Pennsylvania based company that has provided comfort footwear to customers around the world since 1990. They began with clog sales, and now offer footwear including boots, sandals, flats, and sneakers, all designed for long-wear and comfort. In addition to the Complainant's common law trademark rights in its DANSKO marks, through its use, advertisement, and promotion of such marks in connection with its footwear goods, the Complainant has obtained numerous trademark registrations for its DANSKO marks. Amongst these include the following registrations in the United States Patent and Trademark Office, as the United States is the location of both parties:

- DANSKO, Registration No. 2712957, registered May 6, 2003, in class 25, for footwear, namely, casual outdoor shoes and work shoes for use in the health care, food service, equestrian, and general service industries;
- DANSKO and Design, Registration No. 2712953, registered May 6, 2003, in class 25, for footwear, namely, casual outdoor shoes and work shoes for use in the health care, food service, equestrian, and general service industries;
- DANSKO, Registration No. 3265194, registered July 17, 2007, in class 25, for footwear, namely, tips and heel pieces, and leather shoes and imitation leather shoes.

In addition to registering its DANSKO marks, the Complainant has spent significant resources protecting its DANSKO marks from infringement, including obtaining victories in other ICANN proceedings wherein there was a transfer to the Complainant of other domains incorporating DANSKO or a variation thereof. *Dansko, LLC v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-1257](#); *Dansko, LLC v. Congj Buxar*, WIPO Case No. [D2018-1672](#); *Dansko, LLC v. Wenhong Chen*, WIPO Case No. D2012-0583; *Dansko, LLC v. Jeffrey Mosier*, WIPO Case No. 2024-1505.

The Complainant offers its goods for sale, as well as corporate information, on its website at "www.dansko.com".

The Respondent, an individual with an address in the United States, registered the disputed domain name on November 21, 2024. At the time of the Complaint, the disputed domain name resolved to a website prominently displaying the Complainant's DANSKO marks, and purporting to sell the Complainant's goods at severely discounted prices. There is no indication at the website that the Respondent is unaffiliated with the Complainant.

#### 5. Parties' Contentions

##### A. Complainant

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

Notably, the Complainant contends that the disputed domain name is virtually identical to the Complainant's DANSKO marks and domain name, but for the addition of the descriptive phrase "footwear us", which does nothing to distinguish the disputed domain name from the Complainant's marks. The additional phrase actually increases the likelihood of confusion, as it indicates it is a place in the United States (where

Complainant is based) to shop for the Complainant's footwear. Such a descriptive phrase does not eliminate the confusing similarity with the Complainant's marks. Additionally, the use of a generic Top-Level Domain ".com" does not create a meaningful distinction from the Complainant's marks.

The Complainant avers that given the prominent use of DANSKO in the disputed domain name, with the additional descriptive phrase of "footwear us", consumers are likely to believe that the disputed domain name is related to, affiliated with, or otherwise sponsored by the Complainant. Consumers could easily be led to believe that the disputed domain name is intended to be used in connection with identical services covered by the Complainant's registered marks. Additionally, the resolving website contains infringing content in an attempt to confuse consumers.

The Respondent has no rights or legitimate interests in the disputed domain name, as Respondent is not affiliated with the Complainant, nor is there evidence to suggest that the Respondent has registered the disputed domain name to advance legitimate interests for the bona fide offering of legitimate goods or services.

The Respondent is not commonly known as "Dansko", or any of the terms in the disputed domain name. There is no evidence of any connection between the Respondent and the disputed domain name, and the Complainant has not authorized, licensed, or endorsed the Respondent's use of its DANSKO marks in the disputed domain name.

The Respondent's use of the disputed domain name is neither a bona fide offering of goods or services, nor a legitimate noncommercial or fair use. Rather, the disputed domain name resolves to a website with infringing content, prominently featuring the Complainant's DANSKO marks and purporting to offer identical footwear goods. Respondent has attempted to confuse consumers into believing the disputed domain name is related to the Complainant by offering footwear and footwear products via a website that is confusingly similar to the Complainant's bona fide website. The Respondent has made no effort to associate himself or herself with the disputed domain name and instead attempts to confuse consumers into believing that the Respondent is associated with the Complainant, thereby in an apparent attempt to syphon off of the Complainant's goodwill in its DANSKO marks.

The Complainant contends that the Respondent adopted and used the disputed domain name in bad faith and is in willful infringement of the Complainant's prior rights. The Respondent registered the disputed domain name long after the Complainant first began advertising and using its DANSKO marks in connection with footwear goods and services, and after the Complainant obtained United States trademark registrations for its DANSKO marks.

The Respondent attempted to take commercial advantage of the Complainant's trademarks and commercial reputation and to trade off of the Complainant's goodwill. The Respondent clearly had the Complainant in mind when registering the disputed domain name, as is apparent upon viewing the website located at the disputed domain name. The website uses the DANSKO marks in their entirety, along with imitating the Complainant, since the DANSKO mark is prominently displayed in connection with the sale of unauthorized or counterfeit goods. Given that the Respondent chose to attach descriptive terms after the DANSKO mark in the disputed domain name, it is likely that the Respondent plans to use this domain name in attempts to fraudulently obtain personally identifiable information from individuals believing that the disputed domain name is actually related to the Complainant. Based on a totality of the factors, the Respondent registered and used the disputed domain name in bad faith.

## **B. Respondent**

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

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the DANSKO mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "footwear" and "us", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

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

The Respondent has not responded to the Complaint, does not appear to be commonly known by the disputed domain name, is not using the disputed domain name for legitimate noncommercial or fair use, and is not affiliated with the Complainant or authorized to use the Complainant's DANSKO marks.

The Panel notes that the Respondent appears to have been using the disputed domain name to offer what purports to be the Complainant's footwear for sale, while using the Complainant's trademark and logo. The website evidence provided by the Complainant does not contain any information whereby the Respondent has notified consumers of a lack of affiliation with the Complainant. The lack of any disclaimer makes it more likely that Internet users would perceive it as an official website of the Complainant or in some way connected to or authorized by the Complainant. See *Dansko, LLC v. Jeffrey Mosier*, WIPO Case No. [D2024-1505](#).

The Complainant alleges that the goods offered for sale on the resolving website are either unauthorized or counterfeit, although presented as authentic DANSKO shoes of the Complainant. The Respondent has not come forward with any proof denying the allegation. Even if the footwear being offered on the Respondent's website were genuine, the Respondent's reselling of the Complainant's goods would need to satisfy the principles outlined in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#). As the subject website does not accurately and prominently disclose the Respondent's relationship (or lack thereof) with the Complainant, the Respondent has not demonstrated a right or legitimate interest in the disputed domain name. [WIPO Overview 3.0](#), section 2.8.1; *Dansko, LLC. v. Jeffrey Mosier*, WIPO Case No. [D2024-1505](#).

Panels have held that the use of a domain name for illegitimate activity, here, claimed as applicable to this case: sale of counterfeit goods, impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1. Although the Complainant has claimed that the goods are counterfeit, there has not been any proof presented. However, the lack of a disclaimer or lack of affiliation with the Complainant by the Respondent, combined with the use of the Complainant's marks and logo on the subject website would be evidence of impersonation/passing off of the Complainant to consumers encountering the website.

The Panel finds the second element of the Policy has been established.

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

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent registered the disputed domain name many years after the Complainant had acquired rights in its DANSKO marks. The inclusion of the term "footwear", which relates to the Complainant's goods, as well as the term "us", which can be perceived as a geographic term, along with the Complainant's logo mark on the subject website, was clearly intended to attempt to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's marks. The failure to include a disclaimer of any relationship with the Complainant on the resolving website further enhanced possible consumer confusion.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have held that the use of a domain name for illegitimate activity, here, claimed as applicable to this case, possible sale of counterfeit goods, as well as impersonation/passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Other indicia of bad faith use are the Respondent's failure to submit a response and rebut the Complainant's allegations.

Lastly, the Panel notes that the engagement of the Respondent in a pattern of trademark-abusive domain name registrations further supports the finding of bad faith registration and use of the disputed domain name. See, *Pfizer Inc. v. Shi Lei*, WIPO Case No. [D2024-4517](#). The Respondent was found to have engaged in bad faith registration of another trademark-abusive domain name in *CW Brands LLC v. Nadison Cherish*, NAF 2122703 (2024).

Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The Panel finds that the Complainant has established the third 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 name <dansko-footwear-us.com> be transferred to the Complainant.

*/Gary Saposnik/*

**Gary Saposnik**

Sole Panelist

Date: January 20, 2025