Decision for dispute CAC-UDRP-102173

Case number	CAC-UDRP-102173
Time of filing	2019-01-21 09:43:43
Domain names	3shapetaiwan.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	3Shape A/S

Complainant representative

Organization	BrandIT GmbH

Respondent

Organization	Sparta Polis Hosting

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of several trademarks. In particular, 3Shape A/S owns:

(i) the International Registration No. 1095013 "3SHAPE COMMUNICATE" registered on August 3, 2011 for class 9.

(ii) the International Registration No. 1271231 "3SHAPE" registered on August 31, 2015 for class 10.

(iii) the International Registration No. 1142176 "3SHAPE" registered on October 15, 2012 for classes 9 and 42.

The above trademarks are protected in many countries. The trademark listed sub (i) is protected also in China where the Respondent is located

FACTUAL BACKGROUND

3Shape A/S (the "Complainant") was founded by two graduate students in Denmark’s capital in the year 2000.

The Complainant is changing dentistry together with dental professionals across the world by developing innovations that provide superior dental care for patients. Complainant's portfolio of 3D scanners and CAD/CAM software solutions for the dental industry includes the multiple award-winning 3Shape TRIOS intraoral scanner, the upcoming 3Shape X1 CBCT scanner, and market leading scanning and design software solutions for dental labs. These products and innovations continue to challenge traditional methods, enabling dental professionals to treat more patients more effectively.

Today, the Complainant has over 1,200 employees serving customers in over 100 countries from an ever-growing number of Complainant's offices around the world.

The Complainant has a strong presence in China where the Respondent is located. Actually the Complainant's Sale and Academy are operated through local implementations in China.

The Complainant has proved to be the owner of different trademarks consisting of or including "3SHAPE" in several classes and in numerous countries.

The Complainant informs that due to extensive use, advertising and revenue associated with its trademarks worldwide, the Complainant enjoys a high degree of renown around the world, including in China, where the Respondent is located.

The Complainant has registered a number of domain names under generic Top-Level Domains ("gTLD") and country-code Top-Level Domains ("ccTLD") containing the term "3SHAPE", for example, <3shape.com> and <3shape.com.cn>.

The Complainant uses these domain names to connect to a website through which it informs potential customers about its 3SHAPE mark and its products and services.

The Complainant submits that the disputed domain name was registered only on June 1, 2018 and that it is confusingly similar to the Complainant's older trademarks since it directly and entirely incorporates Complainant's trademark "3SHAPE" coupled with the English word "Taiwan" which is a mere geographical indication.

Furthermore, it is the Complainant's view that the Respondent has no rights or legitimate interests in respect of the disputed domain name since the Complainant has never granted the Respondent any right to use the "3SHAPE" trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form. The Complainant also contends that the Respondent is not commonly known by the disputed domain name and that it has no interest over the disputed domain name.

In addition, the Complainant highlights that Complainant's trademarks predate the registration of the disputed domain name and that the active business presence of the Complainant in China market shows that it is unlikely that the Respondent was not aware of the unlawful registration of the disputed domain name. The Complainant also notes that the Respondent has associated the disputed domain name with an active but parked website and that said domain name has never been used in connection with a bona fide offer of products or services. It is also outlined by the Complainant that the Respondent has been using privacy shield to conceal its identity.

Finally, the Complainant informs that 3Shape A/S tried to contact the Respondent on July 23, 2018 through a cease-and-desist letter but it seems that the Respondent has simply disregarded the communication from the Complainant including the remainders sent on August 3, 2018 and August 28, 2018.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to

a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

Paragraph 4(a) of the Policy provides that to obtain the transfer of the disputed domain name, the Complainant must prove that each of the following elements is present:

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

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

1) The Complainant has established to be the owner of the trademark "3SHAPE" at least since October 2012. The Complainant's trademark is registered well before the registration of the disputed domain name (June 1, 2018). The Panel notes that the consensus view in previous UDRP panel decisions is that in determining confusing similarity under paragraph 4(a) of the Policy, the generic Top-Level Domain (“gTLD”) suffix (“.com” in this particular instance) should be totally disregarded. Therefore the comparison has to be made between the signs "3SHAPE" on the one side and "3SHAPETAIWAN" on the other side. The disputed domain name incorporates the Complainant's trademark "3SHAPE" coupled with the word TAIWAN. In this respect the Panel notes that many previous panels under the Policy have found that a mere geographic identifier in a domain name (as in the disputed domain name <3shapetaiwan.com>) does not alter the finding of similarity between the domain name in dispute and the previous registered trademark (please see Six Continents Hotels, Inc. v. Sdf fdgg, WIPO Case No. D2004-0384 and Credit Agricole SA v. Frederik Hermansen, CAC Case No. 101249). Accordingly, the Complainant has, to the satisfaction of the Panel, shown that the domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

2) The Complainant provided prima facie evidence that the Respondent does not have rights or legitimate interests in respect of the disputed domain name as it is not commonly known under the disputed domain name and was never authorized to use it by the Complainant. The Respondent, in the absence of any substantial response, has not shown any facts or element to justify prior rights or legitimate interests in the disputed domain name. The Complainant therefore succeeds also on the second element of the Policy.

3) Given the trademark registrations and widespread use of the mark "3SHAPE" by the Complainant, it is highly improbable that the Respondent was unaware of the Complainant’s trade mark "3SHAPE" when it registered the disputed domain name and therefore a finding of bad faith registration seems to be appropriate in the present case. Furthermore, the Panel accepts the Complainant's contentions that the disputed domain name has been used in bad faith under the principles of passive holding. It is consensus view that the lack of an active use of a domain name does not as such prevent a finding of bad faith under the Policy. In such cases, the panel must examine all the circumstances of the case to determine whether a respondent is acting in bad faith. Examples of circumstances that can indicate bad faith include a complainant having a

well-known trademark, no response to a cease and desist letter sent before the commencement of the proceeding, no response to the complaint, respondent's concealment of identity and the impossibility of conceiving a good faith use of the domain name (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003; Jupiters Limited v. Aaron Hall, WIPO Case No. D2000-0574;Nike, Inc. v. Azumano Travel, WIPO Case No. D2000-1598, Ladbroke Group Plc v. Sonoma International LDC, WIPO Case No. D2002-0131). The Panel is convinced that the trademark is a distinctive and well-known trademark. Furthermore it must be stressed that the Respondent failed to file a Response and therefore did not provide evidence of any actual or contemplated good faith use of the disputed domain name. In the view of the Panel, the facts of this case do not allow for any plausible actual or contemplated active use of the disputed domain name by the Respondent in good faith. The Panel is therefore convinced that, even though the disputed domain name has not yet been actively used, the Respondent's non-use of the disputed domain name equals to use in bad faith (see Amundi Asset Management v. Amundi, CAC Case No. 102288; Accor v. VNT Corporation, CAC Case No. 100004). The Complainant therefore succeeds also on the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **3SHAPETAIWAN.COM**: Transferred

PANELLISTS

Name	**Avv. Guido Maffei**

DATE OF PANEL DECISION 2019-02-25

Publish the Decision