Decision for dispute CAC-UDRP-102312

Case number	CAC-UDRP-102312
Time of filing	2019-02-05 10:58:36
Domain names	3shape-designer.com, 3shapedesignlab.com, 3shape-design.com, 3shapeconsultant.com, 3shapeconsultants.com, 3shapeconsulting.com, 3shapescanners.com, 3shapedesigners.com, 3shapesupport.com, 3shapenetwork.com, 3shapedesignstudio.com, 3shapelessons.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	3Shape A/S

Complainant representative

Organization	BrandIT GmbH

Respondent

Name	Michael Nadeau

OTHER LEGAL PROCEEDINGS

There are no other proceedings that the panel is aware of.

IDENTIFICATION OF RIGHTS

The Complainant is the owner of various national registered trade marks with the dominant and distinctive word element, 3SHAPE, in many countries worldwide. It has an EUTM No. 9719451 for the word mark, 3SHAPE COMMUNICATE, in class 9 registered on 24 August 2011. The specification reads as follows: “3D measuring machines; 3D scanners; software for generation of 3D production data; computer-aided design software (CAD); 3D visualisation and 3D analysis software: computer databases; computer-aided manufacturing (CAM) programming tools; dental practice management software, computer uploading programs, computer programs for providing electronic mail, computer communication systems and tools..”
That EUTM formed the basis for its International application, no. 1095013, in class 9 on 3 August 2011, registered in China, Korea and Russia. It also has many other national marks with the word element 3SHAPE, including five US marks such as no. 5130811 and 3790384 and others. The mark no. 3790384 is for class 9 as above, but also in class 42 for services: “IC 042. US 100 101. G & S: development of 3D measurement machines, 3D scanners, databases and production systems; development of software for 3D modeling, 3D visualization and 3D analysis; professional consulting services in the field of information technology.”
The Complainant has registered a number of domain names under the generic Top-Level Domains ("gTLD") and country-

code Top-Level Domains ("ccTLD") containing the term “3SHAPE.” For example, 3shape.com, in 2000, 3shape.com.cn, in 2009 and 3shapedesign.us in 2018. The Claimant has rights in many national registered trade marks with the word element 3SHAPE. Due to its extensive use and advertising worldwide, the Complainant’s name and marks are well known and enjoy a high degree of renown around the world, including in US.

FACTUAL BACKGROUND

FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

The Complainant was founded by two graduate students in Copenhagen, Denmark in the year 2000. The Complainant's goal was to work with dental professionals across the world in developing innovations that provide superior care for patients. The Complainant’s portfolio of 3D scanners and CAD/CAM software solutions for the dental industry includes the award-winning 3Shape TRIOS intraoral scanner, the pending 3Shape X1 CBCT scanner, and related 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 many locations around the world. The Complainant also has a strong presence in the US where the Respondent is located. The Complainant’s Sales, Academy, Marketing & Costumer Support are operated locally in the US.
According to the WHOIS records, the disputed domain names were registered between August and September 2018.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:
LEGAL GROUNDS:
i) THE DOMAIN NAMES ARE CONFUSINGLY SIMILAR
The disputed domain names registered between August and September 2018, directly, and entirely, incorporate the distinctive and dominant component of the Complainant’s trade mark, 3SHAPE, coupled with descriptive and/or generic terms such as “designer”, “consultant”, “scanner”, “network”, “support” or “lessons”, or similar variations. These generic words, reference or a closely connected to the Complainant’s core business activity.
The various suffixes are to be disregarded in the analysis of similarity. We refer to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Jurisprudential Overview 3.0"), paragraph 1.11. and International Business Machines Corporation v. Sledge, Inc. / Frank Sledge WIPO Case No. D2014-0581 (“it is generally accepted that the addition of the top-level suffix in the domain name (e.g., “.com”) is to be disregarded under the confusing similarity test”). Applying this reasoning, the disputed domain names should be considered confusingly similar to the trade mark, 3SHAPE.

ii) THE RESPONDENT HAS NO RIGHTS OR LEGITIMATE INTEREST IN RESPECT OF THE DOMAIN NAME
The Complainant has never granted the Respondent any right to use the 3SHAPE trade mark within the disputed domain names, or at all, nor is the Respondent affiliated to the Complainant in any way. The Respondent is not commonly known by the disputed domain names nor has it any interest in the disputed domain names or the parts thereof. The name “Michael Nadeau” shown in WHOIS as the Registrant is the only evidence that connects the Respondent to the disputed domain names. When entering the terms “3shape” and “designer”, “consultant”, “scanner”, “network”, “support” or “lessons” in the Google search engine, the results all point to the Complainant and its business activity. The Respondent could have easily performed a similar search before registering the disputed domain names and would have quickly learnt that the trade mark is owned and used by the Complainant. The Respondent has not, by virtue of the content of the website (to which one of the disputed domain names resolves), nor by his use of the disputed domain names shown that he is commonly known by the disputed domain names. The Complainant's 3Shape marks have become distinctive in US and worldwide and that the intention of the Respondent is to take advantage of and free-ride on an association with the business of Complainant.
By the time the Complainant was sending out the cease-and-desist letter, the websites associated with the disputed domain

names were mostly inactive or parked at GoDaddy, however, the website associated with <3shapesupport.com> was offering services as “3shape support” – without disclaimer of any association with the Complainant.
The phone number provided on that website, led to a company called “Quintessential Dental Laboratory & Technologies” that offers “quintessential techniques and materials” to clinicians and patients. Again, this shows the Respondent has no rights or legitimate interests in respect of the disputed domain names.

The Respondent has also engaged in a pattern of registering domain names corresponding to marks held by the Complainant by registering the 12 disputed domain names incorporating the distinctive and dominant element of the trade mark, 3SHAPE, with descriptive, generic terms. Such conduct cannot be considered as fair use of the disputed domain names.

Based on the above, there is no evidence that the Respondent has a history of using, or preparing to use, the disputed domain names in connection with a bona fide offering of goods and services, neither is it making a legitimate, non-commercial or fair use of the disputed domain names.

iii) THE DISPUTED DOMAIN NAMES WERE REGISTERED AND IS BEING USED IN BAD FAITH
It should be highlighted that Complainant’s trade marks predate the registration of the disputed domain names. Moreover, the active business presence of the Complainant in the US market together with its well-known reputation, means it is unlikely that the Respondent was not aware of the unlawful registration of the disputed domain names. Firstly, as noted above, by the time the Complainant sent the cease-and-desist letter, the disputed domain names were inactive/parked at the Registrar, except for <3shapesupport.com> which was offering the Respondent’s services without disclaimer.
The domain name parking may be passive holding of the disputed domain names, but the commercial use of <3shapesupport.com> proves: “the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the Respondent’s website or location or of a product or service on the Respondent’s website or location.” Both elements are considered as bad faith use of domain names.
Secondly, the Complainant tried to contact the Respondent on 26 September 2018, through a cease-and-desist letter regarding five of the disputed domain names (3shapedesigners.com; 3shapesupport.com; 3shapenetwork.com; 3shapelessons.com; 3shapedesignstudio.com). The letter was sent to the email listed in the WHOIS. However, the letter could not be properly delivered, and the email bounced for the stated reason “The address may be misspelled or may not exist.” In the meantime, the Complainant had located another seven of the disputed domain names registered by the Respondent. Consequently, the Complainant submitted a request to the Registrar for the WHOIS records of these 12 disputed domain names. The response from the Registrar of 14 November 2018 confirmed the WHOIS records had not been updated (could be reported as invalid). The Complainant formally notified the Registrar accordingly on 22 November 2018 as to the invalid WHOIS. Following the 15 day period for cure, the disputed domain names were suspended. This was the position when this Complaint was filed. All 12 disputed domain names displayed the notice of suspension page as at that date.

Invalid WHOIS is a separate and stand-alone ground of bad faith, see WIPO Case No. D2017-1594 Tetra Laval Holdings & Finance S.A. v. Su JinLe: (“[a] domain name registrant has a duty to provide valid contact details and the deliberate use of fictitious and/or ineffective contact details to register a domain name without valid reason has been held by past UDRP panels to corroborate a finding of bad faith registration and use (see ECCO Sko A/S v. Protected Domain Services Customer ID: NCR-2448048 / jizhiteam, WIPO Case No. D2010-1113; Farouk Systems Inc. v. David, WIPO Case No. D2009-1245). In the present case, the Panel takes the view that the finding of bad faith use and registration finds corroboration in the Respondent’s invalid contact details.”

Thirdly, the Respondent registered the disputed domain names incorporating the distinctive and dominant word element of the Complainant’s mark, 3SHAPE, combined with descriptive, generic terms, and these terms are closely related to the Complainant’s business. Such registrations constitute a pattern of conduct and have prevented the Complainant, the owner of the trademark, from reflecting the mark in a corresponding domain name. WIPO Jurisprudential Overview 3.0 paragraph 3.1.2 supports the finding of bad faith in this scenario. This is another separate and stand-alone ground of bad faith.

SUMMARY
To summarize: 1) the distinctive and dominant word element of the Complainant's trade mark, 3SHAPE, is a well-known worldwide, including in US where the Respondent is located. Its registration predates the registration of the disputed domain names. 2) The Respondent bears no relationship to the trade mark(s) or the Complainant. It is not commonly known by the disputed domain names nor has it any legitimate right or interest in the disputed domain names or any of them. 3) The Respondent is passively holding the disputed domain names except for one, which he used for commercial purposes and to divert traffic and free-ride on the Complainant's trade mark. 4) The Respondent provided invalid information for the WHOIS records. 5) The Respondent has engaged in a pattern of conduct that prevents the Complainant from reflecting the mark in a corresponding domain name, an additional element of bad faith. Consequently, the Respondent has registered disputed domain names confusingly similar to the Complainant's registered, well-known trade mark element, 3SHAPE. The Respondent has no legitimate right or interest in them, but rather, registered and has used them, in bad faith.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain names are 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 names (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 names have been registered and are 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

This is a straight forward case. The distinctive and dominant word component of the Complainant's well-known trade marks, 3SHAPE, has been registered by the Respondent together with descriptive and/or generic terms such as "designer", "consultant", "scanner", "network", "support" or "lessons", or variants of the same, which are all very closely connected to the Complainant's, highly successful worldwide, business of providing imaging and related software solutions to the dental industry.

These generic terms all reference the very same field of endeavour and services in a very focused and precise way. All are parked except for <3shapesupport.com> which is being used to offer similar services and to the same sector—the dental industry. The phone number on that website, belongs to a company called "Quintessential Dental Laboratory & Technologies" that offers "quintessential techniques and materials" to dental clinicians and patients. No disclaimer is given.

The Panel notes that while 3SHAPE is moderately inherently distinctive for dental software technology and services, being comprised of common terms, being a number character and an ordinary word, it has clearly acquired distinctive character with, and is well known to, the relevant public, the dental profession. Nothing in the use made by the Respondent suggests that this word element is being used in a way that is related to its ordinary common or primary usage or any descriptive meaning. This goes to the lack of legitimate fair use or rights. Nor is there any suggestion that the Respondent is otherwise making bona fide or fair use of it as a reseller or distributor.

In relation to 11 of the disputed domain names, it is not clear whether they were originally always parked. However, "passive holding" or non-use of a domain name will not prevent a finding of bad faith under the doctrine of passive holding. Rather panellists will look at the totality of the circumstances in each case, including: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or

contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>.

However, it is clear that the Complainant's, market leading, mark is being used to generate traffic and leads for the Quintessential Dental Laboratory & Technologies business. While it might be acceptable (in the EU) to make invisible use by bidding on keywords to offer one's services as an alternative, it is not acceptable to incorporate in this way for free-riding to divert traffic and confuse the relevant public. This constitutes bad faith.

We note that the Complainant has the burden of proof under the Policy and it has met it in the view of the Panel and the Respondent has not come forward to rebut it or justify its conduct. See Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>.

In addition, the WHOIS information is incorrect, has not been corrected, and further, the number of these registrations alone can constitute a pattern of conduct. It has not been necessary to consider these grounds in detail but they are relevant to the context as part of an overall assessment on bad faith under the approach in Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003, <telstra.org>.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **3SHAPE-DESIGNER.COM**: Transferred
2. **3SHAPEDESIGNLAB.COM**: Transferred
3. **3SHAPE-DESIGN.COM**: Transferred
4. **3SHAPECONSULTANT.COM**: Transferred
5. **3SHAPECONSULTANTS.COM**: Transferred
6. **3SHAPECONSULTING.COM**: Transferred
7. **3SHAPESCANNERS.COM**: Transferred
8. **3SHAPEDESIGNERS.COM**: Transferred
9. **3SHAPESUPPORT.COM**: Transferred
10. **3SHAPENETWORK.COM**: Transferred
11. **3SHAPEDESIGNSTUDIO.COM**: Transferred
12. **3SHAPELESSONS.COM**: Transferred

PANELLISTS

Name	**Victoria McEvedy**

DATE OF PANEL DECISION 2019-03-12

Publish the Decision