Decision for dispute CAC-UDRP-102662

Case number	CAC-UDRP-102662
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Domain names	3shapechina.com

Case administrator

Name	Šárka Glasslová (Case admin)

Complainant

Organization	3Shape A/S

Complainant representative

Organization	BRANDIT GmbH

Respondent

Organization	li yun fang

OTHER LEGAL PROCEEDINGS

There is no other legal proceedings the Panel is aware of which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

3Shape A/S owns several trademark registrations for 3SHAPE, among others 3Shape A/S is the owner of the following trademark registrations:
- International trademark 3SHAPE No. 779184, registered on December 15, 2001;
- International trademark 3SHAPE No. 1142176 (designating China), registered on October 15, 2012;
- International trademark 3SHAPE No. 1271231 (designating China), registered on August 31, 2015.

The Complainant also registered several domain names containing the term “3SHAPE” such <www.3shape.com> (registered on May 17, 2000) and <3shape.com.cn> (registered on January 10, 2009). The Complainant uses these domain names to resolve to its official website through which it informs internet users and potential consumers about its 3SHAPE mark and its products and services.

The disputed domain name was registered in December 7, 2018 and is inactive. The identity of its registrant is not publicly available. The Registrar disclosed the provided data and it appears that the Registrant is an individual domiciled in Beijing (China).

FACTUAL BACKGROUND

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3Shape A/S is a developer and manufacturer of 3D scanners and computer-aided system/computer-aided manufacturing ("CAD/CAM"), in the field of dental and hearing industries. Based in Denmark, 3Shape provides dental and hearing aid professionals with industry-leading scanners and fully integrated software that create highly streamlined processes for dental treatments.

3Shape A/S is a widely known actor in the dental and hearing aid industries globally. It employs more than 1,500 persons in close to 20 countries. 3Shape A/S has offices in many regions around the world (Europe, America and Asia-Pacific). 3Shape A/S opened an office in the city of Shanghai, China, in 2009 and has since then an established and growing presence in the Chinese market of 3D scanners and software for dental and hearing-aid care. Moreover, 3Shape A/S won several awards attesting of its expertise and strong presence in the dental and hearing aid industries worldwide. The Complainant also enjoys a strong online presence.

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

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT:

Language of the proceeding

In accordance with Paragraph 11 of the UDRP Rules, unless otherwise agreed by the parties, the language of the administrative proceeding is the language of the registration agreement, subject to the authority of the panel to determine otherwise, exercising its "discretion in the spirit of fairness to both parties, which pursuant to paragraph 10(b) of the Rules have to be treated with equality, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs" (see Carrefour v. Contact Privacy Inc. Customer 1242379769 / Le Berre, WIPO Case No. D2018-1552).

According to the Registrar Verification dated September 5, 2019 and the Czech Arbitration Court's Notification dated September 9, 2019, the language of the Registration agreement is Chinese. However, the Complainant requests the language of the administrative proceeding to be English for the following reasons.

Even if the Respondent is located in Bei Jing, China, the fact that the disputed domain name <3shapechina.com> (the "Domain Name") is composed of the English terms "shape" – part of the Complainant's trademark 3SHAPE – and "China" proves that the Respondent understands English. Moreover, the choice of registering and using a domain name combining English terms shows that the Respondent's intention is to target Internet users who understand English. In this regard, the Respondent also registered other domain names including English terms such as "dental" and "shop" in <dentalshop.cn> and "peloton" in <peloton.net.cn>. Furthermore, the Domain Name, being inactive, does not resolve to any website displaying content in Chinese language. Even though the language of the registration agreement is Chinese, the abovementioned facts show that the present case is directly connected to the English language.

Moreover, if the Complainant had to translate the Complaint in Chinese, such translation would entail significant additional costs for the Complainant and delay in the proceedings.

Consequently, the Complainant requests the Panel to exercise its discretion and allow the proceedings to be conducted in English.

The Panel is of the position that the request to choose English as the language of the proceedings is well founded and therefore accepted.

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

The Complainant owns many 3SHAPE trademarks registered before the domain name <3shapechina.com> was created. The disputed domain name in its second-level portion incorporates the Complainant's trademark 3SHAPE in its entirety with the addition of the geographical term "China". Previous UDRP Panels have constantly held that the mere addition of such a geographical term would not prevent a finding of confusing similarity to a trademark (see Credit Agricole SA v. Frederik Hermansen, CAC Case No. 101249 and Arcelormittal S.A v. James, CAC No. 102161). Moreover, the generic Top-Level Domain ".com" is a standard registration requirement and should be disregarded when assessing whether a disputed domain name is confusingly similar to the trademark in which the Complainant has rights (see, Arcelormittal S.A v. James, supra and Credit Mutuel Arkea v. Domain Administration, CAC Case No. 102345).

The disputed domain name is therefore confusingly similar to the Complainant's 3SHAPE trademark.

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

The domain name was registered in December 7, 2018, many years after the registrations of the Complainant's 3SHAPE trademarks.

The Complainant has not licensed or authorized the Respondent to register or use the disputed domain name. On the contrary, the Complainant became aware of the existence of the disputed domain name several months after the Respondent registered it.

Moreover, there is no evidence that the Respondent is known by the disputed domain name or owns any registered trademark including the term "3shapechina" or "3shapechina.com".

The domain name is inactive. Moreover, the Respondent's identity is not disclosed on the publicly available Registrar's WhoIs for <3shapechina.com>. Hence, the Respondent is most likely aiming at hiding its identity rather than being known by the domain name. The Respondent has therefore not by virtue of the content of the website, nor by its use of the domain name shown that he has been commonly known by the disputed domain name.

There is no evidence the Respondent has a history of using, or preparing to use, the disputed domain name in connection with a bona fide offering of goods and services, neither is it making a legitimate, noncommercial or fair use of the disputed domain name.

(iii) The Domain name was registered and is being used in bad faith.

a. Registration in bad faith

The Respondent registered the disputed domain name many years after the registrations of the Complainant's 3SHAPE trademarks. Moreover, the 3SHAPE trademark is a widely known trademark and registered in many countries. The Complainant has a growing presence in the Asia market, especially in China since 2009.

Moreover, by conducting a simple online search regarding the term "3shape", the Respondent would have been aware of the Complainant and its mark. In the most popular search engines, the Complainant's website or social medias account or related topics will appear as top first results. The Complainant is also very active on social media (Twitter, Facebook, Instagram, Weibo) to promote its mark, products and services. The Complainant is followed by more than 5,000 people on Twitter, 29,000 on Facebook and 45,000 on Instagram.

The Respondent also registered other domain names including terms directly related to the field of dentistry such as <dentalshop.cn> or <orthostudio.cn>. The name “Orthostudio” appears on the web to be used by some orthodontic practices in Canada or Czech Republic. The name “Orthostudio” also corresponds to an orthodontic software (Annex 21). Moreover, the Respondent registered the domain names <zortrax.net.cn> in October 2018 and <formlabs.net.cn> in December 2018 which include names of the companies Zortrax and Formalabs, designing and manufacturing 3D printers, especially in the field of dentistry. Formlabs and the Complainant built and made public a partnership in 2017, before the registrations of the domain name and <formlabs.net.cn>. Hence, it is impossible to conceive that Respondent was not familiar in 2018 with the topic of new technologies devices in the field of dentistry. On the contrary, the facts show that the Respondent knew this industry and the Complainant.

Furthermore, the domain name alongside the Complainant’s trademark includes the geographical term “China”. In light of the fact that the Complainant has an established office in China for ten years and a strong presence on the Chinese market, it is most likely that the Respondent – himself based in China – registered the Domain name having the Complainant in mind with a clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant’s trademark in Internet users’ mind.

Therefore, the Respondent knew the Complainant’s trademark at the time it registered the domain name and registered the disputed domain name in bad faith.

b. Use in bad faith

The Domain name is inactive.
Complainant relies on the Telstra case on the doctrine of passive holding, considering that “the non-use of a domain would not prevent a finding of bad faith” (see “WIPO UDRP Questions, Third Edition”, section 3.3). The circumstances of the case may indeed be such that “it is not possible to conceive of any plausible actual or contemplated active use of the domain name by the Respondent that would not be illegitimate, such as by being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant’s rights under trademark law” (see Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003).

In the present case, several factual considerations are clear indicators of bad faith use under the passive holding doctrine.

The disputed domain name is confusingly similar to the Complaint’s highly distinctive and widely known 3SHAPE trademark, which was first registered in 2001, and used for many years.

The Respondent could also not ignore the Complainant and its trademark when it registered the disputed domain name because of the Complainant’s strong online presence and its established office in China.

Moreover, the disputed domain name does not resolve to any website or online location that would testify of a legitimate or good faith use of the disputed domain name. There is therefore no evidence of any actual or contemplated good-faith use of the disputed domain name.

Furthermore, the domain name entirely incorporates the Complainant’s trademark with the addition of term “China”, country where the Complainant has an established office.

The Respondent also chose not to reply to the cease and desist letters sent by the Complainant which infers bad faith (see Arla Foods Amba v. Mlanie Guerin, CAC case No. 101640; Medela AG v. Donna Lucius, CAC case No. 101808).

Furthermore, as the publicly available WhoIs associated with the disputed domain name only discloses partial information on the registrant’s contact details (the registrant state/province and country), it is very likely that the Respondent is trying to conceal its identity which is further evidence of bad faith (see Amundi Asset Management v. Amundi, CAC Case No. 102288).

The overall described circumstances are clear demonstration of the implausibility of any good faith use of the disputed domain name (see Alstom v. Itete Peru S.A., WIPO Case No. D2009-0877).

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).

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant is required to prove that it has rights in a trademark or service mark, and that the disputed domain names are identical or confusingly similar to the Complainant's mark.

The Panel finds that the Complainant has established rights in the 3SHAPE trademark, by virtue of its trademark registrations, details of which are set out above.

The disputed domain name <3shapechina.com> incorporates the 3SHAPE trademark.
In the <3shapechina.com > domain name, the generic term “China” was added to the 3SHAPE trademark. “China” is the country of domicile of the Respondent and is also a country where the Complainant is established.

Adding the name of this country aims at identifying the Chinese market where the Complainant is established, letting the public believe that it is dedicated to the Chinese activities of the Complainant. Therefore, it does not avoid any confusing similarity.

The gTLD ".com" is a standard registration requirement, and may be disregarded when determining identity or confusing similarity under the first element.

For the reasons set out above, the Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(i) of the Policy.

NO RIGHTS OR LEGITIMATE INTERESTS

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in the disputed domain name by demonstrating any of the following:

(i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark or service mark at issue.

While 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 often impossible 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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See WIPO Overview 3.0, section 2.1.
In this case, the Complainant sent a cease and desist letter to the Respondent, using the email address available on the Whois and provided by the Registrar. It remained unanswered.
The disputed domain name postdates the 3SHAPE trademark and is inactive.

The Complainant has not licensed or authorized the Respondent to register or use the domain name and there is no evidence that the Respondent is known by the domain name or owns any registered trademark including the term “3shapechina” or “3shapechina.com”, or that he made any bona fide fair use of the disputed domain name.

In the circumstances of this case, the Panel finds that the Complainant has established a prima facie case of the Respondent’s lack of rights or legitimate interests in relation to the disputed domain names, which the Respondent has not rebutted.
The condition of paragraph 4(a)(ii) of the Policy has therefore been satisfied.

BAD FAITH

Paragraph 4(b) of the Policy sets out examples of circumstances that will be considered by a Panel to be evidence of bad faith registration and use of a domain name. It provides that:

“For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that the 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 trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent’s documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to your 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.”

The 3SHAPE trademark is worldwide protected, in many countries, including China and it predates the disputed domain name.

The addition of the geographical term “China” aims at letting the internet users believe that the disputed domain name is dedicated to the respective Chinese company of the Complainant.

The Complainant submits that the Respondent registered other domain names related to the dentistry. This search was conducted on the basis of the email address of the Respondent, which was disclosed by the registrar.

Given the position of the Complainant on the market, its presence in China, the interest of the Respondent for dentistry related domain names and the absence of any response, the Panel is of the opinion that the Respondent was well aware of the 3SHAPE trademark when it registered the disputed domain name.

Therefore, the Panel finds that the Complainant has made a prima facie case that the Respondent registered the disputed

domain name in bad faith.

When looking at the totality of the circumstances in this case, the Panel finds that the following facts support a finding of bad faith use:
- the 3SHAPE trademark is well-known on the dentistry market, which is of interest for the Respondent;
- the failure to respond to the Complaint or to submit any answer or piece of evidence;
- the registration as a Chinese person using a Privacy shield service;
- the implausibility of any good faith use to which the domain name may be put, in these circumstances.

For all the above reasons, the Panel is of the opinion that the disputed domain names satisfy the requirement of paragraph 4(a)(iii) that the disputed domain names were registered and are being used in bad faith by the Respondent.

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.

The Panel hereby agrees with the Complainants contentions and allows to continue the proceedings in English.

The Respondent remained inactive during the proceedings and did not file any administratively compliant response.

PRINCIPAL REASONS FOR THE DECISION

3Shape A/S is a widely known actor in the dental and hearing aid industries globally, including China, where the Respondent is domiciled. The 3SHAPE trademark 3SHAPE predates the registration of the disputed domain name.

The disputed domain names incorporates the 3SHAPE trademark and the addition of the country name "china" aims at letting the internet users believe that this domain name is dedicated to the Chinese company of the Complainant. Therefore, the disputed domain name is confusingly similar to the 3SHAPR trademark.

The Respondent bears no relationship to the trademarks or the Complainant; it is not commonly known by the disputed domain name and is not making any fair and non-commercial use of the disputed domain name.

The Respondent has interest for the dentistry and was well aware of the 3SHAE trademark when it registered the disputed domain name. It has been passively holding the Disputed Domain name, in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **3SHAPECHINA.COM**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2019-10-24

Publish the Decision