Decision for dispute CAC-UDRP-103158

Case number	CAC-UDRP-103158
Time of filing	2020-07-14 13:27:54
Domain names	3shapelab.icu

Case administrator

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

Complainant

Organization	3Shape A/S

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Dong Hu

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 proprietor of 3 international registrations of trademarks consisting of or containing the term “3shape”. The trademarks cover goods and services in classes 9, 10 and 42 of the Nice Classification and designate, among other territories, the Respondent’s country of origin – China.

Moreover, the Complainant owns an important domain names portfolio containing the term “3shape”, among others also the domain name <3shape.com.cn>.

FACTUAL BACKGROUND

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

The Complainant is a Danish producer of 3D scanners and a particular software design solution for dental and hearing industries, founded in 2000. Today, with more that 1500 employees in almost 20 countries, the Complainant is considered one of the significant global market players in the field. Since the opening of new offices in Shanghai in 2009, the Complainant is operating in Asian market – where the Respondent resides.

Part of the Complainant’s business concerns the digitalization of dental laboratories’ work through implementation of the Complainant’s computer aided design and manufacturing system.

The disputed domain name <3shapelab.icu> was registered after the Complainant’s trademarks referred to above, on 5 December, 2019. It used to redirect to a Chinese adult contend webpage but today resolves in blank page with no content.

On 22 January 2020, the Complainant addressed a cease and desist letter to the Respondent via the Registrar abuse contact e-mail, but has never received any response to it.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

PARTIES' CONTENTIONS:

COMPLAINANT'S CONTENTIONS:

Identical or confusingly similar

The Complainant argues that the disputed domain name <3shapelab.icu> is confusingly similar with its prior trademarks “3SHAPE”.

The Complainant argues that the disputed domain name is fully contained within its trademark and points out that the elements in which the signs vary, are descriptive and thus do not alter the overall confusion between the signs.

No rights or legitimate interests

The Complainant argues that there is no evidence at all that the Respondent is commonly known by the disputed domain name or a name corresponding to the disputed domain name, nor that the Respondent is making a bona fide offering of goods or services. Moreover, the Complainant states that the Respondent has not been licensed or otherwise authorized to use any of the Complainant’s trademarks nor to apply for or use any domain name incorporating such trade marks.

Registered and used in bad faith

As far as bad faith registration is concerned, the Complainant states that due to its worldwide presence, including the Chinese market, and considering that the Complainant’s trademark is notorious, the Respondent could not be unaware of the Complainant rights over the term “3shape” at the time of the disputed domain name’s registration.

The fact that the Respondent did not reply to its cease and desist letter sent on January 2020, is also deemed to be considered as a prima facie evidence of the Respondent’s bad faith in the disputed domain name registration.

Moreover, the Complainant considers that the inclusion of the descriptive term “lab” in the second level of the disputed domain name reflects the Respondent’s intention to create likelihood of confusion or association with the Complainant’s main clients – laboratories.

Finally, the website at the disputed domain name is currently inactive but used to redirect to an adult content web page which excludes, according to the Complainant, fair use of the disputed domain name.

RESPONDENT'S CONTENTIONS:

The Respondent did not respond to the Complaint.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to trademarks 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 15 of the Rules states that the Panel shall decide a Complaint on the basis of the statements and documents submitted and in accordance with the Policy, the Rules and any rules and principles of law deemed applicable.

In the case of default by a Party, Rule 14 states that if a Party, in the absence of exceptional circumstances, does not comply with a provision of, or requirement under the Rules, the Panel shall draw such inferences therefrom as appropriate.

In the present case, the Respondent has not submitted any Response and consequently has not contested any of the contentions made by the Complainant.

The Panel proceeds therefore to decide only on the basis of the Complainant's factual statements and the documentary evidences provided in support of them.

1. The first issue in this case concerns the language in which the UDRP proceeding can be conducted.

The Complainant argues that the Respondent understands English and that conducting the proceeding in English is in accordance with fair process. More specifically, the Complainant points out on the following circumstances:

- The Respondent has registered numerous domain names consisting of English terms;
- The disputed domain name includes two English terms: "shape" and "lab";
- English language is commonly used internationally;
- Conducting the proceeding in English would avoid unwarranted delay incurred into due to the need of provision of Chinese translations.

The Rules for the Uniform Domain Name Dispute Resolution Policy (UDRP) dictate in the article 11 that the language for a dispute proceeding:

(a) Unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

(b) The Panel may order that any documents submitted in languages other than the language of the administrative

proceeding be accompanied by a translation in whole or in part into the language of the administrative proceeding.

In deciding the appropriate language of the proceeding, the Panel considers that the disputed domain name includes an English word elements “shape” together with the abbreviation of an English world “lab”; the Complainant operates worldwide and uses English as a principal language in its business; the Respondent deploys English terms for other of its registered domain names.

Therefore, the Panel finds that all the above-mentioned factors in their conjunction are sufficient to establish that the Respondent understand English and considers reasonable to conduct the proceeding in English.

2. The Complainant produced suitable evidence on having rights in the name “3SHAPE”, and for the purpose of this proceeding, the Panel finds that the Complainant’s international trademark registrations “3Shape” Nos. 1142176, 1271231 and “3Shape Communicate” No. 1095013 satisfies the requirement of having trademark rights.

Having determined that the Complainant has trademark rights in the “3shape”, the Panel next assesses whether the disputed domain name <3shapelab.icu> is identical or confusingly similar to the “3shape” trademark of the Complainant.

The disputed domain name <3shapelab.icu> contains the Complainant’s “3shape” trademark in its entirety. The remaining elements in the disputed domain name are the terms “-lab” and the gTLD “.icu”.

It is well established that the gTLD is viewed as a standard registration requirement is disregarded under the similarity test. Moreover, the addition of descriptive terms to a trademark does not prevent a finding of confusing similarity.

Therefore, the different gTLD “.icu” does not affect the determination that the disputed domain name is identical or confusingly similar to the Complainant’s trademarks. Similarly, the term “lab” does not appear to be sufficient to avoid likelihood of confusion of the Complainant’s trademarks and the risk of association with the Complainant as such, given that the term refers to one of the principal business activity of the Complainant – system of computer aided design and manufacturing for dental laboratories.

The Panel accordingly concludes that paragraph 4(a)(i) of the Policy is satisfied.

3. The Respondent is not in any way related to the Complainant's business, and is not the agents of the Complainant. The Respondent is not currently known and has never been known as “3shape”, or any combination of this trademark.

The disputed domain name <3shapelab.icu> was linked to an adult content webpage and is not currently associated with any webpage. Therefore, the Respondent does not appear to have a legitimate interest in the disputed domain name.

Consequently, and in the absence of a Response, the Panelist finds that the Respondent has no rights or legitimate interests in the disputed domain name, so that the requirements of paragraph 4(a)(ii) of the Policy are met.

4. As to the bad faith at the time of the registration, the Panel finds that, in light of the worldwide presence of the Complainant’s business known under the name “3shape”, including its massive online presentation accessible also from China, the Respondent was more likely be aware of the Complainant’s trademarks at the time of the registration of the disputed domain name.

Furthermore, the Complainant provided screenshots of the adult content websites previously associated to the disputed domain name, showing prima facie evidence of the Respondent’s bad faith in the domain name registration, as it has been pointed out in WIPO Case No. D2001-1387 (January 23, 2002): "it is now well known that pornographers rely on misleading domain names to attract users by confusion, in order to generate revenue from click-through advertising, mouse-trapping, and other pernicious online marketing techniques".

Thus the overall evidence in the file leads this Panel to deduce that Respondents' choice of the disputed domain name was deliberate for its identity with the Complainant's trademarks, and with the intention to benefit from their publicity and notoriety, which indicates the Respondent's bad faith.

Under such circumstances, the Panel finds that the disputed domain name was registered in bad faith and was used in bad faith so that the Complainant has satisfied paragraph 4(a)(iii) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **3SHAPELAB.ICU**: Transferred

PANELLISTS

Name	**JUDr. Hana Číslerová, LL.M.**

DATE OF PANEL DECISION 2020-08-23

Publish the Decision