Decision for dispute CAC-UDRP-103149

Case number	CAC-UDRP-103149
Time of filing	2020-07-07 13:57:13
Domain names	3shape.dev

Case administrator

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

Complainant

Organization	3Shape A/S

Complainant representative

Organization	BRANDIT GmbH

Respondent

Name	Victor Zaitsev

OTHER LEGAL PROCEEDINGS

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

IDENTIFICATION OF RIGHTS

The Complainant, 3Shape A/S, owns several trademark registrations for 3SHAPE consisting or including the word " 3shape", such as:

• the semi-figurative international trademark registration in color 3SHAPE, No. 779184, registered on December 15, 2001 and renewed

• the international trademark registration 3SHAPE, No. 1142176, registered on October 15, 2012

• the international trademark registration 3SHAPE No. 1271231, registered on August 31, 2015

• the international trademark registration 3SHAPE COMMUNICATE, No. 1095013, registered on August 3, 2011

It contends that it registered a number of domain names containing the term "3SHAPE", such as:

• <3shape.com>, registered on May 17, 2000

• <3shape.eu>, registered on November 11, 2007

• <3shape.com.clinic>, registered on August 26, 2015

• <3shape.net>, registered on December 29, 2011

• <3shapeacademy.com>, registered on June 23, 2015

The Whois extracts that it produces for <3shape.com>, <3shape.net> and <3shapeacademy.com> indicate the use of a privacy service and do not provide the personal details of the Complainant, as registrant.

The provided screenshots of the website https://www.3shape.com/en/our-story and the various material produced in relation with the Complainant and its business prove its use of the domain name <3shape.com>.

Therefore, the Complainant is supposed to be the registrant of the domain name <3shape.com>, which it uses on a worldwide basis to communicate and run its business.

The Complainant provides as well screenshots of its website, available at www.3sahpe.net.

The disputed domain name is <3shape.dev>, registered on March 7, 2019

It resolves to a parked page of the Registrar: “Parked on the Bun! / 3shape.dev has been registered at Porkbun but the owner has not put up a site yet. Visit again soon to see what amazing website they decide to build. / Find your own great domain: find your domain… / Submit”.

The identity of its Registrant is not publicly available. The Registrar disclosed the personal data of the registrant after the complaint was notified.

It appears that the Registrant is an individual domiciled in Kiev (Ukraine).

FACTUAL BACKGROUND

The Complainant is the Danish company 3Shape A/S, which is a developer and manufacturer of 3D scanners and software solutions in the field of dental and hearing aid industries.

Based in Denmark, the Complainant employs 1 500 persons, serving customers in over 100 countries and has parent companies in many regions around the world such as Europe, North America, Latin America and Asia Pacific, including in Ukraine.

It has an office in Kiev (Ukraine) since 2006 with currently employs 313 employees. It is an active employer providing job opportunities and has been sponsoring events held in Ukraine.

It enjoys a strong online presence. Due to extensive use, advertising and revenue associated with its trademarks, it enjoys a high degree of notoriety in the field of software development and dentistry all over the world.

It enjoys a high degree of renown around the world, including in Ukraine, where the Respondent is located.

On February 28, 2019, the new gTLD extension “.dev” became available to everyone for registration.

The disputed domain name was registered a few days later, on March 7, 2019, using a privacy service.

As of July 6, 2020 and as hereabove explained, the disputed domain name <3shape.dev> gives access to the parked webpage of the Registrar, informing of the registration of the disputed domain name with Porkbun and that no website is available yet.

The Complainant has tried to reach the Respondent by sending a cease and desist letter to the Respondent on January 21, 2020, using the e-mail address available on the Whois.

It notified its rights on the 3SHAPE trademarks and requested to immediately stop any use of the domain name <3shape.dev>, as well as to stop any use of the 3SHAPE trademark.

On January 22, 2020, the Registrar sent an e-mail to inform the Respondent that it is not the registrant and that “to contact the registrant directly, we provide a method: visit https://porkbun.com/ and search for the domain in question.

Under “Registration Email” there should be a link you can copy and paste into a URL bar that will take you to a form that allows you to contact the registrant.”

On January 24, 2020, the Complainant proceeded accordingly.

The Respondent did not answer or react.

A reverse Whois search using the e-mail address provided by the registrar when it had to disclose the personal data of the Registrant revealed that the domain names <opel.com.ua>, <opel.kiev.ua> and <subaru.com.ua> respectively incorporating the famous brands OPEL and SUBARU are registered with a Registrant using the same e-mail address.

PARTIES CONTENTIONS

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 proceeding is the language of the registration agreement.

According to the Registrar Verification, the registration agreement is in English. Therefore, English is the language of the proceedings.

On the confusing similarity.

The Complainant contends that it owns numerous 3SHAPE trademarks registered around the world before the disputed domain name was created. It adds that “3Shape” has been its business identifier and commercial name for many years.

The disputed domain name incorporates the Complainant’s registered distinctive trademark 3SHAPE. The extension “.dev” does not add any distinctiveness and is a standard registration requirement, that should be disregarded when assessing whether a disputed domain name is confusingly similar to a trademark.

It submits that the disputed domain name is identical to its 3SHAPE trademarks and that there is a likelihood of confusion with its trademark in internet user’s mind.

On the absence of rights or legitimate interest.

The Complainant contends that the Disputed Domain Name was registered on March 7, 2019, many years after the registration of its 3SHAPE trademarks.

It asserts that it has never granted the Respondent any right or license to use its 3SHAPE trademark, that the Respondent is not affiliated to the Complainant in any form or that it has not been endorsed or sponsored by the Complainant.

It relies on the section 2.5.1 of WIPO Jurisprudential Overview 3.0 states: “Generally speaking, UDRP panels have found that domain names identical to a Complainant’s trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use, if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.”

There is no evidence that the Respondent is known by the disputed domain name, or owns any registered trademark including the term “3shape.dev”.

It submits that a search on online trademarks databases does not identify any 3SHAPE trademark in the name of the Respondent.

The disputed domain name was registered under a privacy service to hide the Respondent’s identity.

The Respondent could have easily performed a search on “3Shape” before registering the disputed domain name and would have quickly learnt that the trademarks are owned by the Complainant and that the Complainant has been using its 3SHAPE trademarks and business name for many years.

The disputed domain name resolves to the Registrar’s parked page.

Furthermore, it has tried to reach the Respondent sending a cease and desist letter in January 2020, using the available process, as explained by the Registrar.

It received confirmation from the Registrar’s platform that its message to the Registrant had been sent by its email services.

The Respondent has been granted several opportunities to present some compelling arguments that it had rights or legitimate interests in the disputed domain name, but has failed to do so.

This behavior, coupled with the absence of use of the domain name in connection with a bona fide offering of goods and services, further demonstrates the Respondent’s absence of rights or legitimate interests in respect of the disputed domain name.

On the registration and use in bad faith.

The Respondent registered the disputed domain name many years after the registration of the Complainant’s 3SHAPE trademarks. Its 3SHAPE trademark is a widely known trademark and worldwide registered. The term “3Shape” is also a business name that Complainant is using for many years including in Ukraine, where Respondent seems to be located.

It explains that by conducting a simple online search regarding the term “3shape”, the Respondent would have been aware of the Complainant and its trademark. In the most popular search engines, the Complainant’s website or social media accounts or related topics will appear as top first results. It relies on a decision, Intesa Sanpaolo S.p.A. v. Abayomi Ajileye, CAC Case

No. 102396, <onlineintesasanpaolo.com>.

It contends that it is very active on social media to promote its trademark, products and services. It is followed by more than 33000 people on Facebook, more than 50000 followers on Instagram and more than 5000 people on Twitter.

The use of the Complainant's trademark 3SHAPE in its entirety reflects the Respondent's intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users' mind. The Respondent deliberately chose to use the gTLD ".dev" combined with the distinctive 3SHAPE trademark, with the intention to benefit from the Complainant's renown in the field of dentistry. Generic TLD ".dev" is a space for developers or businesses associated with the tech world and Complainant obviously belongs to this category.

It relies on the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Jurisprudential Overview 3.0") para. 3.1.4 states: "Panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith."

It contends that the Respondent knew the Complainant's trademark at the time it registered the disputed domain name and that it registered it in bad faith.

The disputed domain name incorporates the 3SHAPE trademark in its entirety and is used to resolve to the registrar's parked page. Therefore, the Respondent has not been using it to offer any products or services. Since it is identical to the Complainant's distinctive trademark 3SHAPE, it is very likely to create a likelihood of confusion among Internet users who seek for products or services of the Complainant.

As hereabove explained, it tried to contact the Respondent, sending a cease and desist letter and the Respondent chose not to reply to it. To the Complainant it infers bad faith.

It is very likely that the Respondent was trying to conceal its identity which is further evidence of bad faith. According to section 3.6 of the WIPO Overview 3.0, the use of privacy service or proxy service merely to avoid being notified of a UDRP proceeding, may support an inference of bad faith.

Finally it explains that, by making a reverse WHOIS search by the e-mail of the Respondent as indicated in the Registrar Verification <v….z…@gmail.com, it appears that Respondent has also registered the domain names <opel.com.ua> and <opel.kiev.ua> incorporating famous automobile brand OPEL®, as well as the domain name <subaru.com.ua> incorporating another famous automobile brand SUBARU®. The mentioned domain names also resolve to the Registrar's parked pages. It proves that Respondent engaged in a pattern of trademark-abusive domain name registrations.

RESPONDENT:

The Respondent contends that it registered the disputed domain name as a combination of the generic word "shape" and a number, and that neither registration nor further use was intended in any way to infringe lawful rights of the Complainant.

It submits that the gTLD ".dev" was launched on January 16, 2019 opening successive registration periods, starting with the "Sunrise" period, the "Early Access" period and ending with "General availability".

The "Sunrise" registration period was opened only to trademark owners and the Complainant did not use this opportunity to register the disputed domain name. It did not either use the "Early access" registration period.

As of March 1, started the "General Registration" period, what means that the ".dev" zone became available to anyone, on a

first-come-first-served basis.

The disputed domain name was available and was registered “lawfully” on March 7, 2019.

It contends that it has not used the disputed domain name, since its registration, neither for commercial nor non-commercial purposes. It was planning to use the disputed domain name for a non-commercial purpose in the future, such as blogging. It has not purchased hosting for the disputed domain name and has not developed a website on any topic related to this domain, up to now.

It adds that the applicant's trademark could not be used by it in any area in which the rights of the trademark owner could be infringed. It do not conduct any commercial or non-commercial activity in a field similar to that of the Complainant company and do not use the 3SHAPE trademark to produce, sell or advertise any goods or services. It contends that It is not a founder or beneficiary of legal entities operating in areas identical or related to the business of "3Shape A/S" company. The applicant did not provide any evidence of my use of the 3SHAPE trademark in commercial (business) activities, nor evidence of competition between the Complainant company and it as an individual.

The disputed domain name was not used for parking in the meaning of gaining any commercial profit and was never pointed to the nameservers of companies that broadcast commercial advertising and that it does not use any advertisements or banners. The NS-servers <curitiba.porkbun.com>, <fortaleza.porkbun.com>, <maceio.porkbun.com>, <salvador.porkbun.com> are automatically assigned by the "Porkbun LLC" domain Registrar to any registered domain name, and only emphasize that the disputed domain name is registered with this company. It does not associate <3shape.dev> with the Registrar, and it is not the creator of the parking page automatically generated by the Registrar. It asserts that it did not use the domain name <3shape.dev> in bad faith.

The Complainant did not provide evidence that a cease and desist letter was sent to an actual registrant of the domain <3shape.dev>. The letter was sent only to "Porkbun LLC" abuse email, and the Registrar did not inform it about this fact in any way. It did not know that this letter was actually sent to it, and it was not aware about aim of this letter. It adds that the Complainant states that they had sent a message through the online form provided by the Registrar. But the Complainant itself provided a screenshot that the Registrar cannot guarantee delivery of the message sent through is platform. Moreover, the Complainant did not provide any evidence that the cease and desist letter or the message, sent by Complainant through the Registrar’s platform, were received by the registrant.

The Complainant submits that: "Respondent has been granted several opportunities to present some compelling arguments that they had rights or legitimate interests in the disputed domain name, but has failed to do so." But the statement about "several opportunities" does not reveal to be true, since not only I did not receive, as indicated above, the notifications from the Complainant, but also I could not know that such letter was actually sent to me”.

It has rights to use the domain name since that the registration fee is paid and the domain name is registered. It has no obligation to use the domain name, according to the registration agreement of "Porkbun LLC".

It submits that the statement of Complainant that it had a "clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant's trademark in Internet users' mind", as well as a general value judgement that the registrant had an "intention to benefit from the Complainant's renown in the field of dentistry" - is not true, not based on facts, based only on assumption, and reflects a biased appraisal of it, aiming to create erroneous image of it in order to obtain a disputed domain.

The Complainant's claim that it has used the Whois privacy service of the registrar, in order to use the registered domain in bad faith is a baseless allegation. This service is not infringing the Law and is provided free of charge without exception. Using this service can not be regarded as equivalent to bad faith.

The Complainant's claim that Whois privacy was used "to avoid being notified of the UDRP proceeding" is also a baseless allegation that is not based on facts. The essence of this service is to protect the domain registrant from spam or bots that

collect data and also from other use of personal data without the consent of the domain registrant. It relies on the Registrar's Privacy Policy:" Whois privacy service is provided to protect personal data of registrars' customers". Een Google, as an owner of the domain name <get.dev>, which is used for promoting registrations in the .dev gTLD domain zone, uses Whois privacy to protect the registrant's data, which hardly can be estimated as a bad faith behavior.

As of August 2, 2020, the Complainant can register domain names such as <3shape-as.dev>, <3shape-a-s.dev> and others, which relate to the name of the company.

There are also numerous gTLDs domain zones, which are directly related to the area of business of the Complainant, in which a combination of a number "3" with the generic word "shape" is free for public registration.

The Complainant, instead of registering free domain names to protect its trademark, rather abuses the rights of the registered domains owner, in order to obtain the domain from the registrant who legitimately registered it previously and did not use it in bad faith.

The domain name <3shape.dev> consists of generic word "shape" and a number, which can relate to a wide variety of topics for creating a website with this domain name. The word "shape" is a generic vocabulary word in English language, which has several meanings as a noun and a verb, e.g. "the particular physical form or appearance of something" and others.

RIGHTS

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 name is identical or confusingly similar to the Complainant's mark.

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 <3shape.dev> incorporates the 3SHAPE trademark.

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

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

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights 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.

The Respondent cannot seriously allege that it never received any cease and desist letter, before the complaint was notified.

The Complainant used the available online service run by the Registrar to contact the registrant to send him its cease and desist letter. It received a message from the registrar, saying: “We can promiss you that the message was successfully handed off to our mail servers”.

The Complainant had no other possibility to try to reach the registrant, who has to check its mailbox.

Anyhow, sending a cease and desist letter is not an obligation.

The Complainant contends that a search on Google on “3shape” refers to its business and its 3SHAPE trademarks and not to the Respondent. This fact is proved and not contested.

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 “3shape”, or that he made any bona fide fair use of the disputed domain name.

Indeed, the Respondent acknowledges that it has not made any commercial or non-commercial use of the disputed domain name. It does not contest either that the 3SHAPE trademark is well-known.

The fact that the 3SHAPE trademark is composed of the number “3” and of the English term “shape” does not affect the well-known character of the 3SHAPE trademark.

The Respondent has registered the disputed domain name, immediately after that the new gTLD “.dev” became available to anyone for registration, but it never used it since, alleging an intent to use it for non-commercial activities such as blogging, without proving for example, that it engages in this type of activity.

The response, explaining that the Complainant could register the disputed domain name before the .dev domain zone opened to everyone and that it could register domain names such as <3shape-as.dev>, <3shape-a-s.dev> and others, which relate to the name of the company, as well as under other extensions, cannot support the existence of any legitimate right or interest.

In the circumstances of this case, the Panel finds that the Respondent has no right or legitimate interest in relation to the disputed domain name, within the meaning of paragraph 4(a)(ii) of the Policy.

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."

Given the notoriety of the Complainant's in dental and hearing industry worldwide and its presence on the internet and in Ukraine, the Panel finds that the Respondent was well aware of the Complainant's rights in the well-known 3SHAPE trademarks when it registered the disputed domain name.

The Complainant found out that the domain names <opel.com.ua>, <opel.kiev.ua> and <subaru.com.ua> were registered using the same e-mail address and that they resolve to the same Registrar's parked pages.

The Respondent does not contest this fact, it ignores it.

The Panel finds that the Respondent has engaged in a pattern of conduct that consists of registering domain names composed with well-known trademarks, not using them, in order to prevent the respective right owners to reflect their trademark in corresponding domain names.

The response, asserting that the disputed domain name is not used and that it therefore does not infringe the 3SHAPE trademark, does not meet the UDRP criteria.

Taking into account the circumstances of the case, the Panel finds that passive holding of the disputed domain names amounts to acting in bad faith.

The Respondent did not provide any evidence of actual or contemplated good-faith use.

It is difficult to conceive of any plausible use of the disputed domain name that would amount to good faith use, given that the disputed domain name is identical to the Complainant's 3SHAPE trademark and registered domain names, which would inevitably result in misleading Internet users into believing that the disputed domain name is associated with the Complainant.

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

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

The disputed domain name incorporates the well-known 3SHAPE trademark and is confusingly similar to this trademark.

The Respondent bears no relationship to the Complainant's 3SHAPE trademark. 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.

Therefore, it has no legitimate right or interest in the disputed domain name.

Given the notoriety of the Complainant's in dental and hearing industry worldwide and its presence on the internet and in

Ukraine, the Panel finds that the Respondent was well aware of the Complainant's rights in the well-known 3SHAPE trademarks when it registered the disputed domain name.

The Respondent registered other domain names incorporating other famous trademarks.

The pattern of conduct of the Respondent is to prevent the Complainant from reflecting the 3SHAPE trademark in a corresponding domain name. It constitutes bad faith registration.

Its passive holding of the disputed domain name does not prevent a finding of bad faith use, given the circumstances of the case.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **3SHAPE.DEV**: Transferred

PANELLISTS

Name	**Marie-Emmanuelle Haas, Avocat**

DATE OF PANEL DECISION 2020-08-26

Publish the Decision