

Decision for dispute CAC-UDRP-104249

Case number **CAC-UDRP-104249**

Time of filing **2021-12-28 09:56:53**

Domain names **3shape-support.com**

Case administrator

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

Complainant

Organization **3Shape A/S**

Complainant representative

Organization **BRANDIT GmbH**

Respondent

Name **Michael Nadeau**

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 registrant, among others, of the following trademarks:

- international trademark registration No. 779184 "3shape", registered on December 15, 2001, for goods and services in classes 9 and 42;
- international trademark registration No. 1142176 "3shape", registered on October 15, 2012, for goods and services in classes 9 and 42; and
- US trademark registration No. 4565880 "3shape", registered on July 15, 2014, for goods and services in classes 9 and 42.

The disputed domain name was registered by the Respondent on March 19, 2020.

FACTUAL BACKGROUND

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

The Complainant is a developer and manufacturer of 3D scanners and computer-aided system/computer-aided manufacturing (“CAD/CAM”) and is one of the leaders in the field of dental and hearing industries. The Complainant provides dental and hearing aid professionals with industry-leading scanners and fully integrated software that create highly streamlined processes for dental treatments.

The Complainant is a widely known actor in the dental and hearing aid industries globally. It employs more than 1,600 people serving customers in over 100 countries.

The Complainant is based in Copenhagen, Denmark and has offices in many other areas around the world (Europe, Latin America, Asia-Pacific, North America, and in particular the United States of America where the Respondent seems to be located).

The Complainant also enjoys a strong online presence.

The Complainant is the owner of numerous trademark registrations for 3SHAPE registered worldwide.

Due to extensive use, advertising and revenue associated with 3SHAPE trademark and products, the Complainant enjoys a high degree of notoriety in the field of dentistry all over the world.

The Complainant has registered a number domain names containing the term “3SHAPE”; among them: <3shape.com> registered on May 17, 2000, <3shape.eu> registered on November, 21, 2007, <3shape.clinic> registered on August, 26, 2015, <3shape.net> registered on December, 29, 2011, <3shapeacademy.com> registered on June, 23, 2015 and numerous other domain names. 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 Complainant owns numerous trademarks for 3SHAPE registered before the disputed domain name.

The disputed domain name in its second-level portion incorporates the Complainant’s registered distinctive trademark 3SHAPE in its entirety along with the descriptive term “support” which directly refers to Complainant’s business. The 3SHAPE trademark is clearly recognizable in the disputed domain name. Previous UDRP panels have constantly held that the mere addition of a descriptive term would not prevent a finding of confusing similarity to a trademark.

The addition of the generic top-level domain “.com” does not add any distinctiveness and 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.

The disputed domain name was registered on March 19, 2020, many years after the registration of the Complainant’s 3SHAPE trademarks.

The Complainant has never granted the Respondent any right or license to use the 3SHAPE trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form.

The Complainant has never endorsed or sponsored the Respondent or the Respondent's website.

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

When conducting searches on online trademark databases in relation to the term 3SHAPE all the returned results refer to the trademarks of the Complainant but no information is found in relation with trademarks corresponding to “3shape-support.com”.

When conducting the search with the name of the Respondent and the terms “3shape-support.com” there are no results that

would show that the Respondent is commonly known by the disputed domain name.

Moreover, when searching for the terms “3shape support” or “3shape-support.com” on popular search engines, all the returned results refer to the Complainant and its trademark 3SHAPE or the Complainant’s services or products.

Moreover, the Respondent’s identity is not disclosed on the publicly available Registrar’s Whois for <3shape-support.com>. The registrant is indeed using a privacy shield service. Hence, the Respondent is most likely aiming at hiding its identity.

The Respondent could have easily performed a search 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 trademarks for many years.

Moreover, when searching for the name of the Respondent along with the terms “3shape-support.com” the results show a previous UDRP complaint filed by the Complainant against the Respondent in relation to the domain names: <3shape-designer.com>, <3shapedesignlab.com>, <3shape-design.com>, <3shapeconsultant.com>, <3shapeconsultants.com>, <3shapeconsulting.com>, <3shapescanners.com>, <3shapedesigners.com>, <3shapessupport.com>, <3shapenetwork.com>, <3shapedesignstudio.com>, <3shapelessons.com>. The Complainant was successful in the proceedings (CAC Case No. 102312).

Furthermore, at the time of filing of the Complaint the disputed domain name resolves to a pay-per-click page. By clicking on the links on that page, the domain name further redirects, among others, to a page offering dental braces for sale. Therefore, by clicking on the links, the user will be redirected, among others, to the website of the Complainant’s competitors.

Moreover, Complainant has tried to reach the Respondent by a cease-and-desist letter. However, there was no response. The Respondent has been granted opportunity to present some compelling arguments that they had rights or legitimate interests in the disputed domain name but has failed to do so. This behaviour coupled with the absence of use of the disputed 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.

The Respondent registered the disputed domain name many years after the registration of the Complainant’s 3SHAPE trademarks. 3SHAPE trademark is a widely known trademark in the field of dentistry and registered in many countries including in the United States of America.

Moreover, by conducting a simple online search regarding the term “3shape” or “3shape-support”, 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 inclusion of the Complainant’s trademark 3SHAPE in its entirety in the second level portion of the disputed domain name along with the relevant descriptive term “support” reflects the Respondent’s clear intention to create an association, and a subsequent likelihood of confusion, with the Complainant’s trademark in Internet users’ mind.

The Respondent had the Complainant and its trademark in mind at the time it registered the disputed domain name.

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

The 3SHAPE trademark is incorporated entirely in the disputed domain name along with the descriptive term “support”.

The pay-per-click website to which the disputed domain name redirects contains links to competitors’ websites offering for sale braces, which are products similar to the Complainant’s ones. Thus, the Respondent is capitalizing on the reputation and goodwill of the Complainant’s mark to attract users and direct them to the Complainant’s competing products.

Moreover, the fact that the Complainant tried to contact the Respondent through a cease-and-desist letter but the Respondent chose not to reply is a further indication of bad faith.

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

In accordance with paragraph 4(a) of the Policy, in order to obtain the transfer of the disputed domain name, the Complainant has to demonstrate that:

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

IDENTICAL OR CONFUSINGLY SIMILAR

The first requirement that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant's trademark or service mark rights.

There are two elements of this test: the Complainant must demonstrate that it has rights in a trademark or service mark and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark or service mark.

The Complainant has proven ownership of the registered trademark "3shape", identified in section "Identification of rights" above.

The Panel observes that the registration of the Complainant's trademark predates the registration of the disputed domain name.

On the question of identity or confusing similarity, what is required is simply a comparison and assessment of the disputed domain name itself to the Complainant's trademark.

The disputed domain name differs from the Complainant's trademark "3shape" only by the addition of the hyphen, of the word "support" after the hyphen, and of the top-level domain ".com".

It is well accepted that the hyphen is not relevant in the confusing similarity test (see, for example, WIPO case No. D2016-0676).

It is a common view that where a trademark is the distinctive part of a domain name, the domain name is considered to be confusingly similar to the trademark (see, for example, WIPO case No. D2017-1266).

In the present case the word "support" after the hyphen has no impact on the distinctive part "3shape". Moreover, the word "support" is a generic word which is insufficient to avoid any likelihood of confusion between the disputed domain name and the Complainant (see, for example, WIPO case No. D2019-0347). It is well established that where the relevant trademark is recognizable within the domain name, the addition of other terms would not prevent a finding of confusing similarity.

It is also well established that the top-level domain may generally be disregarded in the confusing similarity test (see, for example, WIPO case No. D2016-2547).

Therefore, the Panel considers that the disputed domain name is confusingly similar to the Complainant's trademark.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

RIGHTS OR LEGITIMATE INTERESTS

The second requirement that the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in the disputed domain name:

(i) before any notice to [the Respondent] of the dispute, [the Respondent's] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a bona fide offering of goods or services; or

(ii) [the Respondent] (as an individual, business, or other organization) [has] been commonly known by the [disputed] domain name, even if [the Respondent] [has] acquired no trademark or service mark rights; or

(iii) [the Respondent] [is] making a legitimate non-commercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

This is a non-exhaustive list of circumstances in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement falls on the Complainant. UDRP panels have recognized that proving that a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative".

Accordingly, it is usually sufficient for a complainant to raise a prima facie case against the respondent and the burden of proof on this requirement shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in a domain name.

The Panel finds that the Complainant has made out a prima facie case that the Respondent does not have rights or legitimate interests in the disputed domain name.

In particular, the Complainant states that:

- the disputed domain name was registered on March 19, 2020, many years after the registration of the Complainant's trademarks;
- the Complainant has never granted the Respondent any right or license to use the "3shape" trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form;
- the Complainant has never endorsed or sponsored the Respondent or the Respondent's website;
- there is no evidence that the Respondent is known by the disputed domain name or owns any registered trademark including the term "3shape-support.com";
- when conducting searches on online trademark databases in relation to the mark "3shape" all the returned results refer to the trademarks of the Complainant but no information is found in relation with trademarks corresponding to "3shape-support.com";
- when conducting an online search with the name of the Respondent and the terms "3shape-support.com" there are no results that would show that the Respondent is commonly known by the disputed domain name;
- when searching for the terms "3shape support" or "3shape-support.com" on popular search engines, all the returned results refer to the Complainant and its trademark "3shape" or the Complainant's services/products;
- the Respondent's identity is not disclosed on the publicly available Registrar's Whois for the disputed domain name and the registrant is using a privacy shield service;
- the Respondent could have easily performed a search 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 trademarks for many years;
- when searching for the name of the Respondent along with the terms "3shape-support.com" the results show a previous UDRP complaint filed by the Complainant against the Respondent;
- at the time of filing of the Complaint the disputed domain name resolved to a pay-per-click page containing, among others, links to the website of the Complainant's competitors;
- the Complainant tried to reach the Respondent by a cease-and-desist letter; however, there was no response.

In the absence of a Response, there is no indication in the present case that the Respondent is commonly known by the disputed domain name.

Furthermore, the Respondent has failed to demonstrate any of the other non-exclusive circumstances evidencing rights or legitimate interests under paragraph 4(c) of the Policy or other evidence of rights or legitimate interests in the disputed domain name.

The Respondent does not appear to make any legitimate non-commercial or fair use of the disputed domain name, nor any use in connection with a bona fide offering of goods or services.

Taking into account, among others elements, that the Respondent has no license or right to use the disputed domain name, that the Respondent is not affiliated to the Complainant, that the Respondent is not commonly known by the disputed domain name,

that there is no evidence of any fair or non-commercial use of the disputed domain name, the Panel cannot imagine any possible legitimate justification for this use, and the Respondent has not come forward with any explanation that demonstrates any rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

BAD FAITH

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, including:

- (i) circumstances indicating that [the Respondent] [has] registered or [has] acquired the [disputed] domain name primarily for the purpose of selling, renting, or otherwise transferring the [disputed] 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 [disputed] domain name; or
- (ii) [the Respondent] [has] registered the [disputed] 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 [disputed] domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the [disputed] domain name, [the Respondent] [has] intentionally attempted to attract, for commercial gain, Internet users to [the Respondent's] web site 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] web site or location or of a product or service on [the Respondent's] web site or location.

The Panel, on the basis of the evidence presented, agrees with the Complainant's contentions that the disputed domain name was registered in bad faith and that it has been used in bad faith.

The Panel observes that it is well established that the scenarios described in UDRP paragraph 4(b) are non-exclusive and merely illustrative. Therefore, even where a complainant is not able to demonstrate the literal application of one of the above-mentioned scenarios, evidence demonstrating that a respondent seeks to take unfair advantage of, abuse, or otherwise engage in behaviour detrimental to the complainant's trademark would also satisfy the complainant's burden.

Taking into account the fact that the registration of the trademark "3shape" predates of many years the registration of the disputed domain name, the wide knowledge of the trademark in the field of dentistry, the significant activity on social media, the previous outcome of another UDRP case (CAC Case No. 102312) against the Respondent concerning the same trademark (used in several domain names, including <3shapessupport.com>, very similar to the disputed domain name), the Panel agrees that it is inconceivable that the Respondent was not aware of the Complainant's rights in the trademark "3shape" when registering the disputed domain name. Other panels considered that knowledge of a corresponding mark at the time of the domain name's registration can suggest bad faith (see, for example, WIPO Case No. D2017-0100) and the Panel share this view.

Previous panels have also considered:

- the use of the disputed domain name in a pay-per-click website which contains links to websites of the Complainant's competitors as indicator of bad faith (see, for example, WIPO Case No. D2019-2748);
- the failure to reply to a cease-and-desist letter as evidence of bad faith (see, for example, WIPO Case No. D2019-0415);
- the use of privacy services for concealing the Respondent's identity as evidence of bad faith (see, for example, WIPO Case No. D2021-1898).

The Panel agrees with these views and considers that they are applicable in the circumstances of this case.

On the basis of the above elements, the Panel finds that the disputed domain name was registered and is being used in bad faith within the meaning of paragraph 4(b)(iv) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **3SHAPE-SUPPORT.COM**: Transferred

PANELLISTS

Name	Michele Antonini
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DATE OF PANEL DECISION	2022-02-06
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Publish the Decision