Decision for dispute CAC-UDRP-107100

Case number	CAC-UDRP-107100
Time of filing	2024-11-29 09:28:53
Domain names	3shape.shop

Case administrator

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

Complainant

Organization	3Shape A/S

Complainant representative

Organization	Abion GmbH

Respondent

Name	Julio Amador

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 has demonstrated ownership of rights in the trademark 3SHAPE for the purposes of standing to file a UDRP Complaint.

In particular, the Complainant is the owner of trademark registrations for 3SHAPE, including the following:

- International trademark registration No. 1142176 for 3SHAPE, registered on October 15, 2012;

- Mexican trademark registration No. 2658866 for 3SHAPE, registered on February 8, 2024; and

- European Union trademark registration No. 010828598 for 3SHAPE, registered on May 17, 2013.

The Complainant also refers to ownership over a number of domain names that incorporate its 3SHAPE trademark, including <3shape.com>, registered on May 17, 2000.

FACTUAL BACKGROUND

The Complainant is a developer and manufacturer of 3D scanners and computer-aided system/computer aided manufacturing

("CAD/CAM") software solutions for the dental and audio industries based in Copenhagen, Denmark. It was founded in 2000 and today has over 2,200 employees serving customers in over 100 countries from a number of offices around the world (Europe, North America, Latin America, China, Japan, Korea, Australia and New Zeeland). The Complainant has production facilities and offices in Asia, Europe, Latin America and the US.

The disputed domain name was registered on May 29, 2024 and it resolves to a parking page.

PARTIES CONTENTIONS

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. In particular, the Complainant argues that the disputed domain name should be observed as identical with or confusingly similar to 3SHAPE trademark and that the applicable TLD ".shop" should be disregarded as a standard registration requirement.

Regarding the second UDRP element, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Complainant has never granted the Respondent any right or license to use its 3SHAPE trademark within the disputed domain name, nor is the Respondent affiliated to the Complainant in any form. The Complainant further underlines that previous UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation. There seems to be no trademark rights owned by the Respondent in respect to the disputed domain name and there is no evidence that the Respondent engages in, or has engaged in any activity or work, i.e., legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name. The Complainant has sent cease-and-desist letter to the Respondent (both through privacy shield and through registrar), but there was no response from the Respondent. The Complainant holds that the Respondent has been granted several opportunities to present some compelling arguments regarding rights or legitimate interests in the disputed domain name, but has failed to do so.

With respect to the third UDRP element, the Complainant holds that the fact that the Respondent has registered a domain name that contains its 3SHAPE trademark in its entirety indicates that the Respondent registered the disputed domain name with full knowledge of the Complainant's trademark and that the disputed domain name was registered years after the registration of Complainant's trademark that is widely known in many countries, including Mexico, where the Respondent is located. Moreover, by conducting a simple online search regarding the term "3shape", the Respondent would have been aware of the Complainant and its trademark. The Complainant holds that passive holding of the disputed domain name does not prevent a finding of bad faith.

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

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy stipulates that the complainant must prove each of the following:

1. that the disputed domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
2. that the respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name, as stipulated in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("WIPO Overview 3.0").

The Complainant has shown rights in respect of the 3SHAPE trademark for the purposes of the Policy (WIPO Overview 3.0, section 1.2.1).

The entirety of the Complainant's trademark is reproduced within the disputed domain name without any additional terms. Accordingly, the disputed domain name is identical with the Complainant's trademark for the purposes of the Policy (WIPO Overview 3.0, section 1.7).

In addition, it is well established that ".shop", as a generic Top-Level Domain, can be disregarded in the assessment of the confusing similarity between the disputed domain name and the Complainant's trademark (WIPO Overview 3.0, section 1.11.1).

The Panel, therefore, finds that the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although 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 difficult 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

In particular, the Panel notes that there appears to be no relationship between the Respondent and the Complainant and that the Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's 3SHAPE trademark. There appears to be no element from which the Panel could infer the Respondent's rights and legitimate interests in the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

Moreover, the Panel notes that the nature of the disputed domain name carries a high risk of implied affiliation, since the disputed domain name is identical with the Complainant's 3SHAPE trademark. Previous UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation (see WIPO Overview 3.0, section 2.5.1). Furthermore, as demonstrated by the Complainant, Google search for the term "3shape" demonstrates results exclusively related to the Complainant, which additionally emphasizes a high risk of implied affiliation.

Having in mind the above, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of the disputed domain name in bad faith.

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, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith (WIPO Overview 3.0, section 3.2.1).

In the present case, the Panel notes that the Respondent must have been aware of the Complainant and its 3SHAPE trademark,

especially having in mind the distinctiveness of the Complainant's trademark. The Complainant's 3SHAPE trademark consists of number 3 and common and dictionary English word "shape", but this particular combination creates a unique and distinctive new word that appears to be exclusively used by the Complainant. It is, therefore, highly unlikely that the Respondent decided to register a domain name containing this trademark in its entirety without having the Complainant in mind when doing so. A mere Google search for the term "3shape" shows the results which are exclusively related to the Complainant. In the Panel's view, this is additional evidence that the Respondent had the Complainant in mind when registering the disputed domain name.

Due to the above, the Panel finds that the disputed domain name has been registered in bad faith.

The disputed domain name currently resolves to a parking page, meaning that the disputed domain has not been actively used by the Respondent. Nevertheless, the Panel holds that the particular circumstances of this case would lead to establishment of the bad faith on the Respondent's side under the doctrine of passive holding. Previous panels have already considered that passive holding of a disputed domain name can satisfy the requirements of paragraph 4(a)(iii) of the Policy, and that in such cases the panel must give close attention to all the circumstances of Respondents' behavior (Telstra Corporation Limited v. Nuclear Marshmallows, WIPO Case No. D2000-0003). The principles established in Telstra Corporation Limited v. Nuclear Marshmallows, had been widely adopted by UDRP panels and have found its place in WIPO Overview 3.0. In accordance with Section 3.3. of WIPO overview 3.0, factors that have been considered relevant in applying the passive holding doctrine include: (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. It should be emphasized that it is not required that all the above-listed factors be present in order to establish bad faith use of the disputed domain name (see, for example, Compagnie Générale des Etablissements Michelin v. K Nandalal, BlueHost, WIPO Case No. D2021-3990).

As indicated above, the Complainant's 3SHAPE trademark is highly distinctive as it is formed from the combination of a number and a common English word and such a unique term appears to be exclusively used by the Complainant. Furthermore, the Respondent has failed to provide its response both to the Complainant's cease-and-desist letter and to the UDRP complaint and thereby to provide any explanation for the choice of the disputed domain name and its planned use. In the Panel's opinion, the distinctiveness of the Complainant's 3SHAPE trademark, which is exclusively used by the Complainant, is such that it is rather difficult to imagine any good faith use that the disputed domain name could be put into. For that reason, the Panel finds that the disputed domain name has been used in bad faith in accordance with the doctrine of passive holding.

The Panel finds that the disputed domain name has been both registered and is being used in bad faith, and consequently that the Complainant has established the third element 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.shop**: Transferred

PANELLISTS

Name	**Stefan Bojovic**

DATE OF PANEL DECISION 2025-01-17

Publish the Decision