

ADMINISTRATIVE PANEL DECISION

3Shape A/S v. Domain Administrator, See PrivacyGuardian.org / B Chính
Case No. DCC2022-0001

1. The Parties

The Complainant is 3Shape A/S, Denmark, represented by BrandIT GmbH, Switzerland.

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States of America (“US”) / B Chính, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <crack3shape.cc> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 24, 2022. On January 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 25, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on January 26, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 2, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on February 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was February 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 28, 2022.

The Center appointed Andrew Brown Q.C. as the sole panelist in this matter on March 2, 2022. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant, 3Shape A/S, is headquartered in Denmark and is a provider of dental and audio technologies for laboratories and clinics. It develops and manufactures 3D scanners and computer-systems/computer aided manufacturing (CAD/CAM). It provides dental and hearing aid professionals with scanners and fully-integrated software that create highly streamlined processes for dental treatments.

The Complainant employs more than 1,600 people serving customers in 100 countries. It has parent companies in Europe, North America, Latin America and Asia-Pacific. It has offices in the US. In Asia it has offices in China, Republic of Korea, and Japan.

The Complainant is the owner of trademark registrations for the Mark 3SHAPE. These include:

- International Registration No. 779184 designating, amongst others, China, Japan, Republic of Korea, the US, and Singapore in classes 9 and 42. The registration date is December 15, 2001.
- International Registration No. 1142176 designating, amongst others, China, Japan, Republic of Korea, and the US in classes 9 and 42. The registration date is October 15, 2012.
- International Registration No. 1271231 designating, amongst others, China, Japan, Republic of Korea, and the US in class 10. The registration date is August 31, 2015.

The Complainant provided an annex showing registration of its 3SHAPE trademark in other jurisdictions.

The Complainant has registered a number of domain names including <3shape.com> (registered May 17, 2000); <3shape.eu> (registered November 21, 2007); <3shape.clinic> (registered August 26, 2015); <3shape.net> (registered December 29, 2011); and <3shapeacademy.com> (registered June 23, 2015).

The disputed domain name was registered on May 31, 2021, and does not resolve to an active website.

5. Parties' Contentions

A. Complainant

The Complainant asserts it owns 3SHAPE trademark registrations that significantly pre-date registration of the disputed domain name. The Complainant states that the disputed domain name incorporates its 3SHAPE trademark in its entirety with the addition of the descriptive term "crack". The term "crack" is claimed to directly relate to the Complainant's dental business and cracked versions of its 3Shape dental software which are often offered for sale online, thus disrupting the Complainant's business.

The Complainant says its 3SHAPE trademark is clearly recognizable within the disputed domain name.

The Complainant also contends that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant states that it has never granted the Respondent any right or license to use the 3SHAPE trademark in any form; nor has it endorsed or sponsored the Respondent.

Finally, the Complainant contends that the disputed domain name was registered many years after the Complainant's 3SHAPE trademark. It asserts that if the Respondent had conducted a simple online search of 3SHAPE, it would have been aware of the Complainant and its trademark. It states that Google searches of 3SHAPE show that the Complainant's website and social media appear as the top results. The Complainant therefore asserts that it is inconceivable that the Respondent was unaware of it and its 3SHAPE trademark.

The Complainant claims that the Respondent's registration of the disputed domain name including the word "crack" reflected a clear intention to create an association with the Complainant, likely with the intention to offer for sale cracked versions of the Complainant's software and to disrupt the Complainant's business.

As to use in bad faith, the Complainant notes that, although the disputed domain name is not associated with any active pages, nonetheless it relies on findings of previous panels and the doctrine of passive holding as allowing a finding of use in bad faith.

The Complainant also relies on the fact that the use of "crack" in the disputed domain name shows that it was likely created for illicit purposes, such as the distribution of cracked versions of the Complainant's software. It is asserted that this use is to attract users for commercial gain, since Internet users would think that the disputed domain name was connected to the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Pursuant to paragraph 4(a) of the Policy, a Complainant must prove each of the following elements with respect to the disputed domain name in order to succeed in this proceeding:

- (i) that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith

A. Identical or Confusingly Similar

The Complainant has provided evidence of registration of its 3SHAPE trademark. It has provided evidence of extensive use of its 3SHAPE trademark and trademarked products, as well as demonstrating that it enjoys a strong reputation in this mark.

It is the Panel's view that the Complainant has clearly and sufficiently demonstrated its rights in the 3SHAPE trademark. The Panel is well satisfied that the Complainant is well known by its 3SHAPE trademark in relation to dental and hearing aid scanners and software creating streamlined processes for remedial treatment.

The disputed domain name incorporates the 3SHAPE trademark in its entirety. Further, the Panel agrees with the Complainant that the addition of the term "crack" in the disputed domain name does not prevent a finding of confusingly similarity.

The WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), sections 1.8 and 1.11, indicates that:

- The addition of descriptive terms does not prevent a finding of confusingly similarity under the first

element.

- The addition of the country code Top-Level Domain (“ccTLD”) “.cc” is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test.

The Panel finds that the disputed domain name is therefore confusingly similar to the Complainant’s 3SHAPE trademark and finds in favor of the Complainant.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish that it has rights or legitimate interests in the disputed domain name, among other circumstances, by showing any one of the following elements:

- (i) that before notice of the dispute, the Respondent used or made 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) that the Respondent has been commonly known by the disputed domain name, even if it had acquired no trademark or service mark rights; or
- (iii) that the Respondent is making a legitimate noncommercial 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.

The overall burden of proof for establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name lies with the Complainant.

There is no evidence of the existence of any rights or legitimate interests on the part of the Respondent in respect of the 3SHAPE trademark pursuant to paragraph 4(c) of the Policy. The Complainant has (prior) rights in the 3SHAPE trademark which well precede the Respondent’s registration of the disputed domain name.

The Panel is also satisfied that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

The Respondent has failed to show that it acquired any rights in respect of the disputed domain name or that the disputed domain name is used in connection with a *bona fide* offering of goods or services. The Respondent had the opportunity to demonstrate its rights or legitimate interests, but it did not reply to the Complainant’s complaint.

The Panel therefore finds that the Complainant has satisfied the burden of establishing a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name, which was not rebutted by the Respondent, and accordingly finds that paragraph 4(a)(ii) of the Policy is satisfied in favor of the Complainant.

C. Registered and Used in Bad Faith

The Panel is also satisfied that the disputed domain name has been registered in bad faith.

The Panel is satisfied that the Complainant’s 3SHAPE trademark is well known amongst professionals in the dental and hearing aid fields. It agrees with the Complainant’s submission that a simple online search would have revealed the presence of the Complainant. In any event, it is inconceivable that the Respondent did not know of the Complainant. Its use of the term “crack” before “3shape” in the disputed domain name

plainly reveals that it knew of the Complainant and that the Respondent had a clear intention to create an association with the Complainant.

The Panel finds it entirely plausible that the Respondent had a likely intention to use the disputed domain name to offer for sale cracked versions of the Complainant's software. The term "crack" in the disputed domain name does not convey or import a legitimate purpose.

The Panel is also satisfied that the disputed domain name has been used in bad faith.

The Panel is satisfied that the passive holding doctrine applies as a result of the following factors and the circumstances of this case:

- (i) The degree of distinctiveness and reputation of the Complainant's 3SHAPE trademark.
- (ii) The lack of response from the Respondent.
- (iii) The Respondent's concealment of its identity.
- (iv) The use of the word "crack" together with the Complainant's trademark in the disputed domain name, which makes it impossible to conceive of a good faith use of the disputed domain name.

Accordingly, the Panel finds that paragraph 4(a)(iii) of the Policy is satisfied in favor of the Complainant.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <crack3shape.cc> be transferred to the Complainant.

/Andrew Brown Q.C./

Andrew Brown Q.C.

Sole Panelist

Date: March 16, 2022