

ADMINISTRATIVE PANEL DECISION

Medtronic, Inc. v. BIN ZHAO, medtronex.com
Case No. D2025-0201

1. The Parties

The Complainant is Medtronic, Inc., United States of America (“United States”), represented by Snell & Wilmer L.L.P., United States.

The Respondent is BIN ZHAO, medtronex.com, China.

2. The Domain Name and Registrar

The disputed domain name <medtronex.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 17, 2025. On January 20, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 20, 2025, 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 (Contact Privacy Inc. Customer 0165689512) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 21, 2025, 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 January 21, 2025.

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 January 22, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 11, 2025. The Response was filed with the Center on January 24, 2025.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on January 29, 2025. The Panel finds that it was properly constituted. 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.

On January 30, 2025, the Complainant submitted an unsolicited supplemental filing. On February 7, 2025, the Respondent submitted a response to the Complainant's unsolicited supplemental filing.

4. Factual Background

The Complainant is a medical device and technology company. According to the Complaint, it has been providing a wide variety of medical and health technology related goods and services under the trademark MEDTRONIC since 1949.

According to its website at "www.medtronic.com", the Complainant has 95,000 people in some 150 countries around the world. It provides solutions for the treatment of 70-plus health conditions from Parkinson's to diabetes. The Complainant's press release announcing the start of construction for a new 42 acre campus in Lafayette, Colorado in the United States stated that the Complainant's employee base included 11,000 scientists worldwide. The Complainant's website further claimed it has at least 191 active clinical trials in progress and USD 2.7 billion in R&D investments.

The Complaint includes evidence that the Complainant owns a number of registered trademarks for MEDTRONIC in the United States:

- (1) Registered Trademark No. 989,169, which was registered on July 23, 1974, in respect of consulting services with physicians and medical researchers in International Class 42;
- (2) Registered Trademark No. 1,038,755, which was registered on May 4, 1976, in respect of medical apparatus and instruments in International Class 10; and
- (3) Registered Trademark No. 5,335,831, which was registered on November 14, 2017, in respect of a range of financial services in International Class 36.

Each of these trademarks is registered in the Principal Register.

The disputed domain name was registered on November 11, 2022.

When the Complaint was filed, the disputed domain name resolved to a website which appeared to be offering for sale medical equipment from a variety of brands including Bard, FujiFilm, GE, Mindray, Olympus, and Philips and identified its main product categories as falling within "Ultrasound", "Endoscopy", "Probes", and "Aluminum". According to the Response, the Respondent also trades in non-ferrous metals.

The website gave the business' address as in Denver, Colorado in the United States.

Two of the Complainant's products are The Beacon EUS Delivery System and the ShareCore FNB Needle which are used in connection with biopsies. Two other products are the PillCam SB3 and PillCam Colon 2, which are capsules which the patient swallows to enable images to be recorded as the capsule passes through the digestive tract or colon.

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of a disputed domain name, the Complainant must demonstrate each of the following:

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

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

Before proceeding to the substance of the dispute, the Panel needs to rule on the admissibility of the Complainant's Supplemental Filing.

Paragraph 12 of the Rules empowers the Panel of its own motion to request further statements or documents from the parties. The Policy does not otherwise contemplate further documents in the proceeding apart from the Complaint and the Response.

Paragraph 10 of the Rules, however, gives the Panel a wide discretion relating to procedural matters subject to an overriding requirement to ensure that parties are treated equally and given a fair opportunity to present their respective cases. Consistently with the objective of providing an efficient and effective online dispute resolution mechanism, paragraph 10(c) directs the Panel to ensure that the proceeding takes place with due expedition. Subject to the overriding obligations mentioned, paragraph 10(d) empowers the Panel to determine the admissibility, relevance materiality and weight of the evidence.

For the most part, the Complainant's supplemental filing responds to a demand by the Respondent to identify overlapping product categories. The Panel, therefore, will include the supplemental filing in the record for this proceeding. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.6. As the Respondent's supplemental filing addresses this material, the Panel will admit it too in the interests of equal treatment.

A. Identical or Confusingly Similar

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

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. [WIPO Overview 3.0](#), section 1.7.

The Complainant has proven ownership of registered trademarks for MEDTRONIC as identified in section 4 above.

The comparison of the disputed domain name to the Complainant's trademark simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the question of "likelihood of confusion" under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties, the date they were acquired and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g., [WIPO Overview 3.0](#), section 1.7.

In undertaking that comparison, it is permissible in the present circumstances to disregard the generic Top-Level Domain (“gTLD”) component as a functional aspect of the domain name system. [WIPO Overview 3.0](#), section 1.11.

Disregarding the “.com” gTLD, the disputed domain name consists of the “medtron” component of the Complainant’s registered trademark with “ex” replacing “ic”. The Complainant contends therefore that the disputed domain name contains the dominant portion of the Complainant’s mark and substituted “ex” for “ic” which sounds similar or will likely be taken as the plural of the Complainant’s trademark. The Respondent contends, however, that the disputed domain name sounds different to the Complainant’s trademark, has a different meaning and, further, points out the Complainant does not have a registration for “Medtron” alone.

The Panel notes that on a standard QWERTY keyboard “e” and “i” are both touch-typed using the 3rd finger (albeit of different hands) and one may be mistyped for the other. Further, “x” is adjacent to “c” on the standard QWERTY keyboard. In addition, the Panel accepts that there is also considerable aural similarity between the two names. That aural resemblance is increased to the extent that the public may refer to the Complainant as “Medtronics” as, for example, people often mistakenly refer to “Lego” as “Legos”, or “Legoes”.

As this requirement under the Policy is essentially a standing requirement, therefore, the replacement of the “ic” component of the Complainant’s trademark with “ex” does not preclude a finding of confusing similarity. See e.g., [WIPO Overview 3.0](#), section 1.9.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

B. Rights or Legitimate Interests

The second requirement 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 a 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 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.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

While 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 often impossible 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. If the respondent fails to

come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name long after the Complainant began using the trademark and also after the Complainant had registered its trademark.

It is not in dispute between the Parties that the Complainant has not authorised the Respondent to use the disputed domain name nor that the Respondent is affiliated with the Complainant.

The disputed domain name is not derived from the Respondent's name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The Complainant contends that the use of the disputed domain name in connection with the business apparently being conducted from the Respondent's website does not qualify as a good faith offering of goods or services under the Policy as it would infringe the Complainant's trademark. The Complainant contends however that goods are not in fact available from the Respondent's website as, when the Complainant tried the "add to cart" button on the Respondent's website, it was not functional. Instead, a prospective purchaser was required to contact the Respondent by email for more information.

Yet further still, the Complainant contends that its MEDTRONIC trademark is of such longstanding and fame that no-one would choose the disputed domain name for use in connection with the Respondent's products unless they were trying to create a false impression of association with the Complainant.

In answer, the Respondent states that the disputed domain name was developed by ChatGPT to convey the idea of expertise in medical devices where "med" stands for "medical", "tron" is derived from the ancient Greek "tron" meaning tool or device, and "ex" is an abbreviation of "expert".

The Respondent further disputes that there is an overlap in its product offerings and those of the Complainant. According to the Respondent, the Respondent's business focuses on imaging products and a trade in aluminum products while the Complainant's business involves cardiovascular, neurostimulation, surgical solutions, diabetes management, spinal and orthopaedic solutions, ENT and respiratory products and renal care involving dialysis equipment. The Respondent says that the Complainant's biopsy products are not ultrasound imaging systems and the Complainant's PillCam products are very different to the Respondent's endoscope products which are physically manipulated by doctors.

As the Complainant points out, the Respondent does not deny knowledge of the Complainant's trademark. Indeed, given the longstanding nature of that trademark and the scale of the Complainant's operations, that would be a difficult case to sustain.

The Panel considers further that the Respondent's approach involves an unduly narrow approach to the risks of confusion. Given the range and scale of the Complainant's operations, there appears considerable potential for consumers to think the Complainant is offering products of the kind the Respondent apparently offers. It also appears likely that a member of the public aware of the Complainant's trademark could be confused into thinking the disputed domain name was being used by, or associated with, the Complainant.

The Respondent seeks to rebut the Complainant's allegations that products are not being genuinely offered from the Respondent's website by pointing out that the Respondent has registered, or is in some way associated with, a company legitimately incorporated in Colorado in the United States under the name Medtronex Inc. (The Panel's searches show that a company under that name was registered in Colorado on November 13, 2022, that is, two days after the disputed domain name was registered.)

It is not in dispute between the Parties that the principal address of Medtronex Inc. is a private residential property in Denver, Colorado. As the Respondent contends, that does not necessarily preclude that there is

a legitimate business. However, Denver Colorado is close to Lafayette Colorado and so contributes to the potential for confusion.

The Respondent further claims that the company is engaged in the trade of medical devices and aluminum products. However, its contracts and financial documents are confidential and will be made available to the Panel only under appropriate conditions to preserve their confidentiality.

The Panel does not accept that it is either necessary or appropriate to permit submission of the claimed contractual or financial documents on a confidential basis to the Panel only (if that is what is intended). The website to which the disputed domain name resolves publicly identifies businesses whose products the Respondent, or his associated company, claims to sell. It would be a simple matter to submit relevant documents with sensitive information, if any, appropriately redacted whether they be of arrangements with suppliers or sales to customers.

As made clear in [WIPO Overview 3.0](#), section 2.2, mere assertion is not sufficient to establish genuine use or demonstrable preparations for such use. Evidence of a website, or commissioning the design of a website, may provide appropriate corroboration bearing in mind, however, that a website may not involve much effort or cost. In the present case, therefore, the Panel is not prepared to accept the mere existence of the website as sufficient in the face of a direct (and apparently undisputed) challenge to its functioning and legitimacy.

In these circumstances, the Panel finds that the Complainant has established a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name and the Respondent has failed to rebut that *prima facie* case. Accordingly, the Panel finds the Complainant has established the second requirement under the Policy also.

C. Registered and Used in 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. These are conjunctive requirements; both must be satisfied for a successful complaint: see e.g., *Group One Holdings Pte Ltd v. Steven Hafto*, WIPO Case No. [D2017-0183](#).

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant.

As already noted, the Respondent does not explicitly deny knowledge of the Complainant and its trademark.

Given the longstanding nature of the Complainant's use of its trademark and the scale of the Complainant's operations, it appears very likely the Respondent was aware of the Complainant's trademark when registering the disputed domain name and registered it to take advantage of its resemblance to the Complainant's trademark and reputation.

Therefore, the Panel finds the Respondent has registered the disputed domain name in bad faith.

Even accepting the Respondent's claim that there is no direct overlap between the Respondent's goods (if Medtronex Inc. is genuinely trading in them), the use of the disputed domain name in connection with those goods is also likely to create a likelihood of confusion with the Complainant's trademark.

Accordingly, the Panel finds the Respondent has been using the disputed domain name in bad faith

Therefore, the Complainant has established all three requirements under the Policy.

6. 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 <medtronex.com> be transferred to the Complainant.

/Warwick A. Rothnie/

Warwick A. Rothnie

Sole Panelist

Date: February 12, 2025