

WIPO Arbitration and Mediation Center  
Case No.: DNL2019-0055  
Date: 23 January 2020

### **1. The Parties**

The Complainant is SmileDirectClub LLC, United States of America (“United States”), represented by Novagraaf Nederland B.V., the Netherlands.

The Respondent is [X], Germany.

### **2. The Domain Name and Registrar**

The disputed domain name <smiledirectclub.nl> is registered with SIDN through 1API GmbH, hereinafter referred to as the “Domain name”.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 4, 2019. On the same day, the Center transmitted by email to SIDN a request for registrar verification in connection with the disputed Domain name. On December 5, 2019, SIDN 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 December 5, 2019, 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 December 9, 2019. The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 11, 2019. In accordance with the Regulations, article 7.1, the due date for Response was December 31, 2019. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on January 3, 2020.

The Center appointed Richard C.K. van Oerle as the panelist in this matter on January 9, 2020. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

### **4. Factual Background**

The Complainant owns a number of registered trademarks around the world for the trademark SMILE DIRECT CLUB, including European Union Trademark registration No. 015998231, filed on December 21, 2016, registered on April 5, 2017, for goods in classes 9 and 10, hereinafter referred to as: the “Trademark”.

The SMILE DIRECT CLUB trademark and trade name are used intensively in commerce as trade name and trademark and continue to be used worldwide. The Complainant communicates on the Internet through various websites. The Complainant’s main domain name is <smiledirectclub.com>, registered on February 2, 2015. The Complainant has

also registered various other country-code Top Level-Domain (“ccTLD”) domain names with its Trademark incorporated therein.

The Respondent registered the Domain name on October 20, 2016. The page that resolves to the Domain name shows a pay-per-click (“PPC”) website, with (amongst others) links to websites that offer products related to the business of the Complainant.

## **5. Parties’ Contentions**

### **A. Complainant**

The Complainant offers all manner of goods and services related to clear aligner teeth straightening, as well as related goods such as lip balm and teeth whitening products. The purpose is to avoid patients having to make multiple surgery visits to dentist or orthodontists. The Complainant has started its business in 2014 in the United States and is nowadays one of the market leaders in the clear aligner industry around the world. Since March 2016, the Complainant is trading under the SMILE DIRECT CLUB trade name and mark. The Complainant has supplied its products to over 750,000 people and has spent some USD 400 million on sales and marketing since 2016.

According to the Complainant, the Domain name is confusingly similar in a high degree to the Trademark. The Complainant asserts that the Domain name is phonetically, visually, and conceptually identical to the Trademark. The Complainant contends that the Domain name contains the identical Trademark. In the opinion of the Complainant, consumers will assume that the Domain name is affiliated to the Complainant, because the Complainant is nowadays doing business in Europe.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain name and the Respondent is not related in any way to the Complainant. There has not been any commercial or noncommercial agreement between the Complainant and the Respondent, nor has the Respondent been granted authorization to make any use of the Complainant’s trade name SMILE DIRECT CLUB. Moreover, the Domain name is inactive, and the Complainant contends that the Respondent did not make any use of the Domain name since its registration in 2016. The above demonstrates a lack of legitimate interests in respect of the Domain name.

Finally, the Complainant asserts that the Domain name has been registered in bad faith. The Complainant contends that the registration of the Domain name seems to have been a deliberate action to tarnish the Trademark, but also to disrupt the business of the Complainant.

The circumstance that the identity and contact information of the Respondent are not publicly made available could enhance the bad faith character of the Respondent. Usage of a privacy shield or false/incomplete contact details are genuinely found in cases where trademark owners are intentionally tarnished by a domain name registration and the Respondent is acting in bad faith.

The Complainant is not only a successful company, but also a disruptor in the clear aligner market worldwide, and that has generated a lot of exposure for the Complainant’s business. In 2016, for example, the Complainant was featured extensively in the news because it was engaged in patent litigation with another clear aligner company. That rival litigant later became the Complainant’s partner. Registration of the Domain name occurred quite soon in 2016 after this news reporting took place. Therefore, it can be established that the Respondent was aware, or should have known the genuinely well-known Trademark of the Complainant at the time of registering the Domain name. The Trademark is well known and a simple trademark register search, or even an Internet

search, prior to registration of the Domain name in its name would have informed the Respondent of the existence of the Trademark.

According to the Complainant, the fact that the Respondent is acting in bad faith is emphasized by the circumstance that the Domain name has not been used ever since the registering thereof.

### **B. Respondent**

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

## **6. Discussion and Findings**

Pursuant to article 2.1 of the Regulations the Complainant must prove each of the following three elements:

a. the Domain name is identical or confusingly similar to:

I) a trademark or trade name protected under Dutch law in which the Complainant has rights; or

II) a personal name registered in the General Municipal Register ("Gemeentelijke Basisadministratie") of a municipality in the Netherlands, or the name of a Dutch public legal entity or the name of an association or foundation registered in the Netherlands under which the Complainant undertakes public activities on a permanent basis; and

b. the Respondent has no rights to or legitimate interests in the Domain name; and c. the Domain name has been registered or is being used in bad faith.

As the Respondent has not filed a Response, the Panel shall rule on the basis of the Complaint. In accordance with article 10.3 of the Regulations, the Complaint shall in that event be granted, unless the panelist considers it to be without basis in law or in fact.

### **A. Identical or Confusingly Similar**

The Panel has established that the Trademark is protected under Dutch law, and that the Complainant is the owner of the Trademark. Therefore, the Panel will not discuss the Complainant's alleged trade name rights.

The Domain Name is confusingly similar to the Trademark as it incorporates the Trademark in its entirety. The country code Top-Level Domain ("ccTLD") ".nl" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 1.11).<sup>i</sup>

Therefore, the Panel finds that the Domain Names are confusingly similar to the Trademark and the first requirement is met.

### **B. Rights or Legitimate Interests**

The complainant has to make out at least a *prima facie* case that the Respondent does not have rights or legitimate interests in the domain name (see, e.g., *Technische Unie B.V. and Otra Information Services v. Technology Services Ltd*, WIPO Case No. DNL2008-0002 and *LEGO Juris A/S v. M. Moench*, WIPO Case No. DNL2009-0052). If the complainant succeeds in making out this *prima facie* case, the burden of production

shifts to the respondent, who will then have to come forward with appropriate allegations demonstrating a right to or legitimate interests in the domain name.

The Panel understands that the Complainant did not give any consent, express or implied, to the Respondent to use their trademark in the Domain name, nor for any other purpose. There is also no commercial connection or affiliation with the Complainant. Therefore, the Respondent's use of the Domain name to host a parked page comprising PPC links with (amongst others) links to websites that offer products related to the business of the Complainant, falsely suggests a connection with the Complainant.

Generally speaking, UDRP panels have found that domain names identical to a complainant's trademark carry a high risk of implied affiliation (WIPO Overview 3.0, section 2.5.1.). Furthermore, previous panels have found that the use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with or capitalize on the reputation and goodwill of the Complainant's mark or otherwise mislead Internet users (see WIPO Overview 3.0, section 2.9). By using the Domain name to host a PPC parking page that is related to the business of the Complainant, the Respondent creates a likelihood of confusion with the Trademark and also disrupt the business of the Complainant.

Based on the above, The Panel finds that the Complainant has sufficiently set out its *prima facie* case.

As the Respondent did not offer any rebuttal, the Panel concludes that the Complainant has established that the Respondent has no rights or legitimate interests in the Domain name and the second requirement is met.

### ***C. Registered or Used in Bad Faith***

Article 2.1(c) of the Regulations requires the Complainant to show that the Domain name was registered and/or is being used in bad faith.

The Panel finds that the Respondent has targeted the Complainant to obtain PPC revenue. This constitutes bad faith under Regulations, see, *Scotch & Soda B.V. v. D-Max Ltd*, WIPO Case No. DNL2011-0058; and *Coöperatieve Raiffeisen-Boerenleenbank B.A. (Rabobank Nederland) v. Nguyet Dang, ND Dang*, WIPO Case No. DNL2010-0074.

The Panel finds that the Respondent must have been aware of the Complainant's rights in the Trademark when the Respondent registered the Domain name. When the Respondent registered the Domain name (in 2016) the Trademark had already been registered and widely used in connection to the Complainant's activities. The Panel finds that, by registering and using the Domain name, the Respondent's only intention was to appropriate the goodwill of the Trademark.

The Panel also notes that the Respondent has not filed a Response in this proceeding to deny knowledge of the Complainant at the relevant time or to explain the reason for its selection of the Domain name.

For the above reasons, the Panel finds that the Respondent has registered and uses the Domain name in bad faith and concludes that the requirement under article 2.1(c) of the Regulation has been met.

## **7. Decision**

For all the foregoing reasons, in accordance with articles 1 and 14 of the Regulations, the Panel orders that the domain name <smiledirectclub.nl> be transferred to the Complainant.

Richard C.K. van Oerle  
Panelist

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<sup>i</sup> While the Complaint is brought under the Regulations, and not the Uniform Domain Name Dispute Resolution Policy “UDRP”), given the similarities between the two, it is well established that cases decided under UDRP are relevant to proceedings under the Regulations (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, [WIPO Case No. DNL2008-0050](#)). The Panel considers UDRP precedents relevant to the current proceedings, and will refer to it.