

ADMINISTRATIVE PANEL DECISION

Medtronic, Inc. v. 王之未 (Wang Zhi Wei)

Case No. D2022-0439

1. The Parties

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

The Respondent is 王之未 (Wang Zhi Wei), China, self-represented.

2. The Domain Name and Registrar

The disputed domain name <medtronhealth.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 9, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 10, 2022, 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 February 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. The Complainant filed an amended Complaint in English on March 1, 2022 and confirmed its request for English to be the language of the proceeding.

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 in Chinese and English of the Complaint, and the proceedings commenced on March 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 23, 2022. On March 9, 2022, the Center received an email communication from the Respondent requesting that Chinese be the language of the proceeding and indicating that he was willing to participate in the proceeding. The Response was filed with

the Center in Chinese on March 10, 2022.

The Center appointed Matthew Kennedy as the sole panelist in this matter on April 12, 2022. 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.

4. Factual Background

The Complainant produces medical and health technologies, including medical devices. It is headquartered in Minnesota, United States, and owns over 75 manufacturing sites worldwide. The Complainant holds multiple trademark registrations for MEDTRONIC, including United States trademark registration number 1,014,415, registered on June 24, 1975 with a claim of first use in commerce at least as early as 1958, specifying biomedical apparatus and other goods in class 10. That trademark registration remains current. The Complainant has also registered the domain name <medtronic.com>, registered on June 7, 1990, that it uses in connection with a website where it provides information about itself and its medical devices. The website prominently displays the MEDTRONIC mark.

The Respondent is an individual. He filed United States trademark application serial number 90805438 for MEDTRON HEALTH on July 1, 2021, specifying medical devices and other goods in class 10. That application is pending. His contact address in the trademark application is in the United States while his contact address in the Registrar's Whois database is in China. According to his website, the Respondent operates a business named "Medtron Health" that was founded in Minnesota in 2010, moved to New York City in 2016, and began shipping products in 2017.

The disputed domain name was registered on March 28, 2021. As at August 17, 2021, it resolved to a website that prominently displayed the terms "Medtron Health" in the same position and font as the MEDTRONIC mark on the Complainant's website. Since at least October 20, 2021, the Respondent's website has displayed the terms "Medtron Health" in a different position and color but still in the same font, with a ring device. The website offers for sale a medical device called the Mega Ring Continuous Oxygen Monitor, and ships worldwide.

On October 20, 2021, the Complainant's legal representative sent a letter of demand in English to the Respondent. On the same day, the Respondent replied in English, undertaking to abandon his trademark application for MEDTRON HEALTH with prejudice, to stop use of MEDTRON, MEDTRON HEALTH and similar marks, and to transfer the disputed domain name to the Complainant. The Complainant's legal representative sent a follow-up letter in English on November 9, 2021.

5. Parties' Contentions

A. Complainant

The disputed domain name is confusingly similar to the Complainant's MEDTRONIC mark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. There is no evidence that the Respondent has been commonly known as "Medtron" or "Medtron Health". The Complainant has not authorized the Respondent to register or use the disputed domain name. The Parties are not affiliated, connected or associated with each other in any way. The Respondent is selling medical devices under the mark "Medtron Health" and intentionally attempting to deceive the public into believing that the Complainant has manufactured, sold, approved or licensed the Respondent's products.

The disputed domain name was registered and is being used in bad faith. It is not possible to conceive of a plausible circumstance in which the Respondent would have been unaware of the Complainant and its

MEDTRONIC mark. The Respondent's website formerly mimicked the font and color scheme of the Complainant's mark, and stated on its website that it was headquartered in Minnesota, the state where the Complainant is headquartered. Despite promising to comply with the Complainant's demands, the Respondent's continues to use the disputed domain name with a website selling medical devices and it has not abandoned its trademark application.

B. Respondent

The Respondent uses the mark MEDTRON HEALTH, which is a home consumer electronics brand that he created himself. His mark has nothing to do with the MEDTRONIC mark claimed by the Complainant. The disputed domain name is registered with the Registrar and the Respondent should have the legitimate right to use it. The Respondent uses the disputed domain name in a normal way to sell his own brand of products, without use in bad faith.

6. Discussion and Findings

6.1 Language of the Proceeding

Paragraph 11(a) of the Rules provides that "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding." The Registrar confirmed that the Registration Agreement for the disputed domain name is in Chinese.

The Complainant requests that the language of the proceeding be English. Its main arguments are that the Respondent is capable of communicating in English because his website was in English and he communicated with the Complainant in English prior to this proceeding whereas translation of the Complaint into Chinese would put an undue financial burden on the Complainant and delay the proceeding.

The Respondent requests that the language of the proceeding be Chinese, which is the language of the Registration Agreement.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that the Complaint and amended Complaint in this proceeding were filed in English and the Response was filed in Chinese. The Respondent's website is in English and the Parties communicated in English prior to the filing of the Complaint, which demonstrates that the Respondent understands that language. Therefore, the Panel considers that requiring the Complainant to translate the amended Complaint into Chinese would create an undue burden and delay whereas accepting all submissions as filed without translation does not cause prejudice to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English but that the Panel will accept the Response as filed in Chinese.

6.2 Analysis and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements:

- (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.

A. Identical or Confusingly Similar

Based on the evidence presented, the Panel finds that the Complainant has rights in the MEDTRONIC mark.

The disputed domain name incorporates most of the MEDTRONIC mark as its initial element, omitting only the final two letters of the mark. As the disputed domain name incorporates the dominant element of the mark, it can be considered confusingly similar to the mark for the purposes of the first element of paragraph 4(a) of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The disputed domain name includes the word "health". As the dominant element of the trademark remains clearly recognizable within the disputed domain name, the addition of this descriptive term does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8.

The disputed domain name also includes a Top-Level Domain ("TLD") extension (".com"). As a mere standard requirement of registration, this element is generally disregarded in the comparison between a domain name and a trademark for the purposes of the first element of paragraph 4(a) of the Policy. See [WIPO Overview 3.0](#), section 1.11.

Therefore, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the Panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (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.

As regards the first and third circumstances set out above, the Respondent uses the disputed domain name, which is confusingly similar to the Complainant's MEDTRONIC mark, in connection with a website that offers for sale a medical device, which is the same type of device that the Complainant produces. The website title "Medtron Health" is displayed in the same font as the MEDTRONIC mark on the Complainant's website, giving the impression that the Respondent is somehow affiliated with the Complainant. However, the

Complainant submits that it has not authorized the Respondent to register or use the disputed domain name and that the Parties are not affiliated, connected or associated with each other in any way. The Panel considers that the Complainant has made out a *prima facie* case that the Respondent is not making a use of the disputed domain name in connection with a *bona fide* offering of goods or services, nor is he making a legitimate noncommercial or fair use of the disputed domain name.

As regards the second circumstance above, the Registrar has verified that the name of the Respondent is “王之未 (Wang Zhi Wei)”, not the disputed domain name. Apart from his own website and his trademark application, there is no evidence indicating that the Respondent has been known as “Medtron Health”. There is no evidence that the Respondent has been commonly known by the disputed domain name.

Moreover, the Panel observes that “Medtron” is not a dictionary word, and that the Respondent’s trademark application for MEDTRON HEALTH is still pending. A mere application does not create rights or legitimate interests for the purposes of the second element of paragraph 4(a) of the Policy, and there is no evidence that would indicate that the Respondent holds unregistered rights in that mark.

In summary, the Panel considers that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Turning to the Respondent’s arguments, he notes that he registered the disputed domain name with the Registrar. However, the mere registration of a domain name does not create rights or legitimate interests for the purposes of the second element of the Policy, otherwise no complaint could ever succeed, which would be an illogical result. See, for example, *Pharmacia & Upjohn Company v. Moreonline*, WIPO Case No. [D2000-0134](#). The Respondent also claims to be making a normal use of the disputed domain name to sell his products, and the Panel has taken note of the claims regarding that business on the Respondent’s website. However, the Respondent provided no evidence of the operation of that business or its reputation. Accordingly, the Panel finds that the Respondent did not rebut the Complainant’s *prima facie* case.

Therefore, based on the record of this proceeding, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances shall be evidence of the registration and use of a domain name in bad faith. The fourth of these is as follows:

(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.

With respect to registration, the Panel observes that the disputed domain name was registered in 2021, many years after the Complainant obtained its trademark registration for MEDTRONIC in the United States, where the Respondent’s business is located, according to his website. The disputed domain name incorporates almost all the MEDTRONIC mark (omitting only the last two letters) as its initial element, with the addition of the descriptive word “health”. The disputed domain name resolves to a website that displays the terms corresponding to the disputed domain name (*i.e.*, “Medtron Health”) in the same font as the MEDTRONIC mark on the Complainant’s website, and offers for sale the same type of product as the Complainant’s products (*i.e.*, a medical device). Moreover, the Respondent claims on his website that his business was founded in Minnesota, the same state where the Complainant is located. The Panel does not consider these circumstances to be coincidental. While the Panel takes note that the prefix “med” is descriptive of the Parties’ respective goods (*i.e.*, medical devices), the term “medtron” is not. Accordingly, the Panel finds that the Respondent had the Complainant’s trademark in mind when he registered the disputed domain name.

With respect to use, the Respondent uses the disputed domain name in connection with a website that offers for sale a medical device, which is the same type of device that the Complainant produces. The Respondent's website prominently displays the title "Medtron Health" in the same font as the MEDTRONIC mark on the Complainant's website, offering for sale the same type of product that the Complainant produces, giving the false impression that the Respondent is somehow affiliated with the Complainant. This use is intentional and for the Respondent's commercial gain. Accordingly, the Panel finds that these circumstances fall within the terms of paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) of the Policy.

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 <medtronhealth.com> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: April 25, 2022