

ADMINISTRATIVE PANEL DECISION

Medtronic, Inc. v. adi terem
Case No. D2024-4552

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 adi terem, United States.

2. The Domain Name and Registrar

The disputed domain name <medtroniks.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 5, 2024. On November 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 7, 2024, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 8, 2024, 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 November 11, 2024.

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 November 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 2, 2024. The Respondent sent an email to the Center on November 12, 2024, apologizing for the confusion caused by the registration of the disputed domain name, saying it had been inadvertently registered and used by its client’s company, and expressed its client’s willingness to settle this matter. The following day, the Center sent an email to the Parties regarding possible settlement, indicating the Complainant should suspend the proceeding if the Parties

would like to explore settlement options, and the Parties should submit a completed Standard Settlement Form if they had agreed to settle the dispute. On November 14, 2024, the Respondent wrote to the Center again by email expressing its client's reluctance to transfer the disputed domain name without compensation due to the loss its client might face. The Complainant did not request a suspension. On November 21, 2024, the Complainant submitted a Supplemental Filing to the Center, copying the Respondent, which refers to the Parties' communications regarding the possible transfer of the disputed domain name. The Panel has decided to accept this further submission from the Complainant. On December 3, 2024, the Center informed the Parties that it would proceed with panel appointment.

The Center appointed Evan D. Brown as the sole panelist in this matter on December 5, 2024. 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 is a medical device and technology company. It owns the trademark MEDTRONIC, for which it enjoys the benefits of registration, including United States Reg. Nos. 989,169 and 1,038,755, registered on July 23, 1974 and May 4, 1976, respectively.

Since at least 1990, the Complainant has provided a website at the domain name <medtronic.com> where it uses its MEDTRONIC marks to advertise its medical devices and related goods and services.

According to the Whois records, the disputed domain name was registered on October 19, 2022. The Respondent has used the disputed domain name to resolve to a website featuring the name "Medtroniks Medical Technology" and purporting to provide medical equipment and services similar to the Complainant's offerings. The website does not appear to allow for direct purchases; instead, visitors are invited to contact the Respondent for more information by filling in a contact form requiring name, email address, and phone number.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

The Complainant further asserts that after the commencement of this proceeding, the Respondent's representative contacted the Complainant's counsel. During those communications, the Complainant's counsel inquired whether the Respondent would transfer the disputed domain name. The Respondent indicated that its client would transfer the disputed domain name only if the Complainant paid "USD \$250,000.00".

B. Respondent

The Respondent did not formally respond to the Complainant's contentions by filing a Response. The Respondent did communicate with the Center via email on November 12 and 14, 2024 on behalf of its client, as noted above. The Respondent claims that its client registered and used the disputed domain name with no malice or ill intent to infringe the Complainant's trademark; that its client did not know that the disputed domain name could be considered confusingly similar to the Complainant's trademark based on such a small variation; and that the Registrar did not flag the registration of the disputed domain name would cause any conflict.

The Respondent has expressed its client's willingness to transfer the disputed domain name, however, the client is concerned such transfer would result in the loss of accumulated client information and sales data that are distinct and separate from the Complainant's operations. Therefore, the Respondent's client would like to discuss any potential proposal of compensation for the loss it might face due to the transfer of the disputed domain name.

During the Parties' communications as submitted in the Complainant's Supplemental Filing, the Respondent claims that its client only uses the disputed domain name for email purposes and does not actively operate the website. Although the client would prefer to keep the disputed domain name, it is open to discussing a potential sale of the disputed domain name. When being asked by the Complainant regarding the compensation, the Respondent indicates that its client would like to propose "\$250,00.00" considering the lost sale opportunities and transition for the business to thrive.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (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. The Panel finds that all three of these elements have been met in this case.

A. Identical or Confusingly Similar

This first element functions primarily as a standing requirement. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. 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. *Id.* This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the MEDTRONIC mark by providing evidence of its trademark registrations. See [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name is confusingly similar to the Complainant's mark — substituting a "k" for the "c" and adding an "s" at the end — which do not prevent a finding of confusing similarity.

Additionally, the Top-Level Domain ("TLD") ".com" is disregarded for the purpose of assessing confusing similarity under the Policy.

Accordingly, the Panel finds that the Complainant has established this first element under the Policy.

B. Rights or Legitimate Interests

The Complainant asserts, among other things, that: (1) there is no evidence that the Respondent is commonly known by the disputed domain name, (2) the Complainant has not authorized the Respondent to register the Complainant's mark as a domain name, (3) the Parties are not affiliated, connected or associated with one another, and (4) the Respondent has not used the disputed domain name in connection with a bona fide offering of goods or services. Instead, the Respondent has set up a website at the disputed domain name similar to the Complainant's mark under the name of "Medtroniks Medical Technology", purporting to provide medical equipment and services similar to the Complainant's offerings.

The Panel finds that the Complainant has made the required prima facie showing. The Respondent has not presented evidence to overcome this prima facie showing.

The Panel also finds that based on the available case record, there is no evidence showing that the Respondent has been commonly known by the disputed domain name. Further, there is no evidence in the record showing the registration of the company “Medtroniks Medical Technology”.

The Panel therefore concludes that nothing in the record tilts the balance in the Respondent's favor. Considering the Complainant's fame in offering medical and health technology-related goods and services under its MEDTRONIC mark, the subtle difference between the disputed domain name and the Complainant's MEDTRONIC mark, and the goods and services provided on the website at the disputed domain name similar to those of the Complainant, there is a risk that Internet users may think that the website at the disputed domain name may be somehow connected with the Complainant.

The Panel therefore finds that the Complainant has established this second element under the Policy.

C. Registered and Used in Bad Faith

The Policy requires a complainant to establish that the disputed domain name was registered and is being used in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a respondent's bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when a respondent “[uses] the domain name to intentionally attempt to attract, for commercial gain, Internet users to [respondent's] website or other online location, by creating a likelihood of confusion with complainant's mark as to the source, sponsorship, affiliation, or endorsement of [respondent's] website or location or a product or service on [the respondent's] website or location”.

The Complainant's MEDTRONIC mark has been known for decades, and certain of the Complainant's trademark registrations achieved incontestable status long before the Respondent registered the disputed domain name. Given the strong and longstanding rights in the MEDTRONIC mark, the Complainant's operation of its website at “www.medtronic.com” since at least 1990, the same location of the Parties, and the Respondent's offering of similar products and services on the website at the disputed domain name, the Panel finds it more likely than not that the Respondent was aware of the Complainant's rights at the time of registration. The facts of this case shows that the Respondent most likely targeted the Complainant and its well-known mark when it registered the disputed domain name. The Panel finds this sort of targeting to demonstrate bad faith registration of the disputed domain name.

The Respondent has also used the disputed domain name in bad faith. By incorporating a confusingly similar variation of the Complainant's mark into the disputed domain name and purporting to provide medical equipment and services under the name “Medtroniks Medical Technology” at a website there, the Respondent has sought to attract Internet users by creating a likelihood of confusion as to the source, sponsorship, or affiliation of its website. This constitutes bad faith under paragraph 4(b)(iv) of the Policy.

Moreover, the Panel finds the Respondent's demand of “\$250,00.00” for the transfer of the disputed domain name to be further indicia of bad faith under paragraph 4(b) of the Policy. The demand reflects an effort on the part of the Respondent to extract payment for the transfer of the disputed domain name for an amount far in excess of the out-of-pocket costs that would have been incurred by the Respondent to first procure the disputed domain name. See [WIPO Overview 3.0](#), section 3.1.

The Panel therefore concludes that the disputed domain name was registered and is being used in bad faith and that accordingly, the Complainant has established this third element under 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 <medtroniks.com> be transferred to the Complainant.

/Evan D. Brown/

Evan D. Brown

Sole Panelist

Date: December 17, 2024