

ADMINISTRATIVE PANEL DECISION

Cimpress plc and Cimpress Schweiz GmbH v. Olive Digital, Olive Digital Case No. D2023-1657

1. The Parties

Complainants are Cimpress plc and Cimpress Schweiz GmbH, United States of America (“USA” or “U.S.”), represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, U.S.

Respondent is Olive Digital, Olive Digital, U.S.

2. The Domain Names and Registrar

The disputed domain names <vistalogos.com> and <vistawebstudio.com> (the “Domain Names”) are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 14, 2023. On April 17, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. That same day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names which differed from the named Respondent (Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to Complainant on April 18, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainants filed an amendment to the Complaint on April 18, 2023.

The Center verified that the Complaint together with the amendment to the 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 Respondent of the Complaint, and the proceedings commenced on April 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 14, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 17, 2023.

The Center appointed Harrie R. Samaras as the sole panelist in this matter on May 24, 2023. 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

Cimpress plc is a publicly traded parent company that was formerly known as Cimpress N.V. prior to its merger with and into Cimpress plc, with Cimpress plc surviving. Cimpress plc's operating entities include Cimpress Schweiz GmbH, which serves as the principal intellectual property owner for Cimpress plc's "Vista" business.¹

Complainants invest in and build customer-focused, entrepreneurial, mass-customization businesses for the long term. Amongst its various businesses is the Vista business that was founded in 1995. It helps more than 15 million small businesses create and customize their marketing with easy-to-use digital tools and design-templates, and it provides expert graphic design support.

Complainants own many trademark registrations worldwide for marks that consist of or contain "VISTA". For the VISTA Mark the registrations include: U.S. Reg. No. 2,459,636 (registered June 12, 2001) and Int'l Reg. No. 1,688,150 (registered March 21, 2022). Complainants also own U.S. trademark registrations for the VISTAPRINT Mark including U.S. Reg. Nos. 2,433,418 (registered March 6, 2001); 3,117,106 (registered July 18, 2006); 3,126,343 (registered August 8, 2006); and 5,473,639 (registered May 22, 2018). And Complainants own European Union Reg. No. 018514704 for the VISTASTUDIO Mark (registered November 27, 2021).

Complainants' domain names (and their creation dates) used in connection with its Vista business include: <vista.com> (November 2, 1994); <vistaprint.com> (May 4, 1999); <vistastudio.com> (December 28, 2011); <vistalogoproduct.com> (July 31, 2013); <vistalogoproducts.com> (July 31, 2013); and <vistalogo.com> (May 5, 2019).

The Domain Name <vistalogos.com> was registered on October 8, 2019 and <vistawebstudio.com> was registered on December 2, 2019. Respondent is using the Domain Names in connection with websites using the VISTA Mark and offering for sale services that are the same as services offered by Complainants in connection with that Mark, including services for creating logos and designing websites. Also, Respondent is using on its website images (namely, logos) from Complainants' website.

5. Parties' Contentions

A. Complainants

The Domain Names are confusingly similar to the VISTA Mark. The relevant comparison to be made is with the second-level portion of the Domain Names (i.e., "vistalogos" and "vistawebstudio"). The top-level domain name (i.e., ".com") may be disregarded for this purpose. The Domain Names contain the VISTA Mark in its entirety, merely adding the words "logos" and "webstudio". The Domain Names also contain the first or

¹ Section 4.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") provides: "In assessing whether a complaint filed by multiple complainants may be brought against a single respondent, panels look at whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation." See also section 1.4 of [WIPO Overview 3.0](#): "A trademark owner's affiliate such as a subsidiary of a parent or of a holding company, or an exclusive trademark licensee, is considered to have rights in a trademark under the UDRP for purposes of standing to file a complaint." Given the legal relationship between Cimpress plc and Cimpress Schweiz GmbH, and the facts and circumstances set forth in the Complaint, it is appropriate for both of these entities to bring the Complaint here and participate in these proceedings.

dominant portion of Complainants' VISTA marks that do not consist solely of VISTA (e.g., VISTAPRINT and VISTASTUDIO), given that the first or dominant portion of those marks is "VISTA".

Adding the descriptive words "logo" and "web studio" in the Domain Names does nothing to alleviate confusing similarity. Panels have found that a domain name containing a complainant's trademark plus a word that is associated with the trademark, as is the case here, given the obvious association between the words "logos" and "web studio" in the Domain Names and the services set forth in Complainants' registrations for the VISTA Mark, does not diminish – and, if anything, may actually increase – confusing similarity between the VISTA Mark and the Domain Names.

Complainants have never assigned, granted, licensed, sold, transferred or in any way authorized Respondent to register or use the VISTA Mark in any manner. By using the Domain Names in connection with websites that appear to be websites for, or otherwise associated with, Complainants and by using the VISTA Mark on those websites while offering for sale services that are the same as services offered by Complainants in connection with the VISTA Mark (including services for creating logos and designing websites), Respondent has failed to create a *bona fide* offering of goods or services under the Policy. Furthermore, to Complainants' knowledge, Respondent has never been commonly known by either of the Domain Names and has never acquired any trademark or service mark rights in either of them. The Whois records identify Respondent as "Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf" – not as "Vista" or "Vista Logos" or "Vista Web Studio" or anything similar thereto. In addition, given Complainants' registration of the VISTA Mark for more than 21 years and Complainants' 60 trademark registrations in at least 28 jurisdictions worldwide for the VISTA Mark, it is practically impossible that Respondent is commonly known by this Mark.

The VISTA Mark is clearly famous and/or widely known, given that it is protected by at least 60 trademark registrations in at least 28 jurisdictions worldwide, the oldest of which was registered more than 21 years ago, and that is used by a company with USD 2.9 billion of revenue in fiscal year 2022 and has approximately 15,000 full-time and approximately 1,000 temporary employees, in connection with a business that helps more than 15 million small businesses. Similarly, given the global reach and popularity of Complainants' services under the VISTA Mark and the Domain Names' similarity to Complainants' own domain names <vista.com>, <vistaprint.com>, <vistastudio.com>, <vistalogoproduct.com>, <vistalogoproducts.com>, and <vistalogo.com>, it is inconceivable that Respondent chose the Domain Names without knowledge of Complainants' activities and the VISTA Mark. Also, by using the Domain Names in connection with websites that falsely appear to be websites for, or otherwise associated with, Complainants – by using Complainants VISTA Mark and offering for sale services that are the same as services offered by Complainants in connection with the VISTA Mark (including services for creating logos and designing websites) – Respondent is creating a likelihood of confusion with the VISTA Mark constituting bad faith. Respondent has also acted in bad faith by, copying images (namely, logos) from a website operated by Complainants and passing them off as Respondent's own images. Finally, Respondent has acted in bad faith by registering the Domain Names to prevent Complainants from reflecting the VISTA Mark in a corresponding domain name considering the registration of two Domain Names using the VISTA Mark.

B. Respondent

Respondent did not reply to Complainants' contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

It is uncontroverted that Complainants have established rights in the VISTA Mark based on the aforementioned trademark registrations for it.

The Domain Names <vistalogos.com> and <vistawebstudio.com> are confusingly similar to the VISTA Mark because they incorporate that Mark in its entirety. See *Government Employees Insurance Company v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / Edward Jarman, MONSOON BLOCKCHAIN*, WIPO Case No. [D2021-4023](#); and *Oki Data Americas, Inc. v. Asdinc.com*, WIPO Case No. [D2001-0903](#). Furthermore, each of the Domain Names contains the first or dominant portion of those VISTA marks that do not consist solely of VISTA (e.g., VISTAPRINT and VISTASTUDIO), given that the first or dominant portion of those marks is “VISTA”. See [WIPO Overview 3.0](#), section 1.7 (“[W]here at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”).

Furthermore, adding the descriptive terms “logos” and “studio” to the VISTA Mark does not prevent a finding of confusingly similarity. See, section 1.8 of [WIPO Overview 3.0](#) (“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”).

It is also well settled that adding the gTLD, here “.com”, is not significant in determining whether a domain name is identical or confusingly similar to a trademark. See *CBS Broadcasting Inc. v. Worldwide Webs, Inc.*, WIPO Case No. [D2000-0834](#).

For the foregoing reasons, the Panel finds that paragraph 4(a)(i) of the Policy has been satisfied.

B. Rights or Legitimate Interests

It is uncontroverted that Complainants have never assigned, granted, licensed, sold, transferred or in any way authorized Respondent to register or use the VISTA Mark in any manner. Furthermore, to Complainants’ knowledge, Respondent has never been commonly known by either of the Domain Names and has never acquired any trademark or service mark rights in either of them. The Whois records initially identified Respondent as “Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf” then later as “Olive Digital, Olive Digital” – neither time as “Vista” or “Vista Logos” or “Vista Web Studio” or anything similar thereto. In addition, Complainants argue that given Complainants’ registration of the VISTA Mark for more than 21 years and the 60 trademark registrations for it, in at least 28 jurisdictions worldwide, it is practically impossible that Respondent is commonly known by the Domain Names.

Complainants further maintain that by using the Domain Names in connection with websites that appear to be websites for, or otherwise associated with, Complainants and by using the VISTA Mark on those websites while offering for sale services that are the same as services offered by Complainants in connection with the VISTA Mark (including services for creating logos and designing websites), Respondent has failed to create a *bona fide* offering of goods or services under the Policy.

Where, as here, Complainants have raised a *prima facie* presumption of Respondent’s lack of any rights or legitimate interests in the Domain Name, and Respondent has failed to rebut that presumption, the Panel is satisfied that Complainants have carried their burden of proving that Respondent has no rights or legitimate interests in the Domain Names within the meaning of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

It is undisputed that Complainants were using the VISTA Mark at least 18 years before Respondent registered the Domain Names <vistalogos.com> on October 8, 2019 and <vistawebstudio.com> on December 2, 2019. Furthermore, given the renown of the Mark here and abroad and that Complainants have various domain names themselves that they use in connection with their Vista business which predate the registration dates of the Domain Names (e.g., <vista.com> (November 2, 1994); <vistaprint.com> (May 4, 1999); <vistastudio.com> (December 28, 2011); <vistalogoproduct.com> (July 31, 2013); <vistalogoproducts.com> (July 31, 2013); and <vistalogo.com> (May 5, 2019)), the Panel finds it is highly unlikely Respondent was unaware of the Mark when registering the Domain Names. Respondent’s bad faith

registration is also evidenced by the facts that: (1) Respondent has not shown any rights or legitimate interests in the Domain Names; (2) Respondent registered two Domain Names that are exactly the same as Complainants registered VISTA Mark merely adding terms that describe services Complainants offer for sale (e.g., logo and website design); (3) Respondent's website uses the VISTA Mark throughout the websites associated with the Domain Names; and (4) Respondent is using the confusingly similar Domain Names to sell competitive services.

The Panel further concludes that by using confusingly similar Domain Names in conjunction with competitive websites (*i.e.*, providing similar services such as designing logos and websites) that also use the VISTA Mark throughout, Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion with the VISTA Mark as to the source, sponsorship, affiliation or endorsement of such site or the products or services advertised on such site, within the meaning of paragraph 4(b)(iv) of the Policy. See Section 3.1.4 of [WIPO Overview 3.0](#), stating that "redirecting the domain name to... a competitor's... website" is evidence of bad faith; see also, *Arla Foods amba v. Juccho Holdings*, WIPO Case No. [D2006-0409](#) ("the practice of registering a domain name and using it to redirect a user to a website which is used for the sale of competing services constitutes evidence of registering and using a trademark in bad faith"). Respondent has also acted in bad faith by copying images (namely, logos) from a website operated by Complainant and passing them off as Respondent's own images. See, e.g., *The Gap, Inc. and Athleta, Inc. v. 朱亚磊 (Ya Lei Zhu)*, WIPO Case No. [D2021-2965](#) (finding bad faith where "Complainants provide evidence that the disputed domain name directed to an e-commerce website which copied images" from Complainant's website "without any disclaimer as to the Respondent's (absence of) relationship with the Complainants"); *Starwood Hotels & Resorts Worldwide, Inc., Worldwide Franchise Systems, Inc., The Sheraton, LLC, Westin Hotel Management, L.P. v. Zeng Zheng, Lin Qing Feng*, WIPO Case No. [D2013-0840](#) (finding bad faith where "the Respondent has copied and reproduced on [its] websites various images... owned by the Complainant").

For the foregoing reasons, the Panel finds that paragraph 4(a)(iii) of the Policy has been satisfied.

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 Domain Names <vistalogos.com> and vistawebstudio.com> be transferred to Complainants.

/Harrie R. Samaras/

Harrie R. Samaras

Sole Panelist

Date: June 7, 2023