

## **ADMINISTRATIVE PANEL DECISION**

Cimpress plc, 99designs Pty. Ltd. v. IT Support, ePlanet Communications Inc,  
WIPO Case No. D2023-1659

### **1. The Parties**

Complainant is Cimpress plc, 99designs Pty. Ltd., United States of America (“United States”), represented by The GigaLaw Firm, LLC, United States.

Respondent is IT Support, ePlanet Communications Inc, United States.

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

The disputed domain name <98webdesigns.com> (the “Domain Name”) is registered with Wild West Domains, LLC (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 Name. On April 17, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the 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 Complainant on April 20, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on April 21, 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 May 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 26, 2023.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on June 6, 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**

Complainant Cimpress plc is a publicly traded parent company, whose operating entities include 99designs Pty. Ltd, which serves as the principal intellectual property owner for Cimpress's 99designs business. In October 2020, Cimpress acquired 99designs, Inc., and its subsidiaries (including Complainant 99designs Pty. Ltd.), a global creative platform for graphic design. Given the legal relationship between Cimpress and 99designs Pty. Ltd, both entities participate in this Complaint. Both are referred to individually, collectively or interchangeably as "Complainant" or "Complainants," as the context may require.

Complainant invests in and builds customer-focused, entrepreneurial, mass-customization businesses for the long term. Mass customization is a competitive strategy that seeks to produce goods and services to meet individual customer needs with near mass production efficiency. Complainant's 2022 annual report indicates Complainant had USD 2.9 billion of revenue in fiscal year 2022 and has approximately 15,000 full-time and approximately 1,000 temporary employees.

Complainant's businesses include BuildASign, Drukwerkdeal, Exaprint, National Pen, Pixartprinting, Printi, Vista, and WIRmachenDRUCK. Complainant's Vista business was founded in 1995 and helps more than 15 million small businesses create attractive, professional-quality marketing products at affordable prices and at low volumes. With Vista, small businesses are able to create and customize their marketing with easy-to-use digital tools and design-templates, or by receiving expert graphic design support.

The signature services of Complainant's Vista business include "99designs by Vista," a custom logo creation service. The business provides a global platform that connects designers and clients, making it easier for small businesses to access both professional design services and marketing products in one place, and enables Complainant to expand its design offering via a worldwide community of more than 150,000 designers to make it easy for designers and clients to work together to create designs.

Complainant is the owner of at least five trademark registrations covering at least 34 jurisdictions worldwide, including the United States and the European Union, for marks that consist of "99DESIGNS". The oldest registrations for the 99DESIGNS trademark are (i) International Trademark Reg. No. 987,829, registered November 19, 2008, and (ii) United States Reg. No. 3,725,766, registered December 15, 2009. Complainant is also the registrant of the domain name <99designs.com>, registered February 7, 2005, for use in connection with its "99designs by Vista" business.

The Domain Name was registered by Respondent on January 4, 2021, more than 12 years after Complainant's first registration for the 99DESIGNS trademark. Respondent is not using the Domain Name in connection with an active website. However, domain name system ("DNS") mail exchange ("MX") records for the Domain Name have been configured to allow Respondent to send and receive email using the Domain Name.

#### **5. Parties' Contentions**

##### **A. Complainant**

###### **(i) Identical or confusingly similar**

Complainant contends that the Domain Name is confusingly similar to its 99DESIGNS trademark. The relevant comparison is with the second-level portion of Domain Name only (*i.e.*, "98webdesigns"), as Complainant states it is well-established that the generic Top-Level Domain (*i.e.*, ".com") may be disregarded for this purpose. The Domain Name contains the 99DESIGNS trademark in its entirety, merely using the

number “98” instead of “99” and adding the word “web”. Complainant submits Respondent’s use of the number “98” in the Domain Name instead of the number “99” that appears in the 99DESIGNS mark is irrelevant for purposes of confusing similarity. The numbers “8” and “9” are adjacent on a keyboard, so this difference is a typo that renders the Domain Name confusingly similar to the 99DESIGNS trademark, especially because sufficiently recognizable aspects of the mark appear in the Domain Name. Despite this slight difference, a dominant feature of the relevant mark is recognizable in the Domain Name, which means that it is confusingly similar to the 99DESIGNS mark.

Moreover, Complainant claims the addition of the word “web” in the Domain Name does nothing to alleviate confusing similarity. In fact, panels have found that a domain name containing a complainant’s trademark plus a word that is associated with that trademark (as is the case here, given the association between the word “web” in the Domain Name and the services set forth in Complainant’s 99DESIGNS trademark registrations) does nothing to diminish confusing similarity between the trademark and the Domain Name. Indeed, Complainant states previous UDRP panels have found that inclusion of the word “web” in a Domain Name does nothing to prevent confusing similarity.

(ii) Rights or legitimate interests

Complainant maintains Respondent has no rights or legitimate interests in the Domain Name. Complainant has never assigned, granted, licensed, sold, transferred or in any way authorized Respondent to register or use the 99DESIGNS trademark in any manner. Complainant claims this fact, on its own, can be sufficient to prove the second criterion of the Policy.

Complainant contends that by failing to use the Domain Name in connection with an active website, Respondent is not using it “in connection with a *bona fide* offering of goods or services” and, therefore, cannot establish rights or legitimate interests pursuant to paragraph 4(c)(i) of the Policy. Complainant states numerous panels have repeatedly said that passively holding a domain name does not constitute a *bona fide* offering of goods or services.

To Complainant’s knowledge, Respondent has never been commonly known by the Domain Name and has never acquired any trademark or service mark rights in it. Therefore, Respondent cannot establish rights or legitimate interests pursuant to paragraph 4(c)(ii) of the Policy. Specifically, Complainant states that the Whois record identifies the registrant of the Domain Name as “Registration Private / Domains By Proxy, LLC,” not as “98 Web Designs” or “99 Designs” or anything similar. Complainant states this fact, combined with the lack of evidence in the record to suggest otherwise, allows the Panel to rule that Respondent is not commonly known by the Domain Name or any variation thereof pursuant to Policy ¶ 4(c)(ii). Further, given Complainant’s registration of the 99DESIGNS trademark for more than 14 years, it is impossible that Respondent is commonly known by this trademark.

Finally, Complainant asserts that by failing to currently use the Domain Name in connection with an active website, Respondent is not “making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue” pursuant to paragraph 4(c)(iii) of the Policy. Accordingly, Respondent has no rights or legitimate interests in respect of either of the Domain Name.

(iii) Registered and used in bad faith

Complainant submits the Domain Name should be considered as having been registered and used in bad faith by Respondent. Complainant argues the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Complainant states the 99DESIGNS trademark is famous and/or widely known, given that it is protected by at least five trademark registrations covering at least 34 jurisdictions worldwide, the oldest of which was registered more than 14 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 has a worldwide community of more than 150,000 designers.

Complainant contends it is implausible that Respondent was unaware of Complainant when it registered the Domain Name given the fame of the trademark. The only explanation of what has happened is that Respondent's motive in registering and using the Domain Name seems to be to disrupt Complainant's relationship with its customers or potential customers or attempt to attract Internet users for potential gain. These both constitute evidence of registration and use in bad faith under the Policy. Given the global reach and popularity of Complainant's services under the 99DESIGNS trademark, as well as the Domain Name's similarity to Complainant's own domain name <99designs.com>, it is inconceivable that Respondent chose the Domain Name without knowledge of Complainant's activities and the name and trademark under which Complainant is doing business.

Although the Domain Name is not associated with an active website, bad faith also exists under the well-established doctrine of "passive holding." Complainant contends the overall circumstances of this case strongly suggest that Respondent's non-use of the Domain Name is in bad faith. Here, the factors set forth in [WIPO Overview 3.0](#), section 3.3, indicate that bad faith exists under the passive holding doctrine, specifically:

- a. the 99DESIGNS trademark is very distinctive and has a strong reputation, given that it has been registered for almost 14 years, is protected by at least five trademark registrations covering at least 34 jurisdictions worldwide, and is used by a company with USD 2.9 billion of revenue in fiscal year 2022 and approximately 15,000 full-time and approximately 1,000 temporary employees, in connection with a business that has a worldwide community of more than 150,00 designers;
- b. Respondent's identity is concealed in the Whois record as "Registration Private / Domains By Proxy, LLC"; and
- c. it is impossible to identify any good faith use to which the Domain Name may be put.

A further indication of bad faith under the Policy is the fact that the oldest registrations for the 99DESIGNS were registered more than 12 years before Respondent's registration of the Domain Name. Indeed, Complainant asserts that because the Domain Name is so obviously connected with Complainant, Respondent's actions suggest opportunistic bad faith in violation of the Policy. In light of the long history of Complainant's trademarks and Complainant's significant presence and brand recognition, it is likely that Respondent knew of Complainant's mark, and has sought to obtain a commercial benefit by attracting Internet users based on that confusion.

Finally, Complainant states the creation of DNS MX records, as Respondent has done here, is evidence of bad faith because it gives rise to the strong possibility that Respondent intended or intends to use the Domain Name to send emails as part of a fraudulent phishing scheme.

Accordingly, Complainant concludes the Domain Name was registered and is being used in bad faith.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. Those elements are as follows:

- (i) the Domain Name registered by Respondent are identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

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

Complainant has demonstrated that it has well-established rights in its distinctive 99DESIGNS trademark, both through registration and use. In addition to evidence of trademark registrations covering at least 34 jurisdictions, Complainant has indicated that the 99DESIGNS trademark is distinctive, has been registered for almost 14 years, and is used by a company with USD 2.9 billion of revenue in fiscal year 2022 and approximately 15,000 full-time and approximately 1,000 temporary employees, in connection with a business that has a worldwide community of more than 150,00 designers, and where Complainant's business has helped more than 15 million small businesses create professional-quality marketing products at affordable prices and at low volumes.

The Panel finds that the Domain Name incorporates the 99DESIGNS mark in its entirety, while changing the number "99" by one digit to "98" and adding the word "web," which is associated with Complainant's business. These changes do not avoid confusing similarity. As set forth in section 1.9 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), "[a] domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element. This stems from the fact that the domain name contains sufficiently recognizable aspects of the relevant mark.... Examples of such typos include... adjacent keyboard letters." Despite the differences, the dominant feature of the 99DESIGNS mark is recognizable in the Domain Name. See [WIPO Overview 3.0](#), section 1.7; see also, e.g., *Cube Limited v. Wei Dong Chen*, WIPO Case No. [D2017-0212](#) (finding domain name <118bet.com> confusingly similar to 188BET despite "[t]he alteration of one number").

The Panel also determines that including the word "web" in the Domain Name, which is associated with the services set forth in Complainant's registrations for the 99DESIGNS trademark, does not diminish confusing similarity between the trademark and the Domain Name. See *El Dupont de Nemours and Company v. Guo Haibo, yangyinghong*, WIPO Case No. [D2011-1445](#); *Enel S.p.A. v. Alejandro Messina*, WIPO Case No. [D2022-2464](#) (finding domain name <enelwebpay.com> confusingly similar to ENEL); *Credit Industriel et Commercial S.A. v. Domains By Proxy, LLC DomainsByProxy.com / CIC BANQUE*, WIPO Case No. [D2021-2673](#) (finding domain name <cic-web.com> confusingly similar to CIC).

Accordingly, the Panel finds that the Domain Name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

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

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#), states, "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."

Here, the Panel determines that Complainant has made out a *prima facie* case, while Respondent has failed to respond to Complainant's contentions. The Panel finds that Complainant has not authorized Respondent to use Complainant's 99DESIGNS mark; that Respondent is not commonly known by the Domain Name; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Instead, the Domain Name is being passively held by Respondent. See *Philip Morris USA Inc. v. Gabriel Hall*, WIPO Case No. [D2015-1779](#) ("Passively holding

a domain name does not constitute a *bona fide* offering of goods or services.”); see also *Six Continents Hotels, Inc. v. Trasporto di Network and Pro Intel*, WIPO Case No. [D2004-0246](#) (“given the Complainant’s established use of its... marks, it is unlikely that the Respondents are commonly known by any of these marks”); *Verizon Trademark Services LLC v. Jeff Goodman / Goody Tickets LLC*, WIPO Case No. [D2015-1750](#) (finding no legitimate noncommercial or fair use where “Respondent is not currently resolving the Domain Name to an active website”).

Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent’s lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

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

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states, “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”.

Here, the Panel determines that the Domain Name was registered and is being used in bad faith. Complainant has provided persuasive evidence that – given the distinctiveness of its 99DESIGNS trademark; the more than 11 years that have passed between Complainant’s earliest trademark registrations and the registration of the Domain Name; and the global reach of Complainant’s business using its trademark – Respondent, when registering the Domain Name, was likely aware of Complainant and its 99DESIGNS marks, and intentionally targeted them, when registering the Domain Name. Similarly, given the global reach and popularity of Complainant’s services under the 99DESIGNS trademark, as well as the Domain Name’s similarity to Complainant’s own domain name <99designs.com>, the Panel considers that the only logical conclusion is that Respondent targeted Complainant and marks (and Complainant’s new branding initiative) when registering the Domain Name. See *Six Continents Hotels v. Lin hongyu, Cheng Qi Lin*, WIPO Case No. [D2017-2033](#) (“[i]t is implausible that [Respondent] was unaware of the Complainant when [it] registered the Domain Name[s] given the fame of the Trade Mark.”); *Pencil LLC v. Domain Deluxe*, WIPO Case No. [D2003-1035](#) (“it is inconceivable that Respondent chose the contested domain name without knowledge of Complainant’s activities and the name and trademark under which Complainant is doing business.”).

Although the Domain Name is not associated with an active website, the Panel also finds that bad faith exists under the well-established doctrine of “passive holding” set forth in the case, *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). As described by [WIPO Overview 3.0](#), section 3.3:

While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.

The Panel determines the overall circumstances of this case strongly suggest that Respondent’s non-use of the Domain Name is in bad faith. The 99DESIGNS trademark is distinctive and has a strong reputation, as discussed above. Respondent has not submitted a response and concealed its identity using a privacy service; and it is difficult, if not impossible, to identify any good faith use to which the Domain Name may be put. See “*Dr. Martens*” *International Trading GmbH and “Dr. Maertens” Marketing GmbH v. Godaddy.com, Inc.*, WIPO Case No. [D2017-0246](#) (“the overall circumstances of this case strongly suggest that the Respondent’s non-use of the Domain Name is in bad faith”); and *Hilton Worldwide, Hilton Hotels Corporation, HLT Domestic IP LLC and HLT International IP LLC . v. Steve Alek, Niagara Falls Corp*, WIPO

Case No. [D2010-1063](#) (“where there are other indicators of bad faith, ‘passive holding’ of a domain name can constitute use in bad faith”).

Finally, the creation of DNS MX records for the Domain Name in the circumstances of this case (including Respondent’s failure to submit a response in the face of Complainant’s allegations), is evidence of bad faith because it gives rise to the possibility that Respondent intended to use the Domain Name to send emails for unlawful purposes. See e.g., *Altria Group, Inc. and Altria Group Distribution Company v. Emerson Terry*, WIPO Case No. [D2021-0045](#). See also, e.g., *Zambon S.p.A. v. Wills Sylace*, WIPO Case No. [D2020-3347](#) (finding bad faith where “the evidence on the record provided by Complainant shows that Respondent set up MX-records for the Domain Name, indicating that the Domain Name may be being used for fraudulent email communications”).

Accordingly, the Panel finds that the Domain Name has been registered and is being used in a bad faith in accordance with paragraph 4(a)(iii) 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 Domain Name, <98webdesigns.com>, be transferred to Complainant.

*/Christopher S. Gibson/*

**Christopher S. Gibson**

Sole Panelist

Date: August 21, 2023