

ADMINISTRATIVE PANEL DECISION

PicsArt, Inc. v. Privacy Services provided by Withheld for Privacy ehf / Robert Brown, Flash logistic Services
Case No. D2022-1364

1. The Parties

Complainant is PicsArt, Inc., United States of America (United States”), represented by DLA Piper US LLP, United States.

Respondent is Privacy Services provided by Withheld for Privacy ehf, Iceland / Robert Brown, Flash logistic Services, United States.

2. The Domain Names and Registrar

The disputed domain names <picsart-app.com>, <picsart-editor.com>, <picsartpcapp.com>, and <picsartpc.com> 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 15, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 19, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on April 21, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 27, 2022.

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 Respondent of the Complaint, and the proceedings commenced on May 2, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 23, 2022.

The Center appointed Phillip V. Marano as the sole panelist in this matter on June 1, 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

Complainant is PicsArt, Inc., a Miami-Florida based technology company founded in 2011 that developed the PicsArt suite of online photo and video editing applications with a social creative community aspect. Complainant owns valid and subsisting registrations for the PICSART trademark in numerous countries, including the trademark for PICSART (U.S. Reg. No. 4,760,661) in the United States, with the earliest priority dating back to June 23, 2015.

Respondent registered the disputed domain name <picsartpcapp.com> on November 1, 2021; the disputed domain name <picsart-app.com> on October 19, 2021; the disputed domain name <picsart-editor.com> on October 21, 2021; and the disputed domain name <picsartpc.com> on October 18, 2021 (collectively, “the disputed domain names”). At the time this Complaint was filed, the disputed domain names resolved to websites featuring Complainant’s PICSART trademark as well as links ostensibly offering downloads of Complainant’s PicsArt mobile applications.

5. Parties’ Contentions

A. Complainant

Complainant asserts ownership of the PICSART trademark and has adduced evidence of trademark registrations in numerous countries around the world, including the United States, with earliest priority dating back to June 23, 2015.

The disputed domain names are confusingly similar to Complainant’s PICSART trademark, according to Complainant, because they each fully incorporate Complainant’s PICSART trademark and simply add terms commonly used in connection with PicsArt’s products, such as “app”, “editor”, and “PC”.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain names based on the lack of evidence that Respondent is commonly known by the disputed domain names, the lack of any relationship or authorization between Complainant and Respondent, and the lack of evidence that Respondent has made use of, or made demonstrable preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services.

Complainant argues that Respondent has registered and used the disputed domain names in bad faith for numerous reasons, including: Respondent’s use of the PICSART trademark on Respondent’s website leads Internet users to believe that Respondent is associated with or otherwise affiliated with Complainant and Complainant’s PicsArt applications; Respondent’s use of a website that closely mimics the look and feel of Complainant’s official website at “www.picsart.com”, including the font, color and general style; and Respondent’s use of a proxy service to shield the true identity of the registrant of the disputed domain names.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights;
- ii. 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.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.3 ("A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true [...] UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g. where a particular conclusion is *prima facie* obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent."); see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as *prima facie* evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Complainant has submitted evidence that the PICSART trademark has been registered in the United States with priority dating back to June 23, 2015, nearly six years before the disputed domain names were registered by Respondent. Thus, the Panel finds that Complainant's rights in the PICSART trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain names are identical or confusingly similar to Complainant's PICSART trademark. In this Complaint, the disputed domain names are confusingly similar to Complainant's PICSART trademark because, disregarding the ".com" generic Top-Level Domain ("gTLD"), the trademark is contained in its entirety within the disputed domain names. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In regards to gTLDs, such as ".com" in the disputed domain names, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.

The combination with the terms "app", "editor", and the abbreviation "pc" for "personal computer" does not prevent a finding of confusing similarity between Complainant's PICSART trademark and the disputed domain names. [WIPO Overview 3.0](#), section 1.8 (Additional terms "whether descriptive, geographic, pejorative, meaningless, or otherwise" do not prevent a finding of confusing similarity under the first element"); see also *AT&T Corp. v. WorldclassMedia.com*, WIPO Case No. [D2000-0553](#) ("Each of the domain names in dispute comprises a portion identical to [the ATT trademark] in which the Complainant has rights, together with a portion comprising a geographic qualifier, which is insufficient to prevent the composite domain name from being confusingly similar to Complainant's [ATT trademark]"); *OSRAM GmbH v. Cong Ty Co Phan Dau Tu Xay Dung Va Cong Nghe Viet Nam*, WIPO Case No. [D2017-1583](#) ("[T]he addition of the letters 'hbg' to the trademark OSRAM does not prevent a finding of confusing similarity between the Disputed Domain Name and the said trademark.").

In view of Complainant's registrations for the PICSART trademark and Respondent's incorporation of that trademark in its entirety in the disputed domain names, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a *prima facie* case that Respondent lacks rights or legitimate interests in the disputed domain names, shifting the burden of production of this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1.

It is evident that Respondent, identified by Whois data for the disputed domain names as "Robert Brown", is not commonly known by the disputed domain names or Complainant's PICSART trademark.

It is also evident that Respondent, in registering the four disputed domain names and configuring them all to resolve to websites which misappropriate Complainant's PICSART trademark and mimic Complainant's official website, is indeed intentionally attempting to impersonate Complainant. UDRP panels have categorically held that use of a domain name for illegal activity—including the impersonation of the complainant and other types of fraud—can never confer rights or legitimate interests on a respondent. In view of the absence of any evidence supporting any rights or legitimate interests in the disputed domain names, and Respondent's use of its websites to pass itself off as Complainant, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted 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 of a product or service on Respondent's website or location.

Where parties are both located in the United States and the complainant has obtained a federal trademark registration pre-dating a respondent's domain name registration, some panels in limited circumstances have applied the concept of constructive notice, subject to the strength or distinctiveness of the complainant's trademark, or circumstances that corroborate respondent's awareness of the complainant's trademark. [WIPO Overview 3.0](#), section 3.2.2. In this Panel's view, when the disputed domain names were registered on November 1, 2021; October 19, 2021; October 21, 2021; and October 18, 2021, Respondent had constructive knowledge of Complainant's pre-existing rights in Complainant's PICSART trademark under United States law. See e.g., *Champion Broadcasting System, Inc. v. Nokta Internet Technologies*,

WIPO Case No. [D2006-0128](#) (Applying the principle of constructive notice where both parties are located in the United States). Indeed, circumstances in this case corroborate Respondent's awareness of Complainant and Complainant's PICSART trademark, including: Respondent's use of Complainant's identical PICSART trademark within each of the disputed domain names, along with terms like "app" that describe Complainant's products and services; Respondent's use of the same PICSART trademark on Respondent's website; and Respondent's decision to offer ostensible downloads of Complainant's PicsArt applications on Respondent's websites.

UDRP panels have categorically held that registration and use of a domain name for illegal activity like impersonation is manifestly considered evidence of bad faith within paragraph 4(b)(iv) of the Policy. [WIPO Overview 3.0](#), section 2.13.1 and 3.1.3. See *CareerBuilder, LLC v. Stephen Baker*, WIPO Case No. [D2005-0251](#); *The Boots Company, PLC v. The programmer adviser*, WIPO Case No. [D2009-1383](#). See e.g. *WSI Holdings Ltd. v. WSI House*, Case No. [D2004-1089](#) ("Respondent appears to be engaged in "phishing" for mistaken potential employees of the Complainant ... Respondent (1) has adopted a confusingly similar domain name, (2) it has used the trade dress ... of the Complainant's website, and (3) it has sought to attract users to its site by creating confusion between its site and the Complainant's. It has clearly engaged in activity which fulfils the bad faith requirements of Paragraph 4(b)(iv) of the Policy.") It remains evident in this Complaint that Respondent, in registering the four disputed domain names with Complainant's identical PICSART trademark and terms like "app" which describe Complainant's products and services, then configuring them all to resolve to a website which misappropriates Complainant's PICSART trademark and mimic's Complainant's official website, is indeed intentionally attempting to impersonate Complainant.

Moreover, prior UDRP decisions have indicated that the use of false registration data in connection with a disputed domain name may further supports a finding of bad faith registration and use. See e.g. *Action Instruments, Inc. v. Technology Associates*, WIPO Case No. [D2003-0024](#) (Providing false contact information violates paragraph 2 of the Policy, which requires a registrant to represent that the statements it "made in [its] Registration Agreement are complete and accurate." Maintaining that false contact information in the WHOIS records (which can easily be updated at any time) after registration constitutes bad faith use of the domain name because it prevents a putative complainant from identifying the registrant and investigating the legitimacy of the registration."); *Royal Bank of Scotland Group v. Stealth Commerce*, WIPO Case No. [D2002-0155](#); *Home Director, Inc. v. HomeDirector*, WIPO Case No. [D2000-0111](#)). Here, there is evidence that Respondent used false registration data, namely, an email address that bounced back notices of the Complainant from the Center, plus a physical address with a "Further Information Needed" error from DHL. Indeed, this Panel could not independently verify through routine Internet searches the existence of the physical address provided by Respondent in the Whois data for the disputed domain names.

In view of Respondent's attempted impersonation and attempts to pass itself off as Complainant, Respondent's use of a proxy registration service to mask its identity, and Respondent's apparent use of false registration data to register the disputed domain names, the Panel concludes that Complainant has established the third element 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 names <picsart-app.com>; <picsart-editor.com>; <picsartpcapp.com>; and <picsartpc.com> be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano

Sole Panelist

Date: June 10, 2022