

ADMINISTRATIVE PANEL DECISION

**Figma, Inc. v. Whois Privacy, Private by Design, LLC / Tinh Nguyen Dang,
Cactus Computer
Case No. D2022-1365**

1. The Parties

1.1 The Complainant is Figma, Inc., United States of America, represented by Kelly Martin, United States of America (the “Complainant”).

1.2 The Respondent is Whois Privacy, Private by Design, LLC, United States of America / Tinh Nguyen Dang, Cactus Computer, Viet Nam (the “Respondent”).

2. The Domain Name and Registrar

2.1 The disputed domain name <figma.store> (the “Disputed Domain Name”) is registered with Porkbun LLC (the “Registrar”).

3. Procedural History

3.1 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 Name. On April 19, 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 April 20, 2022, 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 amendment to the Complaint on April 22, 2022.

3.2 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”).

3.3 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on May 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 23, 2022. The Respondent did not submit any response. Accordingly,

the Center notified the Respondent's default on May 28, 2022.

3.4 The Center appointed Ike Ehiribe as the sole panelist in this matter on June 10, 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

4.1 The Complainant in this administrative proceeding is Figma, Inc., a corporation incorporated under the laws of the state of Delaware, United States of America and operating from San Francisco in California. The Complainant it is said, provides an online design and collaboration platform allowing for real-time collaboration by users of the platform. The Complainant also provides the Figma community an ancillary subdomain via the Complainant's platform where users of the FIGMA platform can publish and share files and plug-ins they have created with users of the FIGMA platform outside of their organisation. The Complainant also provides an online store called the "Figma Store" which sells merchandise under the FIGMA brand to users in the United States of America, Canada, and the United Kingdom, etc. The Complainant's FIGMA mark is widely used in connection with the Complainant's design and collaboration platform, the Figma Community and the Figma Store. Therefore, it is said that the FIGMA brand has come to represent the Complainant, its community, and digital design products. Accordingly, the Complainant enjoys significant goodwill in the name of FIGMA as it relates to digital design online and being an online market place for design resources. The Complainant has attached true copies of certificates of several national and international trademark registrations for FIGMA obtained since January 2015, including the United States of America trademark registration number 5,110,233, FIGMA, registered on December 27, 2016, and other countries such as the United Kingdom, Brazil, Russian Federation, Canada, the European Union, Japan, Australia, India, and the Republic of Korea.

4.2 The Respondent, Tinh Nguyen Dang of Cactus Computer is based in Ho Chi Minh City in Viet Nam. According to the Whois database the Respondent registered the Disputed Domain Name on July 22, 2020, with the Registrar.

5. Parties' Contentions

A. Complainant

5.1 The Complainant contends that the Disputed Domain Name <figma.store> is identical or confusingly similar to the Complainant's FIGMA mark because it incorporates the Complainant's mark in its entirety. The Complainant states further that the addition of the generic Top-Level Domain ("gTLD") ".store" does nothing to differentiate the Disputed Domain Name from the Complainant's mark. The Complainant contends in the alternative that even if the Panel were to consider the gTLD ".store" the Panel should still find the Disputed Domain Name confusingly similar to the Complainant's mark. As it is put, this is because, consumers are likely to believe that a website at the corresponding Internet address is the website associated with the Complainant's online presence which is incorrect. The Complainant concludes by asserting that the combination of "figma" and "store" is likely to mislead Internet users as to the source of products offered at the website associated with the Disputed Domain Name and suggests an affiliate or sponsorship relationship between the Respondent and the Complainant where none exists.

5.2 The Complainant further argues that the Respondent has no rights or legitimate interests in the Disputed Domain Name in that; (i) the Respondent's use of the Disputed Domain Name has no connection with a *bona fide* offering of goods and services as the products offered at the website associated with the Disputed Domain Name appears to be an online marketplace that the Respondent describes as "Figma Store". Furthermore, it is argued that the Respondent has not been given permission by the Complainant to use the name "figma" nor is the Respondent authorised to create a competitive marketplace to offer digital design products that compete with the Complainant using the Complainant's FIGMA trademark; (ii) the Respondent

has not been commonly known by the Disputed Domain Name, as any online search for the term “figma” returns to the Complainant and its FIGMA branded products which the Complainant submits confirms the contention that the Complainant is the only “figma” named company that offers digital design and collaboration products and services; (iii) the Respondent is not making a legitimate noncommercial or fair use of the Disputed Domain Name instead it is contended that the Respondent uses the Disputed Domain Name to mislead consumers or to tarnish the trademark of the Complainant. The Complainant in this regard relies on copies of printouts from the website associated with the Disputed Domain Name and asserts that the website is structured to attract consumers that are aware of the Complainant’s products and to offer those products on the website to which the Disputed Domain Name resolves.

5.3 On the question of bad faith registration and use, the Complainant contends that the Respondent registered and is using the Disputed Domain Name in bad faith as the Disputed Domain Name is being used to attract Internet users for its personal gain. It is further submitted that the Respondent actualises bad faith use by creating a likelihood of confusion with the Complainant’s FIGMA trademark considering that the Complainant first registered its FIGMA trademark in December 2016, thereby predating the creation of the Disputed Domain Name by four years. Secondly, the Complainant in further support of bad faith use contends that since the Respondent uses the descriptive term “store” in connection with the Complainant’s FIGMA mark, consumers are likely to be misled into believing that the Respondent is affiliated with, sponsored or endorsed by the Complainant. Thirdly, the Complainant asserts that the Respondent intentionally uses the Disputed Domain Name to attempt to attract for its personal benefit Internet users to the website associated with the Disputed Domain Name by creating the suggestion that the Complainant, its FIGMA mark and or FIGMA branded digital products are associated with the Respondent. This is considering that the Respondent could have chosen a different name that does not include the FIGMA trademark or a different descriptive term that does not suggest sale or purchase of the Complainant’s products.

B. Respondent

5.4 The Respondent did not reply to the Complainant’s contentions, in the circumstances, the Panel shall draw such adverse inferences from the failure of the Respondent to reply as it considers appropriate.

6. Discussion and Findings

6.1 Under paragraph 4(a) of the Policy, to succeed in the administrative proceeding the Complainant must prove that:

- i) the Disputed Domain Name is identical and confusingly similar to the trademark or service mark of the Complainant;
- ii) the Respondent has no rights or legitimate interest in respect of the Disputed Domain Name; and
- iii) the Disputed Domain Name has been registered and is being used in bad faith.

6.2 As expressly stated in the Policy the Complainant must establish the existence of each of these three elements in any administrative proceeding.

A. Identical or Confusingly Similar

6.3 This Panel notes that the Complainant is apparently a well-known digital design and visual asset management company with extensive online presence as a market place for design resources and products. The Panel accepts that the Complainant operates and has obtained several international trademark registrations in a substantial number of countries including the United States of America, the United Kingdom, the European Union, and other countries in the Asian continent where the Respondent is apparently based. The Panel finds that on a visual examination of the Disputed Domain Name there is no doubt that it is indeed identical to the Complainant’s FIGMA trademark. The Disputed Domain Name clearly incorporates the Complainant’s FIGMA mark in its entirety. The Panel further finds that the addition of the

gTLD “.store” does nothing to prevent such a finding. In this regard, see in support the detailed discussion on the test for confusing similarity as can be found in sections 1.7 and 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)).

6.4 Therefore, the Panel is satisfied that the Complainant has established that the Disputed Domain Name is confusingly similar to the Complainant’s trademark.

B. Rights or Legitimate Interests

6.5 The Panel is equally satisfied that the Respondent has failed to establish that it has rights or legitimate interests in the Disputed Domain Name generally or within the ambit of paragraphs 4(a) (ii) and 4(c) of the Policy. Following earlier UDRP decisions in *Croatia Airlines D.D v. Modern Empire Internet Ltd*, WIPO Case No. [D2003-0455](#) and *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#), the Respondent who is duty-bound to provide evidence of such rights and legitimate interests has failed to demonstrate that it is engaged in any actual *bona fide* offering of goods and services nor a legitimate noncommercial or fair use of the Disputed Domain Name. As further argued on behalf of the Complainant, the Respondent who is not commonly known by the FIGMA trademark, has failed to provide any evidence to demonstrate that it has been authorised, licensed, or permitted to use the FIGMA trademark either in the Disputed Domain Name or in the website to which the Disputed Domain Name resolves. The Panel finds that the website associated with the identical Disputed Domain Name prominently – creating a false impression of affiliation (see WIPO Overview section 2.5.1) – displays the name “Figma Store” and that it is used in connection with promoting and advertising an online collection of resources associated with the Complainant without any form of authorisation. The Panel finds that since the Respondent is using the Disputed Domain Name to divert consumers and seeking the Complainant’s trademark by using the Disputed Domain Name to host a website that infringes on the Complainant’s rights in the FIGMA trademark and goodwill associated with the Complainant’s digital products and designs, such deleterious conduct cannot be described as a *bona fide* offering of goods and services nor a legitimate or noncommercial or fair use of the Disputed Domain Name.

6.6 In the circumstances, the Panel finds that the Complainant has established that the Respondent does not possess any rights or legitimate interests whatsoever in the Disputed Domain Name as stipulated in paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

6.7 On the question of bad faith registration and use, the Panel has taken a number of irrefutable factors into account to conclude that the Respondent deliberately registered the Disputed Domain Name in bad faith and with the obvious intention of exploiting the Complainant’s established reputation and goodwill in the FIGMA trademark.

6.8 First of all, the Panel finds it inconceivable that the Respondent was unaware of the Complainant’s pre-existing trademark rights and worldwide reputation of the Complainant’s FIGMA branded digital products and designs in the industry when the decision was made to create and register the Disputed Domain Name. The nature of the Disputed Domain name being an exact match of the Complainant’s mark, with matching content no less, cannot be a coincidence. The Complainant has moreover submitted that the Complainant first registered its trademark in December 2016, therefore a search or enquiry would have notified the Respondent of the Complainant’s intellectual property rights. Secondly, the Panel finds that the Respondent registered the Disputed Domain Name with the sole intention of exploiting the Complainant’s reputation in its FIGMA branded digital products and designs business. This finding is substantiated by the Respondent’s overt conduct of diverting consumers to the website to which the Disputed Domain Name resolves for its financial gain by creating a likelihood of confusion with the Complainant’s FIGMA mark and FIGMA-branded digital design products. Thirdly, the Respondent’s decision to choose the gTLD “.store” the Panel finds to be demonstrative of an intentional desire to mislead consumers into believing that the website associated with the Disputed Domain Name sells digital products that are associated with, or endorsed by, the Complainant. Fourthly, as indicated in paragraph 5.4 above, the Panel has drawn adverse inferences from the failure of the Respondent to respond at all, to the submissions of the Complainant in this matter.

7. Decision

7.1 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, <figma.store>, be transferred to the Complainant.

/Ike Ehiribe/

Ike Ehiribe

Sole Panelist

Date: June 24, 2022