

ADMINISTRATIVE PANEL DECISION

PicsArt, Inc. v. RipoN Sahaji

Case No. DCC2022-0010

1. The Parties

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

The Respondent is RipoN Sahaji, India.

2. The Domain Name and Registrar

The disputed domain name <picsart.cc> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 25, 2022. On October 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 26, 2022, 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 (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 27, 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 amended Complaint on October 28, 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 the Respondent of the Complaint, and the proceedings commenced on November 7, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 27, 2022. The Respondent did not submit any response. Accordingly, the

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

The Center appointed Jon Lang as the sole panelist in this matter on December 8, 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

The Complainant is a US-based multinational technology company that offers, amongst other services, photo and video editing applications and websites that include social media features and tools for the creation and publication of a wide range of content, including graphics, photography, illustration and multimedia/video. The "Picsart Photo & Video Editor" has been among the top 20 most downloaded mobile applications for 2019 and 2020, according to Sensor Tower digests. The first PicsArt mobile application was launched in 2011 (on Android) and the Complainant is well recognized for the photo and video editing (and related services) that it offers in connection with the PICSART mark.

The Domain Name was registered on August 23, 2019.

The Complainant owns a number of United States federal trademark registrations (and pending federal applications) for the PICSART mark, including United States Trademark Registration No. 4760661 registered on June 23, 2015. It has also a well-established international trademark portfolio of registered PICSART marks some of which, like its rights in its United States trademarks, also pre-date registration of the Domain Name. Furthermore, it is the registered owner of the <picsart.com> domain name (and many other domain names that incorporate the PICSART trademark). Internet users are able to access the Complainant's editing software and download the Picsart mobile application directly from the website at <picsart.com>, and also learn more about the goods and services that the Complainant offers under the PICSART trademark.

Recently, the Complainant became aware of the Domain Name and the website to which it points, which features the PICSART trademark and the Complainant's logo, and includes links that suggest that Internet users would be able to download the Complainant's APK (Android Package Kit).

5. Parties' Contentions

A. Complainant

The following is a summary of the contentions of the Complainant.

The Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights

The Complainant has exclusive rights in the PICSART trademark which is used to identify goods and services relating to photo and video editing and related software. It has been using the PICSART name and trademark in this connection since at least as early as 2011. Such use predates the Respondent's registration of the Domain Name by nearly ten years. The Complainant has developed a strong reputation in the United States and around the world for its PICSART mark. In addition to its registered trademark rights, the Complainant also owns common law rights and related goodwill in the PICSART trademark.

The Respondent's Domain Name fully incorporates the PICSART trademark.

The Respondent has no rights or legitimate interests in respect of the Domain Name

The Domain Name is being used to attract Internet users seeking legitimate information about the Complainant.

The Respondent's website prominently features the PICSART trademark as well as the Complainant's logo, and closely mimics the look and feel of the Complainant's website *e.g.*, in its use of font, color, and general style. The website also includes links that suggest that Internet users would be able to download the Complainant's APK.

The download offered on the Respondent's website may put spamware or other harmful content on Internet users' computers.

At the time the Respondent began using the Domain Name, the Complainant had been using the PICSART name and trademark for nearly ten years. The Respondent has no relationship with the Complainant and no authorization from it to use the PICSART trademark, to appropriate the Domain Name, or to otherwise associate itself and its infringing software content with the Complainant. The Respondent is not affiliated with the Complainant or the PICSART trademark in any way.

To the Complainant's knowledge, the Respondent has not filed any applications for registration of PICSART in any trademark offices or jurisdictions worldwide, and the Respondent is not commonly known by the Domain Name.

The Domain Name was registered and is being used in bad faith.

The Respondent has intentionally, and for commercial gain, registered and is using the Complainant's PICSART name and trademark to attract Internet users to its website. Internet users who accidentally visit the Respondent's website will be led to believe that it is associated or otherwise affiliated with the Complainant. Moreover, they may try to download one of the applications and, as a result, may receive negative content or spamware on their devices.

The Respondent's use of a proxy server is further evidence of bad faith on behalf of the Respondent, as it is an effort to shield its true identity.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy requires a complainant to prove that a respondent has registered a domain name which is: (i) identical or confusingly similar to a trademark or service mark in which a complainant has rights; and (ii) that the respondent has no rights or legitimate interests in respect of the domain name; and (iii) that the domain name has been registered and is being used in bad faith. A complainant must prove each of these three elements to succeed.

A. Identical or Confusingly Similar

The Complainant is the owner of the PICSART trademark and therefore clearly has rights in that mark.

Ignoring the country code Top-Level Domain (ccTLD) ".cc" (as the Panel may do for comparison purposes), the Domain Name comprises the entire PICSART trademark and is therefore identical to it. There is no need to

consider confusing similarity in any detail save to say, for completeness, that section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“the [WIPO Overview 3.0](#)”) provides that “[...] in cases where a domain name incorporates the entirety of a trademark, [...] the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing”.

Paragraph 4(a)(i) of the Policy has clearly been established.

B. Rights or Legitimate Interests

By its allegations, the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name.

Accordingly, the burden of production shifts to the Respondent to come forward with arguments or evidence demonstrating that it does in fact have such rights or legitimate interests. The Respondent has not done so and accordingly, the Panel is entitled to find, given the *prima facie* case made out by the Complainant, that the Respondent indeed lacks rights or legitimate interests in the Domain Name. Despite the lack of any answer to the Complainant’s contentions however, the Panel is entitled to consider whether there would be anything inappropriate in such a finding.

A respondent can show it has rights to or legitimate interests in a domain name in various ways even where it is not, as here, licensed by or affiliated with a complainant. For instance, it can show that it has been commonly known by the domain name or that it is making a legitimate non-commercial 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. A respondent can also show that it is using a domain name in connection with a *bona fide* offering of goods or services.

The Respondent to this Complaint is not known by the Domain Name. There is no relationship between the Complainant and the Respondent. Yet the Respondent has used the Domain Name identical to the Complainant’s PICSART trademark to attract Internet users to its (the Respondent’s) website which contains the PICSART trademark and which includes links that suggest to Internet users that they would be able to download the Complainant’s APK. These circumstances do not suggest a *bona fide* offering of goods or services, or a legitimate non-commercial or fair use. They suggest a deception *i.e.*, that Internet users are at the website of the Complainant, or at least a website that is authorised by it, when they are not. Whether or not the download contains harmful content matters not. It would be extremely unlikely that the Respondent could claim rights or interests in respect of the Domain Name in these circumstances.

The very purpose in the Respondent choosing the Domain Name was to deliberately create a false impression of association with the Complainant. The Respondent has not come forward with a Response or taken any other action to address the Complaint, no doubt because there is unlikely to be anything it could say that could justify its registration and use of the Domain Name in the manner described.

Given that there is no evidence before this Panel suggesting that the Respondent has rights or legitimate interests in the Domain Name, but rather only evidence suggesting the contrary, the Panel finds that the Complainant has fulfilled the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

There can be little doubt that the Respondent was aware of the Complainant’s PICSART trademark at the time of registration of the Domain Name given the reputation of the Complainant’s mark and the use to which the Domain Name has been put.

Paragraph 4(b) of the Policy provides a number of non-exclusive scenarios which may evidence a respondent's bad faith. They include, for instance, a respondent registering a domain name in order to prevent an owner of the trademark or service mark to which it is said to be confusingly similar or identical, from reflecting the mark in question in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct. A respondent registering a domain name primarily for the purposes of disrupting the business of a competitor is another scenario, as is a respondent intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of its website or of products or services on it. This latter scenario appears to capture entirely the circumstances here, as indeed has been suggested by the Complainant. More generally, and quite apart from the non-exclusive scenarios in paragraph 4(b), it seems clear that the Respondent has sought to take unfair advantage of and/or to abuse the Complainant's PICSART trademark and such behaviour is broadly understood to constitute bad faith for the purposes of the Policy, regardless of any precise match with a paragraph 4(b) scenario.

The Complainant also contends that the Respondent's use of a privacy service is further evidence of bad faith. Whilst the use of a privacy service is not in itself necessarily indicative of bad faith, in the circumstances of this Complaint, the Panel finds that the Respondent's use of such a service is supportive of a bad faith finding (see generally section 3.6 of the [WIPO Overview 3.0](#)).

In all the circumstances, the Panel finds that, for the purposes of the Policy, there is evidence of registration and use of the Domain Name in bad faith, and that the Complainant has fulfilled the requirements of 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 <picsart.cc> be transferred to the Complainant.

/Jon Lang/

Jon Lang

Sole Panelist

Date: December 21, 2022