

## **ADMINISTRATIVE PANEL DECISION**

Cimpress PLC, Cimpress Schweiz GmbH, Vistaprint Netherlands B.V,  
Cimpress Windsor Corporation, Cimpress USA Manufacturing Incorporated v.  
Privacy Service Provided by Withheld for Privacy ehf / Osama Tanveer  
Case No. D2022-0320

### **1. The Parties**

The Complainants are Cimpress PLC, Cimpress Schweiz GmbH, Vistaprint Netherlands B.V,  
Cimpress Windsor Corporation, and Cimpress USA Manufacturing Incorporated, United States of America  
("United States"), represented by The GigaLaw, Douglas M. Isenberg, Attorney at Law, LLC, United States.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Osama Tanveer,  
Pakistan.

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

The disputed domain name <vistaprinthub.com> is registered with NameCheap, Inc. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 30, 2022. On January 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 31, 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 Complainants on February 1, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on February 2, 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 February 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 1, 2022.

On February 1, 2022, the Respondent sent an email communication to the Center, stating that it was open to a settlement negotiation. On March 2, 2022, the Center sent an email communication to the Complainants, informing it of the Respondent's settlement offer. On March 2, 2022, the Respondent replied, stating that it wanted to settle the matter by March 3, 2022. On March 2, 2022, the Complainants sent a settlement form to the Respondent, asking the Respondent to sign it. On March 2, 2022, the Respondent replied that it would not agree to sign the form unless it got monetary compensation of USD 10,000. On March 7, 2022, the Center sent an email communication to the Complainants, asking if it would like to suspend the proceedings to negotiate a settlement. On March 7, 2022, the Complainants rejected the offer to suspend the proceedings.

Accordingly, the Center notified the Respondent of the Commencement of the Panel Appointment Process on March 7, 2022.

The Center appointed Alistair Payne as the sole panelist in this matter on March 14, 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 Complainants are a group of companies related to a publicly traded company on the NASDAQ exchange, Cimpress plc, which is involved in the printing and marketing sector. The Complainants' business includes the Vistaprint business founded in 1995, and which helps small business owners create expertly designed, up-to-date custom marketing. Cimpress plc has various operating entities including: Cimpress Schweiz GmbH, which serves as the principal intellectual property owner for the Vistaprint business as well as other Cimpress businesses: Vistaprint Netherlands B.V., which contracts with customers of vistaprint.com in the United States; Cimpress USA Incorporated (formerly known as Vistaprint USA Incorporated), which provides services to related parties; and Cimpress Windsor Corporation and Cimpress USA Manufacturing Incorporated, which provides manufacturing services to related parties. The Cimpress plc group entities will hereafter be referred to collectively as "the Complainant".

The Complainant owns various registrations for the VISTAPRINT mark, including United States trade mark registration 2433418 registered on March 6, 2001. It also owns the domain name <vistaprint.com> from which it operates its main website.

The Respondent registered the disputed domain name on September 8, 2020. It resolves to a website branded as VISTAPRINT, that uses the VISTAPRINT trade mark and appears to be a website of the Complainant's, or which is associated with the Complainant. It offers for sale the same goods as the Complainant and features an "About Us" page using text that was copied from the Complainant's "About Us" page.

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

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

The Complainant submits that it owns registered trade mark rights as set out above. It says that the disputed domain name wholly incorporates its VISTAPRINT mark and is the dominant feature and is therefore confusingly similar to it. It submits that the inclusion in the disputed domain name of the additional term "hub" does not prevent a finding of confusing similarity under the Policy.

The Complainant says that it has never assigned, granted, licensed, sold, transferred or in any way authorised the Respondent to register or use the VISTAPRINT trade mark in any manner. It says that the Respondent, by using the disputed domain name in connection with a website that appears to be a website for or otherwise associated with the Complainant, has failed to create a *bona fide* offering of goods or

services under the Policy and its actions are clearly misleading and not legitimate and therefore that the Respondent cannot demonstrate rights or legitimate interests under Paragraph 4(c)(i) of the Policy. In this regard, the Complainant submits that the website at the disputed domain name uses the VISTAPRINT trade mark, offers for sale goods that are the same as the goods offered by the Complainant in connection with the VISTAPRINT trade mark and describes itself on its "About Us" page using text that was copied from the Complainant's "About Us" page.

The Complainant also contends that, to its knowledge, the Respondent has never been commonly known by the disputed domain name and has never acquired any trade mark or service mark rights in the disputed domain name. It notes in this regard that the Whois record identifies the Respondent as "Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf" and not as "Vistaprint" or "Vistaprint Hub" or anything similar thereto. In addition, says the Complainant, considering its use and registration of the VISTAPRINT trade mark for more than 20 years and the Complainant's 44 trade mark registrations in at least 26 jurisdictions worldwide for the VISTAPRINT trade mark, it is practically impossible that the Respondent is commonly known by this trade mark.

As far as registration in bad faith is concerned, the Complainant says that the VISTAPRINT trade mark is clearly famous and/or widely known in view of the fact that it is protected by at least 44 trade mark registrations in at least 26 jurisdictions worldwide, the oldest of which was registered more than 20 years ago and is used in connection with a business that has an annual revenue of USD 1.445 billion. It says that considering the global reach and popularity of the Complainant's services under the VISTAPRINT trade mark, as well as the disputed domain name's similarity to the Complainant's own domain name, it is inconceivable that the Respondent chose the disputed domain name without knowledge of the Complainant's activities and the name and trade mark under which the Complainant is doing business, and that its registration by the Respondent suggests opportunistic bad faith.

The Complainant further submits that by using the disputed domain name in connection with a website that falsely purports to be the Complainant's website, or one that is associated with it and by offering for sale goods that are the same as the goods offered by the Complainant in connection with the VISTAPRINT trade mark, and also by describing itself on its "About Us" page using text that was copied from the Complainant's "About Us" page, the Respondent is clearly "creating a likelihood of confusion" with the VISTAPRINT trade mark that fulfills the requirements of paragraph 4(b)(iv) of the Policy.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

The Complainant has demonstrated that it owns various trade mark registrations for its VISTAPRINT mark, including United States trade mark registration 2433418 registered on March 6, 2001. The disputed domain name wholly incorporates the Complainant's VISTAPRINT mark and is therefore confusingly similar to it. The Panel finds that the inclusion in the disputed domain name of the term "hub" does not prevent a finding of confusing similarity under the Policy.

Accordingly, the Complaint succeeds under this element of the Policy.

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

The Complainant has submitted that it has never assigned, granted, licensed, sold, transferred or in any way authorised the Respondent to register or use the VISTAPRINT trade mark in any manner. It has contended that the Respondent, by using the disputed domain name in connection with a website that appears to be a

website for, or otherwise associated with the Complainant, has failed to make a *bona fide* offering of goods or services in terms of the Policy and therefore that the Respondent cannot demonstrate rights or legitimate interests under Paragraph 4(c)(i) of the Policy.

The Complainant has also contended that, to its knowledge, the Respondent has never been commonly known by the disputed domain name and has never acquired any trade mark or service mark rights in the disputed domain name. It has noted in that regard that the Whois record identifies the Respondent as “Redacted for Privacy / Privacy service provided by Withheld for Privacy ehf” and not as “Vistaprint” or “Vistaprint Hub”. Further, the Complainant has submitted that it has used the VISTAPRINT trade mark for more than 20 years, and considering the Complainant’s 44 trade mark registrations in at least 26 jurisdictions worldwide, that it is practically impossible that the Respondent could be commonly known by this trade mark.

The Panel notes that the both the disputed domain name and the website to which it resolves uses the VISTAPRINT trade mark. The website at the disputed domain name appears to offer for sale the same goods as offered by the Complainant in connection with its VISTAPRINT trade mark. It is apparent that much of the text on the “About Us” page was copied verbatim from the Complainant’s “About Us” page. This appears to be a straightforward case of the Respondent having sought to use the disputed domain name to divert Internet users to a website that masquerades as being operated by the Complainant, or with its permission, when this is not in reality the case. Such conduct is clearly not legitimate.

In these circumstances, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. As the Respondent has failed to rebut this case, and also for the reasons set out under Part C below, the Panel finds that the Complainant has successfully made out its case and that the Complaint also succeeds under this element of the Policy.

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

The disputed domain name was registered on September 8, 2020, many years after the Complainant’s registration of VISTAPRINT in the United States. The Complainant has made very considerable use of its VISTAPRINT mark in a variety of countries and has registrations in at least 26 jurisdictions worldwide. The business has been operating since 1995, and is clearly very well established with an annual revenue of USD 1.445 billion. Considering these facts and that the Respondent has copied and pasted text from the Complainant’s website onto its own site and appears to offer the same or very similar products, it is more likely that the Respondent was very well aware of the Complainant’s mark and business when it registered the disputed domain name and that it very likely did so opportunistically for its own commercial purposes.

Under paragraph 4(b)(iv) of the Policy there is evidence of registration and use of the disputed domain name in bad faith where a Respondent has used the disputed domain name to intentionally attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant’s trade marks as to the source, sponsorship, affiliation or endorsement of the website.

As noted above under Part B, the website at the disputed domain name appears to offer for sale the same goods as offered by the Complainant in connection with its VISTAPRINT trade mark and much of the text on the “About Us” page was copied verbatim from the Complainant’s “About Us” page. The Respondent appears to have sought to use the disputed domain name to divert Internet users to a website that masquerades as being operated by the Complainant, or with its permission, when this is not in reality the case. These circumstances fall squarely within paragraph 4(b)(iv) of the Policy.

In addition, the Respondent’s use of a privacy service in an attempt to hide his real identity only serves to further confirm the Panel’s view of the Respondent’s bad faith.

For these reasons, the Panel finds that the disputed domain name was both registered and used in bad faith and that the Complaint succeeds under this 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 name <vistaprinthub.com> be transferred to the Complainant.

*/Alistair Payne/*

**Alistair Payne**

Sole Panelist

Date: March 28, 2022