

**IN THE MATTER OF A COMPLAINT MADE PURSUANT TO THE CANADIAN
INTERNET REGISTRATION AUTHORITY DOMAIN NAME DISPUTE
REGISTRATION RESOLUTION POLICY (v 1.3) AND RULES (v 1.5)**

Complainants: PicMonkey, LLC and PicMonkey International Limited
600 Stewart Street, Suite 2000
Seattle, WA 98101
United States of America
(collectively the “Complainants”)

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Registrant: Whois Privacy Services, Inc.
P.O. Box 821650
Vancouver, WA 98682
United States of America

Tel: 858-480-4567
Email: whois@mywhoisprivacy.net
(the “Registrant”)

Disputed Domain Name: picmonkey.ca
(the “Domain Name”)

Registrar: 8648255 CANADA LTD. O/A Dynadot LLC

Single Member Panel: R. John Rogers

Service Provider: British Columbia International
Commercial Arbitration Centre (the “BCICAC”)

BCICAC File: DCA-1884-CIRA

PROCEDURAL HISTORY

The BCICAC is a recognized service provider pursuant to the Domain Name Dispute Resolution Policy (v 1.3) (the “Policy”) and Rules (v 1.5) (the “Rules”) of the Canadian Internet Registration Authority.

On June 2, 2017, the Complainants filed a complaint dated June 1, 2016 (sic) (the “Complaint”) with the BCICAC seeking an order in accordance with the Policy and the Rules directing that registration of the Domain Name be transferred from the Registrant to PicMonkey International Limited as the owner of the trademark, PICMONKEY.

The BCICAC determined the Complaint to be in administrative compliance with the requirements of Rule 4.2 and, by letter of transmittal dated June 5, 2017 (the “Transmittal Letter”), forwarded a copy of the Complaint to the Registrant to serve as notice of the Complaint in accordance with Rules 2.1 and 4.3. The Transmittal Letter determined the date of the commencement of proceedings in accordance with Rule 4.4 to be June 5, 2017. The Transmittal Letter advised the Registrant that in accordance with the provisions of Rule 5, a Response to the Complaint was to be filed within 20 days of the date of commencement of proceedings, or June 26, 2017.

The Transmittal Letter and a copy of the Complaint was sent to the Registrant by email to the email addresses whois@mywhoisprivacy.net and postmaster@picmonkey.ca.

By a letter dated June 29, 2017 delivered by email, with a copy sent to the Registrant by email to the two aforementioned email addresses, the BCICAC advised the Complainants that as the BCICAC had not received a Response to the Transmittal Letter by June 26, 2017 as required by Rule 5.1, that pursuant to Rule 6.5 the Complainants had the right to elect that the panel in this matter be converted from a three member panel to a single member panel.

The Complainants so elected and the undersigned was appointed by the BCICAC as the Single Member Panel by letter dated July 4, 2017, copies of which letter were sent by email to both the Complainants and to the Registrant. The undersigned has confirmed to the BCICAC that he can act impartially and independently as the Single Member Panel in this matter.

The undersigned determines that he has been properly appointed and constituted as the Single Member Panel to determine the Complaint in accordance with the Rules.

CANADIAN PRESENCE REQUIREMENTS

The Canadian Presence Requirements for Registrants v 1.3 (“Presence Requirements”) require that to be permitted to apply for registration of, and to hold and maintain the registration of, a .ca domain name, the applicant must meet at least one of the criteria listed as establishing a Canadian presence. Section 2(q) of the Presence Requirements specifies that a Person which does not meet any of the foregoing conditions laid out in this Section 2, but which is the owner

Domain Name: picmonkey.ca
Picmonkey International Limited and PicMonkey, LLC
and
Whois Privacy Services, Inc.
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of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c. T-13 meets the Presence Requirements provided that the domain name sought to be registered in that Person's name consists of or includes the exact word component of that registered trade-mark. PicMonkey International Limited qualifies as a "Person" under the Presence Requirements.

The Complainants have provided evidence that PicMonkey International Limited is the owner of the Canadian trade-mark PICMONKEY under Canadian trade-mark registrations No. TMA929,955 and TMA965,212 (the "Trade-Mark"). PicMonkey International Limited licenses the right to use the Trade-Mark in Canada to PicMonkey, LLC.

As the Trade-Mark includes the exact word component as that contained in the Domain Name, excluding the .ca, I find that the Complainants have satisfied the provisions of Section 2 of the Presence Requirements and that PicMonkey International Limited, as it owns the Trade-Mark registered in the Canadian Intellectual Property Office, is an Eligible Complainant pursuant to section 1.4 of the Policy.

ALL TECHNICAL REQUIREMENTS MET

Based upon the information provided by the BCICAC and the Complainants, I find that all technical requirements for the prosecution of this proceeding have been met.

FACTS OFFERED BY THE COMPLAINANTS

The facts put forward by the Complainants might be summarized as follows:

1. The Complainants' brand image processing services first became operational and available to Canadians in February 2012 operating under the coined word, PICMONKEY, on the website www.picmonkey.com, a website owned by PicMonkey LLC.
2. An application for the coined word, PICMONKEY, was first filed as a US trade-mark application in March 2012 and subsequently a Canadian trade-mark application was filed claiming priority to the US filing date.
3. From its launch in February 2012 until April 10, 2012, the www.picmonkey.com website was visited by individuals from Canadian IP addresses 41,188 times, and, since April 10, 2012, has been visited by individuals from Canadian IP addresses over 36,000,000 times.
4. On April 10, 2012, the Registrant registered the Domain Name.
5. PicMonkey, LLC also advertises its PICMONKEY image procession services on Twitter having promoted the PICMONKEY image processing services since January 2012.
6. As of March 5, 2017, this Twitter feed had over 29,000 followers, 4% of which are identified as Canadian, and had broadcast over 13,000 tweets promoting the PICMONKEY image processing services.
7. As of March 5, 2017, the Facebook page - www.facebook.com/PicMonkey - was "liked" by over 2.4 million Facebook users of whom 18,368 were Canadian.

8. The Domain Name resolves to a pay-per-click website which, the Complainants allege, has never been used for any bona fide offering during the 5 years since the registration of the Domain Name.
9. The Complainants further allege that this website states at the top that “The domain picmonkey.ca may be for sale”.
10. A report provided by the Canadian Internet Registration Authority indicates that the Registrant controls 5 other .ca domain names and that each of these domain names corresponds to a trademark owned by a third party.

FACTS OFFERED BY THE REGISTRANT

As was noted above, the Registrant has not responded to the Complaint.

REMEDIES SOUGHT

The Complainants seek an order from the Single Member Panel in accordance with paragraph 4.3 of the Policy instructing the Registrar of the Domain Name to transfer the Domain Name from the Registrant to PicMonkey International Limited as the owner of the Trade-Mark

THE POLICY

The purpose of the Policy as stated in paragraph 1.1 of the Policy is to provide a forum in which cases of bad faith registration of .ca domain names can be dealt with relatively inexpensively and quickly.

Paragraph 4.1 of the Policy puts the onus on the Complainants to demonstrate this “bad faith registration” by proving on a balance of probabilities that:

1. a trade-mark or trade name owned by the Complainants qualifies as a “Mark” as this term is defined in paragraph 3.2 of the Policy;
2. the Complainants had “Rights” in the Mark prior to the date of registration of the Domain Name and continue to have “Rights” in the Mark,
3. the Domain Name is “Confusingly Similar” to the Mark as the concept of “Confusingly Similar” is defined in paragraph 3.3 of the Policy;
4. the Registrant has no “legitimate interest” in the Domain Name as the concept of “legitimate interest” is defined in paragraph 3.4 of the Policy; and
5. the Registrant has registered the Domain Name in “bad faith” in accordance with the definition of “bad faith” contained in paragraph 3.5 of the Policy.

If the Complainants are unable to satisfy this onus, bad faith registration is not demonstrated and the Complaint fails.

MARK

In the matter at hand, the relevant portion of paragraph 3.2 of the Policy states that for the purpose of the Policy a “Mark” is:

- (a) a trade-mark, including the word elements of a design mark, or a trade name that has been used in Canada by a person, or the person’s predecessor in title, for the purpose of distinguishing the wares, services or business of that person or predecessor or a licensor of that person or predecessor from the wares, services or business of another person;

The Complainants have provided evidence that they have been operating in Canada since at least February 2012, a date prior to the registration of the Domain Name. In the course of this operation, the Complainants have used the Trade-Mark in Canada to distinguish their provision of wares, services or business from another provider of similar wares, services or business.

The Complainants continue to use the Trade-Mark in Canada.

The Trade-Mark clearly qualifies as a “Mark” pursuant to paragraph 3.2(a) of the Policy.

RIGHTS

Paragraph 3.1(a) of the Policy requires that the Complainants have “Rights” in the Trade-Mark and that these “Rights” existed prior to the date of registration of the Domain Name and continue to the present date. Unfortunately, this term “Rights” is not defined in the Policy.

Given the evidence before me of the ownership and the use by the Complainants of the Trade-Mark in Canada, I find that for the purpose of paragraph 3.1(a) of the Policy, the Complainants had Rights in the Trade-Mark prior to the registration of the Domain Name on April 10, 2012 and that these Rights continue to the present date.

CONFUSINGLY SIMILAR

Policy paragraph 3.3 provides that the Domain Name will be found to be “Confusingly Similar” to the Trade-Mark only if the Domain Name so nearly resembles the Trade-Mark in appearance, sound or the ideas suggested by the Trade-Mark as to be likely to be mistaken for the Trade-Mark.

The Domain Name includes the same coined word used in the Trade-Mark together with the .ca suffix. As paragraph 1.2 of the Policy defines the Domain Name for the purpose of this proceeding to exclude the .ca suffix, the portion of the Domain Name consisting of “picmonkey” is the portion relevant for consideration.

Therefore, to satisfy the onus placed upon it by the Policy, the Complainants must demonstrate that the “picmonkey” portion of the Domain Name so nearly resembles the Trade-Mark in appearance, sound or the ideas suggested by the Trade-Mark so as to be likely to be mistaken for this identifier.

As the wording is the same, I find that the Complainants have satisfied the onus placed upon them by paragraph 3.3 of the Policy and have demonstrated that the Domain Name so nearly resembles the Trade-Mark in appearance, sound or the ideas suggested by the Trade-Mark as to be likely mistaken for the Trade-Mark.

NO LEGITIMATE INTEREST

Paragraph 4.1 of the Policy requires that to succeed in the Complaint, the Complainants must provide some evidence that the Registrant has no legitimate interest in the Domain Name as the concept of “legitimate interest” is provided for in paragraph 3.4 of the Policy.

Paragraph 3.4 of the Policy provides that the Registrant has a legitimate interest in a domain name if:

- a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
- b) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of:
 - (i) the character or quality of the wares, services or business;
 - (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or
 - (iii) the place of origin of the wares, services or business;
- c) the Registrant used the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- f) the domain name was the geographical name of the location of the Registrant’s non-commercial activity or place of business.

In paragraph 3.4(d) “use” by the Registrant includes, but is not limited to, use to identify a web site.

It is to be noted that in paragraphs 3.4(a), (b), (c), and (d), there is a requirement that the Registrant used the Domain Name “in good faith”. The evidence before me, as referenced below, is that the Registrant used the Domain Name not in good faith, but rather to trade upon the goodwill of the Complainants without a license to do so. Therefore, the provisions of these paragraphs do not apply.

The Registrant's name is not included in the Domain Name, so the provisions of paragraph 3.4(e) do not apply nor do the provisions of paragraph 3.4(f) apply.

I therefore find that the Complainants have provided some evidence that the Registrant has no legitimate interest in the Domain Name.

BAD FAITH

Under paragraph 3.5 of the Policy, the Registrant will be considered to have registered the Domain Name in bad faith if, and only if, the Complainants can demonstrate that the Registrant in effecting the registration of the Domain Name was motivated by any one of the four general intentions set out in paragraph 3.5.

Of these intentions, the form of intention contained in paragraph 3.5(a) is the one most applicable to the matter at hand.

Paragraph 3.5(a) provides as follows:

(a) the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant's licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant's actual costs in registering the domain name, or acquiring the Registration;

The evidence before me demonstrates that the Registrant registered the Domain Name primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainants. I note particularly:

1. Following the introduction to Canadians of the image processing services under the Trade-Mark in February 2012, there was a significant response from Canadians so that by April 10, 2012, the date of registration of the Domain Name, the Trade-Mark had a developed a noticeable following in Canada;
2. The Registrant on the website to which the Domain Name resolves is offering the Domain Name for sale; and
3. Evidence to the effect that the Registrant controls 5 other .ca domain names and that each of these domain names corresponds to a trademark owned by a third party

As was found by other panels with similar evidence before them, I find that both the timing of the registration of the Domain Name by the Registrant, the Registrant's offer to sell the Domain Name, and the ownership by the Registrant of these 5 other .ca domain names all constitute clear evidence that the Registrant registered the Domain Name in bad faith. See for example *Bank of Montreal v. Chris Bartello*, (CIRA 0094 July 27, 2008), and *Ford Motor Company of Canada, Limited v. Canadian Model Trains Inc.*, 00036 (CIRA July 27, 2005).

The Complainants have submitted that the evidence before me also supports a finding of bad faith on the Registrant's part pursuant to the provisions of subparagraphs 3.5(b) and 3.5(d). I agree that such is the case.

I therefore find that the Complainants have satisfied the provisions of subparagraphs 3.5 (a), 3.5(b) and 3.5(d) of the Policy by establishing that the Registrant registered the Domain Name primarily for the purposes set out in these subparagraphs.

DECISION

As was above set out, paragraph 4.1 of the Policy provides that to be successful in the Complaint the Complainants have the onus of proving on a balance of probabilities three specific items and of providing some evidence that the Registrant has no legitimate interest in the Domain Name.

I find that the Complainants have satisfied this onus with respect to all three of these items by demonstrating on a balance of probabilities that the Trade-Mark qualifies as a Mark in accordance with paragraph 3.2 of the Policy; that the Domain Name is Confusingly Similar to the Trade-Mark; and that the Registrant has registered the Domain Name in bad faith in accordance with the provisions of paragraph 3.5 of the Policy.

I have also found that the Complainants have shown some evidence that the Registrant does not have a legitimate interest in the Domain Name in accordance with the provisions of paragraph 3.4.

I therefore find that the Complainants have satisfied the onus placed upon them by paragraph 4.1 of the Policy and are entitled to the remedy sought by them.

ORDER

I order that the domain name "picmonkey.ca" be transferred to PickMonkey International Limited.

Dated: July 14, 2017.

"R. John Rogers"

R. John Rogers
Single Member Panel