

ADMINISTRATIVE PANEL DECISION

Picture Organic Clothing v. Privacydotlink Customer 4032039 / James Booth, Booth.com, Ltd.

Case No. D2020-2016

1. The Parties

Complainant is Picture Organic Clothing, France, represented by Labonne & ACDP, France.

Respondent is Privacydotlink Customer 4032039, Cayman Islands, United Kingdom / James Booth, United Arab Emirates, represented by Greenberg & Lieberman, United States of America. As discussed further below in Section 5.B.(1), Respondent is also Booth.com, Ltd., a company based in Gibraltar, United Kingdom, and also represented by Greenberg & Lieberman.

2. The Domain Name and Registrar

The disputed domain name <picture.com> is registered with GoDaddy Online Services Cayman Islands Ltd. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 31, 2020. On July 31, 2020, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 5, 2020, 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 Complainant on August 5, 2020, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on August 5, 2020.

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").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on August 6, 2020. In accordance with the Rules, paragraph 5, the due date for Response was August 26, 2020. On August 13, 2020, Respondent contacted the Center in regards to an extension to the Response filing period. On August 14, 2020, pursuant to paragraph 5(b) of the Rules, the Response due date was extended until August 30, 2020. The Center received an email communication

from a third party on August 25, 2020. The Response was filed with the Center August 28, 2020.

The Center appointed Georges Nahitchevansky, Marie-Emmanuelle Haas, and The Hon Neil Brown Q.C. as panelists in this matter on September 16, 2020. The Panel finds that it was properly constituted. Each member of 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, Picture Organic Clothing, is a French clothing company that produces eco-friendly clothes and accessories. Complainant uses the name and mark PICTURE in connection with its products. Complainant owns several trademark registrations that include PICTURE in connection with its clothing products, including a registration for PICTURE as a word mark in the European Union that issued to registration on June 27, 2011 (Registration No. 009736281) and an international registration for PICTURE that issued to registration on March 13, 2012 (Registration No. 113240).

The disputed domain name was originally registered on September 19, 1994 and was owned by a party, other than Respondent since at least 2009. In August 2019, Complainant received an unsolicited offer from a domain name broker offering the disputed domain name for sale with an asking price of USD 350,000.

Respondent is an Internet business that deals in buying, selling and/or leasing domain names. Respondent acquired the disputed domain name on October 25, 2019 for the price of USD 110,000 through the same domain name broker who previously contacted Complainant in August 2019. The disputed domain name currently resolves to a web page that offers the disputed domain name for sale.

5. Parties' Contentions

A. Complainant

Initially, Complainant contends that the Respondent in this matter "could also be" an individual who attempted to sell the disputed domain name to Complainant in August 2019 with an asking price of USD 350,000.

Complainant contends that it has rights in the name and mark PICTURE by virtue of its trademark registrations that include PICTURE.

Complainant asserts that the disputed domain name is identical to Complainant's PICTURE mark as it fully and solely consists of the PICTURE name and mark.

Complainant argues that Respondent has no rights or legitimate interests in the disputed domain name as Respondent (i) has never been known by the disputed domain name, (ii) has not made, or prepared to make, use of the disputed domain name with a *bona fide* offering of goods and services, and (iii) is using the disputed domain name to misleadingly divert consumers or to tarnish Complainant's PICTURE mark.

Lastly, Complainant contends that Respondent has registered and used the disputed domain name in bad faith as Respondent has not made any use of the disputed domain name for a *bona fide* offering of goods or services and has only sought to sell it. In that regard, Complainant asserts that because Respondent has not used the disputed domain name for an active website or other online presence, Respondent has engaged in passive holding in bad faith. Complainant further argues that Respondent has acted in bad faith by concealing its identity through a privacy service. Complainant also contends that Respondent is a domain name investor who has engaged in cybersquatting by seeking to profit from the disputed domain name, that is based on Complainant's PICTURE mark, at a price well in excess of the cost of the disputed domain name. Complainant maintains that it was contacted in August 2019 by a domain name broker who offered to

sell the disputed domain name to Complainant for an asking price of USD 350,000. Complainant also asserts that Respondent is continuing to act in bad faith by using the disputed domain name with a website that offers the disputed domain name for sale, and which ultimately requires an interested purchaser to make a minimum offer of USD 2,000.

B. Respondent

(1) Preliminary Consideration Regarding the Response

According to the Response, there are two Respondents: (1) the company Booth.com, Ltd. domiciled in Gibraltar, identified as the “True respondent,” and (2) James Booth, identified as “held by respondent” (presumably the party who holds the disputed domain name). In reviewing the exhibits submitted in this proceeding, the disputed domain name was assigned to Booth.com, Ltd. by a prior owner of the disputed domain name. The person who signed on behalf of Booth.com, Ltd., however, is an individual by the name of Andy Booth. The assignment document submitted by Respondent never mentions James Booth, who is the only party who was identified by the registrar as the registrant of the disputed domain name.

A threshold issue thus arises as to who is in fact the Respondent in this proceeding. Paragraph 1 of the Rules defines the “Respondent” as the “holder of the domain name registration against which a complaint is initiated”. Neither this definition, nor other provisions of the Policy and Rules, prevent a finding that a person or entity, other than the named registrant in the Whois details for the domain name, may be treated as the holder of the domain name registration at issue. Previous panels who have considered the issue have in certain cases held that another person or entity could be treated as the respondent, or the beneficial owner of a disputed domain name. See, e.g., *PHE, Inc. v. Aisha Haider*, WIPO Case No. D2007-0992.

Here, there is some evidence that links James Booth and Booth.com, Ltd. and which shows that Booth.com, Ltd. is the beneficial owner of the disputed domain name. Since the Response was submitted in the name of both the company Booth.com, Ltd. and James Booth, the Panel is of the opinion that the Response is valid and that Booth.com, Ltd. can be treated as a Respondent in this proceeding.

(2) Respondent's Response

Respondent rejects Complainant's contentions and contends that Complainant is engaged in an egregious act of reverse domain name hijacking given that Complainant and its counsel have knowingly asserted claims that are wholly without merit.

Respondent argues that the disputed domain name is based on a generic word and that Respondent is a good-faith registrant of the disputed domain name, a generic domain name. Respondent maintains that it bought the disputed domain name in October 2019 for USD 110,000 through the same domain name broker who had previously contacted Complainant in August 2019.

Respondent maintains that the disputed domain name is not identical to Complainant's claimed trademark, as Complainant uses a figurative version of the mark that includes the word “picture.”

Respondent contends that it has a legitimate interest in the disputed domain name and has not registered or used the disputed domain name in bad faith as (i) the disputed domain is a generic domain name based on the word “picture,” (ii) Complainant's rights are limited to clothing and related accessories only, (iii) the word “picture” is a widely used generic term, (iv) Respondent has not done anything to take advantage of Complainant's claimed rights in the mark PICTURE and had no knowledge of Complainant prior to Complainant filing the Complaint, and (v) the disputed domain name is a legitimate business asset of Respondent.

Lastly, Respondent asserts that Complainant has failed to prove its case and asks that the Panel deny the Complaint and make a finding that Complainant has engaged in reverse domain name hijacking.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark 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.

The standard of proof under the Policy is often expressed as the “balance of the probabilities” or “preponderance of the evidence” standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. The touchstone, however, is that an asserting party cannot meet its burden by simply making conclusory statements unsupported by evidence. To allow a party to merely make factual claims without any supporting evidence would essentially eviscerate the requirements of the Policy as both complainants or respondents could simply claim anything without any proof. For this reason, Panels have generally dismissed factual allegations that are not supported by any *bona fide* documentary or other credible evidence.

A. Preliminary Consideration Regarding Respondent

Complainant has argued that Respondent “could also be” a domain name broker who contacted Complainant in August 2019 to sell the disputed domain name. After the Complaint was filed, the identity of the registrant of the disputed domain name was disclosed by the Registrar. The only name that was provided by the Registrar is Respondent involved in this proceeding, namely, James Booth. Complainant has provided no evidence linking or suggesting a connection between the third party domain name broker and Respondent. Moreover, the domain name broker, who through counsel has objected to being named as a respondent in this proceeding, has provided evidence establishing that in August 2019 he was acting as a broker to sell the disputed domain name on behalf of a prior owner of the disputed domain name. The evidence submitted on behalf of the domain name broker shows that the prior owner owned the disputed domain name since at least 2009 and that the prior owner contracted with the domain name broker to sell the disputed domain name as an asset of the prior owner who was going out of business. The evidence before the Panel also shows that the domain name broker ultimately arranged for a sale of the disputed domain name from the prior owner to Respondent in October 2019 for USD 110,000.

Complainant has not contested or rebutted any of the evidence submitted on behalf of the domain name broker. Consequently, based on the evidence before the Panel, there is no basis for including the domain name broker as a respondent in this proceeding and the only Respondent in this proceeding, as per the information disclosed by the Registrar, is James Booth (and Booth.com, Ltd. as the beneficial owner of the disputed domain name).

B. Identical or Confusingly Similar

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 1.2.1. Complainant has provided evidence that it owns trademark registrations for the PICTURE mark in connection with its clothing products.

With Complainant’s rights in the PICTURE mark established, the remaining question under the first element of the Policy is whether the disputed domain name (typically disregarding the generic Top-Level Domain “.com”) is identical or confusingly similar with Complainant’s mark. See *B & H Foto & Electronics Corp. v. Domains by Proxy, Inc. / Joseph Gross*, WIPO Case No. D2010-0842. The threshold for satisfying this first

element is low and generally panels have found that fully incorporating the identical mark in a disputed domain name is sufficient to meet the threshold.

In the instant proceeding, for purposes of the first element the disputed domain name is identical to Complainant's PICTURE mark as it consists fully and solely of the PICTURE mark. The Panel therefore finds that Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy in establishing its rights in Complainant's PICTURE mark and in showing that the disputed domain name is identical or confusingly similar to that trademark.

C. Rights or Legitimate Interests

Given that Complainant's Complaint fails on the third element, as discussed below, the Panel does not need to address whether Respondent has rights or legitimate interests in the disputed domain name. The Panel notes, however, that Complainant's sparse evidence in this matter fails to establish that Respondent lacks a legitimate interest in the disputed domain name, particularly as there is no evidence that Respondent registered the disputed domain name, which consists solely of the dictionary word "picture," to expressly take advantage of any rights Complainant might claim in the PICTURE name and mark in relation to clothing. Given that "picture" is a common dictionary word and there is evidence in the record that "picture" is used by numerous unrelated parties in connection with a variety of goods and services, the fact that Respondent has listed the disputed domain name for sale without more does not in and of itself prove a lack of legitimate interest. Complainant, here, has failed to provide any evidence that would establish or suggest that Respondent registered the disputed domain name in order to profit from the disputed domain name at the expense of Complainant as opposed to registering and attempting to sell a generic domain name as a valuable asset.

D. Registered and Used in Bad Faith

Complainant asserts that Respondent has registered and used the disputed domain name in bad faith as Respondent has not used the disputed domain name with an active website and has only sought to sell the disputed domain name. In support of Complainant's bad faith claim, Complainant refers to (i) an unsolicited offer to sell the disputed domain name it received from a domain name broker in August 2019 and (ii) a current web page at the disputed domain name that offers the disputed domain name for sale which when accessed ultimately leads to a communication with Respondent that requires a minimum offer of USD 2,000 in order to proceed with negotiations regarding a potential acquisition of the disputed domain name.

As already noted above, the evidence before the Panel shows that the domain name broker was acting on behalf of a prior owner of the disputed domain name in August 2019. Moreover, there is no evidence in the record, and none has been provided by Complainant, that the domain name broker and Respondent are somehow connected or acting in concert. Consequently, whatever happened in August 2019 is irrelevant in determining whether Respondent registered and has used the disputed domain name in bad faith.

Complainant's contention of bad faith registration and use is based solely on a current attempt by Respondent to sell the disputed domain name and Respondent's lack of use of the disputed domain name for anything else. Such contention, though, ignores the fact that the disputed domain name fully and solely consists of the dictionary term "picture." The mere act of buying and selling a domain name that fully and solely consists of a dictionary word that may also function as a trademark in connection with certain goods and services does not in and of itself establish bad faith. A domain name that solely and fully consists of a dictionary word likely has an inherent value as a generic domain name that potentially can be exploited legitimately by a registrant as long as it is not done to take advantage of, or to exploit, the trademark rights of another party in the same term. It is thus incumbent on Complainant to provide evidence showing that Respondent registered and is using the disputed domain name not because Respondent did so on account of its generic value, but did so to take advantage of Complainant's rights in the PICTURE name and mark. Complainant, however, has failed to meet this burden on two grounds.

First, Complainant has not submitted any evidence regarding its use of the PICTURE mark, the extent of such use, and/or the status, reputation or fame of Complainant's PICTURE mark. Complainant's entire Complaint is based on the fact that Complainant owns some registrations for PICTURE in Europe in connection with clothing. While such registrations establish that Complainant enjoys some rights in PICTURE in connection with clothing, they do not in and of themselves say anything regarding the extent of use, status, reputation or fame of Complainant's claimed PICTURE mark. This failure of evidentiary support is telling given that the word "picture" is a common term and there is evidence that "picture" is likely used by many other parties for a wide variety of goods and services. Because Complainant is not everything "picture," Complainant, at the very least, needed to provide evidence establishing its use of PICTURE and the reputation and fame it enjoys in PICTURE that would make it plausible that Respondent registered the disputed domain name based on such reputation or fame (or its trademark value), and not for its generic nature and value.

Second, Complainant has not established with evidence that Respondent specifically sought to target and exploit Complainant's rights in the PICTURE mark. Indeed, the record is devoid of any evidence that would show that Respondent acquired the disputed domain name in October 2019 to explicitly target rights Complainant owns in the PICTURE mark for clothing or that Respondent has made use of the disputed domain name with a website that is aimed at goods and services associated with Complainant. See generally WIPO Overview 3.0 at section 2.10 and *Domain Name Arbitration*, Gerald Levine (2nd Edition) at Section 5.01-D.1.a, pages 326 and 327. Such failure further undermines Complainant's contention of bad faith registration and use on the basis that Respondent is attempting to sell a generic domain name that likely has a value separate and apart from any trademark value associated with the disputed domain name.

Simply put, Complainant's sparse Complaint does not establish bad faith registration and use and thus fails.

E. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking ('RDNH') or was brought primarily to harass the domain name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding." Moreover, under Paragraph 1 of the Rules RDNH is defined as "using the Policy in bad faith to attempt to deprive the registered domain name holder of a domain name."

To be sure, when a complaint has failed, such does not automatically result in a finding of RDNH. The touchstone under Rule 15(e) is for a panel to determine whether the complaint constitutes an abuse of the administrative proceeding.

Complainant filed a case regarding a domain name that fully consists of a common dictionary word, and did so without providing any evidence that Respondent registered or used the disputed domain name to target Complainant or to take advantage of Complainant's claimed rights in PICTURE in connection with Complainant's clothing products. Indeed, Complainant provided no evidence regarding its use of the PICTURE mark or of the reputation or fame of the PICTURE mark. Instead, Complainant instead relied entirely on the fact that because Respondent is currently offering the disputed domain name for sale, Respondent has no legitimate interest in the disputed domain name and is acting in bad faith. To put it bluntly, Complainant, who was represented by counsel, had ample reason to know its case would fail in a situation in which the disputed domain name consists of a generic term, and where Complainant submitted no evidence regarding the extent of use, reputation or fame of Complainant's claimed PICTURE mark, and/or showing that Respondent registered and used the disputed domain name to expressly take advantage of Complainant's claimed rights in PICTURE in connection with clothing products or related accessories.

But what makes this case even more egregious here is that after Complainant filed the Complaint, the Respondent's identity was disclosed, and the domain name broker named by Complainant objected to being named as a respondent and provided substantial evidence in support of its contention, Complainant

continued with a Complaint that still suggested that the domain name broker who had contacted Complainant in August 2019 “could also be” the Respondent. Notably, Complainant provided no evidence that supported that contention or which arguably would show a connection between the broker and the current registrant. Moreover, when the broker, through an attorney, submitted documentary evidence showing that the broker had been acting on behalf of a prior owner, which had owned the disputed domain name since at least 2009, and that the disputed domain name had been sold to Respondent in October 2019, Complainant nevertheless maintained its Complaint with its baseless contentions of bad faith based on the actions of the former owner’s broker. At that point, Complainant knew, or ought to have known, its case was doomed to fail given the underlying facts and, in particular, the generic nature of the disputed domain name and the lack of evidence that Respondent had targeted Complainant or done anything to capitalize on Complainant’s trademark interests in PICTURE in connection with clothing.

Simply put, there was no reasonable basis for Complainant’s Complaint given the underlying facts, yet Complainant chose to proceed with the matter and put Respondent to the burden and expense of having to prepare a Response.

Accordingly, the majority of the Panel (the Presiding Panelist and Panelist Brown) finds that the Complainant has abused the administrative proceeding and engaged in reverse domain name hijacking.

Dissenting Opinion on Finding of RDNH (Panelist Marie-Emmanuelle HAAS)

The Complainant did not use the UDRP in bad faith to attempt to deprive the registered domain-name holder of the disputed domain name.

The disputed domain name is composed with a generic term which can nevertheless be a valid trademark around the world, as soon as it’s protected for goods or services which differ from the good designated by the generic term at issue.

This situation puts the trademark owners whose trademarks are composed of generic terms under a very high pressure and in a difficult position on the Internet.

Any trademark owner may want to recover a domain name composed with its valid trademark.

The domain names “world”, or to be more precise, the domainers’ “world”, is very different from the trademarks “world”, especially when it’s about evaluating a domain name and accepting to pay a sum such as USD 350,000 to buy a domain name which is not being used.

Offering to sell a domain name in these conditions can be regarded as an abuse by a trademark owner, but it’s not enough to succeed in a UDRP procedure.

It’s not because the Complainant failed at proving that all the criteria were met, that it used the UDRP in bad faith.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Georges Nahitchevansky/
Georges Nahitchevansky
Presiding Panelist

/Marie-Emmanuelle Haas/
Marie-Emmanuelle Haas
Panelist

/The Hon Neil Brown Q.C./
The Hon Neil Brown Q.C.
Panelist
Date: October 5, 2020