

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE
CANADIAN INTERNET REGISTRATION AUTHORITY
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Domain Name: picmonkey.ca

Complainants: PicMonkey, LLC and PicM (Cayman) L.P.

Registrant: Whois Privacy Services Inc.

Registrar: 8648255 CANADA LTD. O/A Dynadot LLC

Panel: Bradley J. Freedman (Chair), Harold Margles and Thomas Manson, Q.C.

Provider: The British Columbia International Commercial Arbitration Centre

BCICAC File No.: DCA-1808-CIRA

DECISION

A. The Parties

1. Complainants are PicMonkey, LLC and PicM (Cayman) L.P., companies with an office in Seattle, Washington, United States of America.
2. Registrant is identified as “Whois Privacy Services Inc.”, with a mailing address in Vancouver, Washington, United States of America.

B. The Domain Name and Registrar

3. The disputed domain name is picmonkey.ca (the “**Domain Name**”).
4. The Domain Name was registered on April 10, 2012.
5. The registrar of the Domain Name is 8648255 CANADA LTD. O/A Dynadot LLC.

C. Procedural History

6. This is an administrative dispute resolution proceeding pursuant to the *CIRA Domain Name Dispute Resolution Policy* version 1.3 (August 22, 2011) (the “**Policy**”) and the *CIRA Domain Name Dispute Resolution Rules* version 1.5 (July 28, 2014) (the “**Rules**”), both issued by the Canadian Internet Registration Authority (“**CIRA**”).

7. This proceeding is administered by British Columbia International Commercial Arbitration Centre (the “**Provider**”), which is an approved service provider pursuant to Policy paragraph 1.5.

8. According to the information provided by the Provider, the initial procedural history of this proceeding is as follows:

- On August 2, 2016, Complainants filed a complaint in relation to the Domain Name pursuant to the Policy (the “**Complaint**”).
- By letter and email dated August 4, 2016, the Provider advised both Complainants and Registrant that the Complaint was in administrative compliance with the Policy and the Rules, and delivered a copy of the Complaint to Registrant in the manner prescribed by Rules paragraph 2.1.
- Registrant failed to file a response to the Complaint by the applicable due date (August 24, 2016).
- By letter and email dated August 25, 2016, the Provider gave notice to the parties that Registrant had failed to file a response to the Complaint by the applicable due date.
- On September 7, 2016, the Provider appointed the Panel.

9. As required by Rules paragraph 7.2, each panellist has submitted a declaration of impartiality and independence to the Provider.

10. The Panel finds that it was properly constituted and appointed in accordance with the Policy and the Rules.

11. Based on the information provided by the Provider, the Panel finds that all technical requirements for the commencement and maintenance of this proceeding have been met.

12. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would give rise to a need to alter the progress of this proceeding pursuant to Rules paragraph 13.2.

D. Eligibility of Complainant

13. The Complainant PicM (Cayman) L.P. is an eligible complainant under Policy paragraph 1.4, because the Complaint relates to the PICMONKEY trademark registered in the Canadian Intellectual Property Office (“**CIPO**”) and the Complainant PicM (Cayman) L.P. is the owner of that trademark.

E. Relief Requested

14. Complainants request that the Domain Name registration be transferred from Registrant to the Complainant PicM (Cayman) L.P.

F. Applicable Law

15. In accordance with Rules paragraph 12.1, the Panel will render its decision based on the rules and principles of the laws of Ontario and the laws of Canada applicable in Ontario.

G. Procedural Issues – Panel Directions and Registrant Failure to Respond

16. Rules paragraph 9.1 requires the Panel to ensure that, among other matters, the parties are treated with equality, that each party is given a fair opportunity to present its case, and that this proceeding takes place in a timely fashion. Rules paragraph 11.1 permits the Panel, in its sole discretion, to request further evidence or argument from the parties. Rules paragraph 9.1(c) permits the Panel, on its own motion, to extend a period of time fixed by the Rules.

17. To assist the Panel to make an appropriate decision in accordance with the Policy and the Rules, on September 14, 2016, the Panel issued a Direction inviting Complainants to submit further evidence and argument regarding specific issues (i.e. Registrant's identity, Registrant's lack of legitimate interest in the Domain Name, and Complainants' rights in the PICMONKEY trademark before the Domain Name was registered), and inviting Registrant to respond to the Complaint and Complainants' further evidence and argument submitted pursuant to the Direction.

18. Due to a technical error, the Direction was not effectively sent to Complainants' specified email address for communications. Complainants' legal counsel requested additional time to respond to the Direction. On September 28, 2016, the Panel issued a second Direction granting both parties additional time to respond to the Direction.

19. Complainants submitted their additional evidence and argument before the applicable due date. Registrant did not deliver any response to the Direction by the applicable due date or any date afterwards.

20. Registrant's failure to respond to the Complaint and the Panel's Directions does not automatically result in a decision in favour of Complainants. There is no concept of a default decision under the Policy or the Rules. Rules paragraph 5.8 provides that if a registrant does not submit a response within the applicable period, the Panel shall decide the proceeding on the basis of the complainant's complaint. While the Panel may draw appropriate inferences from a registrant's failure to respond to a complaint, the complainant must still satisfy the requirements of the Policy. Accordingly, it is incumbent on the Panel to assess the Complaint and Complainants' additional evidence and argument submitted in response to the Panel's Directions and determine whether Complainants have satisfied the requirements of the Policy.

H. Facts

21. The undisputed facts relevant to the Panel's decision are set out in the Complaint (including its schedules) and Complainants' additional evidence and argument, and are as follows:

- Since March 2012, Complainants have offered an online photo-editing service called "PicMoney". The service was named one of "The Top 100 Websites of 2013" by PC Magazine, and is currently used by more than six million people each month.
- Complainants' "PicMoney" service is available online at a website using the domain name <picmonkey.com>, which was created on March 26, 2006, and through Android and iOS apps for mobile devices.
- Complainants' PICMONKEY trademark is registered in numerous countries or jurisdictions, including Canada. Complainants are registrants of 89 domain names that contain the PICMONKEY trademark.
- The Complainant PicM (Cayman) L.P. is the current owner of the Canadian registered trademark PICMONKEY (registered February 26, 2016, TMA929955), which is registered for use in association with "image processing software design; providing a website featuring on-line non-downloadable software tools for image editing". The application for the Canadian registration of the PICMONKEY trademark was filed on August 30, 2012 based on proposed use in Canada, and claimed a priority filing date of March 12, 2012 based on a corresponding trademark application filed in the United States of America on March 12, 2012.
- The Canadian registration of the PICMONKEY trademark was granted on February 26, 2016, after a declaration of use in Canada of the PICMONKEY trademark was filed on February 4, 2016.
- The Domain Name was registered on April 10, 2012.
- The Domain Name resolves to a monetized parking page that includes links to websites that offer services in competition with Complainants' services, including links labeled "Free Photo Editing Software", "Free Image Editing Software" and "A Video Editor".
- Complainants have "never assigned, granted, licensed, sold, transferred or in any way authorized Registrant to register or use" the PICMONKEY trademark in any manner.
- On August 4 and 19, 2016, Complainants' lawyer received emails from an individual who identified himself as a domain broker named "Shaun" and claimed to represent Registrant. Shaun indicated that Registrant might engage in negotiations regarding the sale of the Domain Name if Complainants cancelled this proceeding. Shaun refused to identify Registrant.

I. Summary of Parties' Contentions

22. Complainants contend as follows:

- The Complainant PicM (Cayman) L.P. is the owner of the PICMONKEY trademark and had rights in that mark before the Domain Name was registered and continues to have

those rights, and the Domain Name is identical, and therefore confusingly similar to, that mark.

- Registrant has no legitimate interest in the Domain Name.
- Registrant registered the Domain Name in bad faith for various reasons, including to intentionally attempt to attract, for commercial gain, Internet users to Registrant's website by creating a likelihood of confusion with the PICMONKEY trademark.

23. Registrant did not file a response to the Complaint or Complainants' additional evidence and argument or dispute Complainants' contentions in any other way.

J. Discussion and Findings

24. Policy paragraph 3.1 provides that the Policy applies where a complainant asserts the following:

- (a) the registrant's dot-ca domain name is "Confusingly Similar" (as defined in Policy paragraph 3.3) to a "Mark" (as defined in Policy paragraph 3.2) in which the complainant had rights prior to the date of registration of the domain name and continues to have such rights;
- (b) the registrant has no "legitimate interest" in the domain name, as described in Policy paragraph 3.4; and
- (c) the registrant has registered the domain name in "bad faith", as described in Policy paragraph 3.5.

If a dispute does not fall within that narrow framework, then it is beyond the scope of the Policy.

25. Policy paragraph 4.1 sets out the onus on Complainants, and reads as follows:

"4.1 **Onus.** To succeed in the Proceeding, the Complainant must prove, on a balance of probabilities, that:

- (a) the Registrant's dot-ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights; and
- (b) the Registrant has registered the domain name in bad faith as described in paragraph 3.5;

and the Complainant must provide some evidence that:

- (c) the Registrant has no legitimate interest in the domain name as described in paragraph 3.4.

Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the Proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in paragraph 3.4."

26. To satisfy the requirements of Policy paragraph 4.1(a), Complainants must prove, on a balance of probabilities, that the Domain Name is "Confusingly Similar" to a "Mark" in which

the Complainant had “Rights” prior to the date of registration of the Domain Name and continues to have those “Rights”.

27. Policy paragraph 4.1(a) uses the capitalized term “Rights”, which was defined in a previous version of the Policy but is not defined in the current version of the Policy. In the Panel’s view, the word “Rights” in the current version of the Policy should be given its plain and ordinary meaning.

28. Policy paragraph 3.1 provides that the date of registration of a domain name is “the date on which the domain name was registered in the Registry or the predecessor registry operated by the University of British Columbia by the Registrant or a predecessor in title of the Registrant”. Based on the evidence provided by the Complainant, the Panel finds that the Domain Name was first registered by Registrant or Registrant’s predecessor in title on April 10, 2012. Accordingly, April 10, 2012 is the date for determining whether Complainants had rights in a “Mark”.

29. Complainants correctly note that the Policy does not require that a complainant own a Canadian trademark registration before the disputed domain name is registered. Policy paragraph 3.2 defines the term “Mark”, as follows:

3.2 **Mark.** 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;
- (b) a certification mark, including the word elements of a design mark, that has been used in Canada by a person or the person’s predecessor in title, for the purpose of distinguishing wares or services that are of a defined standard;
- (c) a trade-mark, including the word elements of a design mark, that is registered in CIPO; or
- (d) the alphanumeric and punctuation elements of any badge, crest, emblem or mark in respect of which the Registrar of Trade-marks has given public notice of adoption and use pursuant to paragraph 9(1)(n) of the *Trade-marks Act* (Canada).”

30. Complainants do not rely on Policy paragraphs 3.2(b) and 3.2 (d). The Panel finds that those provisions are not applicable.

31. The Complaint contains an assertion that Complainants used the PICMONKEY trademark before the registration of the Domain Name, and supports that assertion by reference to a March 9, 2012 date of first use of the PICMONKEY trademark in the United States specified in three United States registrations for the PICMONKEY trademark (U.S. Reg. No. 4,347,794; U.S. Reg. No. 4,347,801 and U.S. Reg. No. 4,977,253). The Complaint does not contain any assertion or evidence of use of the PICMONKEY trademark in Canada, before the Domain Name was registered. In response to the Panel’s Directions, Complainants did not provide any assertion or evidence of use of the PICMONKEY trademark in Canada before the Domain Name was registered. Policy paragraph 3.2(a) is limited to a trademark that has been used in Canada. For those reasons, the Panel finds that Complainants have failed to prove, on a

balance of probabilities, that the PICMONKEY trademark was a “Mark” within the meaning of Policy paragraph 3.2(a) prior to the registration of the Domain Name.

32. Complainants do not expressly refer to Policy paragraph 3.2(c), but they implicitly rely on that provision. Complainants assert that the Complainant PicM (Cayman) L.P. had rights in the PICMONKEY trademark before the Domain Name was registered because the application for registration of the PICMONKEY trademark, which was filed after the Domain Name was registered, claimed a priority filing date of March 12, 2012 based on a corresponding trademark application filed in the United States of America.

33. Complainants rely on *Trade-marks Act* section 34(1), which in certain circumstances deems the date on which a trademark application is filed in Canada to be an earlier date on which a corresponding trademark application was filed in one of certain foreign countries (including the United States of America). *Trade-marks Act* section 34(1) reads, in relevant part, as follows (emphasis added):

Date of application abroad deemed date of application in Canada

34(1) When an application for the registration of a trade-mark has been made in or for any country of the Union other than Canada and an application is subsequently made in Canada for the registration for use in association with the same kind of goods or services of the same or substantially the same trade-mark by the same applicant or the applicant’s successor in title, the date of filing of the application in or for the other country is deemed to be the date of filing of the application in Canada, and the applicant is entitled to priority in Canada accordingly notwithstanding any intervening use in Canada or making known in Canada or any intervening application or registration if ...

34. The priority referenced in *Trade-marks Act* section 34(1) relates to the trademark application filing date. The Panel accepts that, by virtue of *Trade-marks Act* section 34(1), the application for registration of the PICMONKEY trademark is deemed to have been filed on March 12, 2012. However, that does not complete the analysis. The Panel must determine whether the application for registration of the PICMONKEY trademark, which is deemed to have been filed before the Domain Name was registered but matured to registration many years after the Domain Name was registered, is sufficient to give Complainants rights in the PICMONKEY trademark before the Domain Name was registered.

35. The Panel is aware of three previous decisions that considered that issue: *Cheap Tickets and Travel Inc. v. Emall.ca Inc.*, CIRA Decision No. 4 (January 31, 2003), *TWENGA v. privacy protected*, CIRA Decision No. 00177 (January 23, 2012) and *JOBRAPIDO S.r.l. v. Langue*, CIRA Decision No. 00186 (April 20, 2012).

36. In *Cheap Tickets and Travel Inc. v. Emall.ca Inc.*, the panel held (emphasis added):

29. The Complainant initially submitted limited evidence regarding its use of the CHEAP TICKETS trade-mark. The Registrant initially submitted that the Complainant’s evidence in that regard was not sufficient. In its December 30, 2002 Procedural Order, the Panel requested that each party provide such evidence and argument as they considered appropriate regarding, among other things, whether the trade-mark CHEAP

TICKETS is a “Mark” (as defined in Policy paragraph 3.2(a)) in which the Complainant or its predecessors in title had “Rights” (as defined in Policy paragraph 3.3(a)) prior to the date of registration of the Domain Name and continues to have such “Rights”. Both parties submitted evidence and argument on that issue in response to the Procedural Order.

30. The Complainant argued that the “presumption of validity” regarding the registration of the CHEAP TICKETS trade-mark (Registration No. TMA564905) means that the trade-mark rights arose and were in existence as of the date of first use stipulated in the registration (July 1, 1997) and could not be challenged by the Registrant in this proceeding. The Complainant further argued that the Panel does not have authority to make a determination that is contrary to the registration of the CHEAP TICKETS trade-mark.

31. The Complainant’s argument regarding the effect of the registration of the CHEAP TICKETS trade-mark is contrary to Policy paragraphs 3.1 and 4.1, which direct that the inquiry regarding a complainant’s trade-mark rights focus on the date on which the domain name is registered. Further, Policy paragraphs 3.2 and 3.3 treat registered and unregistered trade-marks differently. If a complainant’s “Mark” is a trade-mark registered in the Canadian Intellectual Property Office prior to the domain name registration date, the complainant is not required to establish distinctiveness or use; the mere registration of the trade-mark is sufficient to establish “Rights” in the “Mark”. On the other hand, if the complainant’s “Mark” is an unregistered trade-mark or a trade-mark registered in the Canadian Intellectual Property Office after the domain name registration date, the complainant must establish that the trade-mark was used in Canada by the complainant or its predecessor for the purpose of distinguishing the wares, services or business of the complainant or its predecessor prior to the domain name registration date. Accordingly, the Panel concludes that it is not bound by the facts set forth in the registration of the CHEAP TICKETS trade-mark, and is obligated to make its own determination of this issue based upon all of the evidence and argument before it, including the registration of the CHEAP TICKETS trade-mark.

...

39. The Complainant also relied upon its May 25, 1999 application to the Canadian Intellectual Property Office for the registration of the CHEAP TICKETS trade-mark, and the subsequent registration of that trade-mark. In the Panel’s view, the trade-mark application is not evidence that the CHEAP TICKETS trade-mark was distinctive either on the date of the application or on September 16, 1999 (the domain name registration date). By virtue of Trade-marks Act section 54, the registration of the CHEAP TICKETS trade-mark is evidence of the facts set out in the registration. However, the trade-mark registration is not conclusive or determinative of those facts, particularly where the validity of the trade-mark is challenged.

37. In *TWENGA v. privacy protected*, the panel disagreed with the reasoning in *Cheap Tickets and Travel Inc. v. Emall.ca Inc.* That case involved a proposed use trademark application filed before the domain name was registered that matured to registration after the domain name was registered. The panellist stated as follows (emphasis added):

36. The Complainant did not submit evidence of prior use of the trade-mark in Canada to me. It had, however, filed its application for the trade-mark on May 12, 2008. Unlike the Learned Panel in Cheap Tickets, I am prepared to find that once a trade-mark has been registered, that the trade-mark owner has rights in the Mark from the date of application and thereafter. Further, in the case of a trade-mark registered based on clause 14 (1) (b) of the Trade-marks Act, R. S. C., 1985, c. T-13, I am prepared to accept that the Complainant has rights in the Mark back to the date accepted by the Canadian Intellectual Property Office for the TWENGA trade-mark, which was issued based on the registration in France on November 18, 2004. Rights are not defined in the Policy and in my view are not limited to the classical test of prior use as described in “Cheap Tickets.”

37. A broad reading of the phrase “rights in the Mark” is required to provide for a fair balance between the rights of a domain name holder and that of a trade-mark registrant. The trade-mark registrant has followed the application process in the Trade-marks Act and that process allows for a determination of who is entitled to the use of the trademark. In the case of trade-marks which are for the same class of goods and services as provided by the owner of the domain name, I defer to the registration of the trade-mark as establishing which of the competing claimants have rights in the trade-mark. Where the trade-mark is for a different class of goods and services, considerations of the possibility of reverse domain name hijacking would lead to the necessity of then balancing the rights of the parties by considering restricting the interpretation of “rights in the Mark” to the date of Registration of the trade-mark. I leave that analysis to a future date when such a fact circumstance comes before me.

38. In *JOBRAPIDO S.r.l. v. Langue*, which also involved a proposed use trademark application that was filed before the domain name was registered and that matured to registration after the domain name was registered, the panel stated as follows (emphasis added):

19. The Complainant’s JOBRAPIDO trade-mark was registered after the date on which the disputed domain name was registered and as such the Complainant cannot rely upon its registration of the JOBRAPIDO trade-mark to meet its onus. The Panel is of the view that is Complainant has the burden of proving that it has rights prior to date of registration of the domain name, and if the Complainant is relying on a registered trade-mark pursuant to paragraph 3.2(c) of the Policy, then in our view the Complainant’s trade-mark must have been registered prior to the registration of the domain name. We do not think that the Complainant should be able to rely on a trade-mark registration to establish its rights, yet reference some other date other than the registration date of that trade-mark for the purpose of assessing priority as against the date of registration of the domain name.

20. In light of the above findings, in our view the Complainant cannot rely solely on its Canadian trade-mark registration for JOBRAPIDO Design, since the Complainant did

not have rights under paragraph 3.2(c) until August 17, 2011, which is over five months after the disputed domain name was registered by the Registrant.

21. The Panel is then left to consider whether the Complainant has established evidence of any other “Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights”.

22. Based on the information contained in the complaint, it appears that the Complainant’s trade-mark application for JOBRAPIDO Design was filed on March 9, 2009 on the basis of proposed use in Canada. The mark was advertised in the Canadian Trade-marks Journal on April 28, 2010 and ultimately progressed to allowance, and subsequently to registration when the Declaration of Use was filed on August 17, 2011. There is nothing in the application details by which the Panel can conclude that the Complainant had rights in the Mark prior to the registration of the domain name (March 13, 2011). In the Panel’s view, a pending trade-mark application based on proposed use in Canada is insufficient for the purposes of establishing rights in a Mark. The word “Mark” is a defined term (see paragraph 3.2 of the Policy) and the various subsections require one or more of the following (a) use in Canada of a trade-mark, (b) use in Canada of a certification mark, (c) a trade-mark that is registered in CIPO, or (d) a badge, crest, emblem or mark pursuant to paragraph 9(1)(n) of the Trade-marks Act.

39. The decision in *JOBRAPIDO S.r.l. v. Langue* does not refer to the decisions in *Cheap Tickets and Travel Inc. v. Emall.ca Inc.* or *TWENGA v. privacy protected*.

40. In the Panel’s view, there are two difficulties with the decision in *TWENGA v. privacy protected*. First, the decision appears to ignore the exhaustive definition of “Mark” in Policy paragraph 3.2, which does not include an application for registration of a trademark. Second, the decision appears to ignore the timing requirement (“prior to the date the domain name is registered”) expressly set out in Policy paragraph 4.1(a). In the Panel’s view, it is not appropriate for a panel to interpret the Policy in a way that effectively amends the Policy and changes the balance of rights as between trademark owners and domain name registrants set out in the Policy. For those reasons, the Panel declines to follow the reasoning in *TWENGA v. privacy protected*. Instead, the Panel will follow the reasoning in *Cheap Tickets and Travel Inc. v. Emall.ca Inc.* and *JOBRAPIDO S.r.l. v. Langue*.

41. In summary, it is the Panel’s view that a mere application for registration of a proposed use trademark in Canada that is filed (or deemed to have been filed) by a complainant before a disputed domain name is registered and that matures to registration after the disputed domain name is registered is not sufficient to give the complainant rights in the registered trademark before the domain name was registered as required by Policy paragraph 4.1(a).

42. The Panel acknowledges that actual use in Canada of an unregistered trademark before a domain name is registered may be sufficient to establish sufficient rights in a Mark, as defined in Policy paragraph 3.2(a), irrespective of whether or when an application to register that trademark has been filed. However, as discussed above, Complainants have not made any assertion, or provided any evidence, of any use of the PICMONKEY trademark in Canada before the Domain Name was registered.

43. For all of the reasons set out above, the Panel finds that Complainants have failed to prove, on a balance of probabilities, that either of Complainants had rights in the PICMONKEY trademark prior to the registration of the Domain Name.

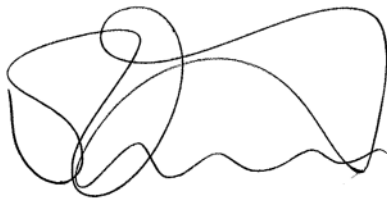
44. Given that finding, it is neither necessary nor appropriate for the Panel to consider the other issues presented by the Complaint.

K. Conclusion and Decision

45. For the reasons set out above, the Panel finds that Complainants have failed to prove, as required by Policy paragraph 4.1(a), that either of Complainants had rights in the “Mark” relied on by the Complainants (the PICMONKEY trademark) prior to the registration of the Domain Name.

46. Based on that finding, the Panel dismissed the Complaint.

Dated: November 22, 2016.



_____ for
Bradley J. Freedman (Chair), Harold Margles and Thomas Manson, Q.C.