

ADMINISTRATIVE PANEL DECISION

Vizrt AG v. Ashwaghosh, Viz Creative Pvt. Ltd.
Case No. D2023-1340

1. The Parties

The Complainant is Vizrt AG, Switzerland, represented by AWA Sweden AB, Sweden.

The Respondent is Ashwaghosh, Viz Creative Pvt. Ltd., India.

2. The Domain Names and Registrar

The disputed domain names <vizrtcreative.com> (the “First Disputed Domain Name”), <vizrtscreen.com> (the “Second Disputed Domain Name”), <vizonair.com> (the “Third Disputed Domain Name”), <vizkea.com> (the “Fourth Disputed Domain Name”), and <vizuniversity.com> (the “Fifth Disputed Domain Name”) are registered with PDR Ltd. d/b/a PublicDomainRegistry.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 28, 2023. On March 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 30, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is the registrant and providing additional contact details. The Center sent an email communication to the Complainant on April 3, 2023, 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 April 6, 2023. On April 3, 2023, the Respondent sent email communications to the Center filing an early Response.

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 April 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 2, 2023. The Response was filed with the Center on April 29, 2023.

The Center appointed Warwick Rothnie as the sole panelist in this matter on June 5, 2023. 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 provides visual storytelling tools for media content creators. These tools include software applications for the creation of 3D graphics and maps in real-time, visualized sports analysis, and media asset management. The Complainant's products are used by some of the world's largest media companies including CNN, CBS, NBC, Fox, BBC, Sky Group, Al Jazeera, NDR, ZDF, Network 18, and Tencent.

The Complaint claims the Complainant is the world's leading provider of such tools.

Amongst other things, the Complainant promotes its products and services from a website at "www.vizrt.com" and "www.vizrtgroup.com". In addition to its software products, the Complainant also offers training and related courses through its training platform, which it calls "Viz University". According to the Complaint, it has been offering its training courses under the name "Viz University" since "at least" 2020. Amongst other things, the courses offered include certification as a Vizrt Certified Professional.

The Complaint includes evidence that the Complainant holds a number of registered trademarks. These include:

- (a) International Registration No. 1069561,



which was registered on February 3, 2011, in respect of a range of goods and services in International Classes 9, 37, 41, and 42 including, in class 41, planning and conducting of training courses, seminars, and workshops;

- (b) International Registration No. 1264826, VIZ ARTIST and a star shaped device comprised of 5 pyramids, which was registered on April 23, 2015, in respect of a corresponding range of goods and services in International Classes 9, 41, and 42;
- (c) International Registration No. 1264825, VIZ TRIO and a triangular device comprised of 3 pyramids which was registered on April 23, 2015, in respect of a corresponding range of goods and services in International Classes 9, 41, and 42.

While not submitted into evidence, the Panel notes that a trademark corresponding to the trademark comprised in International Registration No. 1069561 has also been registered in India, Registered Trademark No. 2068886, which has been registered with effect from December 15, 2010, in respect of goods and services including planning and conducting training courses and other educational services in International Class 41.

The Respondent, Ashwaghosh, completed the Complainant's Viz Guru Certification course in December 2011. He has also been an employee of the Complainant although, according to the Respondent, it was for one year only. He was until recently included in a list published by the Complainant of certified designers of

the Complainant's software programs. (There is a dispute between the Parties about the basis on which he ceased to be so identified.)

The Respondent Company was incorporated in India in 2014.

The disputed domain name:

- (1) <vizrtcreative.com> was registered on August 18, 2012;
- (2) <vizrtscreen.com> was registered on January 7, 2018;
- (3) <vizonair.com> was registered on October 15, 2018;
- (4) <vizkea.com> was registered on June 6, 2020>; and
- (5) <vizuniversity.com> was registered on June 24, 2022.

All of the disputed domain names are registered in the name of the Respondent, Ashwaghosh. The information disclosed by the Registrar for the Fifth Disputed Domain Name included the Respondent Company, "Viz Creative Pvt. Ltd.", as the registrant organization. The same physical and nearly identical email addresses have been provided for each disputed domain name and, as noted above, the Respondent is a director of the Respondent Company. The same telephone number was provided for all of the disputed domain names except the First Disputed Domain Name. Unless it becomes necessary to distinguish between them, therefore, the Panel will refer to them as "the Respondent" for ease of reference.

Each of the disputed domain names resolves to a website.

The Fifth Disputed Domain Name resolves to a website "VizUNIV" which promotes courses apparently offered by the Respondent in the Complainant's products and other parties' products including Wasp 3D Xpress and Ross XPression. This website appears to offer courses in some 180 countries. A scrolling band at the bottom of the screen displays logos or trademarks of numerous broadcasters and other media including, for example only, CBS, NBC, BBC America, Discovery Channel, MTV, AsiaNet, India Today, HBO, to name just a few.

The First Disputed Domain Name appears to offer software packages – for example VIZ News Suite and VIZ Election Suite, design services and training. The brand VIZ is presented on the website with an orange circle in superscript similar to the positioning commonly for the ® logo (when used). However, by enlarging the screen, it is revealed to be a hollow circle only.

The Second Disputed Domain Name resolves to a website which offers for purchase by subscription the Viz Screen app, to assist with visual storytelling and adding live graphics to video.

The Third Disputed Domain Name resolves to a website "VIZ ONAIR" with a device of the letter "V" in a square border with round corners, corresponding to a trademark registration owned by the Respondent (as mentioned further below). The word "VIZ", the letter "V" and its surrounding border are in orange. There is also a red dot in superscript adjacent the letter "V". This website promotes a service or application for use in "broadcasting on mobile", and also appears to promote the services of "Viz Creative".

The Fourth Disputed Domain Name resolves to a website promoting "KEA" which appears to be a subscription education service for K12 learning and teaching.

The Respondent is the owner of three registered trademarks in India:

- (a) Registered Trademark No. 2034170, VIZSCREEN, which has been registered with effect from May 19, 2018, for software creation and related services in International Class 42;

- (b) Registered Trademark No. 2229014, VIZ ONAIR, which has been registered with effect from January 11, 2019, in respect of software used for live broadcast graphics of videos on social media, digital image processing & sequences, storage in databases for media asset management, Internet & website and related services in International Class 42; and
- (c) Registered Trademark No. 2232776, VIZ ONAIR & V device, which has been registered with effect from December 1, 2018, in respect of software used for live broadcast graphics of videos on social media, digital image processing & sequences, storage in databases for media asset management, Internet & website and related services in International Class 42.

In each of these trademarks, the word VIZ is present in orange and contrasting in colour to the other words.

The Respondent has also applied to register as trademarks in India:

- (v) Application No. 5510245, VIZ UNIVERSITY, in respect of teaching and training services in International Class 41. The application was filed on June 29, 2022 on the basis of proposed use.
- (w) Application No. 5914132, VIZ KEA, also in respect of teaching and training services in International Class 41. The application was filed on April 28, 2023 and also on the basis of proposed use.

The VIZ KEA Application was filed after the Respondent received a cease and desist letter from the Complainant's attorneys dated February 2, 2023. Additionally, the VIZ UNIVERSITY Application shows a status of "objected".

5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the 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.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant does claim to own registered trademarks for or including VIZ. However, none of the trademarks it has provided evidence of are for VIZ alone.

The Complainant has proven ownership of the registered trademarks identified in section 4 above (or a number of national derivatives therefrom). In addition, although the evidence in support is not extensive, the Panel also finds that the Complainant has shown rights in VIZ UNIVERSITY sufficient for the purposes of the Policy particularly having regard to the Respondent's apparent targeting of that expression. See e.g. [WIPO Overview 3.0](#), sections 1.3 and 1.15.

As is generally the case, it is appropriate in this case to disregard the inclusion of the “.com” generic Top-Level Domain (“gTLD”) in the disputed domain names as a functional requirement of the domain name system. See e.g. [WIPO Overview 3.0](#), section 1.11.

<vizrtcreative.com> and <vizrtscreen.com>

Both of the First and Second Disputed Domain Names include the whole of the Complainant’s trademark exemplified by International Registration No 1069561 and Indian Registered Trademark No. 2068886, disregarding the figurative elements.

It is, however, appropriate to disregard the design elements of a trademark under the first element as such elements are generally incapable of representation in a domain name. In the present case, the figurative elements are not sufficiently dominant to displace the usual rule. See for example, [WIPO Overview 3.0](#), section 1.10. Similarly, the appending of the words “creative” or “screen” to the verbal element of the Complainant’s trademark does not obviate a finding of confusing similarity under the Policy. See e.g. [WIPO Overview 3.0](#), section 1.8.

<vizuniversity.com>

Disregarding the “.com” gTLD, the Fifth Disputed Domain Name is identical to the Complainant’s unregistered trademark VIZ UNIVERSITY.

<vizonair.com> and <vizkea.com>

The Third and Fourth Disputed Domain Names can be seen as consisting of the elements, respectively, “viz” and “on air” or “kea”.

The first and primary feature of both is the “viz” element.

This element is shared with the first verbal element of the Complainant’s trademarks exemplified by International Registration Nos. 1264826 and 1264825.

The Respondent points out that “viz” is an accepted abbreviation for “vidilicet”, a Latin term which in English is used for “that is to say”. While “viz” may be a commonly used term, the Panel does not understand it to be descriptive in the context of the goods and services being offered by the Complainant or the Respondent. The Respondent also points out that there are other persons using “viz” including VIZ Media LLC at “www.viz.com”, which is a provider of Manga, anime and similar publications and Autodesk Inc.’s product Autodesk VIZ 4. As noted above in the cases referred to in [WIPO Overview 3.0](#), section 1.7, these matters are not usually relevant at this stage but may well be relevant when considering the second and third elements under the Policy.

Both of the Complainant’s trademarks include a device component which is not insubstantial. That said, the natural verbal reference to these trademarks would be VIZ ARTIST or VIZ TRIO. The second verbal element of each is an ordinary dictionary word.

In this case, it is at least reasonably arguable that it is the verbal combination as a whole which is likely to be the recognisable component of the Complainant’s trademarks rather than the word “viz” alone. In that case, it is rather more doubtful that either of the Complainant’s trademarks can confidently be said to be recognisable in the particular verbal combinations in, respectively, the Third and Fourth Disputed Domain Names in the typical side by side comparison.

However, it is well recognised in the case law that, while the content of the Respondent’s website is not usually relevant at this stage of the inquiry, in cases of doubt reference can be made to the Respondent’s website to ascertain if the Respondent is targeting the Complainant or the Complainant’s trademarks. See e.g. [WIPO Overview 3.0](#), section 1.15.

Taking that course, the Panel finds that both disputed domain names are confusingly similar under the Policy.

First, the website to which the Third Disputed Domain Name resolves emphasizes the “viz” element distinctly from the “on air” element as “viz” is represented in an orange colour very similar to the gold colour in which the Complainant depicts its VIZRT trademark. Also, the website promotes the services of “Viz Creative”, the main business of which appears to be providing services using and based on “our deep understanding of real-time graphics of VizRT”.

Secondly, the website at the Fourth Disputed Domain Name is less obviously targeted at the Complainant and its trademarks. However, the product being promoted on the site is “KEA”. It appears that the element “viz” has been included in the disputed domain name only through its use as a “house” brand by the Complainant and the Respondent’s apparent reflection of that.

Based on the available record, the Panel finds the first element of the Policy has been established in respect of each disputed domain name.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

While the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

All of the disputed domain names were registered after the Complainant began using and also after it registered its VIZRT trademark. All but the First Disputed Domain Name were also registered after the Complainant registered its VIZ ARTIST and VIZ TRIO trademarks.

While the Respondent disputes the basis on which the Complainant has removed it from the list of certified consultants, it is not in dispute between the Parties that the Complainant has not authorised the Respondent to register or use the disputed domain names. Nor is it in dispute that the Respondent is not affiliated with the Complainant.

These matters are sufficient to raise a *prima facie* case of lack of rights or legitimate interests.

The Panel notes that the Respondent Company is identified as “Viz Creative Pvt. Ltd.” in the registration details of the Fifth Disputed Domain Name only. However, it is apparent that it is the vehicle through which the Respondent exploits the other disputed domain names as well.

As previously stated, the Respondent Company was incorporated in 2014. That was after the First Disputed Domain Name was registered but before the other disputed domain names were registered.

Importantly, however, the Respondent Company was incorporated after the Respondent had completed his Viz Guru certification in 2011. In those circumstances, the Respondent cannot claim that the company’s name was adopted independently of knowledge of the Complainant and its trademarks. As a result, the Panel considers that the Respondent cannot rely on paragraph 4(c)(ii) of the Policy to establish rights or legitimate interests in the disputed domain names.

It is necessary, however, to consider further the position of each disputed domain name individually.

<vizrtcreative.com>

The Respondent's contentions in relation to "viz" have been noted in section 5A above. The Respondent further contends that "RT" is an accepted abbreviation around the world for "real-time". The evidence advanced by the Respondent, however, falls well short of establishing that the combination "vizrt" is a commonly accepted or used term. On the materials before the Panel, it appears to be an inherently distinctive term which has significance only as the Complainant's trademark.

Insofar as the website to which the First Disputed Domain Name resolves is concerned, the Respondent appears to be acting as a reseller of the Complainant's products or providing services related to the Complainant's products.

A respondent may have rights or a legitimate interest in a domain name which involves use of another's trademark even in the absence of authorization from the trademark owner. In cases where the respondent's use involves use in relation to goods or services the same as or closely connected with the goods or services of the trademark owner, panels generally assess a claim to rights or legitimate interests according to the so-called "Oki-Data" test: see e.g. [WIPO Overview 3.0](#), section 2.8. That test requires consideration of a number of factors:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) the respondent must not try to "corner the market" in domain names that reflect the trademark.

As the [WIPO Overview 3.0](#) notes, these conditions are primarily directed to investigating whether the respondent's use is genuine nominative (fair) use or involves an unfair trade practice such as "bait or switching" or seeking to attract customers, or potential customers, by an incorrect or false implied affiliation.

In the present case, there is no suggestion that the Respondent is not offering the goods or services promoted on the website to which the First Disputed Domain Name resolves.

Also, it cannot be said that the First Disputed Domain Name reveals an attempt to "corner the market". On the other hand, the Respondent has registered five disputed domain names which can be seen as an attempt over time at the very least to shadow or "box in" the Complainant.

Turning to the second factor, the website is also offering services (at least) in relation to what are apparently competing products. It is not just offering the Complainant's products or services related to the Complainant's products.

Moreover, there is no clear disclosure of the relationship between the Respondent and the Complainant. The First Disputed Domain Name does include an additional descriptive word "creative". As noted in [WIPO Overview 3.0](#), section 2.8.2, that can be a basis for reducing the risk of misrepresentation. The Panel does not think that is the case here. On the contrary, the website could easily give the impression that the services are being offered by or with the blessing of the Complainant. The Panel accepts that the Respondent can legitimately publicise his certifications on the Complainant's products and his experience in providing services with those products. When doing so, however, it is incumbent to make it clear that he is not the Complainant or associated with it.

On balance, therefore, the Panel finds that the Respondent has not rebutted the *prima facie* case established by the Complainant under this requirement in respect of the First Disputed Domain Name.

<vizrtscreen.com>

The Respondent does own a registered trademark in India, No. 2034170, VIZSCREEN.

That registration cannot be used to confer rights or legitimate interests in <vizrtscreen.com>, however, in view of the different identifier. "Vizscreen" is not "vizrtscreen".

Furthermore, the "Screen" app being promoted at the website to which this disputed domain name resolves is not one of the Complainant's products at all. The use of a confusingly similar disputed domain name in connection with such an offering does not qualify as a good faith offering of goods or services.

Accordingly, the Panel finds that the Respondent has not rebutted the *prima facie* case in respect of this disputed domain name.

<vizuniversity.com>

The Respondent does have a pending trademark application for VIZ UNIVERSITY in India. This was filed only last year. Whether or not it will mature into a registered trademark is unknown and, furthermore, an objection appears to have been filed. In addition, the website to which the Fifth Disputed Domain Name resolves does not appear to be restricted to an audience in India alone but, on the contrary, emphasizes the international nature of the services being offered. Accordingly, the Panel is not prepared to accept a pending trademark application as conferring rights or legitimate interests on the Respondent.

As with the First Disputed Domain Name, the services being offered through the website to which the Fifth Disputed Domain Name resolves include third party products, not just the Complainant's products and there is no clear disclosure of the Respondent's relationship with the Complainant. On the contrary, someone familiar with the Complainant's trademark and, having regard to the use of the Complainant's VIZRT trademark on the site, could readily be led into mistakenly thinking they were dealing with the Complainant or someone associated with the Complainant. For reasons corresponding to those for the First Disputed Domain Name, therefore, the Respondent has not rebutted the *prima facie* case in respect of this disputed domain name.

<vizkea.com>

The subscription service being offered through the website to which the Fourth Disputed Domain Name resolves is called "Kea". It is not a product of the Complainant and it is not apparent that it is provided using any of the Complainant's products or services.

The Respondent also has a pending trademark application in India for VIZ KEA. This was only filed after receipt of the cease and desist letter from the Complainant. It is also not the name of the product or service which the Respondent is actually offering given that the subscription service for which the Fourth Disputed Domain Name resolves is entitled only, "Kea". As with the Fifth Disputed Domain Name, therefore, the Panel does not accept the pending trademark application as conferring a right or legitimate interest in the Respondent.

Given that the Respondent has not demonstrated that "viz" is a common or descriptive term for the type of product or service being offered, the Panel infers its use in this disputed domain name could readily be misunderstood as a product or brand extension of the Complainant. The Panel also bears in mind the Respondent's certification as a "Viz Guru" by the Complainant in 2011. In those circumstances, the Panel finds that the Respondent has not rebutted the *prima facie* case in respect of the Fourth Disputed Domain Name.

<vizonair.com>

The Respondent has two trademarks registered in India based on VIZ ONAIR including one registration for VIZ ONAIR alone.

The prior registration of a trademark can provide a basis for a finding of rights or legitimate interests. However, it has long been recognized that a prior registered trademark does not *automatically* confer rights or legitimate interests on the respondent. [WIPO Overview 3.0](#) section 2.12.2 summarises:

“For example, panels have generally declined to find respondent rights or legitimate interests in a domain name on the basis of a corresponding trademark registration where the overall circumstances demonstrate that such trademark was obtained primarily to circumvent the application of the UDRP or otherwise prevent the complainant’s exercise of its rights (even if only in a particular jurisdiction). Absent evidence of such circumstances indicating pretext however, panels have been reluctant to reject a respondent trademark registration out of hand.”

In the present case:

1. The Respondent registered the trademarks in 2018, well after the Respondent had obtained his Viz Guru certification from the Complainant and was very familiar with the Complainant and its products.
2. In both registered trademarks the word “VIZ” is represented in orange and in contrast to the red colouring of “on air” and, as noted above, the orange colour recalls the gold colour in which the Complainant’s VIZRT trademarks are registered.
3. The Respondents’ trademarks are registered in India only. However, insofar as can be gathered from the website to which this disputed domain name resolves the product is being offered to a global audience.
4. As already noted, the Panel has not accepted the Respondent’s claim that “viz” is a descriptive term in the context of the products and services offered by the Parties.

In these circumstances, the Panel finds that the Respondent has not rebutted the *prima facie* case that he does not have rights or legitimate interests in the Third Disputed Domain Name.

C. Registered and Used in Bad Faith

Under the third requirement of the Policy, the Complainant must establish that the disputed domain name has been both registered and used in bad faith by the Respondent. These are conjunctive requirements; both must be satisfied for a successful complaint: see *e.g. Burn World-Wide, Ltd. d/b/a BGT Partners v. Banta Global Turnkey Ltd* WIPO Case No. [D2010-0470](#).

As already explained above, it is plain that the Respondent was well aware of the Complainant and its trademarks when registering the disputed domain names.

Given that knowledge, it follows from the findings that the Respondent does not have rights or legitimate interests in the disputed domain names, that the Respondent has registered the disputed domain names in bad faith and is using them in bad faith. The Respondent uses the disputed domain names to create a false impression that the Respondent’s products and services are products or services of, or authorised or otherwise associated with, the Complainant.

Accordingly, the Complainant has established all three requirements under 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 names <vizkea.com>, <vizonair.com>, <vizrtcreative.com>, <vizrtscreen.com>, and <vizuniversity.com> be transferred to the Complainant.

/Warwick A Rothnie/

Warwick A Rothnie

Sole Panelist

Date: June 20, 2023