

ADMINISTRATIVE PANEL DECISION

Qingdao Pico Technology Co. Ltd. and Pico Technology Co. Ltd. v.

yong kah chuen

Case No. D2023-1849

1. The Parties

The Complainants are Qingdao Pico Technology Co., Ltd., China and Pico Technology Co., Ltd., China (“the Complainant”), represented by CSC Digital Brand Services Group AB, Sweden.

The Respondent is yong kah chuen, Malaysia, represented by Ming & Partners, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <picogame.shop> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 25, 2023. On April 25, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 27, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 2, 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 May 5, 2023.

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”).

The Respondent sent an email communication to the Center on May 5, 2023. On May 10, 2023, the Respondent’s representative sent an email communication to explore settlement options. On May 23, 2023, the Complainant requested the suspension of the proceedings. Accordingly, on May 23, 2023, the Center sent the Notification of Suspension to the Parties.

On June 16, 2023, the Complainant requested the Center to reinstitute the proceedings. Accordingly, the case has been reinstated on June 19, 2023.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on June 19, 2023. In accordance with the Rules, paragraph 5, the due date for Response was July 9, 2023. The Respondent did not submit any formal response until the due date. Accordingly, the Center notified the Respondent's default on July 13, 2023.

Due to an administrative oversight, the Center's Notification emails were not copied to the Respondent's representative. Accordingly, the Center granted the Respondent an additional five day period, until August 7, 2023, in which to indicate whether it wishes to participate to this proceeding. Neither the Respondent nor the Respondent's Representative did not submit any response until the due date. Accordingly, the Center notified the Respondent's default on August 8, 2023.

The Center appointed Anne-Virginie La Spada as the sole panelist in this matter on August 11, 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 is specialized in the virtual reality ("VR") industry and sells VR headsets, which are used in connection with a range of immersive games offered by the Complainant.

Among other registrations, the Complainant owns the following trademark registrations:

- United States of America registration for the semi-figurative trademark PICO No. 5355508, registered on December 12, 2017 in class 42;
- Malaysia registration for the semi-figurative trademark PICO No. TM2021031213, registered on November 8, 2021 in classes 9 and 28
- Switzerland registration No. 788504 for the word trademark PICO, registered on October 27, 2022 in class 9.

The Complainant is also the owner of the domain name <picoxr.com> since 2018.

The disputed domain name was registered on January 25, 2023.

The disputed domain name used to resolve to a website purportedly offering VR games of the Complainant for download and containing links to a listing where users are able to purchase game package codes allowing them to download game files on the Respondent's website. At the time of the Panel's decision, the disputed domain name does not resolve to an active webpage.

5. Parties' Contentions

A. Complainant

According to the Complainant, the disputed domain name is confusingly similar to its PICO registered trademark as it captures the entirety of its trademark with the mere adjunction of the word "game".

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name for the following reasons: (i) the Respondent is not sponsored by or affiliated with the Complainant in any way; (ii) the Respondent is not commonly known by the disputed domain name; and (iii) the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Instead, the Respondent offers highly likely pirated versions of games that are offered on the Complainant's store, thus directly competing with the Complainant's offerings. The Complainant also contends that the games offered by the Respondent may be connected to viruses or malware.

Finally, the Complainant contends that the Respondent has used and registered the disputed domain name in bad faith. Considering the fact that the disputed domain name used to resolve to a website offering unauthorized and/or highly likely pirated virtual reality games, the Respondent was aware of the existence of the Complainant and of its trademark when it registered the disputed domain name. According to the Complainant, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark, a behavior amounting to registration and use in bad faith.

B. Respondent

The Respondent and its representative have submitted emails in order to explore settlement options indicating that the Respondent did not "engage in any buying or selling of the disputed domain name". However, the Respondent did not formally reply to the Complainant's contentions.

6. Discussion and Findings

According to paragraph 4(a) of the Policy, a complainant must assert and prove each of the following:

- (i) the domain name registered by the respondent 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 domain name; and
- (iii) the domain name registered by the respondent has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name reproduces the Complainant's trademark PICO in its entirety with no alteration, and combines this trademark with the word "game".

UDRP panels consider that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element of paragraph 4(a) of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)")).

In the present case, the trademark PICO is clearly recognizable in the disputed domain name. The mere addition of the term "game" does not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark.

UDRP panels accept that a generic Top-Level Domain ("gTLD"), such as ".shop", may be disregarded when assessing whether a domain name is identical or confusing similar to a trademark (see [WIPO Overview 3.0](#), section 1.11.1).

The Complainant has satisfied the condition set forth in paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Respondent has failed to file a formal response.

Based on the information submitted by the Complainant, the Respondent does not appear to have rights or legitimate interests in respect of the disputed domain name, nor has the Complainant granted to the Respondent any authorization to use its trademark in the disputed domain name.

Based on the evidence provided by the Complainant, it appears that the Respondent used the disputed domain name to direct Internet users to a website offering VR games for download and containing links to a

listing where users are able to purchase game package codes. Such use further supports the apparent lack of rights or legitimate interests of the Respondent in the disputed domain name. Indeed, attracting Internet users to a website offering highly likely pirated virtual reality games for download can hardly be a legitimate or fair use.

Furthermore, the composition of the disputed domain name carries a risk of implied affiliation (see [WIPO Overview 3.0](#), section 2.5.1), as the Complainant has activities in the field of VR games.

Accordingly, the Respondent's use of the disputed domain name does not constitute *bona fide* offering of goods and services.

Finally, the Panel may draw from the lack of a formal Response the inferences that it considers appropriate, according to the Rules, paragraph 14(b). The Panel finds that the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Panel finds that the Respondent's silence corroborates the Complainant's *prima facie* case.

Accordingly, the Panel rules on balance that the Complainant has satisfied the condition set out in paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Given that the trademark PICO of the Complainant is distinctive and that the Respondent offered VR games on the website at the disputed domain name, the Panel accepts that the Respondent was aware of the existence of the Complainant and of its PICO trademark at the time of the registration of the disputed domain name. Accordingly, the Panel finds that the disputed domain name was registered in bad faith.

Under paragraph 4(b)(iv) of the Policy, the use of a disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of a website or location or of a product or service on the website or location, amounts to evidence of registration and use in bad faith.

The Panel finds that the Respondent has demonstrated bad faith by using the disputed domain name for a website purportedly offering virtual reality games (*i.e.* games similar to those offered by the Complainant), thereby deliberately relying upon a perceived association with the Complainant to attract Internet users. Consequently, by using the disputed domain name in such manner, the Respondent intentionally attempted to attract, for the purposes of commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source and affiliation of its website. Such behavior constitutes use in bad faith under paragraph 4(b)(iv) of the Policy.

For the reasons set out above, the Panel finds that the Respondent has registered and is using the disputed domain name in bad faith, and that the Complainant has accordingly satisfied the condition set forth in paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <picogame.shop> be transferred to the Complainant.

/Anne-Virginie La Spada/

Anne-Virginie La Spada

Sole Panelist

Date: August 27, 2023