

ADMINISTRATIVE PANEL DECISION

Pexels GmbH v. Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2022-4357

1. The Parties

The Complainant is Pexels GmbH, Germany, represented by SafeNames Ltd., United Kingdom.

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <1pexels.com> (“Domain Name”) 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 November 16, 2022. On November 16, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On November 16, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the 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 November 16, 2022, 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 November 18, 2022.

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 November 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 12, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 13, 2022.

The Center appointed Nicholas Smith as the sole panelist in this matter on December 17, 2022. 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 a German company, founded in 2013, that operates as a media provider for online services. The Complainant maintains an online library with 3.2 million photos and videos from its website at “www.pexels.com” (the “Complainant’s Website”) offered under the trademark PEXELS (the “PEXELS Mark”). The Complainant’s Website receives an average of 30 million monthly visits and its mobile app has been installed on over 1 million devices.

The Complainant is the owner of trademark registrations for the PEXELS Mark in various jurisdictions including a United States registration, registration number 5,860,074, registered on September 17, 2019, for goods and services in classes 9, 16, 35, 38, 41 42 and 45.

The Domain Name <1pexels.com> was registered on February 1, 2022. The Domain Name is used to divert Internet users to a rotating series of third party sites unconnected to any descriptive meaning of the Domain Name for which the Respondent may receive affiliate revenue. The Respondent has been the named and unsuccessful respondent in over 80 previous proceedings with the Center, including *Skyscanner Limited v. Registration Private, Domains By Proxy, LLC/Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2020-0018](#); *Serena & Lily, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2021-0568](#); *Calvin Klein Trademark Trust and Calvin Klein, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-3045](#); *LEGO Juris A/S v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-2834](#); *Starbucks Corporation v. Registration Private, Domains by Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1991](#); *Patagonia, Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1409](#); *Philip Morris USA Inc. v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2019-1109](#); *Société Air France v. Registration Private, Domains By Proxy, LLC, DomainsByProxy.com / Carolina Rodrigues*, WIPO Case No. [D2019-0578](#); and *Ford Motor Company v. Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2018-2787](#).

5. Parties’ Contentions

A. Complainant

The Complainant makes the following contentions:

- (i) that the Domain Name is identical or confusingly similar to the Complainant’s PEXELS Mark;
- (ii) that the Respondent has no rights nor any legitimate interests in respect of the Domain Name; and
- (iii) that the Domain Name has been registered and is being used in bad faith.

The Complainant is the owner of the PEXELS Mark, having registered the PEXELS Mark in various jurisdictions including the European Union and the United States. The Domain Name is confusingly similar to the PEXELS Mark since it wholly incorporates the PEXELS Mark and adds the number “1”.

There are no rights or legitimate interests held by the Respondent in respect of the Domain Name. The Respondent is not commonly known by the Domain Name nor does the Respondent have any authorization from the Complainant to register the Domain Name. The Respondent is not making a legitimate noncommercial or fair use of the Domain Name. Rather the Respondent is using the Domain Name to resolve to third party commercial websites for which it likely receives revenue.

The Domain Name was registered and is being used in bad faith. By using the Domain Name to resolve to third party websites for which it likely receives revenue, the Respondent is using the Domain Name to divert Internet users searching for the Complainant for commercial gain. Such conduct amounts to registration and use of the Domain Name in bad faith. In addition, the Respondent has engaged in a pattern of registering domain names corresponding to famous trademarks in order to prevent the trademark owners from reflecting their marks in corresponding domain names.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

To prove this element the Complainant must have trade or service mark rights and the Domain Name must be identical or confusingly similar to the Complainant's trade or service mark.

The Complainant is the owner of the PEXELS Mark, having registrations for the PEXELS Mark as a trademark in the United States. The Domain Name wholly incorporates the PEXELS Mark along with the additional element "1" (and the ".com" generic Top-Level Domain ("gTLD"), which can be discounted as an essential element of any domain name). Other UDRP panels have repeatedly held that where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) do not prevent a finding of confusing similarity under the first element; see section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Panel finds that the Domain Name is confusingly similar to the Complainant's PEXELS Mark. Consequently, the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

To succeed on this element, a complainant must make out a *prima facie* case that the respondent lacks rights or legitimate interests in the domain name. If such a *prima facie* case is made out, then the burden of production shifts to the respondent to demonstrate rights or legitimate interests in the domain name.

Paragraph 4(c) of the Policy enumerates several ways in which a respondent may demonstrate rights or legitimate interests in a domain name:

"Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of Paragraph 4(a)(ii):

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

The Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the Domain Name or to seek the registration of any domain name incorporating the PEXELS Mark or a mark similar to the PEXELS Mark. There is no evidence that the Respondent is commonly known by the Domain Name or any similar name. There is no evidence that the Respondent has used or made demonstrable preparations to use the Domain Name in connection with a legitimate noncommercial fair use or a *bona fide* offering of goods and services; the use of the Domain Name to resolve to a rotating series of third party commercial websites unrelated to any dictionary meaning of the Domain Name (for which the Respondent is likely to receive revenue) does not amount to use for a *bona fide* offering of goods and services.

The Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the Domain Name. The Respondent has failed to rebut that *prima facie* case and establish that it has rights or legitimate interests in the Domain Name under the Policy. The Panel finds that the Respondent has no rights or legitimate interests in respect of the Domain Name under paragraph 4(a)(ii) of the Policy.

D. Registered and Used in Bad Faith

For the purposes of paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trade mark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) the respondent has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or
- (iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its 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 the respondent’s website or location or of a product or service on the respondent’s website or location (Policy, paragraph 4(b)).

The [WIPO Overview 3.0](#) records, in response to the question “3.1.2 What constitutes a pattern of conduct of preventing a trademark holder from reflecting its mark in a domain name?” that:

“UDRP panels have held that establishing a pattern of bad faith conduct requires more than one, but as few as two instances of abusive domain name registration. This may include a scenario where a respondent, on separate occasions, has registered trademark-abusive domain names, even where directed at the same brand owner. A pattern of abuse has also been found where the respondent registers, simultaneously or otherwise, multiple trademark-abusive domain names corresponding to the distinct marks of individual brand owners ...”

The Panel finds that the Respondent has engaged in pattern of registering domain names closely corresponding with the trademarks of commercial enterprises (in the cases referred to in the Factual Background) for commercial gain and to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name. The Respondent has been the unsuccessful party in over 80 cases under the Policy before the Center. On the basis of this information, the reputation of the Complainant and its PEXELS Mark, the entire reproduction of the PEXELS Mark within the Domain Name, as well as the lack of any explanation by the Respondent of its registration and use of the Domain Name, the Panel is satisfied that the Domain Name was registered and is presently used in order to prevent the Complainant, being the owner of the PEXELS Mark, from reflecting its mark in a corresponding domain name and that the Respondent has engaged in a pattern of such conduct. The Policy, paragraph 4(b)(ii), provides that this circumstance is evidence of registration and use of a domain name in bad faith.

Accordingly, the Panel finds that the Respondent has registered and used the Domain Name in bad faith under 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 Domain Name <1pexels.com> be transferred to the Complainant.

/Nicholas Smith/

Nicholas Smith

Sole Panelist

Date: December 24, 2022