

## **ADMINISTRATIVE PANEL DECISION**

**Pixabay GmbH v. Whois Privacy Protection Service, Inc. / WIS INC**  
**Case No. D2022-2550**

### **1. The Parties**

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

The Respondent is Whois Privacy Protection Service, Inc., United States of America / WIS INC, United Kingdom.

### **2. The Domain Names and Registrar**

The disputed domain names <pixabya.com> and <pixsabay.com> are registered with eNom, LLC eNom, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 13, 2022. On July 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 13, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 14, 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 July 15, 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 July 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 18, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 19, 2022.

The Center appointed Williams R. Towns as the sole panelist in this matter on August 29, 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 Pixabay GmbH, a free stock photography and royalty-free media website founded in 2010 and used with an online platform enabling the sharing of photos, illustrations, graphics, film footage, and music. The Complainant is the owner of numerous trademark registrations for its PIXABAY marks issued in Australia, India, and the European Union, as well as in other jurisdictions, including among the following:

- PIXABAY, Australia Trademark Registration No. 2004679, registered April 22, 2019;
- PIXABAY, India Trademark Registration No. 4212079, registered June 20, 2019;
- PIXABAY, Mexico Trademark Registration No. 2033884, registered August 28, 2019; and
- PIXABAY, European Union Trademark Registration No. 018041811, registered September 20, 2019.

The Complainant since its inception has established a strong media presence, utilizing its PIXABAY mark to promote networking services enjoyed by a multitude of followers on Instagram, Facebook, and Twitter. The Complainant registered its domain name <pixabay.com> on October 7, 2010. The Complainant's main site today is accessible in as many as 26 languages, with a variety of customers enjoying some 37 million site visits per month. The Complainant's services include mobile and tablet devices.

The disputed domain names <pixabay.com> and <pixabya.com> were registered by the Respondent on separate dates. The disputed domain name <pixabay.com> was registered by the Respondent on January 1, 2018, and the disputed domain name <pixabya.com> registered by the Respondent on February 28, 2018, respectively. The disputed domain names have been used by the Respondent with pay-per-click ("PPC") links directed to third-party sites being advertised for sale, redirecting Internet visitors to third-party websites and seeking to download malicious files to the devices of unsuspecting Internet users.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant submits that the disputed domain names <pixabya.com> and <pixabay.com> (hereinafter "the disputed domain names") are identical or confusingly similar to the Complainant's PIXABAY mark in which the Complainant asserts rights. The Complainant remarks that it holds a number of registered trademarks for its PIXABAY mark in numerous jurisdictions, including Australia, India, Mexico, and the European Union. The Complainant also asserts common law rights in its PIXABAY marks, contending it has become a distinctive identifier of source that consumers associate with the complainant's goods and services, and also noting that the <.com> extension of the disputed domain names typically are disregarded when assessing confusing similarity of the disputed domain names to the Complainant's mark.

The Complainant maintains that the Respondent lacks rights or legitimate interests in respect of the disputed domain names. According to the Complainant, the Respondent has not registered trademarks reflecting the Complainant's PIXABAY mark, has not been licensed by the Complaint or otherwise authorized to register domain names incorporating the Complainant's PIXABAY mark, and is not making a legitimate noncommercial or other fair use of the disputed domain name without intent for commercial gain or misleadingly to divert consumers or tarnish the trademark or service mark at issue.

The Complainant asserts that the Respondent's use of the disputed domain names to advertise sales on one or more websites is not conduct consistent with a *bona fide* offering of goods or services, observing that the Complainant's PIXABY mark is highly distinctive in relation to the typosquatting nature of the disputed domain names, which according to the Complainant clearly has not been acquired for any legitimate resale purpose. The Complainant emphasizes that the Respondent's use of the disputed domain names for illegal activity such as impersonation, passing off, or other types of fraud can never confer rights or legitimate interests under Paragraph 4(c) of the Policy. The Complainant submits that the Respondent's conduct clearly is illegitimate, and refers to similar respondent conduct, citing *Empire Flippers, LLC v. Domain Administrator / Fundacion Privacy Services LTD*, NAF Case No. 1996793 (2022).

The Complainant contends that the disputed domain names were registered by the Respondent in bad faith and have been used by the Respondent in bad faith. The Complainant reiterates it has become a distinctive identifier of source associated with the Complainant's PIXABAY marks, including both registered and unregistered common law marks. The Complainant asserts that the Respondent has targeted the Complainant in bad faith through the Respondent's registration and use of the disputed domain names.

The Complainant further contends that the Respondent registered the disputed domain name with a view to targeting Internet users mistyping the PIXABAY mark, hoping to reach the Complainant's established "www.pixabay.com" website. The Complainant remarks that WIPO panels consistently have found such conduct to constitute bad faith, concluding that the disputed domain names are so clearly connected to the PIXABY mark as undoubtedly to have been registered in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain name", also known as "cybersquatting". *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the First WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169-177. The term "cybersquatting" is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.*, at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

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

Cancellation or transfer of the domain name is the sole remedy provided to the complainant under the Policy, as set forth in paragraph 4(i). Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the view is that the burden of production shifts to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

### **A. Identical or Confusingly Similar**

The Panel finds that the disputed domain names are confusingly similar to the Complainant's PIXABAY mark. In considering this issue, the first element of the Policy serves essentially as a standing requirement. The threshold inquiry under the first element of the Policy involves a relatively straightforward comparison between the Complainant's trademark and the disputed domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7. The fact that the disputed domain names predate the registration of the Complainant's trademarks is not material for purposes of the first element.

The Complainant's PIXABAY mark is clearly recognizable in each of the disputed domain names.<sup>1</sup> A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element.<sup>2</sup>

Neither the Respondent's inclusion in the disputed domain name of the letter "s" in <pixsabay.com> (emphasis added) or the Respondent's reversal in the disputed domain name of the letters "ay" in <pixabya.com> (emphasis added) preclude a finding of confusing similarity respecting the Complainant's PIXABAY mark.

Top-level-domains ("TLDs") generally are disregarded when evaluating the identity or confusing similarity of the complainant's mark to the domain name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.<sup>3</sup>

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

### **B. Rights or Legitimate Interests**

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) of the Policy has been made. It is undisputed that the Respondent has not been authorized to use the Complainant's PIXABAY mark. Nevertheless, the Respondent has misappropriated the Complainant's PIXABAY mark, using pay-per-click ("PPC") links directed to third-party sites that are allegedly for sale, at the presumed commercial gain of the Respondent.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's 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

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<sup>1</sup> See [WIPO Overview 3.0](#), section 1.9 and cases cited therein.

<sup>2</sup> *Id.*

<sup>3</sup> See [WIPO Overview 3.0](#), section 1.11.

- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is 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 has not submitted a formal response to the Complaint, in the absence of which the Panel may accept all reasonable inferences and allegations in the Complaint as true. See *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#). Regardless, the Panel has carefully reviewed the record in this case, and finds nothing therein that would bring the Respondent's registration and use of the disputed domain names within any of the "safe harbors" of paragraph 4(c) of the Policy.

Having regard to the relevant circumstances, the Panel finds that the Respondent has neither used nor demonstrated preparations to use the disputed domain names in connection with any *bona fide* offerings of goods or services under paragraph 4(c)(i) of the Policy, and has not made a legitimate noncommercial or other fair use of the disputed domain name for purposes of paragraph 4(c)(iii) of the Policy. The Respondent has not been authorized to use the Complainant's PIXABAY mark, and there is no indication that the Respondent has been commonly known by the disputed domain names within the meaning of paragraph 4(c)(ii) of the Policy. In short, nothing in the record supports a claim by the Respondent of rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that the respondent registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant (the owner of the trademark or service mark) or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or
- (ii) circumstances indicating that the respondent registered the domain name in order to prevent the owner of the trademark 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) circumstances indicating that the respondent registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) circumstances indicating that the respondent is using the domain name to intentionally attempt 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 its website or location.

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain name in circumstances where the registrant seeks to profit from and exploit the trademark of another. *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For the reasons discussed under this and the preceding heading, the Panel considers that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain names within the

meaning of paragraph 4(a)(iii) of the Policy. The Panel concludes that the Respondent clearly was aware of the Complainant and had the Complainant's PIXABAY mark firmly in mind when registering the disputed domain names. By itself, the typosquatting nature of the disputed domain names is suggestive of the Respondent's intent to target the Complainant and mislead unsuspecting Internet users, which is bad faith.

Moreover, whereas the date of the Complainant's trademark registrations are after the registration of the disputed domain names, the Complainant has provided suitable evidence demonstrating common law rights in PIXABAY by virtue of its continued use since the registration of the Complainant's domain name <pixabay.com> in 2010, the website of which has reflected the Complainant's logo and advertised its services under the PIXABAY mark since 2011. Accordingly, considering the distinctive nature of the PIXABAY mark, the Complainant's common law and trademark rights, and the typosquatting nature of the disputed domain names, the Panel considers that the Respondent registered the disputed domain names with the bad faith intention of exploiting and profiting from the Complainant's distinctive PIXABAY mark. Absent any explanation from the Respondent, the Panel cannot conceive of any plausible good faith use of the disputed domain names that could be asserted by the Respondent.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 names <pixabya.com> and <pixabay.com> be transferred to the Complainant.

*/William R. Towns/*

**William R. Towns**

Sole Panelist

Date: September 12, 2022