

ADMINISTRATIVE PANEL DECISION

Pexels GmbH v. John Wilson

Case No. D2023-2650

1. The Parties

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

The Respondent is John Wilson, United States of America.

2. The Domain Name and Registrar

The disputed domain name <pexels.one> is registered with NameSilo, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 20, 2023. On June 20, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 21, 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 (PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 22, 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 June 26, 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”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 6, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 7, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on August 10, 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 a German-based company founded in 2014, operating as a media provider for online downloads, maintaining a library that contains over 3.2 million photos and videos. The Complainant's services provide authenticated stock photography and stock footage to consumers. The Complainant partners with photographers from 170 countries, and receives over four billion monthly image views.

The Complainant has registered several trademarks consisting of PEXELS, including:

- the European Union trademark No. 017913932 registered on September 19, 2018, for goods and services in classes 9, 16, 35, 38, 41, 42, 45;
- the United States of America trademark No. 5860074 registered on September 17, 2019, for goods and services in classes 9, 16, 35, 38, 41, 42, 45.

The Complainant predominantly operates from its main website at "www.pexels.com", registered on May 15, 2015, averaging over 35 million monthly visits and offers its services in multiple languages, including but not limited to English, Spanish, German, French, and Italian. In addition, the Complainant is also the owner of a number of domain names, such as <pexels.co>, <pexels.org>, <pexels.us>, <pexels.in>, <pexels.photos>, etc.

In January 2023, the Complainant sent cease-and-desist correspondence to the Respondent, which remained unanswered on the part of the Respondent.

The disputed domain name was registered on October 26, 2022, and resolves to a website providing free stock images and copying visual indicia from the Complainant's official site, also reproducing the following text: "Pexels provides high quality and completely free stock photos licensed under the Pexels license...".

5. Parties' Contentions

A. Complainant

The Complainant asserts that each of the elements enumerated in paragraph 4(a) of the Policy and the corresponding provisions in the Rules have been satisfied. In particular, the Complainant asserts that:

- (1) the disputed domain name is identical to its PEXELS trademark in which the Complainant has rights, because it is composed of the exact reproduction of the PEXELS trademark and generic Top-Level Domain ("gTLD") ".one". The applicable gTLD in a domain name is viewed as a standard registration requirement and as such is disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a trademark;
- (2) the Respondent does not have any trademark rights to the term PEXELS and has not received any license from the Complainant to use domain names featuring the PEXELS trademark. The Respondent is not commonly known by the distinctive term PEXELS, nor is he offering any genuine goods or services by the term "pexels". The disputed domain name has been used to resolve to a site that brandishes the PEXELS mark and a similar-looking icon (a stylised white "p" within a green background), which impersonates and passes itself off as the Complainant's official site. The site claims to provide "Free Stock Photos" while featuring textual and other visual indicia copied from the Complainant's official site. It is likely that the website under the disputed domain name is being used to collect the personal data of confused Internet users, believing they are interacting with the Complainant, in order to engage in other deceptive/illicit activities. Therefore, there is no plausible reason for the registration and use of the disputed domain name, other than for taking advantage of the goodwill and reputation attached to the PEXELS brand;

- (3) the Respondent both registered and is using the disputed domain name in bad faith. The Complainant's earliest trademark registration predates the creation date of the disputed domain name and substantial goodwill has accrued in the "Pexels" name since the Complainant's establishment in 2014. The Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's PEXELS mark. The Respondent is clearly using the PEXELS-contained domain name and indicia from the Complainant's official site to collect the details of confused Internet users who believe they are interacting with the Complainant. Also, the Respondent has failed to respond to the Complainant's cease and desist letter.

The Complainant requests a decision that the disputed domain name be transferred to the Complainant.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as 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.

The Panel will further analyze the potential concurrence of the above circumstances.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

According to paragraph 4(a)(i) of the Policy it should be established that the disputed domain name is identical or confusingly similar to a mark in which the Complainant has rights.

The Panel confirms that for the purposes of paragraph 4(a)(i) of the Policy the Complainant has satisfied the threshold requirement of having relevant trademark rights for PEXELS in jurisdictions throughout the world.

The disputed domain name incorporates the PEXELS mark in full, without alteration or addition. It is well accepted by UDRP panels that a gTLD, such as ".one", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark. See section 1.11 of the [WIPO Overview 3.0](#). Therefore, the Panel is of the view that the disputed domain name is identical to the Complainant's mark.

For all of the above-mentioned reasons, the Panel concludes that the disputed domain name is identical to the Complainant's trademark and therefore finds that the requirement of paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Under paragraph 4(a)(ii) of the Policy, the Complainant has the burden of establishing that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

As established by previous UDRP panels, it is sufficient for the Complainant to make a *prima facie* case demonstrating that the Respondent has no rights or legitimate interests in the disputed domain name in order to place the burden of production on the Respondent (see section 2.1 of the [WIPO Overview 3.0](#)).

In the present case, the Complainant has established a *prima facie* case that it holds rights over the trademark PEXELS and claims that the Respondent has no legitimate reason to acquire and use the disputed domain name.

In the present case, the Complainant's un rebutted evidence establishes that its PEXELS trademark was registered and is well-known prior to registration of the disputed domain name.

The Complainant has submitted that the Respondent is neither affiliated with the Complainant in any way nor has it been authorized by the Complainant to use and register the disputed domain name, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent has not made and is not making a legitimate noncommercial or fair use of the disputed domain name and is not commonly known by the disputed domain name in accordance with paragraph 4(c)(ii) of the Policy.

The case file also does not contain any evidence that the Respondent has been commonly known by the disputed domain name as an individual, business, or other organization.

The Complainant submits that the Respondent has not used, nor prepared to use, the disputed domain name in connection with a *bona fide* offering of goods or services, and the Panel agrees. The disputed domain name has been used to resolve to a site that brandishes the PEXELS mark and a similar-looking icon (a stylised white "p" within a green background), which impersonates and passes itself off as the Complainant's official site. The site claims to provide "Free Stock Photos" while featuring textual and other visual indicia copied from the Complainant's official site.

Furthermore, the disputed domain name resolves to a web page displaying the Complainant's mark and logo, and inviting users to login by entering their password. According to the Complainant, it is likely, given the Respondent's use of indicia from the Complainant's official site (and heading "Welcome Back to Pexels") that the site is being used to collect the personal data of confused Internet users, believing they are interacting with the Complainant, in order to engage in other deceptive/illicit activities.

Having precisely considered evidence in the case file, the Panel finds that the Respondent uses the disputed domain name to present a site which creates the false impression that it is endorsed by, or otherwise associated with the Complainant. It does this by purporting to provide free stock images and copying visual indicia from the Complainant's official site. The website under the disputed domain name also features a login facility which encourages Internet users to input personal data under the false pretence that such users are interacting with a site controlled by the Complainant. Therefore, this Panel is of the view that the Respondent uses the disputed domain name to pass off as the Complainant and collects the details of confused Internet users, that clearly does not confer the Respondent with rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.13.1.

Furthermore, the disputed domain name is identical to the Complainant's distinctive PEXELS mark; its composition effectively impersonates or suggests endorsement by the Complainant and cannot constitute fair use (see [WIPO Overview 3.0](#), section 2.5.1).

The Respondent has not replied to the Complainant's contentions, claiming any rights or legitimate interests in the disputed domain name. With the evidence on file, the Panel finds that the requirement of paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified

in paragraph 4(b) of the Policy may, “in particular but without limitation”, be evidence of the disputed domain name’s registration and use in bad faith.

The disputed domain name was registered after the Complainant had obtained registration of its PEXELS trademark and used it in commerce. Bearing in mind the above-discussed representation of the website under the disputed domain name, it is highly unlikely that the Respondent was unaware of the existence of the Complainant and its PEXELS trademarks while it registered the disputed domain name. On the contrary, considering the reputation of the Complainant, the fact that the disputed domain name is identical to the Complainant’s PEXELS trademark, it is most likely that the Respondent registered the disputed domain name having the Complainant’s trademarks in mind.

As regards the use of the disputed domain name, from the evidence put forward by the Complainant and not rebutted by the Respondent, it results that the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant’s PEXELS mark. The Respondent has used a domain name, which encompasses the PEXELS mark without alteration or addition, to attract users, based on the mark’s trademark value, to a site which copies content from, and passes itself off as, the Complainant. Given the Respondent’s targeting conduct, and lack of authorisation from the Complainant, there is a high likelihood that the Respondent is using such illicitly-obtained information to engage in other deceptive activities. UDRP panels have repeatedly found respondents’ unauthorised collection/solicitation of personal data from unsuspecting Internet users to substantiate evidence of bad faith (see *Banque Delubac et Cie v. Global Domain Privacy / Michel Vivier*, WIPO Case No. [D2020-0925](#)).

Further, the Respondent’s failure to respond to the Complainant’s cease-and-desist letter is additional evidence of bad faith. Moreover, the Respondent has not participated in these proceedings and has failed to rebut the Complainant’s contentions and to provide any evidence of actual or contemplated good-faith use and indeed none would seem plausible.

For the reasons set out above, the Panel concludes that the disputed domain name was registered and is being used in bad faith, within the meaning 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 name, <pexels.one>, be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: August 23, 2023