

ADMINISTRATIVE PANEL DECISION

Pixabay GmbH. v. Samir Campos, Food Clipart Border
Case No. D2024-4014

1. The Parties

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

Respondent is Samir Campos, Food Clipart Border, United States of America.

2. The Domain Name and Registrar

The disputed domain name <pixabay.one> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 30, 2024. On October 1, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 1, 2024, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on October 2, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on October 2, 2024.

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 Respondent of the Complaint, and the proceedings commenced on October 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 27, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 28, 2024.

The Center appointed Richard C.K. van Oerle as the sole panelist in this matter on October 30, 2024. 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

Complainant, founded in 2010, is an online platform through which its customers create and share copyright-free images, videos and music. It is a subsidiary of Canva Pty Ltd, the operator of a popular online graphic design platform.

Complainant holds numerous trademark registrations for PIXABAY, inter alia:

- European Union Trademark Registration, registration n° 018041811, registered on September 20, 2019,
- Australian Trademark Registration, registration n° 2004679, registered on February 4, 2020;
- Indian Trademark Registration, registration n° 4212079, registered on June 20, 2019.

The registrations have been duly renewed and are still valid. The registrations will jointly be referred to, in singular, as the “Trademark”.

The disputed domain name was registered on November 21, 2023. At the time of filing the Complaint, the disputed domain name resolved to a website providing various pay-per-click (“PPC”) commercial advertising links. At the time of the Decision, the disputed domain name does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, Complainant contends that its main site is available in 26 languages and currently offers visitors more than 2.6 million images, videos and music shared by its community members. Complainant’s online offerings receive a significant volume of traffic, with its main website attracting more than 32 million visits in August 2024. Complainant’s services are also available via an app for iPad and iPhone devices. Complainant exclusively operates online and from “www.pixabay.com”, which makes its offerings inherently global. Complainant says that the Trademark is renowned within its sector and listed by reputable third parties as one of the top providers of free stock photography, its images being used throughout the Internet.

Complainant further contends that the disputed domain name is identical to its Trademark, and that the generic Top-Level Domain (“gTLD”) “.one” needs to be disregarded for the purposes of comparison.

Complainant asserts that Respondent has no rights or legitimate interests in the disputed domain name. Complainant contends that Respondent does not have any trademark rights to the term “pixabay”, nor has Respondent been granted a license by Complainant to use domain names featuring the Trademark. All active trademarks for PIXABAY are held by Complainant. Under Paragraph 4(c) of the Policy, there are specific circumstances where Respondent could show a legitimate interest, but Complainant argues that none of these apply in this case.

Complainant states that, to the best of its knowledge, Respondent has not used or prepared to use the disputed domain name in connection with a bona fide offering of goods or services. Instead, the disputed domain name is being used to direct users to PPC advertisements that redirect to third-party websites. This use, according to Complainant, does not constitute a bona fide offering of goods or services and seeks to exploit the reputation and goodwill of the Trademark.

Complainant further argues that Respondent is not commonly known by the “pixabay” name. The Trademark is distinctive, and there is no evidence suggesting that Respondent has any common law rights or business association with the term “pixabay”. Complainant believes Respondent’s registration of the disputed domain name is an attempt to capitalize on the goodwill of the Trademark, without any legitimate interest in the term

itself. The mere ownership of a domain name does not grant Respondent any rights or legitimate interests, according to prior decisions.

Finally, Complainant asserts that Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The disputed domain name is being used to host PPC ads, generating revenue by misleadingly diverting users to third-party websites, which Complainant argues is not a fair or noncommercial use.

Complainant has presented a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name, and the burden of production now shifts to Respondent to demonstrate otherwise.

Complainant submits that the disputed domain name was registered and is being used in bad faith.

Complainant claims that it acquired rights to the Trademark before the disputed domain name was registered. Complainant's Trademark is clearly listed in publicly accessible trademark databases. A simple online search reveals that the Trademark is strongly associated with Complainant's offerings, making it highly likely that Respondent was aware of Complainant's rights when registering the disputed domain name. The Trademark is well-known in its industry, with numerous third-party sources recognizing Complainant as a top provider of free stock photography. This widespread recognition predates the registration of the disputed domain name, indicating Respondent was aware of the mark's significance. Complainant argues that Respondent intentionally registered the disputed domain name with the aim of targeting Complainant's Trademark. Given that the mark is unique and non-descriptive, Complainant contends that Respondent had no legitimate reason for registering the disputed domain name other than to exploit the Trademark PIXABAY.

Complainant also claims that Respondent is using the disputed domain name in bad faith, citing a specific circumstance in Paragraph 4(b) of the Policy, where Respondent has intentionally attempted to attract Internet users for commercial gain by creating confusion with Complainant's mark. The disputed domain name currently resolves to a webpage with sponsored links to third-party websites. Complainant argues that Respondent is using the disputed domain name to attract users who intend to visit Complainant's website, thereby diverting traffic for commercial gain by exploiting the likelihood of confusion between the disputed domain name and the Trademark. Complainant points out that using the disputed domain name for commercial purposes, such as generating revenue from PPC links, is further evidence of bad faith use. Such actions rely on misleading users into thinking they are interacting with Complainant's official website. Complainant finally highlights that Respondent has set up Mail Exchange (MX) records for the disputed domain name, raising concerns about potential phishing activities. Complainant argues that this adds to the evidence of bad faith use, as Respondent could use the domain to send fraudulent emails that could deceive unsuspecting users into thinking they are receiving communication from Complainant.

Complainant sent a cease-and-desist letter to Respondent on June 12, 2024, but Respondent did not respond. Complainant argues that the lack of response is further evidence of bad faith.

Complainant requests that the disputed domain name be transferred to Complainant.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that a complainant must prove each of the following elements in order to succeed in its Complaint:

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

(ii) 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 burden of proof of each element is borne by Complainant. Respondent's default does not by itself mean that Complainant is deemed to have prevailed. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 4.3.

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 Complainant's trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

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

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

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the disputed domain name was created after the date of registration of the Trademark. Additionally, Complainant's submissions establish that the Trademark, used since 2010,

has a very widespread reputation on the Internet. Furthermore, Respondent's disputed domain name includes the Trademark, merely with the addition of non-distinguishing gTLD. The Panel therefor finds that Respondent registered the disputed domain name in bad faith.

In the circumstances of this case, acquiring the disputed domain name which incorporates Complainant's registered mark and then parking it on a website for the sake of generating PPC license payments is a bad faith activity. This is because Respondent relies on tricking or misleading Internet users into visiting a connected website thinking they are engaging with Complainant's genuine web presence.

Respondent's bad faith is further evidenced by its establishment of MX records with the disputed domain name, suggesting the disputed domain name could be used to send fraudulent email. See *Carrier Corporation v. DNS Admin, Domain Privacy LTD*, WIPO Case No. [D2021-3728](#) ("if Respondent is using the disputed domain name to send fraudulent emails – which the MX records suggest is at least a possibility – then bad faith use is further obvious").

The circumstances that Respondent did not reply to the letter sent by Complainant, nor respond formally to the Complaint, supports a finding of registration and use in bad faith.

The disputed domain name currently does not resolve to an active website. Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. [WIPO Overview 3.0](#), section 3.3.

Discontinuing use that qualifies as bad faith use and after Complainant has summoned Respondent to do so, neither precludes a finding of bad faith.

Having reviewed the available record, the Panel notes the distinctiveness or reputation of Complainant's Trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the current passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds that Complainant has established the third element 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 <pixabay.one> be transferred to Complainant.

/Richard C.K. van Oerle/

Richard C.K. van Oerle

Sole Panelist

Date: November 8, 2024.