

ADMINISTRATIVE PANEL DECISION

Pixabay GmbH v. Domain Administrator, See PrivacyGuardian.org /
Erna Watiningsih
Case No. D2022-2218

1. The Parties

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

The Respondent is Domain Administrator, See PrivacyGuardian.org, United States of America /
Erna Watiningsih, Indonesia.

2. The Domain Name and Registrar

The disputed domain name <pixabay.live> 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 17, 2022. On June 17, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 17, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on June 20, 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 the same day.

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 June 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 26, 2022.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on August 1, 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 was founded in 2010 and runs an online platform that allows its customers to create and share copyright-free images, videos and music. In 2019 the Complainant was acquired by Canva Pty Ltd, a global online graphic design platform. The Complainant's main website is available in 26 languages and currently permits the sharing of 2.3 million images.

The Complainant owns a number of registered trademarks including PIXABAY Australia Reg No 2004679, registered on April 22, 2019; PIXABAY India Reg No 4212079, registered on June 20, 2019; PIXABAY Mexico Reg No 2033884, registered on August 28, 2019; and PIXABAY European Union Reg No. 018041811, registered on September 20, 2019. All trademarks are registered in classes 9, 42, and 45.

The disputed domain name was registered on November 29, 2019. At present the disputed domain name is inactive.

5. Parties' Contentions

A. Complainant

The Complainant says that its PIXABAY brand 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. The Complainant owns a number of trademark registration for PIXABAY and also uses a logo that incorporates the term PIXABAY and a stylized representation of a camera. The Complainant has a social media presence on Facebook, Instagram and Twitter.

The Complainant points out that it has the necessary registered trademark rights in the mark PIXABAY in which it also owns substantial goodwill. The Complainant further contends that the disputed domain name is identical to its PIXABAY trademark, the generic Top-Level Domain ("gTLD") ".live" needing to be disregarded for the purposes of comparison.

The Complainant says that to the best of its knowledge, the Respondent does not have any trademark rights in the term "pixabay", nor is there evidence that the Respondent has unregistered trademark rights in that term. The Respondent has not received any license from the Complainant to use domain names with the "PIXABAY" trademark. The Complainant also contends that none of the circumstances of paragraph 4(c) of the Policy apply here.

The Complainant points out that the distinctive term PIXABAY is not a word a trader would legitimately choose to adopt unless seeking to create an impression of association with the Complainant. It says that non-use of a registered domain name is not considered to amount to a *bona fide* offering of goods or services. A historical screenshot of the website to which the disputed domain name resolves shows the offering of images for download, similar to what the Complainant offers. Offering competing goods or services in this manner does not confer rights or legitimate interests, says the Complainant. The term PIXABAY is not a generic or descriptive term, and its registration without further use does not amount to legitimate or noncommercial fair use, as has been regularly held by previous Panels. The Complainant having established a *prima facie* case concerning absence of Respondent rights and interests, the burden shifts to the Respondent, but the latter has not responded to the Complainant's contentions in any way.

According to the Complainant, the disputed domain name was also registered and used in bad faith. Its trademark registrations predated creation of the disputed domain name by two years, and substantial goodwill has accumulated in PIXABAY since its creation in 2010. A Google search of the term “pixabay” reveals the Complainant’s website as the first search result, and its ownership of that mark can be ascertained from public trademark databases in any case. The Respondent did not reply to the Complainant’s notification and attempt to resolve matters amicably before the instigation of these proceedings, a further indication of bad faith, according to the Complainant. Historically the disputed domain name was used to offer copyright-free images, which indicates bad faith registration to serve that purpose. Although currently the disputed domain name does not resolve to a functional webpage it is well established that ‘passive use’ does not preclude a finding of bad faith use. The Complainant points out that previous UDRP Panels have found bad faith ‘passive use’ simply where a complainant has a distinctive trademark and the respondent provides no evidence of any actual or contemplated good faith use, as is the case here. There is in this matter no plausible good faith use that can be conceived of as the disputed domain name is identical with what the Complainant refers to as a renowned non-generic trademark. The disputed domain name, the Complainant says, is clearly connected to its distinctive trademark and use by a person with no affiliation with the Complainant thus strongly suggests ‘opportunistic bad faith’.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The disputed domain name is identical to the PIXABAY trademark of the Complainant. The gTLD extension “.live” is not to be taken into account.

B. Rights or Legitimate Interests

The Respondent has not replied to any of the contentions of the Complainant. The Complainant has not licensed or authorized the use of its distinctive PIXABAY trademark by the Respondent in any way. There is no indication before the Panel that the Respondent is known by the disputed domain name or has any registered or unregistered rights in the trademark PIXABAY. The disputed domain name at one time resolved to a website offering competing services to those offered by the Complainant, and at the present time does not resolve to any active website. The acquisition of a domain name that is identical to a distinctive registered mark to which very considerable goodwill attaches in many different jurisdictions is not likely to result in the recognition of any rights or legitimate interests. This is because it is difficult to conceive of any use of such a domain name that is not in some way fraudulent or deceptive.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The trademark PIXABAY was registered by the Complainant well before the creation of the disputed domain name by the Respondent. The Complainant’s material establishes that the PIXABAY mark, used since 2010, has a very widespread reputation in relation to the provision of free stock images on the Internet. The fact that it is an Internet-based business further reinforces the inference that it is almost inconceivable that the Respondent was not aware of the Complainant and its rights in the PIXABAY trademark prior to the creation of the disputed domain name. A simple entry of ‘PIXABAY’ on Google would have immediately revealed the Complainant and its rights in that term, if the Respondent were not already aware of it, which seems unlikely.

The Complainant says, and provides a screenshot to prove, that the disputed domain name at one point resolved to a website offering competing services relating to free images on the Internet. This indicates bad faith use in and of itself, but the fact that the disputed domain name now does not resolve to any active website is in any case sufficient to establish bad faith use. That is because where a domain name identical to a highly distinctive and widely known trademark is acquired by a party with no connection with the trademark owner, it is almost impossible to envisage any legitimate or good faith use of it. The Respondent did not reply to the Complainant's notification, and has not sought to counter the allegations of the Complainant in any way. That further indicates that it registered the disputed domain name in bad faith and then proceeded to put it to bad faith use as well.

Therefore, the Panel holds that the disputed domain name was registered and used in bad faith.

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.live>, be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: August 15, 2022