

ADMINISTRATIVE PANEL DECISION

Pexels GmbH v. Carolina Rodrigues, Fundacion Comercio Electronico Case No. D2023-1796

1. The Parties

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

Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Domain Name and Registrar

The disputed domain name <pexels.com> 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 April 21, 2023. On April 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 24, 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 (Registration Private, Domains By Proxy LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on April 27, 2023, 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 April 27, 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 Respondent of the Complaint, and the proceedings commenced on May 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 22, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 24, 2023.

The Center appointed Marina Perraki as the sole panelist in this matter on May 30, 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

Complainant is a company based in Germany founded in 2014. It operates as a media provider for online downloads, maintaining a library of over 3.2 million photos and videos. Complainant has been listed as one of the top providers of free stock photos and videos. Its photographs have been used by magazines such as Forbes since 2014. Complainant partners with photographers from 170 countries and receives over 4 billion monthly image views. Complainant's photos are used on more than 25,000 web pages and Complainant's top users receive billions of image views.

Complainant maintains its main website at "www.pexels.com", with an average of more than 36 million monthly visits, offering its services in more than 25 languages. Complainant's mobile app is available on Google Play and the App Store and has been installed more than a million times.

Complainant owns the European Union trademark registration No. 017913932, PEXELS (word) registered on September 19, 2018, for goods and services in international classes 9, 16, 35, 38, 41, 42 and 45.

The Domain Name was registered on July 16, 2018, and is used to display pay-per-click ("PPC") advertisement links to third-party websites, including websites that offer online stock photography, like Complainant. Per Complaint, the Domain Name was previously used to redirect users to several different websites. Last, the Domain Name is listed for sale for USD 1,299 on Domain Aftermarket Site. Complainant sent a cease and desist letter to Respondent on November 15, 2022, to which Respondent did not reply.

5. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under paragraph 4(a) of the Policy for a transfer of the Domain Name.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Domain Name is confusingly similar with the PEXELS trademark of Complainant. The Domain Name incorporates the said trademark of Complainant in its entirety. This is sufficient to establish confusing similarity. The addition of the letter "x" in the Domain Name does not prevent a finding of confusing similarity as the PEXELS mark remains clearly recognizable (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.9).

The generic Top-Level Domain (“gTLD”) “.com” is also disregarded, as gTLDs typically do not form part of the comparison on the grounds that they are required for technical reasons only (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#)).

The Panel finds that the Domain Name is confusingly similar to the PEXELS trademark of Complainant.

Complainant has established Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to Respondent of the dispute, 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
- (ii) Respondent (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) 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 Panel concludes that Respondent lacks rights or legitimate interests in respect of the Domain Name.

Respondent has not submitted any response and has not claimed any such rights or legitimate interests with respect to the Domain Name. As per Complainant, Respondent was not authorized to register the Domain Name.

Respondent has not demonstrated any preparations to use, or has not used the Domain Name or a trademark corresponding to the Domain Name in connection with a *bona fide* offering of goods or services.

On the contrary, the Domain Name is used to host a parked page with PPC links to websites, including websites which directly compete with Complainant. The Panel finds that it is not unlikely that Respondent received PPC fees from the linked websites that were listed at the Domain Name’s website and used the Domain Name for his own commercial gain. The use of a domain name to host a parked page comprising PPC links does not represent a *bona fide* offering where such links compete with Complainant’s trademark (*Archer-Daniels-Midland Company v. Wang De Bing*, WIPO Case No. [D2017-0363](#); *Virgin Enterprises Limited v. LINYANXIAO aka lin yanxiao*, WIPO Case No. [D2016-2302](#); *Donald J. Trump v. Mediaking LLC d/b/a Mediaking Corporation and Aaftek Domain Corp.*, WIPO Case No. [D2010-1404](#); [WIPO Overview 3.0](#), section 2.9).

Furthermore, there is no evidence on record giving rise to any rights or legitimate interests in the Domain Names on the part of Respondent within the meaning of paragraphs 4(c)(ii) and 4(c)(iii) of the Policy.

Moreover, the addition of the letter “x” can also be viewed as a typo, reflecting an intent on part of Respondent to profit from unsuspecting Internet users unaware of said typo and believing the Domain Name to be Complainant’s <pexels.com> domain name.

Last, as Complainant has demonstrated, the Domain Name is being listed for sale.

The Panel finds that these circumstances do not confer upon Respondent any rights or legitimate interests in respect of the Domain Name.

Complainant has established Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of the Domain Names in “bad faith”:

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Domain Names registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Names; or
- (ii) that Respondent has registered the Domain Names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding Domain Names, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Names primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

The Panel concludes that Respondent has registered and used the Domain Name in bad faith.

Because the PEXELS mark had been used before the Domain Name registration, the Panel finds it more likely than not that Respondent had Complainant’s mark in mind when registering the Domain Name. In this regard, Complainant contends that the PEXELS mark has become a distinctive identifier that users have associated with Complainant’s image-sharing offerings since its establishment in 2014 and that it acquired common law trademark rights in the PEXELS mark prior to the registration of the Domain Name in 2018. Complainant substantiated these contentions with relevant arguments and evidence. Accordingly, the Panel finds that the PEXELS mark had become a distinctive identifier with which consumers associate Complainant at the time Respondent registered the disputed domain name and that Respondent’s intent in registering the disputed domain name was to unfairly capitalize on Complainant’s unregistered trademark rights.

Moreover, the typosquatting nature of the Domain Name, reflecting merely an added “x” to Complainant’s mark, reinforces the notion that Respondent was aware of an intentionally targeted Complainant in an attempt to confuse Internet users expecting to find Complainant.

As regards bad faith use, the Domain Name leads to a website displaying links to third party sites, which suggests that, presumably, Respondent received PPC fees from the linked websites that were listed thereon. It has been recognized that such use of another’s trademark to generate revenue from Internet advertising can constitute registration and use in bad faith (*McDonald’s Corporation v. ZusCom*, WIPO Case No. [D2007-1353](#); *Volkswagen Aktiengesellschaft v. Robert Brodi*, WIPO Case No. [D2015-0299](#); *SAP SE v. Domains by Proxy, LLC / Kamal Karmakar*, WIPO Case No. [D2016-2497](#); [WIPO Overview 3.0](#), section 3.5).

This, in view of the finding that Respondent has no rights to or legitimate interests in the Domain Name, and in the circumstances of the case, affirms the bad faith (*Aygaz Anonim Sirketi v. Arthur Cain*, WIPO Case No. [D2014-1206](#); [WIPO Overview 3.0](#), section 3.1).

Furthermore, Complainant demonstrated that the Domain Name is being listed for sale for an amount that likely exceeds the acquisition price paid by Respondent.

Finally, the Panel notes the pattern of abusive registrations in which Respondent has been involved (see e.g. over 200 cases involving named Respondent Carolina Rodrigues including *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](#); *Ford Motor Company v. Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2018-2787](#); over 750 cases involving named Respondent Above.Com Domain Privacy including *Robert Bosch GmbH v. Above.com Domain Privacy, Above.com Domain Privacy / David Woo*, WIPO Case No. [D2018-1549](#); *The American Automobile Association, Inc. v. Above.com DomainPrivacy a/k/a Oliver Goldsmith/ Host Master, Transure Enterprise Ltd. / David Woo, DNWDNS/ Shu Lin*, WIPO Case No. [D2011-1884](#); *Intesa Sanpaolo S.p.A. v. Above.com Domain Privacy / David Woo*, WIPO Case No. [D2010-1566](#); *Intesa Sanpaolo S.p.A. v. Above.Com Pty Ltd./ David Woo*, WIPO Case No. [D2010-1611](#); *Revlon Consumer Products Corporation v. David Woo / Above.com Domain Privacy*, WIPO Case No. [D2010-1483](#); *Universidad Autónoma de Nuevo León v. Above.Com Domain Privacy / David Woo*, WIPO Case No. [D2010-1160](#); and over 3 cases involving named Respondent Wis Inc, including *Mothers Polishes Waxes Cleaners Incorporated v. WIS Inc.*, WIPO Case No. [D2020-2903](#); *Sodexo v. Wis Inc.*, WIPO Case No. [D2019-2185](#); *SODEXO v. Wis INC, Wis INC*, WIPO Case No. [D2020-0887](#). All of the above cases resulted in decisions against Respondent.

This pattern, established by the decisions cited above, further supports a finding of bad faith pursuant to paragraph 4(b)(ii) of the Policy, which provides that a “pattern of such conduct” is evidence of bad faith.

Under these circumstances and on this record, the Panel finds that Respondent has registered and is using the Domain Name in bad faith.

Complainant has established Policy paragraph 4(a)(iii).

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 <pexxels.com> be transferred to Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: June 13, 2023