

## **ADMINISTRATIVE PANEL DECISION**

Pixabay GmbH v. Privacy Protection / zhang wei  
Case No. DCO2022-0062

### **1. The Parties**

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

The Respondent is Privacy Protection, United States of America / zhang wei, China.

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

The disputed domain name <pixabay.co> (the “Disputed Domain Name”) is registered with Sav.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 9, 2022. On August 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On August 10, 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 August 10, 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 August 12, 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 August 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 8, 2022.

The Center appointed Gabriela Kennedy as the sole panelist in this matter on September 14, 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**

Founded in 2010, the Complainant is a global online platform which allows its customers to create, share, and use copyright free images, videos, and music under a “Pixabay License”. Since August 2011, the Complainant has provided its services through its website at “www.pixabay.com” (the “Complainant’s Website”). The Complainant also provides its services for mobile devices and tablets through the PIXABAY apps (the “Complainant’s App”). Operating under the PIXABAY mark, the Complainant has acquired considerable goodwill and reputation globally and has been listed as one of the top providers of free stock photographs. As of December 31, 2017, the Complainant’s Website is available in 26 languages, offering over 1.2 million images for its customers’ usage. As of June 22, 2022, the Complainant’s App had more than a million downloads.

The Complainant enjoys exclusive rights to use the PIXABAY mark through its ownership of trademark registrations in various countries and classes, including, *inter alia*, Australian Trademark Registration No. 2004679 in Classes 9, 42, and 45, registered on April 22, 2019, Indian Trademark Registration No. 4212079 in Classes 9, 42, and 45, registered on June 20, 2019, Mexican Trademark Registration No. 2033884 in Class 9, registered on August 28, 2019, and European Union Trademark Registration No. 018041811 in Classes 9, 42, and 45, registered on September 20, 2019 (the “Complainant’s Registered Trademark”). The Complainant used the PIXABAY mark prior to its registration in various countries and acquired goodwill in it (the “Complainant’s Unregistered Trademark”). The Complainant’s Registered Trademark and the Complainant’s Unregistered Trademark (altogether the “Complainant’s Trademark”) are fully incorporated in the Complainant’s Website and the Complainant’s App. The Complainant has a strong social media presence with over 79,000; 650,000; and 66,500 followers on Instagram, Facebook, and Twitter respectively. The Complainant has thus obtained an exclusive right to the Complainant’s Trademark through extensive use.

The Disputed Domain Name was registered on June 9, 2018, which is more than six years after the Complainant first started to offer its service under its PIXABAY mark via the Complainant’s Website. The Disputed Domain Name resolves to a parked page comprising pay-per-click (“PPC”) advertising links, some of which direct to sites which are in competition with the Complainant and other unrelated sites.

#### **5. Parties’ Contentions**

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

(a) The Complainant contends that the Disputed Domain Name is identical or confusingly similar to the Complainant’s Trademark and that the Complainant’s Trademark is reproduced in its entirety in the Disputed Domain Name. The Complainant also claims unregistered rights in addition to the Complainant’s Trademark referred to above.

(b) The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not received any license or other authorization of any kind to make use of the Complainant’s Trademark as part of a domain name or otherwise. There is no evidence to show that the Respondent used or has made preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services. There is also no evidence suggesting that the Respondent is commonly known by the Disputed Domain Name. The Respondent uses the Disputed Domain Name to mislead and divert Internet users to sites in competition with the Complainant and other unrelated sites. Such uses are not commercial or fair.

(c) The Respondent has a history of bad faith registrations and he was involved in at least 25 domain disputes, all of which resulted in the transfers of the relevant disputed domain names. The Respondent must have been fully aware of the existence of the Complainant's Trademark when it registered the Disputed Domain Name given the extensive reputation and goodwill acquired by the Complainant in its PIXABAY mark globally and the Complainant's strong social media presence online. Moreover, the Respondent's registration of the Disputed Domain Name, which fully incorporates the Complainant's Trademark and is confusingly similar to the Complainant's Trademark, is in itself an act of bad faith by someone with no legal connection to the Complainant's business. The Respondent has used the Disputed Domain Name to host parked pages comprising PPC links, which direct either to unrelated or competing websites with the Complainant. Furthermore, the Respondent has failed to respond to the trademark infringement notices sent to him on December 6, 2021, and December 13, 2021, respectively. In light of the above, the Respondent's actions amount to bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, the Complainant is required to prove each of the following three elements:

- (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 by the Respondent in bad faith.

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

The Panel accepts that the Complainant has rights in the Complainant's Trademark based on various trademark registrations listed above in Section 4. Further, the Panel also accepts that at the time the Disputed Domain Name was registered the Complainant had obtained unregistered rights in the Complainant's Trademark by virtue of its extensive use online for over six years.

It is well established that in making an enquiry as to whether a trademark is identical or confusingly similar to a domain name, the Top-Level Domain ("TLD") extension, ".co" in this case, may be disregarded. See section 1.11 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety. UDRP panels have consistently found that a domain name that wholly incorporates a complainant's trademark is identical or confusingly similar to the complainant's trademark (see *Societe Air France v. Indra Armansyah*, WIPO Case No. [D2016-2027](#); and *Icebug AB v. Domain Administrator*, WIPO Case No. [D2013-1823](#)).

As such, the Panel finds that the Disputed Domain Name is identical to the Complainant's Trademark, and accordingly, paragraph 4(a)(i) of the Policy is satisfied.

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

Once a complainant establishes a *prima facie* case in respect of the lack of rights or legitimate interests of a respondent in a disputed domain name, the respondent then carries the burden of demonstrating that it has rights or legitimate interests in the disputed domain name. Where the respondent fails to do so, a

complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy. See section 2.1 of the [WIPO Overview 3.0](#).

The Panel accepts that the Complainant has not authorized the Respondent to use the Complainant's Trademark. There is no relationship between the Complainant and the Respondent which would otherwise entitle the Respondent to use the Complainant's Trademark. Accordingly, the Panel is of the view that a *prima facie* case has been established by the Complainant and it is for the Respondent to show rights or legitimate interests in the Disputed Domain Name.

The Respondent did not submit a Response. The fact that the Respondent did not submit a formal Response does not automatically result in a decision in favor of the Complainant. However, the Respondent's failure to file a Response may result in the Panel drawing appropriate inferences from such default. The Panel may also accept all reasonable and supported allegations and inferences flowing from the Complainant as true (see *Entertainment Shopping AG v. Nischal Soni, Sonik Technologies*, WIPO Case No. [D2009-1437](#); and *Charles Jourdan Holding AG v. AAIM*, WIPO Case No. [D2000-0403](#)).

Pursuant to paragraph 4(c) of the Policy, the Respondent may establish rights or legitimate interests in the Disputed Domain Name by demonstrating any of the following:

- (i) Before any notice to him of the dispute, the Respondent's use of, or demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services; or
- (ii) The Respondent has been commonly known by the Disputed Domain Name, even if the Respondent has acquired no trademark or service mark rights; or
- (iii) The Respondent is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

There is no evidence to suggest the Respondent used or made demonstrable preparations to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a *bona fide* offering of goods or services. The Panel agrees with the Complainant that the Respondent's use of the Disputed Domain Name to host parked pages comprising PPC advertising links does not represent a *bona fide* offering of goods or services. See section 2.9 of the [WIPO Overview 3.0](#). Moreover, considering some of the PPC links (e.g., "Free Stock Photos" and "Free Pictures and Images") redirect Internet users to competing services to those of the Complainant, the Panel finds that such use reflects the Respondent's intent to capitalize on the reputation and goodwill associated with the Complainant's trademark and thus cannot constitute a legitimate or noncommercial fair use.

No evidence has been provided to show that the Respondent has trademarks rights corresponding to the Disputed Domain Name or that the Respondent has become known by the Disputed Domain Name.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

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

UDPR panels have consistently found that the mere registration of a domain name that is confusingly similar to a widely known trademark by an unaffiliated entity can already by itself create a presumption of bad faith. See section 3.1.4 of the [WIPO Overview 3.0](#).

The Disputed Domain Name incorporates the Complainant's Trademark in its entirety. A quick Internet search conducted by the Panel shows that the top search results returned for the keyword "pixabay" relate to the Complainant's services and/or third party websites providing information relating to the Complainant's

services. Therefore, the Panel agrees with the Complainant that the Respondent must have been aware of the Complainant and the Complainant's Trademark rights when registering and using the Disputed Domain Name despite the fact that the Disputed Domain Name was registered prior to the registration of the Complainant's Trademarks (see section 3.8 of the [WIPO Overview 3.0](#) and *Heraeus Kulzer GmbH v. Whois Privacy Services Pty Ltd / Stanley Pace*, WIPO Case No. [D2016-0245](#)). The Complainant's incorporation in 2010 and continuous use of the Complainant's Trademark for six years reinforces the Panel's finding that the Respondent was likely aware of the Complainant's unregistered rights at the of registering the Disputed Domain Name.

In addition, the Panel finds that the following factors further support a finding that the Disputed Domain Name was registered and has been used by the Respondent in bad faith:

- (i) The Respondent failed to respond to the Complainant's contentions and trademark infringement notices and has provided no evidence of actual or contemplated good faith use by it of the Disputed Domain Name.
- (ii) The Respondent registered the Disputed Domain Name using a privacy shield to conceal its identity (see *Primonial v. Domain Administrator, PrivacyGuardian.org / Parla Turkmenoglu*, WIPO Case No. [D2019-0193](#)).
- (iii) The Respondent engaged in a pattern of conduct in registering multiple trademark-abusive domain names which resulted in UDRP decisions ordering him to transfer the relevant domains on at least 25 occasions (see, for instance, *Kubota Corporation v. Privacy Protection / zhang wei*, WIPO Case No. [DCO2022-0045](#)). See section 3.1 of the [WIPO Overview 3.0](#).
- (iv) The Respondent registered and has been using the Disputed Domain Name to mislead and divert Internet users for commercial gain by creating a likelihood of confusion with the Complainant's Trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website which is resolved to by the Disputed Domain Name. See section 3.1 of the [WIPO Overview 3.0](#).

In the circumstances, the Panel finds that the Respondent registered and has been using the Disputed Domain Name in bad faith, and paragraph 4(a)(iii) of the Policy has been satisfied.

## 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.co> be transferred to the Complainant.

*/Gabriela Kennedy/*

**Gabriela Kennedy**

Sole Panelist

Date: September 23, 2022