

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc. v. Whois Privacy Protection Service by onamae.com /
john matthew
Case No. D2022-0661

1. The Parties

The Complainant is Meta Platforms, Inc., United States of America (“United States”), represented by Tucker Ellis LLP, United States.

The Respondent is Whois Privacy Protection Service by onamae.com, Japan / john matthew, Thailand.

2. The Domain Names and Registrar

The disputed domain names <fbtoyou.com> and <fb2you.com> are registered with GMO Internet, Inc. d/b/a Discount-Domain.com and Onamae.com (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on February 25, 2022. On February 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 28, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on February 28, 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 in English on March 3, 2022.

On February 28, 2022, the Center transmitted an email communication to the Parties in English and Japanese regarding the language of the proceeding. On March 3, 2022, the Complainant submitted a request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

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 paragraphs 2 and 4 of the Rules, the Center formally notified the Respondent in English and Japanese of the Complaint, and the proceedings commenced on March 7, 2022. In accordance with paragraph 5 of the Rules, the due date for Response was March 27, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on March 28, 2022.

The Center appointed Yuji Yamaguchi as the sole panelist in this matter on April 15, 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 paragraph 7 of the Rules.

4. Factual Background

The Complainant operates the Facebook social networking website and mobile application. Facebook enables its users to create their own personal profiles and connect with each other on their personal computers and mobile devices. Facebook has more than one billion daily active accounts and over two billion monthly active users from all over the world. Facebook's social networking services are provided in more than 70 languages.

In addition to its extensive common law rights in the FACEBOOK trademarks and service marks (collectively, the "FACEBOOK Marks"), which have been in use for over seventeen years, the Complainant owns numerous registrations including United States registration Nos. 3,122,052 (registered on July 25, 2006), 3,881,770 (registered on November 23, 2010) and 4,441,540 (registered on November 26, 2013), European Union Trade Mark Nos. 009151192 (registered on December 17, 2010) and 009776618 (registered on November 2, 2011), and International trademark No. 1,075,094 (registered on July 16, 2010) protecting the FACEBOOK Marks.

In addition to its extensive common law rights in the FB trademarks and service marks (collectively, the "FB Marks"), which have been in use since at least as early as 2011, the Complainant owns United States registration Nos. 4,659,777 (registered on December 23, 2014), 4,764,764 (registered on June 30, 2015), 4,782,234 (registered on July 28, 2015), and 4,782,235 (registered on July 28, 2015), and European Union Trade Mark No. 008981383 (registered on August 23, 2011) protecting the FB Marks.

The Complainant owns and uses the domain name <fb.com>, which redirects to the Complainant's primary domain name <facebook.com>. The Complainant owns and operates numerous other domain names consisting of the FB and FACEBOOK Marks, including <facebook.org> and <facebook.net>.

The Respondent is an individual located in Thailand using privacy services provided by the Registrar in Japan. Both of the disputed domain names were registered on October 22, 2021. The disputed domain names have been used to host a commercial website that purportedly allows users to buy "tokens" that appear to be exchanged for fake Facebook accounts.

5. Parties' Contentions

A. Complainant

The Complainant's contentions may be summarized as follows:

The disputed domain names, which add the phrases "to you" or "2 you" to the Complainant's FB Marks, are confusingly similar to the Complainant's FB Marks. The disputed domain names plainly misappropriate all the textual components from the Complainant's FB Marks, such that an ordinary Internet user who is familiar with the FB Marks would, upon seeing the disputed domain names, think an affiliation exists between the disputed domain names and the Complainant and/or its FB Marks. The addition of a generic Top-Level Domain ("gTLD") has no distinguishing value in the analysis under paragraph 4(a)(i) of the Policy.

The Respondent has no rights or legitimate interests in the disputed domain names. The Complainant has neither licensed nor authorized the Respondent to use the Complainant's FB Marks, nor does the Respondent have any legal relationship with the Complainant that would entitle the Respondent to use the FB Marks. Further, neither the Whois data for the disputed domain names nor the corresponding website available at the disputed domain names supports that the Respondent is commonly known by either of the disputed domain names. The Respondent has used the disputed domain names in connection with an illegitimate commercial scheme purportedly selling fake Facebook accounts, which appears to offer users the ability to purchase "tokens" that can be used to "buy" a fake Facebook account.

The Respondent has registered the disputed domain names that are confusingly similar to the Complainant's FB Marks and has used the disputed domain names to purportedly sell fake Facebook accounts in violation of the Complainant's terms of service and community guidelines. Because the FB Marks are so obviously connected with the Complainant and its well-publicized services, and the disputed domain names clearly reference the FB Marks, the registration and use of the disputed domain names by the Respondent, who has no connection with the Complainant, supports a finding of bad faith under the Policy. Under these circumstances, there is no conceivable use of the disputed domain names by the Respondent that could be legitimate.

B. Respondent

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

6. Discussion and Findings

6.1 Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise having regard to the circumstances of the administrative proceeding. The language of the Registration Agreements for the disputed domain names is Japanese.

However, the Complainant requests that the proceeding be conducted in English with the reasons that the disputed domain names are comprised entirely of English words, the disputed domain names are plainly targeting the Complainant, a United States company, and the Complainant's well-known FB Marks, and the website available at the disputed domain names does not appear to be in Japanese.

Although there is no agreement between the Parties on the language of the proceeding, the Respondent submitted neither comment on the language of the proceeding nor objection to the Complainant's request to proceed in English when the Center had sent a notification regarding the language of the proceeding to the Parties by email both in English and Japanese. Whereas preparing a Japanese translation of the Complaint would create a significant additional expense and delay for the Complainant, the necessity for conducting the proceeding in Japanese may not be so high for the Respondent who is located in Thailand.

In view of these circumstances of the proceeding, the Panel decides that English should be the language of the proceeding within the spirit of fairness and justice intended by the Policy.

6.2 Substantive Elements of the Policy

In accordance with paragraph 4(a) of the Policy, the Complainant must assert and prove the following three elements are present:

(i) the disputed domain names are 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 names; and

(iii) the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

The disputed domain name <fbtoyou.com> incorporates the letters “fb”, which are the same as the Complainant’s FB Marks, in its entirety followed by the phrases “to you” after deleting the space between the two words, plus the gTLD “.com”, which is generally disregarded as a technical requirement of the domain name registration.

The disputed domain name <fb2you.com> is almost the same as the disputed domain name <fbtoyou.com> except for replacing the word “to” with the number “2” with the same pronunciation.

The FB Marks are clearly recognizable in the disputed domain names. The addition of other terms to a trademark does not prevent a finding of confusing similarity (see *Facebook, Inc. v. Domain Administrator, PrivacyGuardian.org / Hernando Sierra*, WIPO Case No. [D2018-1145](#); see also section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Accordingly, the Panel finds that the disputed domain names are confusingly similar to the Complainant’s FB Marks.

B. Rights or Legitimate Interests

The Complainant asserts and shows that the Respondent is not authorized to use the Complainant’s FB Marks. The disputed domain names have been used to host a commercial website that purportedly allows users to buy “tokens” that appear to be exchanged for fake Facebook accounts. Regardless if the services offered by the Respondent are real or not, the Respondent is engaging in misleading conduct targeting the Complainant’s FB and FACEBOOK Marks, without any explanation of the lack of relationship between the Parties.

Further, the Respondent has repeatedly used the FACEBOOK Marks throughout the website to advertise the sale of fake Facebook accounts, even though no affiliation exists between the Respondent and the Complainant, and the Respondent is not authorized to make any such offering. The Respondent’s use of the Complainant’s FACEBOOK and FB Marks is highly likely to cause consumer confusion, to cause mistake, or to deceive.

Based on the above facts, the Respondent’s use is not a use in connection with a *bona fide* offering of goods or services within the meaning of paragraph 4(c)(i) of the Policy. Also, the Respondent’s use is clearly commercial and is not a legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

The Complainant asserts and shows that the Respondent is not commonly known by the Complainant’s FB Marks. The Whois data for the disputed domain names does not identify a person or company commonly known by the disputed domain names. The Respondent’s name does not resemble the disputed domain names in any way. Therefore, the circumstances described in paragraph 4(c)(ii) of the Policy are not applicable.

Accordingly, the Panel finds that the Complainant has made out a *prima facie* case that the Respondent lacks rights or legitimate interests, and then, the Respondent bears the burden of production to provide evidence demonstrating that the Respondent has rights or legitimate interests in the disputed domain names. See section 2.1 of the [WIPO Overview 3.0](#).

Since no response was submitted by the Respondent and no evidence of any rights or legitimate interests is presented before the Panel, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

C. Registered and Used in Bad Faith

The use of the disputed domain names that are confusingly similar to the Complainant's FB Marks to offer fake products falsely suggesting an association with the Complainant suggests bad faith. The registration of the disputed domain names that are confusingly similar to the Complainant's FB Marks by the Respondent with no connection with the Complainant, but with apparent knowledge of the Complainant's FB Marks, suggests bad faith. In addition, given the widespread recognition of the Complainant's FB Marks and the Respondent's unauthorized incorporation of the exact FB Marks into the disputed domain names, the Panel is unable to consider any circumstances under which the Respondent's use of the disputed domain names could plausibly be in good faith under the Policy.

Moreover, the fact that the content resolving from the disputed domain names was removed after the filing of the Complaint supports a finding of bad faith. See sections 3.2.1 and 3.3 of the [WIPO Overview 3.0](#).

The Respondent's bad faith is further indicated by the fact that the disputed domain name <fb2you.com> is listed on a blacklist conducted by a third party MX lookup service, which suggests previous use in connection with spam, malware, or other domain name abuse.

Consequently, the Panel concludes that the requirement of registration and use in bad faith is 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 names, <fbtoyou.com> and <fb2you.com>, be transferred to the Complainant.

/Yuji Yamaguchi/

Yuji Yamaguchi

Sole Panelist

Date: April 29, 2022