

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc v. Whois Agent, Domain Protection, Services, Inc. /
jackwilki, jackwilkison jackwilkison
Case No. D2022-1155

1. The Parties

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

Respondent is Whois Agent, Domain Protection, Services, Inc., United States/ jackwilki, jackwilkison jackwilkison, United States.

2. The Domain Name and Registrar

The disputed domain name <security-facebook.com> is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 2, 2022. On April 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 6, 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 Complainant on April 8, 2022, 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 13, 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 Respondent of the Complaint, and the proceedings commenced on April 19, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 9, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on May 10, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on May 17, 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

Without contest by Respondent, Complainant asserts in its Complaint as amended, and its Annexes attached provide evidence sufficient to support that:

Complainant Meta Platforms, Inc. f/k/a Facebook, Inc., provides social networking website and mobile application services under the trademark FACEBOOK (the "FACEBOOK Mark") in which it holds exclusive rights and which it has used since 2004. Complainant claims worldwide fame and recognition of the FACEBOOK Mark based on its use worldwide for more than 18 years and submits content supporting its claims for such world-wide recognition in the Annexes to its Complaint. For example, the Annex evidence submitted shows Complainant's Facebook social networking service has more than one billion daily active accounts and over two billion monthly active users from all over the world. Complainant's official website, accessed through its domain name <facebook.com> (the "Official FACEBOOK Website") is currently ranked as the seventh most visited website in the world according to information company Alexa, the third most downloaded app globally and the seventh most downloaded app in the United States, both according to Forbes magazine. Approximately 85 percent of active daily Facebook users are outside the United States and Canada. Facebook's social networking services are provided in more than 70 languages. In support of its claim of worldwide fame for the FACEBOOK Mark, Complainant also submits evidence that the Mark ranked 15th in Interbrand's current Best Global Brands report.

Complainant also has submitted screen captures from its Official FACEBOOK Website showing in detail that as part of its social networking services it offers security features, such as login alerts and two-factor authentication.

Complainant owns numerous registrations protecting the Facebook Mark in the United States and around the world, including:

United States Trademark Registration No. 3,122,052, FACEBOOK, registered with the United States Patent and Trademark Office ("USPTO") on July 25, 2006, for online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking in international class 38 and claiming a first use date of November 16, 2004.

International Registration No. 1075094, FACEBOOK, registered on July 16, 2010, for goods and services in International Classes 9, 35, 36, 38, 41, 42, and 45, designating AL, AU, BA, BH, CH, CN, EG, GE, GH, HR, IS, JP, KE, KR, MA, ME, MK, NO, RS, SD, SG, UA, and VN.

European Union Trademark Registration No.009776618, FACEBOOK, registered on November 2, 2011 for goods and services in International Classes 9, 16, 35, and 36.

The disputed domain name was registered on January 23, 2008, and entering the disputed domain name into a web browser generates an error message stating "This site can't be reached", signifying that the disputed domain name is not in use or linked to an inactive website.

5. Parties' Contentions

A. Complainant

Complainant contends that the disputed domain name is identical or confusingly similar to Complainant's trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain name,

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

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

There are no exceptional circumstances within paragraph 5(e) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint (as amended), notwithstanding the failure of any person to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall "draw such inferences therefrom as it considers appropriate".

Where no substantive Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To succeed, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied.

The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

A. Identical or Confusingly Similar

Ownership of a nationally registered trademark constitutes *prima facie* evidence that the complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainant claims trademark rights in the coined term FACEBOOK for various social networking website and mobile app products and services dating back to 2004. Sufficient evidence has been submitted, in the form of electronic copies of active U.S. and international trademark registration certificates, showing the above referenced trademark registrations for the FACEBOOK Mark in the name of Complainant. Complainant has through such valid and subsisting trademark registrations demonstrated its rights in the FACEBOOK Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

With Complainant's rights in the FACEBOOK Mark established, the remaining question under the first element of the Policy is whether the disputed domain name is identical or confusingly similar to Complainant's FACEBOOK Mark. It is well accepted that the first element functions primarily as a standing requirement and that the threshold test for confusing similarity involves a "reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name". [WIPO Overview 3.0](#), section 1.7. Prior UDRP panels have also held "in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing". See, *id*; see also, *Wal-Mart Stores, Inc. v. MacLeod d/b/a/ For Sale*, WIPO Case No. [D2000-0662](#).

A side by side comparison between the disputed domain name and the FACEBOOK Mark shows the disputed domain name consists of the Mark in its entirety and is identical except for the addition of a term "security" attached with a hyphen as a prefix to Complainant's FACEBOOK Mark.

Numerous prior UDRP panels have held that the addition of a descriptive term to a complainant's mark fails to prevent a finding of confusing similarity. See, e.g., *Facebook, Inc. v. Paulette Collier*, WIPO Case No. [D2021-3175](#); see also [WIPO Overview 3.0](#), sections 1.7 and 1.8. The Panel notes the relevance of Respondent's choice of the term "security" to add to Complainant's mark to form the disputed domain name

given that security is a feature of Complainant's social networking services, a factor more appropriately considered under the second and third elements of the Policy below.

Prior UDRP panels have also found typographic differences, such as the inclusion or omission of hyphens and apostrophes are inadequate to avoid a finding of confusing similarity. See, e.g., *L'Oreal v. Tracey Johnson*, WIPO Case No. [D2008-1721](#).

Finally, the Top-Level Domain ("TLD") in a domain name (e.g., ".com", ".club", ".co") typically adds no meaning or distinctiveness to a disputed domain name and is viewed as a standard registration requirement; as such it is disregarded under the paragraph 4(a)(i) analysis. Accordingly, the TLD of the disputed domain name here, ".com", does not avoid a finding of confusing similarity. See, [WIPO Overview 3.0](#), section 1.11; see also *Research in Motion Limited v Thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#).

In light of the above, the Panel finds the disputed domain name confusingly similar to the FACEBOOK Mark in which Complainant possesses rights and Complainant has thus satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, the complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, upon which the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the dispute domain name. If the respondent fails to come forward with such evidence, a complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or interests.

The first example, under paragraph 4(c)(i), is where "before any notice to you of the dispute, your 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".

Here, the annex to the Complaint shows Respondent is passively holding the disputed domain name as entering the subject domain name into a web browser generates an error message indicating that the site cannot be reached. Prior UDRP panels have held that absence of use does not confer any rights or legitimate interests on a respondent. See *Indiamart Intermesh Ltd. v. Yi Zhi Ge, Ge Yi Zhi*, WIPO Case No. [D2019-0930](#). Similarly, prior UDRP panels have also found use of a disputed domain name to resolve to a blank or inactive web page does not represent a *bona fide* use of the disputed domain name. See *Microsoft Corporation v. Charilaos Chrischoou*, WIPO Case No. [D2004-0186](#); [WIPO Overview 3.0](#), section 2.9.

Whether the error message submitted is evidence of non-use or use of a blank or inactive web page, based on the foregoing decisions this Panel finds the disputed domain name is not being used in connection with a *bona fide* offering of goods or services sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraph 4(c)(i) of the Policy.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant states that it has not given permission to Respondent to use the FACEBOOK Mark. Complainant also shows that Respondent is not commonly known by the disputed domain name because the original Respondent listed in the Whois record submitted with the initial Complaint displayed "Whois Agent, Domain Protection, Services, Inc." of the United States. The Registrar identified the underlying registrant in its verification process, "jackwilki, jackwilkison jackwilkison" also of the

United States, who has been added via the amended Complaint as a co-Respondent in addition to the original Respondent. Neither Respondent bears any resemblance to the disputed domain name whatsoever. Thus, there is no evidence in this case to suggest that Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, the Panel finds this sub-section of the Policy is of no help to Respondent and the facts presented here support a lack of rights and legitimate interests in the subject domain name. See *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. [D2002-0433](#).

Complainant has met its initial burden as it is generally regarded as *prima facie* evidence of no rights or legitimate interests if a complainant shows that the disputed domain name is identical or confusingly similar to Complainant's trademark, that Respondent is not commonly known by the disputed domain name, and that Complainant has not authorized Respondent to use its mark (or an expression which is confusingly similar to its mark), whether in the disputed domain name or otherwise. See, *Roust Trading Limited v. AMG LLC*, WIPO Case No. [D2007-1857](#); see also *Abbott Laboratories v. Li Jian Fu, Li Jian Fu*, WIPO Case No. [D2016-0501](#).

As to the third and final example under paragraph 4(c)(iii) of the Policy, the Panel finds there is no evidence here that 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 Complainant's trademark. The disputed domain name does not resolve to an active website and therefore there is no *bona fide* offering nor any plausible fair use to which the disputed domain name may be put under the circumstances of this proceeding. See *Indiamart, supra*; see also *Bloomberg Finance, L.P. v. Huang Wei*, WIPO Case No. [D2015-1378](#).

In light of the above, and with no Response or other submission in this case to rebut Complainant's assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#). Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, as noted in 6B above, Respondent is passively holding the disputed domain name based on the browser error it generates, representing either non-use or linking to an inactive website. Prior UDRP panels have found under the doctrine of passive holding that the non-use of a domain name that is confusingly similar to a complainant's mark constitutes use in bad faith. [WIPO Overview 3.0](#), Section 3.3.

Bad faith use seems especially appropriate given totality of facts here. Assuming Respondent is the same registrant who registered the disputed domain name in 2008, approximately four years after Complainant began using its mark, Respondent has concealed its identity, failed to submit a response or to provide any evidence of actual or contemplated good-faith use of the disputed domain name since 2008, a period of over 14 years. During that same period of apparent non-use by Respondent, Complainant's FACEBOOK Mark has grown in recognition to the level of worldwide fame, supporting the implausibility of any good faith use to which the disputed domain name may now be put. The factors present here are well-settled as supporting a finding of bad faith use for passive holding or non-use of a disputed domain name that is confusingly similar to a complainant's mark. See *Bloomberg, supra*; *Instagram, LLC v. Asif Ibrahim*, WIPO Case No. [D2020-2552](#); [WIPO Overview 3.0](#), Section 3.3.

Given the widespread recognition of Complainant's FACEBOOK Mark in the U.S., where Respondent is located, even in the approximately four years of use of the FACEBOOK Mark prior to Respondent's assumed registration of the disputed domain name in 2008, Respondent likely had actual knowledge of Complainant's rights when it registered the disputed domain name, which shows bad faith registration. See *Facebook, Inc. v. Ricky Bhatia*, WIPO Case No. [D2017-2542](#) (citing multiple prior decisions as early as 2011 finding fame of FACEBOOK Mark).

Prior UDRP panels have also held that a respondent's selection of a disputed domain name that comprises the complainant's mark in its entirety demonstrates a respondent's actual knowledge to support a finding of bad faith in registering and using the domain. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v Mark Lott*, WIPO Case No. [D2000-1487](#).

The disputed domain name incorporates the mark in its entirety and is essentially identical to both Complainant's Mark and its <FACEBOOK.com> domain name, coupled with a descriptive term "security", which likely magnifies the false association with Complainant in light of Complainant's security features it provides as part of its social networking services displayed on its website. With no explanation or submission from Respondent to dispute Complainant's assertions or the presented facts of this case, this Panel finds it reasonable to conclude that it is more likely than not that Respondent registered the disputed domain name with actual knowledge of Complainant's trademark rights in order to take unfair advantage of its similarity with the disputed domain name and Complainant's security features.

The Panel finds that the circumstances of this case, Respondent's registration of the disputed domain name with awareness of Complainant and the FACEBOOK Mark, and with the absence of any of its own rights or legitimate interests, leads to a conclusion of registration in bad faith by Respondent. See *Royds Withy King LLP v. Help Tobuy*, WIPO Case No. [D2019-0624](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied paragraph 4(a)(iii) 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, <security-facebook.com> be transferred to Complainant.

/Scott R. Austin/

Scott R. Austin

Sole Panelist

Date: June 5, 2022