

## **ADMINISTRATIVE PANEL DECISION**

Meta Platforms, Inc. v. Contact Privacy Inc. Customer 12410042356 / Clifford Johnson

Case No. D2022-1199

### **1. The Parties**

The Complainant is Meta Platforms, Inc.<sup>1</sup>, United States of America (“United States”), represented by Tucker Ellis, LLP, United States.

The Respondent is Contact Privacy Inc. Customer 12410042356, Canada / Clifford Johnson, United States.

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

The disputed domain name <secureaccountfacebook.com> (the “Disputed Domain Name”) is registered with Google LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2022. On April 6, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 7, 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 April 7, 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 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 the Respondent of the Complaint, and the proceedings commenced on April 13, 2022. In accordance with the Rules, paragraph 5,

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<sup>1</sup> On 28 October 2021, the Complainant, formerly known as Facebook, Inc., changed its name to Meta Platforms, Inc.

the due date for Response was May 3, 2022. On April 7, 2022, and May 4, 2022, the Respondent sent email communications to the Center but did not submit any formal response. On May 4, 2022, the Center informed the Parties that it would proceed to Panel appointment.

The Center appointed Lynda M. Braun as the sole panelist in this matter on May 9, 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 operates the Facebook social networking website and mobile application, which enables its users to create their own accounts and user profiles and connect with each other on their personal computers and mobile devices. The website has more than one billion daily active accounts and over two billion monthly active users worldwide.

The Complainant owns the following trademarks, among others, which it has used for over 17 years: FACEBOOK, United States Registration No. 3,122,052, registered on July 25, 2006; FACEBOOK, United States Registration No. 3,881,770, registered on November 23, 2010; and FACEBOOK, United States Registration No. 4,441,540, registered on November 26, 2013. The Complainant also owns international and European Union trademarks for the FACEBOOK trademark. The aforementioned trademarks will hereinafter collectively be referred to as the "FACEBOOK Mark".

The Complainant owns the domain name <facebook.com>, which redirects to its official website at "www.facebook.com" and the domain name <facebook-security.com>, which redirects to "www.facebook.com/security", a webpage in which the Complainant updates users about how to protect their information both on and off the Facebook social media platform. The Complainant also owns and operates numerous other domain names consisting of the FACEBOOK Mark in combination with various generic and country code Top-Level Domain extensions, including <facebook.org> and <facebook.net>.

The Disputed Domain Name was registered on April 23, 2021, which postdates the Complainant's registration and use of the Facebook Mark by many years. The Disputed Domain Name resolves to an inactive landing page with no substantive content that currently states "This site can't be reached. secureaccountfacebook.com's server IP address could not be found".

The Complainant's attorneys sent a cease-and-desist letter to the Respondent on January 12, 2022, but received no response.

#### **5. Parties' Contentions**

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

The following are the Complainant's contentions:

- the Disputed Domain Name is confusingly similar to the Complainant's FACEBOOK Mark;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- the Disputed Domain Name was registered and is being used in bad faith; and
- the Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

## B. Respondent

The Respondent did not submit a formal reply to the Complainant's contentions, although on April 7, 2022 and May 4, 2022, the Respondent sent emails to the Center indicating mainly that: a) he hasn't used or promoted or done anything with the Disputed Domain Name since he was told not to last year and b) he doesn't understand why he is getting in trouble for something he didn't even do.

## 6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

(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 in bad faith.

### A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the FACEBOOK Mark.

It is uncontroverted that the Complainant has established rights in the FACEBOOK Mark based on its years of use as well as its registered trademarks for the FACEBOOK Mark in the United States and other jurisdictions worldwide. The consensus view is that "registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the FACEBOOK Mark. Moreover, the registration of a mark satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Thus, the Panel finds that the Complainant has rights in the FACEBOOK Mark.

The Disputed Domain Name consists of the FACEBOOK Mark preceded by the descriptive terms "secure" and "account", and then followed by the generic Top-Level Domain ("gTLD") ".com". It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), "where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element". For example, numerous UDRP decisions have reiterated that the addition of descriptive terms to a trademark does not prevent a finding of confusing similarity. See *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Further, the addition of a gTLD such as ".com" in a domain name is technically required. Thus, it is well established that, as here, such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that the first element of paragraph 4(a) of the Policy has been met by the Complainant.

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

Under the Policy, a complainant has to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such a *prima facie* case is made, the respondent carries the burden of production of evidence that demonstrates rights or legitimate interests in the disputed domain name. If the respondent fails to do so, the complainant may be deemed to have satisfied paragraph 4(a)(ii) of the Policy. See [WIPO Overview 3.0](#), section 2.1.

There is no evidence in the record suggesting that the Respondent has rights or legitimate interests in the Disputed Domain Name. The Complainant has not authorized, licensed, or otherwise permitted the Respondent to use the Complainant's FACEBOOK Mark. There is also no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name nor has the Respondent made any demonstrable preparations to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

Moreover, the Complainant does not have any business relationship with the Respondent and based on the passive use made of the Disputed Domain Name to resolve to a landing page with no substantive content, the Panel finds that the Respondent is not making a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name.

In sum, the Panel finds that the Complainant has established an unrebutted *prima facie* case that the Respondent lacks rights or legitimate interests in the Disputed Domain Name.

Accordingly, the Panel finds that the second element of paragraph 4(a) of the Policy has been met by the Complainant.

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

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent's bad faith pursuant to paragraph 4(b) of the Policy.

First, based on the circumstances here, the Panel concludes that the Respondent's registration and use of the Disputed Domain Name had been done for the specific purpose of trading on the name and reputation of the Complainant and its FACEBOOK Mark. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com"*, WIPO Case No. [D2000-0847](#) ("[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain").

Second, with respect to the use of the Disputed Domain Name, passive holding does not prevent a finding of bad faith. By holding the Disputed Domain Name passively, the Respondent registered and is using the Disputed Domain Name in bad faith. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). "The lack of use [of a domain name] by itself does not indicate anything. Nevertheless, the lack of use of a domain name that is not backed up by any trademark and that coincides with a known, well-known or renowned trademark owned by someone else, does not indicate other than bad faith in the sense of paragraph 4(b) of the Policy." See *El Bebe Productions Ltd v. Rachid Zouad*, WIPO Case No. [D2018-0469](#) (citing *Itaú Unibanco Holding S.A. v. Valdey Dos Santos Decorações ME*, WIPO Case No. [D2009-1335](#)).

Third, the Panel finds it likely that the Respondent had actual knowledge of the Complainant's FACEBOOK Mark and targeted the Complainant when it registered the Disputed Domain Name, demonstrating the Respondent's bad faith. It can be inferred that the Respondent had actual knowledge of the Complainant and its FACEBOOK Mark when it registered the confusingly similar Disputed Domain Name. UDRP panels

have found that the registration of a domain name that is confusingly similar to a well-known trademark by an unaffiliated entity can create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Finally, the lack of response by the Respondent to the cease-and-desist letter sent by the Complainant's attorneys supports a finding of bad faith. Past UDRP panels have held that failure to respond to a cease-and-desist letter may be considered a factor in finding bad faith registration and use of a domain name. See *WhatsApp LLC v. Bulk Whatsapp Software*, WIPO Case No. [D2021-0564](#) (respondent's failure to reply to the cease and desist letter was a circumstance pointing to bad faith registration and use of the disputed domain name); *Encyclopaedia Britannica, Inc. v. John Zuccarini and The Cupcake Patrol a/ka Country Walk a/k/a Cupcake Party*, WIPO Case No. [D2000-0330](#) (failure to respond to a demand letter provides "strong support for a determination of 'bad faith' registration and use").

Accordingly, the Panel finds that the third element of paragraph 4(a) of the Policy has been met by the Complainant.

## **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 <secureaccountfacebook.com> be transferred to the Complainant.

*/Lynda M. Braun/*

**Lynda M. Braun**

Sole Panelist

Date: May 19, 2022