

## **ADMINISTRATIVE PANEL DECISION**

Meta Platforms, Inc. v. Registration Private, Domains By Proxy, LLC / Tim Ordonez

Case No. D2022-2373

### **1. The Parties**

The Complainant is Meta Platforms, Inc., United States of America (“United States”), represented by Hogan Lovells (Paris) LLP, France.

The Respondent is Registration Private, Domains By Proxy, LLC, United States / Tim Ordonez, United States.

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

The disputed domain names <facebookmetadownload.info>, <facebookmetadownload.live>, <facebookmetadownload.net>, <facebookmetadownload.xyz>, <metafacebookdownload.info>, <metafacebookdownload.live>, <metafacebookdownload.net>, and <metafacebookdownload.xyz> are registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 29, 2022. On June 30, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 1, 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 July 1, 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 July 6, 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 July 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 9, 2022.

The Center appointed William R. Towns as the sole panelist in this matter on August 26, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence required by the Center to ensure compliance with the Rules, paragraph 7.

#### 4. Factual Background

The Complainant is Meta Platforms, Inc. (formerly "Facebook, Inc."), a social technology company founded in 2004 and a well-known provider of social-media and networking services. The Complainant's Facebook platform was founded in 2004 and since has experienced substantial growth, providing online networking services under the FACEBOOK mark. According to the Complainant, FACEBOOK today experiences 2.9 billion monthly active users.

The Complainant is the owner of numerous trademark registrations for its FACEBOOK and META marks issued in the United States ("U.S."), European Union, and in other jurisdictions, including among the following:

- FACEBOOK, United States Trademark Registration No. 3041791, registered January 10, 2006;
- FACEBOOK, European Union Trade Mark Registration. No. 002483857, registered June 13, 2003;
- FACEBOOK, International Registration. No. 1280043, registered December 23, 2014; and
- META, United States Trademark Registration No. 5548121, registered August 28, 2018.

UDRP panels have recognized the Complainant's FACEBOOK mark as one of the most famous online marks in the world. See *Facebook, Inc. v. Franz Bauer*, WIPO Case No. [D2010-1247](#); *Facebook, Inc. v. He Wenming*, WIPO Case No. [DCC2013-0004](#); and *Facebook Inc. v. Domain Admin, Whoisprotection.biz / Murat Civan*, WIPO Case No. [D2015-0614](#); *Facebook, Inc. v. Domain Administrator, PrivacyGuardian.org / Hernando Sierra*, WIPO Case No. [D2018-1145](#).

The disputed domain names <facebookmetadownload.info>, <facebookmetadownload.live>, <facebookmetadownload.net>, <facebookmetadownload.xyz>, <metafacebookdownload.info>, <metafacebookdownload.live>, <metafacebookdownload.net>, and <metafacebookdownload.xyz> were registered by the Respondent on December 4, 2021, according to the registrar's Whois database. The Complainant upon becoming aware of the disputed domain names contacted the Respondent seeking to resolve the matter amicably; however, the Respondent did not offer a reply.

The disputed domain names presently do not appear to resolve to any active websites; however, the Complainant has provided screen captures of inactive webpages appearing to have been associated with the disputed domain names. The Respondent appears after registering the disputed domain names to have offered the disputed domain names <facebookmetadownload.net> and <facebookmetadownload.xyz> for sale on the GoDaddy website for the asking price of USD 69.99 each. The disputed domain names presently do not appear to resolve to any active websites.

## 5. Parties' Contentions

### A. Complainant

The Complainant submits that each of the disputed domain names are identical or confusingly similar to the Complainant's FACEBOOK and META marks. According to the Complainant, the disputed domain names differ from the Complainant's FACEBOOK and META marks only by the addition of the term "download", and as such do not preclude a finding of confusing similarity. The Complainant reiterates that the disputed domain names are confusingly similar to the Complainant's marks, citing *Meta Platforms, Inc. v. Domain Administrator*, See *PrivacyGuardian.org / ConstanceJBrody, Constance Brody*, WIPO Case No. [D2022-0605](#). The Complainant further remarks that the addition of gTLD extensions such as for example ".info", ".live", ".net", and ".xyz" are not considered relevant when determining the confusing similarity of the disputed domain names to the Complainant's FACEBOOK and META marks.

The Complainant asserts that the Respondent lacks rights or legitimate interests in respect of the disputed domain names, and has not been licensed by the Complainant or otherwise authorized to use or register the Complainant's FACEBOOK or META marks with a domain name. The Complainant remarks that the Respondent has neither used nor made demonstrable preparations to use the disputed domain names in connection with a *bona fide* offering of goods or services, has not been commonly known by the disputed domain names, and has not made any substantive use thereof. The Complainant further notes that the Respondent's passive holding of the disputed domain names does not give rise to any legitimate noncommercial or fair use of the disputed domain names.

The Complainant asserts that the disputed domain names have been registered by the Respondent and are being used by the Respondent in bad faith. The Complainant reiterates that its FACEBOOK mark is known throughout the world for the Complainant's social networking and messaging applications and enjoys a substantial number of as many as two billion monthly active users. The Complainant is adamant that the Respondent has engaged in a deliberate pattern of registering multiple domain names seeking to prevent the Complainant from reflecting its FACEBOOK and META marks in corresponding domain names.

The Complainant concludes there is no good faith use to which the disputed domain names could be put by the Respondent that would not carry an inherent risk of confusion, and voices further concern that the presence of the disputed domain names in the hands of the Respondent would constitute an even greater threat hanging over the head of the Complainant.

### B. Respondent

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

## 6. Discussion and Findings

The Policy is addressed to resolving disputes concerning allegations of abusive domain name registration and use. *Milwaukee Electric Tool Corporation v. Bay Verte Machinery, Inc. d/b/a The Power Tool Store*, WIPO Case No. [D2002-0774](#). Accordingly, the jurisdiction of this Panel is limited to providing a remedy in cases of "the abusive registration of domain name", also known as "[c]ybersquatting". *Weber-Stephen Products Co. v. Armitage Hardware*, WIPO Case No. [D2000-0187](#). See Final Report of the First WIPO Internet Domain Name Process, April 30, 1999, paragraphs 169-177. The term "cybersquatting" is most frequently used to describe the deliberate, bad faith abusive registration of a domain name in violation of rights in trademarks or service marks. *Id.*, at paragraph 170. Paragraph 15(a) of the Rules provides that the panel shall decide a complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the panel deems applicable.

Paragraph 4(a) of the Policy requires that the complainant prove each of the following three elements to obtain a decision that a domain name should be either cancelled or transferred:

- (i) the 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 with respect to the domain name; and
- (iii) the domain name has been registered and is being used in bad faith.

Cancellation or transfer of the domain name is the sole remedy provided to the complainant under the Policy, as set forth in paragraph 4(i).

Paragraph 4(b) of the Policy sets forth four situations under which the registration and use of a domain name is deemed to be in bad faith, but does not limit a finding of bad faith to only these situations.

Paragraph 4(c) of the Policy in turn identifies three means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, UDRP panels have recognized that this could result in the often impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the view is that the burden of production shifts to the respondent to come forward with evidence of a right or legitimate interest in the domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

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

The Panel finds that the disputed domain names are confusingly similar to the Complainant's distinctive and well-known FACEBOOK marks. In considering this issue, the first element of the Policy serves essentially as a standing requirement. The threshold inquiry under the first element of the Policy involves a relatively straightforward comparison between the Complainant's trademark and the disputed domain names. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant's FACEBOOK marks are clearly recognizable in the disputed domain names.<sup>1</sup> When the relevant trademark is recognizable in the disputed domain names, the addition of other terms, whether descriptive, geographical, pejorative, meaningless, or otherwise, does not preclude a finding of confusing similarity under paragraph 4(a)(i) of the Policy.<sup>2</sup> Top-Level Domains ("TLDs") generally are disregarded when evaluating the identity or confusing similarity of the complainant's mark to the domain name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.<sup>3</sup>

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

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

As noted above, once the complainant makes a *prima facie* showing under paragraph 4(a)(ii) of the Policy, paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in a domain name. The Panel is persuaded from the record of this case that a *prima facie* showing under paragraph 4(a)(ii) of the Policy has been made. It is undisputed that the Respondent has not been authorized to use the Complainant's FACEBOOK marks. Nevertheless, the Respondent has

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<sup>1</sup> See [WIPO Overview 3.0](#), section 1.8 and cases cited therein.

<sup>2</sup> *Id.*

<sup>3</sup> See [WIPO Overview 3.0](#), section 1.11.

registered multiple disputed domain names, each of which clearly appropriates the Complainant's FACEBOOK marks.

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, the 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) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the 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 Respondent has not submitted a formal response to the Complaint, in the absence of which the Panel may accept all reasonable inferences and allegations in the Complaint as true. See *Talk City, Inc. v. Michael Robertson*, WIPO Case No. [D2000-0009](#). Regardless, the Panel has carefully reviewed the record in this case, and finds nothing therein that would bring the Respondent's registration and use of the disputed domain names within any of the "safe harbors" of paragraph 4(c) of the Policy.

Having regard to the relevant circumstances, the Panel finds that the Respondent has neither used nor made demonstrable preparations to use the disputed domain names in connection with any *bona fide* offerings of goods or services under paragraph 4(c)(i) of the Policy, and is not making a legitimate noncommercial or other fair use of the disputed domain names for purposes of paragraph 4(c)(iii) of the Policy. The Respondent has not been authorized to use the Complainant's FACEBOOK mark, and there is no indication that the Respondent has been commonly known by the disputed domain names within the meaning of paragraph 4(c)(ii) of the Policy. In short, nothing in the record would support a claim by the Respondent of rights or legitimate interests in the disputed domain names.

Accordingly, the Panel finds the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

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

Paragraph 4(b) of the Policy states that any of the following circumstances, in particular but without limitation, shall be considered evidence of the registration and use of a domain name in bad faith:

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

The examples of bad faith registration and use set forth in paragraph 4(b) of the Policy are not meant to be exhaustive of all circumstances from which such bad faith may be found. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). The overriding objective of the Policy is to curb the abusive registration of domain names in circumstances where the registrant seeks to profit from and exploit the trademark of another. *Match.com, LP v. Bill Zag and NWLAWS.ORG*, WIPO Case No. [D2004-0230](#).

For the reasons discussed under this and the preceding heading, the Panel considers that the Respondent's conduct in this case constitutes bad faith registration and use of the disputed domain names within the meaning of paragraph 4(a)(iii) of the Policy. The Panel concludes that the Respondent was aware of the Complainant and had the Complainant's well-known FACEBOOK marks in mind when registering the disputed domain names. The Panel concludes that the Respondent in all likelihood registered the disputed domain names seeking to exploit and profit from the Complainant's FACEBOOK marks.

The Panel considers such circumstances to be indicative of the Respondent's bad faith. As previously noted, the Complainant's FACEBOOK marks are distinctive and well known, and it is clearly evident that the Respondent would have been aware of the Complainant's FACEBOOK marks when registering the disputed domain names. Absent any explanation from the Respondent, the Panel cannot conceive of any plausible good faith use of the disputed domain names that could be made by the Respondent. The fact that the disputed domain names do not resolve to an active website (or in some cases are offered for sale) does not preclude a finding of bad faith under the doctrine of passive holding. *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

Accordingly, the Panel finds that the Complainant has satisfied the requirements of 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 names <facebookmetadownload.info>, <facebookmetadownload.live>, <facebookmetadownload.net>, <facebookmetadownload.xyz>, <metafacebookdownload.info>, <metafacebookdownload.live>, <metafacebookdownload.net>, and <metafacebookdownload.xyz>, be transferred to the Complainant.

*/William R. Towns/*

**William R. Towns**

Sole Panelist

Date: September 9, 2022