

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc. v. Lanny Kapetz / Domains By Proxy, LLC
Case No. D2022-2485

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 Lanny Kapetz, Canada / Domains By Proxy, LLC, United States.

2. The Domain Names and Registrar

The disputed domain names <facebookard.com>, <facebookednow.com>, <facebookedpro.com>, <facebookedweb.com>, <facebookerd.com>, <facebookerdnow.com>, <facebookerd.org>, <facebookerdpro.com>, <facebookerds.com>, <facebookerr.com>, <facebookine.com>, <facebookinewpv.com>, <facebookinpro.com>, <facebookinshop.com>, <facebookinweb.com>, <facebookinwpv.com>, <facebookmy.com>, <facebookpopcom.com>, <facebookpopshop.com>, <facebookpopular.com>, <facebookpopweb.com>, <myweboffacebook.com>, <thenetfacebook.com>, <thewebbofacebook.com>, <thewebfacebook.com>, <theweboffacebook.com>, and <weboffacebook.com> 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 July 8, 2022. On July 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 20, 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 21, 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 22, 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 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 18, 2022.

The Center appointed Knud Wallberg as the sole panelist in this matter on September 2, 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 is a United States social technology company, and operates Facebook, Instagram, and WhatsApp. Since its launch in 2004, Facebook has rapidly developed considerable renown and goodwill worldwide. Its main website is currently ranked as the 3rd most visited website both in the world and in Canada where the Respondent is based. Facebook is also available for mobile devices and is the 3rd most downloaded mobile application worldwide and 14th in Canada.

The Complainant is the owner of numerous trademark registrations for FACEBOOK in many jurisdictions throughout the world, including United States Trademark Registration No. 3041791, FACEBOOK, registered on January 10, 2006, (first use in commerce in 2004) for services in classes 35 and 38, and Canadian Trademark Registration No. TMA921403, FACEBOOK, registered on November 26, 2015, for goods and services in classes 9, 16 and 35.

The Complainant is the owner of numerous domain names consisting of or including the FACEBOOK trademark under various generic Top-Level Domains ("gTLDs") as well as under various country code Top-Level Domains.

The disputed domain names <facebookerd.com>, <facebookerds.com>, and <facebookerr.com> were registered on December 22, 2021.

The disputed domain names <facebookard.com>, <facebookednow.com>, <facebookedpro.com>, <facebookedweb.com>, <facebookerdnow.com>, <facebookerd.org>, <facebookerdpro.com>, <facebookine.com>, <facebookinewpv.com>, <facebookinpro.com>, <facebookinshop.com>, <facebookinweb.com>, <facebookinwpv.com>, <facebookmy.com>, <facebookpopcom.com>, <facebookpopshop.com>, <facebookpopular.com>, <facebookpopweb.com>, <myweboffacebook.com>, <thenetfacebook.com>, <thewebbofacebook.com>, <thewebfacebook.com>, <theweboffacebook.com>, and <weboffacebook.com> were registered on December 23, 2021.

On March 28, 2022, the Complainant's lawyers, submitted the Registrar's registrant contact form for each of the disputed domain names to reach out to the Respondent. The Respondent never responded to these messages.

At the time of filing of this dispute all the disputed domain names redirected to the same online shopping site purportedly offering various products for sale.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain names are confusingly similar to the trademarks in which it has rights. The fact that the disputed domain names wholly incorporate the Complainant's FACEBOOK

trademarks is sufficient to establish confusing similarity between the disputed domain names and the Complainant's trademarks.

In the present case, the Complainant's FACEBOOK trademarks are clearly recognizable as the leading elements of the disputed domain names. It is well established in previous UDRP decisions that, where the relevant trademarks are recognizable within the disputed domain names, the addition of other elements, such as terms (e.g., "my", "web" and "popular") and letters, would not prevent a finding of confusing similarity under the first element.

The Complainant further submits that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent is not a licensee of the Complainant, nor has he been otherwise authorized or allowed by the Complainant to make any use of its FACEBOOK trademarks, in a domain name or otherwise.

The Respondent cannot assert that, prior to any notice of this dispute, he was using, or had made demonstrable preparations to use, the disputed domain names in connection with a *bona fide* offering of goods or services in accordance with paragraph 4(c)(i) of the Policy. The Respondent is using the disputed domain names, which are confusingly similar to the Complainant's FACEBOOK trademarks, to redirect Internet users to an online shopping site purportedly offering various products for sale, from which the Respondent or a third party presumably derives or attempts to derive revenue.

The Respondent cannot conceivably claim that he is commonly known by the disputed domain names in accordance with paragraph 4(c)(ii) of the Policy. The Respondent's name, Lanny Kapetz, bears no resemblance to the disputed domain names. To the best of the Complainant's knowledge, the Respondent has never secured or attempted to secure any trademark rights for FACEBOOK. Furthermore, the Respondent's use of the disputed domain names to redirect traffic to a commercial site does not support any legitimate claim of being commonly known by the disputed domain names and cannot give rise to any reputation in the disputed domain names themselves, independent of the Complainant's trademark rights.

The Respondent's website is clearly intended to be commercial in nature. As such, the Respondent is not making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain to misleadingly divert consumers, pursuant to paragraph 4(c)(iii) of the Policy.

The Complainant finally asserts that the disputed domain names were registered and are being used in bad faith.

The Complainant's FACEBOOK trademark is highly distinctive and famous throughout the world (including in Canada where the Respondent is based) and has been continuously and extensively used since 2004. All the results obtained by typing FACEBOOK in the Google search engine available at "www.google.com" and "www.google.ca" refer to the Complainant. The Complainant therefore submits that it is inconceivable for the Respondent to argue that he was not aware of the Complainant's FACEBOOK trademark when registering the disputed domain names in 2021. The Complainant further submits that the Respondent has engaged in a pattern of conduct by registering not only 27 disputed domain names but also other disputed domain names targeting the Complainant's and well-known third-party trademarks, which clearly indicates bad faith. In addition, the fact that 25 disputed domain names have been registered through a privacy registration service is another indication of the Respondent's bad faith and his intent to use these disputed domain names in a way which may be abusive or otherwise detrimental to the Complainant and its rights.

The Complainant also submits that the Respondent is using the disputed domain names to intentionally attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's trademarks as to the source, sponsorship, affiliation, or endorsement of the website, in accordance with paragraph 4(b)(iv) of the Policy. As described, the Respondent is using the disputed domain names, which are confusingly similar to the Complainant's FACEBOOK trademarks, to redirect Internet users to an online shopping site purportedly offering various products for sale, from which the Respondent or a third party presumably derives or attempts to derive revenue. The Complainant submits

that such use of the disputed domain names to attract traffic to a commercial website, obviously for commercial gain, is recognized by prior panels as strong evidence of bad faith in accordance with paragraph 4(b)(iv) of the Policy as the Respondent is clearly seeking to unduly profit from the Complainant's reputation and goodwill.

As a final point, the Complainant submits that the Respondent's failure to respond to the messages sent by the Complainant's lawyers via the Registrar's registrant contact forms also indicates bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 15(a) of the Rules the Panel shall decide the Complaint in accordance with the Policy, the Rules and any rules and principles of law that it deems applicable.

Paragraph 4(a) of the Policy directs that a complainant must prove each of the following:

- (i) that the domain names registered by the respondent are identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) that the respondent has no rights or legitimate interests in respect of the domain names; and
- (iii) that the domain names have been registered and are being used in bad faith.

Paragraph 4(a) of the Policy states that the burden of proving that all these elements are present lies with the Complainant. At the same time, in accordance with paragraph 14(b) of the Rules, if a party, in the absence of exceptional circumstances, does not comply with any provision of, or requirement under, the Rules, or any request from the Panel, the Panel shall draw such inferences therefrom as it considers appropriate.

A. Identical or Confusingly Similar

The Panel finds that the disputed domain names are confusingly similar (in the sense of the Policy) to the Complainant's registered trademark FACEBOOK. The disputed domain names all incorporate this mark in its entirety with the addition of different terms or letter strings as prefixes or suffixes.

Where the Complainant's trademark is recognizable within the disputed domain names, the addition of other terms or letter strings would not prevent a finding of confusing similarity to the complainant's mark under the first element. See section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Furthermore, the addition of the gTLD ".com" or ".org" does not prevent a finding of confusing similarity under the first element test. See section 1.11.1 of the [WIPO Overview 3.0](#).

The Panel finds that the conditions in paragraph 4(a)(i) of the Policy are therefore fulfilled in relation to the disputed domain names.

B. Rights or Legitimate Interests

It is clear from the facts of the case that the Complainant has not licensed or otherwise permitted the Respondent to use its trademark and given the circumstances of this case, the Panel finds that the Complainant has established a *prima facie* case that the Respondent has no rights or legitimate interests in

the disputed domain names.

The Respondent has not produced, and there is no evidence of the types of circumstances set out in paragraph 4(c) of the Policy that might give rise to rights or legitimate interests in the disputed domain names on the part of the Respondent in these proceedings. This view is supported by the fact that the disputed domain names have been used to redirect to a third-party online shopping site that purportedly offers various products for sale. See section 2.5.3 of the [WIPO Overview 3.0](#).

Consequently, the Panel finds that the condition in paragraph 4(a)(ii) of the Policy is also fulfilled.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires the Complainant to prove both registration and use of the disputed domain names in bad faith. Paragraph 4(b) of the Policy provides examples of circumstances which shall be evidence of registration and use in bad faith:

- (i) circumstances indicating that the respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is 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) the respondent has 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) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, the respondent has intentionally attempted 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 the respondent's website or location.

Accordingly, for the Complainant to succeed, the Panel must be satisfied that the disputed domain names have been registered and are being used in bad faith.

Given the circumstances of the case, including the evidence on record of the use and worldwide reputation of the Complainant's trademark FACEBOOK and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the disputed domain names without prior knowledge of the Complainant and the Complainant's mark.

The Panel therefore finds that the disputed domain names were registered in bad faith.

As described above, at the time of filing of this dispute, all the disputed domain names redirected to a third-party online shopping site purportedly offering various products for sale and from which the Respondent or a third party may be able to derive revenue. It thus seems evident that the Respondent's intent in registering the disputed domain names was to profit from or otherwise exploit the Complainant's widely reputed trademark. This is supported by the fact that the Respondent by registering all the 27 disputed domain names has been engaged in a pattern of abusive registrations. See section 3.1.1 of the [WIPO Overview 3.0](#). That some of the disputed domain names appears to be deactivated after the filing of the Complaint does not alter the Panels finding of bad faith use. As first stated in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and repeated in many subsequent decisions under the UDRP: "the concept of a domain name 'being used in bad faith' is not limited to positive action; inaction is within the

concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith.” See section 3.3 of the [WIPO Overview 3.0](#).

Noting that the disputed domain names incorporate the Complainant’s distinctive and reputed trademark FACEBOOK, that no Response has been filed, and that there appears to be no conceivable good faith use that could be made by the Respondent of the disputed domain names and considering all the facts and evidence of the case, the Panel finds that the requirements of paragraph 4(a)(iii) of the Policy are also fulfilled in this case.

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, <facebookard.com>, <facebookednow.com>, <facebookedpro.com>, <facebookedweb.com>, <facebookerd.com>, <facebookerdnow.com>, <facebookerd.org>, <facebookerdpro.com>, <facebookerds.com>, <facebookerr.com>, <facebookine.com>, <facebookinewpv.com>, <facebookinpro.com>, <facebookinshop.com>, <facebookinweb.com>, <facebookinwpv.com>, <facebookmy.com>, <facebookpopcom.com>, <facebookpopshop.com>, <facebookpopular.com>, <facebookpopweb.com>, <myweboffacebook.com>, <thenetfacebook.com>, <thewebbofacebook.com>, <thewebfacebook.com>, <theweboffacebook.com>, and <weboffacebook.com> be transferred to the Complainant.

/Knud Wallberg/

Knud Wallberg

Sole Panelist

Date: September 16, 2022