

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc. v. Domains By Proxy, LLC / Ashley Chong-Scott Case No. D2022-1603

1. The Parties

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

The Respondent is Domains By Proxy, LLC, United States / Ashley Chong-Scott, United States.

2. The Domain Name and Registrar

The disputed domain name <makefacebookreels.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2022. On May 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 4, 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 May 6, 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 May 10, 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 May 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 31, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on June 7, 2022.

The Center appointed William R. Towns as the sole panelist in this matter on June 14, 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 Meta Platforms, Inc. (formerly Facebook, Inc.), a social technology company founded in Menlo Park, California, United States, and a well-known provider of networking services. The Complainant operates Facebook, Instagram, and WhatsApp. The Complainant's Facebook platform was founded in 2004. The Complainant more recently has launched its "Reels" product on Facebook. The Complainant's "Reels" product is now available in the United States and in 150 other countries.

The Complainant is the owner of numerous trademark registrations for its FACEBOOK mark issued in the US, European Union, and in other jurisdictions, including among the following:

- US Registration No. 3041791, applied for February 24, 2005, and registered January 10, 2006;
- European Union Trade Mark (EUTM) Registration No. 005585518, applied for December 12, 2006, and registered May 25, 2011; and
- International Registration No. 1075094, registered July 16, 2010 (designating multiple jurisdictions).

The Complainant has experienced substantial growth since it first began offering online networking services under the FACEBOOK mark, growing from 1 million active users by the end of 2004 to 2.27 billion users as of September 2018, and on average 1.93 billion daily average users as of December 2021. The Complainant's website "www.facebook.com" is consistently ranked among the most visited websites in the world, and 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](#). The Complainant has registered numerous domain names as well reflecting its FACEBOOK mark.

UDRP panels also have acknowledged the considerable reputation of the Complainant's FACEBOOK mark. See, e.g., *Facebook, Inc. v. Domain Administrator, PrivacyGuardian.org / Hernando Sierra*, WIPO Case No. [D2018-1145](#). The Complainant's FB trademark is also an abbreviated version of the of its FACEBOOK mark, and has been recognized as such by UDRP panels. See, e.g., *Facebook, Inc. v. Kim Changho*, WIPO Case No. [D2019-1432](#).

The disputed domain name was registered by the Respondent on December 14, 2021, according to the registrar's Whois database. The Complainant upon becoming aware of the disputed domain name sought to contact the Respondent on March 16, 2022, utilizing the Registrar's contact form; however, the Respondent did not reply. Insofar as the record reflects, the disputed domain name at the time of submission of the Complaint and presently does not resolve to any active website.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain name is confusingly similar to the Complainant's FACEBOOK mark. The Complainant calls attention to its numerous FACEBOOK trademark registrations in jurisdictions around the world, which the Complainant represents satisfies *prima facie* the threshold requirement of holding trademark rights for purposes of standing. The Complainant further adds that the

mere presence of its FACEBOOK mark in the disputed domain name is demonstrative of the confusing similarity between the disputed domain name and the Complainant's mark. The Complainant emphasizes that the Respondent's inclusion in the disputed domain name of the terms "make" and "reels" bracketing the Complainant's FACEBOOK mark does not preclude a finding of confusing similarity under the first element of the Policy. The Complainant further explains that the generic Top Level Domain ("gTLD") ".com" may be disregarded for purposes of assessing confusing similarity, and is viewed as a standard requirement of registration.

The Complainant maintains that the Respondent has no rights or legitimate interests in respect of the disputed domain name, and avers that the Respondent has not been commonly known by the disputed domain name. The Complainant further asserts that the Respondent is neither a licensee of the Complainant nor otherwise affiliated with the Complainant. The Complainant maintains that the Respondent is unable to invoke any circumstances set forth in paragraph 4(c) of the Policy that would demonstrate rights or legitimate interests in the disputed domain name.

The Complainant further observes that the disputed domain name does not resolve to an active website, and submits there is no evidence that the Respondent has either used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. According to the Complainant, the Respondent is not making any legitimate noncommercial or other fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers. The Complainant further notes that the Respondent's use of the disputed domain name can never be fair if it falsely suggests affiliation with the Complainant.

The Complainant maintains that the disputed domain name currently is being directed by the Respondent to an inactive website and passively held. The Complainant emphasizes that the Respondent's passive holding of the disputed domain name does not constitute a legitimate noncommercial or other fair use of the disputed domain name, citing *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#), and contends that Internet users are likely to be misled as to the sources of the disputed domain name, citing *Facebook, Inc. v. kadir eren, software*, WIPO Case No. [D2021-3335](#).

The Complainant submits that the disputed domain was registered by the Respondent and is being used in bad faith. The Complainant maintains that the Complainant's FACEBOOK mark has been extensively and continuously used since as early as 2004, and is highly distinctive and famous throughout the world. The Complainant observes that UDRP panels have repeatedly recognized the strength and renown of the Complainant's FACEBOOK mark, citing *Facebook, Inc. v. Franz Bauer*, WIPO Case No. [D2010-1247](#).

The Complainant finds it almost inconceivable that the Respondent could have been unaware of the Complainant's famous FACEBOOK mark when registering the disputed domain name. To the contrary, the Complainant asserts the Respondent could not credibly argue that it lacked knowledge of the Complainant and the Complainant's FACEBOOK mark when registering the disputed domain name. The Complainant maintains that the Respondent's intent to target the Complainant is informed from the inclusion of the element "Reels", referring to a product launched by the Complainant a short time before the Respondent's registration of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

A. Scope of the Policy

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 “cybersquatting”. *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 rights or legitimate interests 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](#).

B. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant’s distinctive and well-known FACEBOOK mark. 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 name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7.

In this case, the Complainant’s FACEBOOK mark is clearly recognizable in the disputed domain name.¹ When the relevant trademark is recognizable in the disputed domain name, 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.² Top Level Domains (“TLDs”) generally are disregarded when evaluating the identity or confusing similarity of the complainant’s mark to the domain

¹ See WIPO Overview 3.0, section 1.8 and cases cited therein.

² *Id.*

name under paragraph 4(a)(i) of the Policy, irrespective of any ordinary meaning that might be ascribed to the TLD.³

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

C. 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 mark. Nevertheless, the Respondent has registered the disputed domain name, which appropriates the Complainant's FACEBOOK mark in its entirety. The disputed domain name by all appearances has not been used or otherwise associated with a website.

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 name 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 or demonstrated preparations to use the disputed domain name in connection with a *bona fide* offering 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 name 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 name within the meaning of paragraph 4(c)(ii) of the Policy. In short, nothing in the record supports a claim by the Respondent of rights or legitimate interests in the disputed domain name.

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

D. 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:

³ See WIPO Overview 3.0, section 1.11.

- (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 name 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 name 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 FACEBOOK mark in mind when registering the disputed domain name. The Respondent in all likelihood registered the disputed domain name seeking to exploit and profit from the Complainant's FACEBOOK mark. The Panel's finding is reinforced given the launch of the Complainant's "Reels" product a few months before the Respondent's registration of the disputed domain name.

The Respondent's apparent passive holding of the disputed domain name does not preclude a finding of bad faith in the attendant circumstances of this case. As set forth in *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*, "the relevant issue is not whether the Respondent is taking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. [...] [I]t is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith". See also *Red Bull GmbH v. Kevin Franke*, WIPO Case No. [D2012-1531](#).

The Panel considers the following circumstances to be indicative of the Respondent's bad faith under *Telstra Corporation Limited v. Nuclear Marshmallows*, *supra*. As previously noted, the Complainant's FACEBOOK mark is distinctive and well known. It is evident that the Respondent was aware of the Complainant's FACEBOOK mark when registering the disputed domain name. Absent any explanation from the Respondent, the Panel cannot conceive of any plausible good faith use of the disputed domain name that could be made by the Respondent.

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 name <makefacebookreels.com> be transferred to the Complainant.

/William R. Towns/

William R. Towns

Sole Panelist

Date: June 29, 2022