

## **ADMINISTRATIVE PANEL DECISION**

Meta Platforms, Inc. v. Saida Yakubova

Case No. D2023-1029

### **1. The Parties**

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

The Respondent is Saida Yakubova, Kazakhstan.

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

The disputed domain name <myfbdownloader.com> is registered with Wild West Domains, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 8, 2023. On March 8, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 9, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 10, 2023, 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 March 17, 2023.

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 March 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 9, 2023. The Respondent did not submit any formal response, however the Center received an informal communication from a third party on March 22, 2023. Accordingly, the Center notified the parties of the Panel Appointment Process on April 12, 2023.

The Center appointed Andrea Mondini as the sole panelist in this matter on April 18, 2023. 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 which operates, *inter alia*, Facebook, Instagram, Meta Quest (formerly Oculus) and WhatsApp. Founded in 2004, the Complainant's Facebook platform, commonly also referred to as "FB", is amongst the leading providers of online social-media and social-networking services.

The Complainant owns several registrations for the trademark FB, *inter alia*, the European Union Trademark No. 008981383, registered on August 23, 2011, and the United States Trademark Registration No. 4659777, registered on December 23, 2014.

The Complainant also holds several domain names, including the domain names <fb.com> and <facebook.com>.

The disputed domain name was registered on March 13, 2022.

The disputed domain name resolves to a website which purports to provide a tool to download videos from Facebook and makes prominent reference to the Complainant's FACEBOOK and FB trademarks.

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

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

The Complainant contends as follows:

The term FB commonly refers to Facebook. The disputed domain name is confusingly similar to the FB trademark in which the Complainant has rights, because it incorporates this trademark in its entirety, and the addition of the descriptive words "my" and "downloader" is not sufficient to avoid confusing similarity.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not a licensee of the Complainant, nor has the Respondent been authorized by the Complainant to make any use of its FB trademark, in a domain name or otherwise. The Respondent's website contains prominent links that redirect Internet users to a third-party website, which offers tools for the searching, viewing, and downloading of content, *inter alia*, from Instagram, without using an Instagram account. The Complainant submits that the provision of such tools violates the Complainant's Meta Developer Policies and the Instagram Terms of Use. The Respondent is not a *bona fide* service provider in that it is not providing services for the proper use of the Complainant's product. Rather, the Respondent is making an unauthorized use of the Complainant's trademarks in order to offer services that facilitate unauthorized downloading of content from the Complainant's platform. Moreover, the Respondent's website does not accurately and prominently disclose its lack of relationship with the Complainant. Therefore, the Respondent is not making a *bona fide* use of the disputed domain name pursuant to paragraph 4(c)(i) of the Policy.

The disputed domain name was registered and is being used in bad faith because it is clear that the Respondent intended to target the Complainant and its trademarks, since the contents of the Respondent's website makes explicit references to Facebook and FB, and because the Respondent's website includes prominent links that redirect Internet users to another website which offers tools for the unauthorized downloading of content from Facebook and Instagram, going beyond the technical limits that have been placed on the platforms, in violation of the Meta Developer Policies.

## B. Respondent

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

On March 22, 2023, the Center received an email from the third party operating the third party website mentioned in Section 5A above, stating in essence that it has no connections with the disputed domain name and its owners. The third party states that it has contacted the owners of the disputed domain name in a request that the disputed domain name no longer includes links to the third party's website.

## 6. Discussion and Findings

According to paragraph 4(a) of the Policy, in order to succeed, a complainant must establish each of the following elements:

- (i) the disputed domain name is identical or confusingly similar to the trademark or service mark in which the complainant has rights;
- (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

The Panel is satisfied that the Complainant owns trademark registrations for its FB trademark.

The Panel notes that the disputed domain name incorporates the FB trademark in its entirety. The addition of the terms words "my" and "downloader" does not prevent a finding of confusing similarity under Policy, paragraph 4(a)(i). See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8. See also *Meta Platforms, Inc. v. Stefano Grossi, Grossi Consulting LLC*, WIPO Case No. [D2022-2715](#).

The addition of the generic Top-Level Domain ".com" in the disputed domain names is a standard registration requirement and as such is disregarded under the confusing similarity test under Policy, paragraph 4(a)(i). See [WIPO Overview 3.0](#), section 1.11.

For these reasons, the Panel concludes that the disputed domain name is confusingly similar to the Complainant's mark FB.

The first element of paragraph 4(a) of the Policy has been met.

### B. Rights or Legitimate Interests

The Complainant states that the Respondent is not a licensee of the Complainant and that the Respondent been not authorized by the Complainant to make any use of its FB trademark, in a domain name or otherwise. The Panel does not see any contrary evidence from the record.

The Respondent's website contains prominent links that redirect Internet users to another third-party website which offers tools for the searching, viewing, and downloading of content, *inter alia*, from Instagram, without using an Instagram account. The Complainant submits that the provision of such tools violate the Complainant's Meta Developer Policies and the Instagram Terms of Use. Prior UDRP panels have held that such use does not amount to a *bona fide* offering of goods or services. See *Facebook, Inc. v. Domain Administrator, PrivacyGuardian.org / Hernando Sierra*, WIPO Case No. [D2018-1145](#). See also *Facebook, Inc. v. Batyi Bela, Whois privacy services, provided by DomainProtect*, WIPO Case No. [D2020-2683](#).

Prior panels have recognized that service providers using a domain name containing a third-party trademark may be making a *bona fide* offering of goods or services and thus have a legitimate interest in such domain name. Whether or not this is the case is typically measured against the list of factors set out in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (the “Oki Data criteria”):

- (i) The respondent must actually be offering the goods or services at issue;
- (ii) The respondent must use the site to sell only the trademarked goods or services;
- (iii) The site must accurately and prominently disclose the registrant's relationship with the trademark holder; and
- (iv) The respondent must not try to “corner the market” in domain names that reflect the trademark.

In the present case, the Panel is of the view that the Respondent fails to fulfil the first of the Oki Data criteria, because it is making an unauthorized use of the Complainant's trademarks beyond the technical limits that the Complainant placed on its platforms, in order to offer services that facilitate unauthorized downloading of content from the Complainant's platform, in violation of the Complainant's policies and terms of use identified above.

Moreover, in the Panel's view the Respondent's website fails to meet the third of the Oki Data criteria, because it does not accurately and prominently disclose its lack of relationship with the Complainant. Therefore, the Respondent is not making a *bona fide* use of the disputed domain name pursuant to paragraph 4(c)(i) of the Policy.

In the view of the Panel, the Complainant has succeeded in raising a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. For its part, the Respondent failed to provide any explanations as to any rights or legitimate interests. Therefore, the Panel finds that the Respondent does not have any rights or legitimate interests in the disputed domain name.

The second element of paragraph 4(a) of the Policy has been met.

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

The Complainant has shown to the satisfaction of the Panel that its FB trademark is well known as the short form of its famous FACEBOOK trademark.

In the view of the Panel, noting that the Complainant's trademark predates the registration of the disputed domain name and the fact that the contents of the Respondent's website makes explicit references to the Complainant's Facebook and FB, it is inconceivable that the Respondent could have registered the disputed domain name without knowledge of the Complainant's well-known trademarks. In the circumstances of this case, this is evidence of registration in bad faith.

The Respondent's website includes prominent links that redirect Internet users to another third-party website which offers tools for the unauthorized downloading of content from Facebook and Instagram going beyond the technical limits that have been placed on the platforms, in violation of the Meta Developer Policies. The Panel thus finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its websites by creating a likelihood of confusion as to the source, sponsorship or affiliation of its website in the sense of paragraph 4(b)(iv) of the Policy.

The Panel thus finds that the disputed domain name was registered and is being used in bad faith.

The third element of paragraph 4(a) of the Policy has been met.

## 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, <myfbdownloader.com>, be transferred to the Complainant.

*/Andrea Mondini/*

**Andrea Mondini**

Sole Panelist

Date: April 24, 2023