

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc. v. carlos nathan

Case No. D2023-1899

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 carlos nathan, United States.

2. The Domain Name and Registrar

The disputed domain name <facebook.shiksha> (the “Domain Name”) is registered with Tucows, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 27, 2023. On April 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 27, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name that differed from the named Respondent (Contact Privacy Inc. Customer 0150293261) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 28, 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 May 2, 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 May 12, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 1, 2023. The Respondent did not submit a response by the due date. Accordingly, the Center notified the Respondent’s default on June 2, 2023. After this notification of default, the Respondent sent emails to the Center that were not in the language of the proceeding, except for a few statements and two one-sentence inquiries about the status of the proceeding, which did not address any of the allegations in the Complaint.

The Center appointed A. Justin Ourso III as the panelist in this matter on June 23, 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, an American social technology company, operates the well-known Facebook social-media and social-networking service, which has over two billion daily active users, on average, worldwide.

The Complainant owns a United States registration issued on January 10, 2006, No. 3,041,791, for its FACEBOOK mark with a first use in Class 38 in 2004 for “providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking”; another United States registration issued on July 25, 2006, No. 3,122,052, for its FACEBOOK mark with a first use in Class 38 in 2004 for the same services; a Canadian registration issued on January 21, 2009, No. TMA732799 for its FACEBOOK mark, with a priority filing date in 2005 in Classes 35, 38, 39, 41, and 45 for “(1) Providing an online directory information service featuring information regarding, and in the nature of, collegiate life, classifieds, virtual community and social networking, and (2) Providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking,” among other registrations, including an European Union registration for its FACEBOOK mark and an international registration for a figurative FACEBOOK mark.

Among others, the Complainant, or its predecessor, Facebook, Inc., is the registrant for the domain names <facebook.com>, which it registered on March 29, 1997; <facebook.biz>, which it registered on September 11, 2005; <facebook.us>, which it registered on May 5, 2004; <facebook.ca>, which it registered on January 26, 2005; and <facebook.mx>, which it registered on May 14, 2009, among many others that consist of its FACEBOOK mark and a generic Top-Level Domain (“gTLD”).

The Respondent registered the Domain Name on January 5, 2018, without any authorization from the Complainant. At the filing of the Complaint and during the preparation of this Decision it resolved to a landing page with a notice that the site was under construction.

5. Parties’ Contentions

A. Complainant

In addition to facts set forth in the Factual Background in Part 4 above, the Complainant contends the following.

Regarding the element of confusing similarity with a trademark in which it has rights, the Complainant contends that it owns numerous national and regional trademark registrations worldwide for its FACEBOOK trademark and, therefore, has established trademark rights under the Policy; the Domain Name is identical to its mark; and the gTLD “.shiksha” may be disregarded under the first element.

Regarding the element of rights or legitimate interests in the Domain Name, among other contentions, the Complainant contends that it has not licensed or otherwise authorized the Respondent to use its trademark; the Respondent is not using but is passively holding the Domain Name with the associated website in an inactive state, which is not a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use; the Respondent has not replied to the Complainant’s demand letter with a claim that it is preparing to use the Domain Name for any legitimate purpose or with a claim to any legitimate noncommercial or fair use; the Respondent registered the Domain Name using a privacy service; neither the registrant data for the Domain Name nor the Respondent’s lack of use of the Domain Name supports that the Respondent is known by the Domain Name; no evidence shows that the Respondent has applied for a trademark registration for the term “facebook” or any variation of this term; because the Domain Name is identical to the

Complainant's well-known mark, a high risk is present that the Domain Name will mislead Internet users into thinking that it is affiliated with the Complainant; and, accordingly, the Complainant has established a *prima facie* showing that the Respondent lacks rights or legitimate interests in the Domain Name.

Regarding the element of bad faith registration and use of the Domain Name, among other contentions, the Complainant contends that its trademark is distinctive, with worldwide fame that has been recognized by prior UDRP panels; its trademark registrations predate the registration of the Domain Name; it is implausible that the Respondent did not have prior knowledge of the Complainant's trademark; the Respondent registered the Domain Name, which carried a high risk of affiliation, without authorization, to create a misleading impression of association with the Complainant in bad faith; the Domain Name resolves to a "website under construction" web page, a passive use that does not prevent a finding of bad faith; because of the Complainant's long and widespread use, its trademark is exclusively associated with the Complainant; the Respondent has not replied to the Complainant's demand letter with evidence of actual or contemplated good faith use or preparation to use the Domain Name in connection with a *bona fide* offering; the Respondent's address disclosed by the Registrar is inaccurate or false; and the Domain Name has a high risk of misleading affiliation with the Complainant, such that no *bona fide* use is plausible, all of which show bad faith under the passive holding doctrine; any use of the Domain Name would be misleading, so the Domain Name is a continuing abusive threat hanging over the Complainant; and, accordingly, the Respondent registered and is using the Domain Name in bad faith.

The Complainant requested transfer of the Domain Name.

B. Respondent

The Respondent did not submit a response to the Amended Complaint by the date specified in the Rules. The Respondent sent several emails to the Center after the response deadline, which were in Arabic, a language other than the language of the registration agreement—which is English—except for a few statements and inquiries to the Center that were in English. The English text in these emails did not respond to the Complaint or address any of the allegations in the Complaint in accordance with the Rules. In Arabic text, the Respondent alleged that it bought the Domain Name for work. After the Center sent Notification of the Complaint to the Respondent, the Respondent tried to change the status of the Domain Name, but could not, because the Registrar had locked the Domain Name.

6. Discussion and Findings

The Elements of a Claim

A complainant must prove three elements to obtain relief: (i) the domain name is identical or confusingly similar to a trademark in which the complainant has rights; (ii) the respondent has no rights or legitimate interests in the domain name; and (iii) the respondent registered and is using the domain name in bad faith. Policy, paragraph 4(a).

(i). Identical or Confusingly Similar

On the first element, the Panel finds that the Domain Name <facebook.shiksha> is identical to a trademark in which the Complainant has rights, its registered FACEBOOK trademark. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1. Unless it contributes to confusing similarity, UDRP panels disregard the gTLD in determining confusing similarity. [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel concludes that the Complainant has proven the first element: the Domain Name is identical to a trademark in which it has rights.

(ii). Rights or Legitimate Interests

The Respondent has not claimed the existence of any circumstance under the Policy, paragraph 4(c), that demonstrates that a respondent has rights to, or legitimate interests in, a domain name. The Complainant, on the other hand, has shown that it established its trademark rights before the Respondent registered the Domain Name, it has not authorized the Respondent to use its trademarks, no evidence exists that the Respondent is known by the Domain Name, and the Respondent is passively holding the Domain Name, which does not resolve to a functioning site. These constitute *prima facie* a showing that the Respondent lacks any rights or legitimate interests in the Domain Name under the Policy, paragraph 4(a)(ii), shifting the burden of production on this second element to the Respondent to come forward with relevant evidence proving rights or legitimate interests in the domain name. [WIPO Overview 3.0](#), section 2.1. The Respondent has not submitted any evidence to rebut the *prima facie* showing.

Additionally, the Panel finds that the Respondent masked its identity by using a privacy service; the Registrar identified the Registrant as “carlos nathan,” which does not resemble the Domain Name, and provided an email address for the Respondent that do not resemble the Domain Name, which corroborate that the Respondent is not known by the Domain Name; the Respondent provided an incomplete address to the Registrar; the Respondent failed to respond to the Complainant’s demand letter, to submit a response to the Complaint by the deadline, or to provide any evidence of an actual or a planned *bona fide* commercial use, a noncommercial use, or a fair use of the Domain Name. The Panel further finds that the Domain Name being identical to the Complainant’s trademark carries a high risk of implied affiliation. [WIPO Overview 3.0](#), section 2.5.1.

Accordingly, the Panel concludes that the Complainant has proven the second element: the Respondent lacks rights or legitimate interests in the Domain Name.

(iii). Registered and Used in Bad Faith

The Domain Name is identical to the Complainant’s globally famous FACEBOOK trademark. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a well-known trademark can create a presumption of bad faith registration. [WIPO Overview 3.0](#), section 3.1.4. The Respondent has not even attempted to rebut this presumption.¹ The Panel finds that the Respondent must have been aware of the Complainant’s trademark and of the Complainant’s rights in its mark at the time that the Respondent registered the Domain Name. Rules, paragraph 14(b); [WIPO Overview 3.0](#), section 3.2.2.

Additionally, in view of the Complainant’s allegations that it has not authorized the Respondent to use its mark and that no *bona fide* use of the Domain Name is plausible, the Respondent’s failure to explain the choice of a domain name, coupled with an absence of rights or legitimate interests, tends to show bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The Domain Name does not resolve to an active, functioning website. However, UDRP panels have consistently found that non-use of a domain name would not prevent a finding of bad faith, under the doctrine of passive holding, when other elements are present that demonstrate bad faith. [WIPO Overview 3.0](#), section 3.3.

All these findings above, collectively, compel the Panel to conclude that the Respondent intentionally registered the Domain Name in bad faith to take unfair advantage of the Complainant’s trademark and that the Respondent is using the Domain Name in bad faith, in violation of the Policy, paragraph 4(b). [WIPO Overview 3.0](#), sections 3.2.1, 3.2.2, and 3.3.

¹ See Part 3 and Part 5(b), *supra*, regarding emails that the Respondent sent to the Center after the due date and in a language other than the language of this proceeding. Rules, paragraphs 2(d), 5, and 11.

Accordingly, the Panel concludes that the Complainant has proven the third element: the Respondent registered and is using the Domain Name in bad faith.

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 Domain Name <facebook.shiksha> be transferred to the Complainant.

/A. Justin Ourso III/

A. Justin Ourso III

Panelist

Date: July 7, 2023