

DISPUTE RESOLUTION SERVICE

D00016992

Decision of Independent Expert

Facebook, Inc.

and

Steven Cameron

1. The Parties

Complainant: Facebook, Inc.
1601 Willow Road
Menlo Park
California
94025
United States

Respondent: Mr Steven Cameron
Bognor Regis Campus
Bognor Regis
PO21 1HR
United Kingdom

2. The Domain Name

thefacebook.co.uk

3. Procedural History

- 3.1 I confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.
- 3.2 The complaint was received by Nominet on 22 January 2016. On 25 January 2016 the complaint was validated and notification of it sent to the parties. On 11 February 2016 a response reminder was sent. On 16 February 2016 the response was received and notification of it sent to the parties. On 19 February 2016 a reply reminder was sent, the reply received and notification of it sent to the parties. On the same day the mediator was appointed and the mediation started. On 14 March 2016 the mediation failed. On 17 March 2016 close of mediation documents were sent. On 31 March 2016 a Complainant full fee reminder was sent and the Expert decision payment received.

4. Factual Background

- 4.1 The Complainant is a well known provider of online social networking services from the site at facebook.com. The Complainant was founded in 2004 and originally launched as “The Facebook” at thefacebook.com (this domain name now redirects to facebook.com) and since then has experienced extensive growth.
- 4.2 The Complainant has made the following submissions of fact which I accept having regard to the Complainant’s evidence in support and taking into account that the Respondent has not challenged these submissions or adduced any evidence to the contrary.
- (a) The Complainant is the world’s leading provider of online social networking services. It had 1 million active users by the end of 2004, 100 million users in August 2008, 500 million users in July 2010 and 1 billion users worldwide by September 2012.
 - (b) The Complainant had more than 1.55 billion monthly active users, half of the world’s estimated online population, and 1.01 billion daily active users worldwide as of September 2015.
 - (c) Approximately 83.5% of the Complainant’s daily active users are outside the US and Canada. The Complainant provides its social networking services in more than 70 languages.
 - (d) In the UK the Complainant had 33 million monthly active users and 24 million daily active users in 2013 and over 37 million monthly active users in 2015.
 - (e) The Complainant had 1.39 billion mobile monthly active users and 894 million mobile daily active users as of September 2015. In 2013 the majority of the Complainant’s users in the UK, four out of five of the 24 million who logged on each day, accessed the Complainant’s online services via a mobile device.
 - (f) The Complainant’s main web site at facebook.com is currently ranked as the 2nd most visited site in the UK and in the world by web information company Alexa.
 - (g) In 2015 the FACEBOOK brand was ranked 23rd, up from 29th in 2014 and 52nd in 2013, in Interbrand’s Best Global Brands report.
 - (h) The Complainant has revenues reaching USD 12.5 billion, an increase of 58% year-over-year.
- 4.3 The Complainant is the owner of an extensive number of domain names which incorporate ‘facebook’. The Complainant is also the owner of a number of registered trade marks including:
- (a) Community Trade Mark Number 004554614 for THEFACEBOOK registered on 2 August 2006;
 - (b) Community Trade Mark Number 004535381 for FACEBOOK registered on 22 June 2011;
 - (c) Community Trade Mark Number 005585518 for FACEBOOK registered on 25 May 2011;
 - (d) US Trade Mark No 3041791 for FACEBOOK registered on 10 January 2006;
 - (e) US Trade Mark No 3122052 for FACEBOOK registered on 25 July 2006; and
 - (f) International Trade Mark No.1075094 for FACEBOOK registered on 16 July 2010.

4.4 The Domain Name was registered on 7 January 2015. It does not resolve to a web site. On 20 February 2015 the Complainant's representatives, Hogan Lovells, wrote to the Respondent seeking the transfer of the Domain Name to the Complainant. No response was received to this letter.

5. Parties' Contentions

5.1 I set out below a summary of what I regard to be the main contentions of the Parties.

The Complainant's complaint

5.2 The Complainant asserts that it has Rights in the terms FACEBOOK and THE FACEBOOK based on its registered and unregistered trade mark rights in these terms in many jurisdictions, including the European Union and the United Kingdom. The Complainant relies on its trade mark registrations set out at paragraph 4.3 above.

5.3 The Complainant further asserts that it has Rights in respect of a name or mark which is identical or similar to the Domain Name. The Complainant says the Domain Name incorporates its FACEBOOK and THE FACEBOOK trade marks in their entirety and that prior Nominet Experts have held that when a domain name wholly incorporates a trade mark this is sufficient to establish identity or similarity.

5.4 The Complainant argues that the Domain Name was registered in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights in accordance with paragraph 1(i) of the Nominet Dispute Resolution Service Policy ("the Policy").

(a) The Complainant submits that it has not authorised, licensed or otherwise allowed the Respondent to use its FACEBOOK or THE FACEBOOK trade marks in a domain name or otherwise. The Complainant says the Respondent is not connected to it in any manner.

(b) The Complainant further submits that the Respondent registered the Domain Name in full knowledge of the Complainant and its Rights, with the intention of opportunistically and unfairly taking advantage of the Complainant's goodwill and renown.

(c) The Complainant says FACEBOOK and THE FACEBOOK have been used extensively since 2004 and rapidly acquired considerable goodwill and renown throughout the world in connection with social networking services. The Complainant states that given the strength and renown of these trade marks it is inconceivable that the Respondent did not have knowledge of the Complainant and its Rights at the time of registration of the Domain Name in 2015 over 10 years after the Complainant first launched its services.

(d) The Complainant states that prior domain name dispute panels have acknowledged that it is highly unlikely a respondent would not have had awareness of the Complainant's Rights, given the nature of the Internet and the Complainant's worldwide popularity. The Complainant cites the Panel's decision in a WIPO case brought by the Complainant in respect of facebook.cc.

(e) The Complainant therefore submits that the Respondent registered the Domain Name with prior knowledge of the Complainant's Rights. The Complainant refers to the decision in DRS 04331 verbatim.co.uk where it was said that for a complaint to succeed the complainant must satisfy the Panel that the respondent was aware of the existence of the complainant or its brand at the date of registration of the domain name or at commencement of an objectionable use of the domain name.

- (f) The Complainant further submits that the Respondent deliberately chose to register a domain name that is identical or similar to FACEBOOK and THE FACEBOOK, with the ultimate intention of seeking to create a false association with the Complainant in order to benefit from the Complainant's goodwill and reputation. The Complainant relies on the decision in DRS 0658 chivasbrothers.co.uk.
- 5.5 The Complainant argues that the Respondent is using the Domain Name in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights in accordance with paragraph 1(ii) of the Policy.
- 5.6 The Complainant relies on paragraph 3(a)(ii) of the Policy. The Complainant says that by passively holding the Domain Name the Respondent is threatening to use the Domain Name in a way which will confuse or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant says there is no doubt that Internet users would expect to find a web site at the Domain Name that is affiliated to or sponsored by the Complainant and that any active use of the Domain Name would be likely to mislead Internet users into thinking that it is registered to, operated or authorised, or otherwise connected with the Complainant.
- 5.7 The Complainant says that a likelihood of confusion may be sufficient to constitute Abusive Registration and cites DRS 05366 ebayuniversity.co.uk. The Complainant argues that given the Domain Name identically reproduces THE FACEBOOK trade mark and that the Complainant's official site is at facebook.com it is easy to see how and why Internet users are likely to be misled into thinking the Complainant is behind the Domain Name.
- 5.8 The Complainant states that whilst paragraph 3(b) of the Policy expressly provides that a failure on a respondent's part to use the domain name for the purposes of e-mail or a web site is not itself evidence of abusive registration, prior Nominet Experts have found that in certain circumstances, such as when a brand is well-known and there is no apparent legitimate reason for the domain name registration, non-use may be indicative of a threatened abuse hanging over the head of the complainant. The Complainant cites paragraph 1.3 of the Nominet Experts' Overview and the decision in DRS 0658 chivasbrothers.co.uk.
- 5.9 The Complainant argues that there is no legitimate reason which would explain why the FACEBOOK and THE FACEBOOK trade marks are being used in the Domain Name. The Complainant asserts that the non-use of the Domain Name is a strong indication that the Respondent is holding on to it with the intention of taking unfair advantage of the Complainant's Rights when the right opportunity arises and is unfairly detrimental to the Complainant as it detracts traffic away from the Complainant to the Respondent's non-active web site. The Complainant says there cannot be any actual or contemplated use of the Domain Name by the Respondent or a third party that would not be abusive as it would inevitably create a false association with the Complainant. The Complainant cites DRS 00956 kodapost.co.uk.
- 5.10 The Complainant argues that the Respondent is not able to rely on any of the factors in paragraph 4 of the Policy as evidence that the Domain Name is not an Abusive Registration.

The Respondent's Response

- 5.11 On 25 January 2016 the Respondent e-mailed Nominet in response to service of the complaint. He asked Nominet for log in details to view the complaint. He also stated "I

have not done anything with this domain and have at no point purchased the address. I'd quite like to just resolve this issue and any advice you can offer would be greatly appreciated." Nominet responded suggesting that as the Respondent was unaware of the Domain Name registration he put in a short response to explain this and to let Nominet know that he would be happy for Nominet to transfer the Domain Name to the Complainant. Nominet said that it could then act on this and let the Complainant's representative know that the Respondent agreed that Nominet can transfer the Domain Name to the Complainant. Nominet could then complete the transfer and close the DRS case.

- 5.12 On 4 February 2016 Nominet e-mailed the Respondent stating that if he is willing for Nominet to transfer the Domain Name to the Complainant Nominet could accept an e-mail from him to confirm this and Nominet would then notify the Complainant, complete the transfer and close the DRS case. Nominet said that if the Respondent decided not to reply to Nominet or respond through the online account the Complainant would have the option to pay a fee for an independent expert decision and that if the Expert decides the Domain Name should be transferred to the Complainant Nominet would act on that decision and the decision would also be published on the Nominet web site.
- 5.13 On 12 February 2016 the Respondent e-mailed Nominet stating *"I am willing to let you transfer the domain name over to Facebook, Inc."*
- 5.14 On 15 February 2016 the Complainant's representative e-mailed Nominet in the terms set out at paragraph 5.16 below stating that the Complainant wished to obtain a full decision rather than to settle the proceedings. On the same day Nominet notified the Respondent of this and informed the Respondent of the deadline for submitting a formal response and how to do this. The Respondent was also informed that if he did not respond through his online services account Nominet would take his last e-mail received on 12 February 2016 (see paragraph 5.13) as his response.
- 5.15 In making this decision I have taking into account the content of the Respondent's e-mails to Nominet.

The Complainant's Reply

- 5.16 This comprises an e-mail from the Complainant's representative to Nominet. In view of its brevity it is set out in full below.

"Thank you for your email. Please note that the Complainant does not wish to settle these proceedings at this late stage. The Respondent did not respond to the Complainant's three emails and thus the Complainant had no choice but to file these proceedings. As a result the Complainant been put to considerable inconvenience and expense and so now wishes to obtain a full decision".

6. Discussions and Findings

- 6.1 Paragraph 2 of the Policy sets out that for a Complainant's complaint to succeed it must prove to the Expert that:
- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 6.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

The Complainant's Rights

- 6.3 Under Paragraph 1 of the Policy, Rights is defined as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.” It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.
- 6.4 In view of the Complainant’s registered trade marks summarised at paragraph 4.3 I am satisfied that the Complainant has Rights in the marks FACEBOOK and THE FACEBOOK. I also consider that in view of the evidence of extensive and substantial trade the Complainant also has unregistered Rights through use in these marks.
- 6.5 I regard THE FACEBOOK mark to be identical to the Domain Name and FACEBOOK to be identical or similar to the Domain Name (in each case disregarding the .co.uk). The addition of ‘the’ to ‘facebook’ in the Domain Name does not distinguish the Domain Name from FACEBOOK.
- 6.6 Accordingly, I find that the Complainant has Rights in the names or marks THE FACEBOOK and FACEBOOK which are identical or similar to the Domain Name.

Abusive Registration

- 6.7 Paragraph 1 of the Policy defines Abusive Registration as a Domain Name which either:
- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or
 - ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights.
- 6.8 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is set out in paragraph 3(a) of the Policy. These include at paragraph 3(a)(i):
- Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
- A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent’s documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant.
- 6.9 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is set out at paragraph 4 of the Policy. Paragraph 3(b) of the Policy also sets out that failure on the Respondent’s part to use the Domain Name for the purposes of email or a web site is not in itself evidence that the Domain Name is an Abusive Registration. In this case, there is no evidence that the Domain Name has been used either for email or a web site. However, this is only one factor for me to take into account when determining whether the Complainant has established that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

6.10 The Complainant has drawn my attention to paragraph 1.3 of The Nominet Dispute Resolution Service – Experts’ Overview which states the following in relation to non-use of a domain name:

“Moreover, some Experts have found that in certain circumstances, e.g. where the name is a known brand and the Respondent has no obvious justification for having adopted the name and has given no explanation, the non-use itself can constitute a threatened abuse hanging over the head of the Complainant.”

6.11 The Complainant has also referred me to the decision in DRS 0658 chivasbrothers.co.uk which is cited in the above paragraph of the Expert’s Overview and which concerned non-use of a domain name incorporating a famous name. In that case the expert considered that, in the particular circumstances of the case, a detailed analysis of the provisions of paragraphs 3 and 4 of the Policy was unnecessary. The expert considered the name CHIVAS BROTHERS to be exclusively referable to the complainant, to be a distinctive name and in the context of alcoholic beverages, a very famous name. The expert viewed it as inconceivable that the respondent registered the domain name without having the complainant firmly in mind. The expert considered there was no obvious reason why the respondent might be said to have been justified in registering the domain name and the respondent had elected not to come forward with any explanation for his registration of the domain name.

6.12 The expert said as follows:

“While it may be possible (at least theoretically) that the Respondent registered the Domain Name for no purpose at all, the Expert regards that as most improbable. What could the Respondent’s purpose have been? It could have been with a view to making a use of it, or it could have been with a view to selling it, or simply to block the Complainant. We are left to speculate because the Respondent has not responded, nor has the Respondent made any use at all of the Domain Name.

Where a Respondent registers a Domain Name:-

- 1. which is identical to a name in respect of which the Complainant has rights; and*
- 2. where that name is exclusively referable to the Complainant; and*
- 3. where there is no obvious justification for the Respondent having adopted that name for the Domain Name; and*
- 4. where the Respondent has come forward with no explanation for having selected the Domain Name,*

it will ordinarily be reasonable for an expert to infer first that the Respondent registered the Domain Name for a purpose and secondly that that purpose was abusive. In this case the Expert draws those inferences.”

6.13 The expert went on to find on the balance of probabilities that the respondent registered the domain name for one or more of the purposes set out in paragraph 3(a)(i) of the Policy or for some other abusive purpose.

6.14 I consider that the facts of this dispute are very similar to those in DRS 0658 chivasbrothers.co.uk. Both cases concern non-use of a domain name which incorporates a famous mark. I therefore consider it appropriate for me to adopt the guidance given by the expert in that decision and like that expert I do not consider a detailed analysis of the provisions of paragraphs 3 and 4 of the Policy is necessary.

- 6.15 The expert in DRS0658 chivasbrothers.co.uk considered it inconceivable that the respondent registered the domain name without having the complainant firmly in mind. In this case, the Respondent says in his e-mail of 25 January 2016 to Nominet "*I have not done anything with this domain and have at no point purchased the address.*" Nominet took this to mean the Respondent was unaware of the Domain Name registration. However, that is not what the Respondent explicitly said. The Respondent also did not respond to the Complainant's representatives when they approached him seeking the transfer of the Domain Name. I would have expected the Respondent to inform the Complainant's representatives if he had been unaware of the Domain Name registration. The Respondent has also chosen not to give any explanation of the circumstances of the registration or acquisition of the Domain Name and what he means by "*at no point purchased the address*". Taking all of this into account and given that the Respondent is the named registrant of the Domain Name I consider I am entitled to proceed on the basis that the Respondent registered or otherwise acquired the Domain Name.
- 6.16 The Complainant's evidence establishes that FACEBOOK is an extremely well known mark in the UK and worldwide. In view of the fame of FACEBOOK for online social networking services I consider it inconceivable that the Respondent was unaware of the Complainant at the time of registration or acquisition of the Domain Name and the Respondent has not suggested anything to the contrary. I consider the Respondent had the Complainant firmly in mind when he registered or otherwise acquired the Domain Name.
- 6.17 The Domain Name is identical to THE FACEBOOK and is identical or very closely similar to FACEBOOK being names in respect of which the Complainant has Rights. These names are exclusively referable to the Complainant. In my view there is no obvious reason why the Respondent was justified in registering or otherwise acquiring the Domain Name and the Respondent has chosen not to come forward with any explanation for his registration or acquisition of the Domain Name. In such circumstances I consider it reasonable for me to infer and I do infer that the Respondent registered or otherwise acquired the Domain Name for a purpose and that the purpose was abusive, either one or more of the purposes set out in paragraph 3(a)(i) of the Policy or for some other abusive purpose. I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration.

7. Decision

- 7.1 I find that the Complainant has Rights in names or marks which are identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I therefore direct that the Domain Name be transferred to the Complainant.

Patricia Jones

12 April 2016