

ADMINISTRATIVE PANEL DECISION

Facebook Inc. v. Stuart West, West & Associates, A PC
Case No. D2015-1766

1. The Parties

The Complainant is Facebook Inc. of Menlo Park, California, United States of America (“United States” or “US”) represented by Hogan Lovells (Paris) LLP, France.

The Respondent is Stuart West, West & Associates, A PC of Walnut Creek, California, United States.

2. The Domain Name and Registrar

The disputed domain name <patentfacebook.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 October 5, 2015. On October 5, 2015, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 5, 2015, the Registrar transmitted, by email to the Center, its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “UDRP” or the “Policy”), 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 that the proceedings commenced on October 20, 2015. In accordance with the Rules, paragraph 5, the due date for Response was November 9, 2015. The Response was filed with the Center on November 9, 2015.

The Complainant submitted a Supplemental Filing on November 16, 2015.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on November 20, 2015. 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

As reflected in the registration record for the disputed domain name in the Whois database (a copy of the records appears in Annex 1 to the Complaint) and as confirmed by the Registrar, the disputed domain name <patentfacebook.com> was registered on April 13, 2012 and is due to expire on April 13, 2016.

A. The Complainant's Facebook Marks

As indicated in the Complaint, the Complainant owns various United States and foreign trademark registrations for the mark FACEBOOK. The Complainant has provided, in Annex 13 to the Complaint, copies of entries from the publicly accessible Trademark Electronic Search System ("TESS") database, provided by the United States Patent and Trademark Office, for some of its US registrations, the details of those registrations are as follows:

1. FACEBOOK

United States Registration No.: 3,122,052
Registered: July 25, 2006; filed: February 24, 2005

This mark is registered for use in connection with: "Providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking" in international class 38. This registration claims a date of first use and first use in commerce in connection with these services of November 16, 2004.

2. FACEBOOK

United States Registration No.: 3,041,791
Registered: January 10, 2006; filed: February 24, 2005

This mark is registered for use in connection with: "Providing online chat rooms for registered users for transmission of messages concerning collegiate life, classifieds, virtual community and social networking" in international class 38. This registration claims a date of first use and first use in commerce in connection with these services of February 4, 2004.

B. The Parties and Their Interaction

The Complainant, Facebook Inc., is a well-known provider of online social networking services. Founded in 2004, the Complainant allows Internet users to stay connected with friends and family, and to share information mainly via its website available at "www.facebook.com" (a copy of the home page of the Complainant's website appears in Annex 3 to the Complaint.)

Access to Facebook's social network (hereinafter simply "Facebook" unless the specific context dictates otherwise) was originally restricted to students at Harvard University but quickly expanded to other universities and, in 2006, to anyone in the world with a valid email address. Since its launch in 2004, Facebook rapidly expanded from 1 million active users by the end of 2004, to 100 million users during August 2008, 500 million users during July 2010, a billion users by September 2012, and currently over 1.49 billion monthly active users and 968 million daily users worldwide. The Complainant's website is currently ranked as the 2nd most visited website in the United States and in the world, according to web information company Alexa during February 2015 (a print-out of the top ten websites in both the US and globally as found by Alexa as of October 10, 2015 appears in Annex 4 to the Complaint). With approximately 83.1 percent of its daily active users outside the US and Canada, Facebook's social networking services are provided in more than 70 languages. Facebook is also available for mobile devices, and in recent years has

1.31 billion mobile monthly active users and 844 million mobile daily active users (print-outs of the Complainant's Corporate Information from its website and also of various articles appear in Annex 5 to the Complaint).

In 2014, the FACEBOOK brand ranked 29 in Interbrand's Best Global Brands report, and was selected "top riser" for a second year in a row. That year, the Complainant's revenues reached USD 12.5 billion, representing an increase of 58 percent year-over-year.

To protect its social networking technology, the Complainant currently holds a number of patent applications and issued patents in multiple jurisdictions, the US amongst them, and including those it acquired from third parties. It has expended millions of dollars to expand and protect its patent portfolio. Specifically, to acquire patents and other intellectual property rights from third-parties, the Complainant spent USD 633 million in 2012 and another USD 92 million in 2013.

During early 2012, the Complainant was in the midst of a patent dispute with YAHOO Inc. ("YAHOO"). This dispute was widely reported in the press, including during March-April 2012 shortly before the disputed domain name was registered. The dispute was subsequently resolved by the parties a few months later with the resolution having been publicly announced on July 6, 2012 (print-outs of various online articles also appear in Annex 5 to the Complaint).

The Respondent is both a patent attorney and a managing attorney at West & Associates, which is an intellectual property law firm based in California primarily specializing in patent law. The Respondent's main website is accessible through the domain name <westpatentlaw.com> which has the same contact details in its Whois entry as does the disputed domain name (a print-out of the home page of this website appears in Annex 11 to the Complaint).

Until recently, the disputed domain name redirected Internet users to a GoDaddy website template consisting of standardized web pages designed for a law firm, though only partially completed. The home page of the website displayed, at the top right of the page, the name of the Respondent's law firm, "West and Associates", and, in the middle of that page, the text: "At Smith Jones and Associates, our clients come first. Every client is treated with courtesy and is guaranteed effective representation. Our experts and integrity have earned us a reputation as one of Anystate's premier legal firms". The page also displayed a fictitious physical address, phone number and email address, specifically:

"Smith Jones and Associates
1234 Main Street
Anytown, AA 1234
(123) 123-4567
Fax (123)-4568
email@smithjones.coolexample.com"

The links appearing on the website directed viewers to similar standardized pages, for example, pages containing a description of the services provided, namely areas of practice, and fictional lawyer biographies. When the Complaint was filed, the disputed domain name pointed to the same website template (including layout and photographs), but, as a result of communications, as described below, between the Complainant's representative and the Respondent, the Respondent subsequently removed all the textual content then appearing in the website (print-outs of screen captures, of the current and prior versions of the Respondent's website, appear in Annex 10 to the Complaint).

With respect to those communications, on June 22, 2015, the Complainant's legal representative sent a letter, by email, to the Respondent asserting the Complainant's trademark rights and requesting the latter to cease and desist from using the Complainant's mark FACEBOOK and the disputed domain name. Later that day, the Respondent replied contending that his use is non-infringing and the Complainant's analysis of infringement is inaccurate. Subsequently, the Complainant's representative made several attempts to discuss this matter with the Respondent over the telephone. However, the Complainant was unable to reach

the Respondent that way.

On July 7, 2015, the Complainant's representative finally reached the Respondent, by email, stating her disagreement with the Respondent's position. That representative also requested the Respondent to "disable the disputed domain name and allow it to expire". On July 21, 2015, the Respondent replied to the July 7, 2015 message stating that "your analyses are conclusory and fail to establish any form of a *prima facie* case under any legal theory" and refused to comply with the Complainant's request. While the Complainant's representative, through the July 21, 2015 message, invited the Respondent to amicably settle the matter, no further discussions ensued (a copy of the email correspondence between the parties appears in Annex 12 to the Complaint).

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its FACEBOOK marks.

Specifically, the disputed domain name contains the mark FACEBOOK to which the generic word "patent" has been prepended, with that word being incapable of adding sufficient distinctiveness whatsoever to the disputed domain name to mitigate any resulting user confusion between the disputed domain name and the Complainant's marks.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Respondent is neither a licensee of the Complainant nor has he been authorized or allowed to use any of the FACEBOOOK marks whether in a domain name or other use.

The Respondent, before he received notice of this dispute, has not made any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services. In that regard, the Respondent was apparently intent on using the disputed domain name, which incorporates the Complainant's mark FACEBOOK, to resolve to a website which would provide details about the Respondent's law firm. Nor has the Respondent made and is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Specifically, the Respondent's use of a confusingly similar domain name to the Complainant's mark FACEBOOK, which itself is very widely known, which capitalized on and exploited the goodwill and reputation of that mark to promote the Respondent's own firm does not constitute either a *bona fide* offering of goods and services or a legitimate noncommercial or fair use of the disputed domain name. In that regard, since the disputed domain name contains the Complainant's well known mark FACEBOOK in conjunction with the generic term "patent", Internet users would undoubtedly expect the disputed domain name to resolve to a website that is in some manner affiliated with or sponsored by the Complainant — when, in fact, the domain name does not. It resolves to the Respondent's site instead which has no connection whatsoever with the Complainant.

Lastly, the Respondent is also not commonly known by the Complainant's mark FACEBOOK, particularly given the Complainant's notoriety and the exclusivity with which the mark is associated with the Complainant.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

Specifically, given the renown of the Complainant's mark FACEBOOK and the fact that the Respondent is a patent attorney who likely had knowledge of the Complainant's patent dispute with YAHOO, the Respondent, having full prior knowledge of that mark and the Complainant's exclusive rights in that mark and with no connections to the Complainant, nevertheless intentionally registered the disputed domain name containing that mark together with the word "patent" in order to exploit the mark for the Respondent's own benefit. Thus, the Respondent registered the disputed domain name in bad faith.

Currently, the Respondent appears to be passively holding the disputed domain name. Further, the Respondent cannot use the domain name in good faith as any use, of the type apparently intended by the Respondent as an address of his law firm website, would invariably cause a false association with the Complainant in the minds of Internet users which would result in misleadingly diverting those users to the Respondent's website instead for the Respondent's own commercial advantage. This reflects bad faith use.

B. Respondent

(i) Identical or Confusingly Similar

Through the Response, the Respondent contends that the disputed domain name is neither identical nor confusingly similar to the Complainant's FACEBOOK marks. Specifically, the Respondent points to a lack of any instance over the past three years, since the domain name has been registered, of actual confusion between the domain name and the marks.

(ii) Rights or Legitimate Interests

The Respondent contends that he is making a legitimate noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers. Specifically, the Respondent states that all the information on the homepage of his website, to which the domain name resolves, is fictional in nature. Further, all links on that website referred Internet users to other pages, on the same website, which also provided fictional information. Further, the Respondent alleges that his website is in use for "internal and confidential attorney-client privileged legal matters that are not publicly available or viewable".

(iii) Registered and Used in Bad Faith

Here, the Respondent contends that his registration and use of the disputed domain name were and are not in bad faith.

Specifically, he states that the information on his website is fictional and all the links on his site merely direct Internet users to other pages within the same site. Those users are unable to purchase anything from the site and nothing on the site generates or is intended to generate any revenue for the Respondent.

The Respondent also states that he has no intention to sell, rent or otherwise transfer the disputed domain name to the Complainant or any other third party.

As the Complainant and the Respondent are not competitors — as social networking services and the practice of law are highly unrelated, the Respondent did not register the disputed domain name primarily to disrupt the Complainant's business.

C. Complainant's Supplemental Filing

Through its Supplemental Filing, the Complainant pointed to various new arguments put forth by the Respondent which found no basis in the Complaint and thus could not be addressed earlier. Its main argument appears to be centered on and responsive to the Respondent's contention, as first set forth in the Response, that the Complainant's representative is not a member of the bar of the State of California and thus not authorized to practice law in the State of California. As this argument is irrelevant to the present dispute, it will be ignored both in the Response and the Supplemental Filing. The Panel finds all the other arguments in the Supplemental Filing to be of little, if any, consequence.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's FACEBOOK marks.

Contrary to the Respondent's view, determining whether a domain name is either identical or confusingly similar to a mark, for purposes of paragraph 4(a)(i) of the Policy, merely entails comparing each such domain name to the mark and assessing whether the resulting differences impart sufficient distinctiveness to the domain name so as to avoid any confusing similarity with the mark. See WIPO Overview of WIPO Panel on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 1.2. The fact that the Complainant has shown no actual confusion between the two is irrelevant, as is the three-year period during which both the disputed domain name and the Complainant's website have existed online.

After applying that comparison-based methodology here, no doubt exists that the disputed domain name is confusingly similar to the Complainant's mark FACEBOOK. The differences between the disputed domain name and the mark amount to the generic word "patent" having been prepended to the mark to form a composite term and the generic Top-Level Domain ("gTLD") ".com" having been appended to that term to form the disputed domain name, with the last addition being irrelevant in this case in assessing identity or confusing similarity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP proceedings, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding a short letter or number group, or even generic or highly descriptive words, or geographic identifiers, such as a country name, to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that domain name to avoid a finding of confusing similarity. Here, prepending the word "patent" in the manner which the Respondent specifically did, to the mark FACEBOOK clearly resulted in such a minor variation. See, e.g., *Philip Morris USA Inc. v. Daniele Kanai, iKiss LLC*, WIPO Case No. D2015-1527; *Valero Energy Corporation and Valero Marketing and Supply Company v. Lisa Katz, Domain Protection LLC / Domain Hostmaster, Customer ID: 62520014085963*, WIPO Case No. D2015-0787; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of Realtors v. Hammerberg & Associates, Inc.*, WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v.*

Edwin De Jesus, EDJ Associates Inc., WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. 791657; *Google Inc. v. Jennifer Burns*, NAF Claim No. 726096; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491.

Moreover, by including the generic word “patent” with the Complainant’s mark FACEBOOK to form the disputed domain name, the potential for user confusion was likely to have been exacerbated, not reduced. It is quite conceivable, given current common naming conventions and patterns in use on the Internet, that an Internet user, who seeks information on a patent dispute that involves or previously involved the Complainant would likely have formed a domain name by prepending the term “patent” to the mark FACEBOOK to yield a composite name and then add the common gTLD “.com” to generate a resulting domain name <patentfacebook.com>. The user would then have inserted that domain name into his/her browser with a reasonable expectation that doing so would have directed that browser to either the Complainant’s website or a website authorized by or affiliated with the Complainant from which that user would probably have obtained information about patent disputes in which the Complainant was a party. However, here the Respondent registered that domain name. The result is that the user’s action would have caused that person not to be taken to the Complainant’s website or one associated with the Complainant, but rather, and without that user realizing the diversion, to the Respondent’s website instead. There, the user would have been intentionally presented with information having nothing to do with the Complainant but rather with information concerning the Respondent’s law firm. Thus, the user would very likely have been deceived into thinking that the Respondent’s website was affiliated with, authorized by or related in some fashion to the Complainant when, in fact, it was not. Hence, adding the term “patent” to the mark FACEBOOK, as the Respondent did, only heightened the likelihood of the Respondent having caused user deception and ensuing confusion to the Respondent’s ultimate benefit and the detriment of the Complainant. See, e.g., *Cummins Inc.*, *Tommy Bahama Group, Inc.*, *Krispy Kreme Doughnuts*, *National Association of Realtors*, *Space Needle*, *Burberry*, *Dreamworks* and *MySpace*, all cited *supra*.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant’s FACEBOOK marks. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c) of the Policy.

In response to having been contacted by the Complainant, the Respondent recently removed all his prior textual content from his current website and appears to be passively holding the disputed domain name. Nevertheless, prior to this dispute, the Respondent’s use of the domain name as an address of his website through which the Respondent unfairly exploits, for his own commercial benefit, the Complainant’s reputation acquired through its marks, does not constitute a *bona fide* offering of goods and services. Accordingly, the Respondent’s prior use of the domain name does not satisfy paragraph 4(c)(i) of the Policy.

Further, the Complainant has never authorized the Respondent to utilize any of the Complainant’s marks, whether in a domain name or otherwise, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent.

The record before the Panel is simply devoid of any evidence which proves that the Respondent actually acquired any recognition in the marketplace to become commonly known by the disputed domain name, a name similar to it, or more generally the term “facebook”. Given the exclusive trademark rights that reside in the Complainant and the extensive global reputation now inherent in its marks, the Respondent could not legitimately acquire any public association between himself and the Complainant’s mark FACEBOOK or even any mark similar thereto, certainly for the services provided by the Complainant under its marks. This is so in light of the Complainant’s exclusive trademark rights which date back to 2006 in connection with the mark FACEBOOK and the extensive global reputation and recognition which its FACEBOOK marks have since acquired – which clearly predate April 13, 2012, when the Respondent registered the disputed domain name. See, e.g., *Philip Morris USA Inc., Valero, Cummins Inc., Staatliche Porzellan-Manufaktur Meissen GmbH, Forideas, National Westminster, Tommy Bahama Group, Inc., Space Needle, Oakley, Burberry, HRB Innovations, MySpace and General Motors LLC*, all cited *supra*. Further, given the fame now inherent in the mark FACEBOOK, the sphere of exclusivity provided by that mark extends, well beyond the services specifically set forth in the Complainant’s registrations, to encompass, as a source-indicator, a rather expansive realm of goods and services which Internet users (the market for the Complainant’s social networking services) might reasonably think emanate or have some connection, whether by affiliation, sponsorship or endorsement, with the Complainant. Upon seeing the disputed domain name <patentfacebook.com>, it is well within reason for Internet users to believe that the Respondent’s patent-related legal services are sponsored or sanctioned by or affiliated or connected with the Complainant in some manner — when, in fact, they are not and no relationship whatsoever exists between these two entities. As such, the Respondent could never likely become commonly known by the disputed domain name or the Complainant’s marks for a wide range of goods and services, probably including the Respondent’s own legal services, without infringing on the exclusive trademark rights of the Complainant. There can simply be no question that the Respondent was well aware of the Complainant, its FACEBOOK marks and the Complainant’s exclusive rights and reputation in those marks, when the Respondent registered the disputed domain name. Being that the Respondent is a patent attorney who likely became aware of the Complainant and its patent dispute with YAHOO shortly prior to the date when he registered the disputed domain name, it is simply inconceivable that the registration of this domain name is not based on or triggered by this prior knowledge coupled with the Respondent’s desire, to increase his firm’s future business, by then leveraging off and exploiting the Complainant’s reputation for his own commercial benefit, such as by misleading Internet users into believing that the Respondent and his law firm were then somehow involved with the Complainant in that or other of its patent matters and thus that firm is endorsed by the Complainant, when the Respondent and his firm were clearly neither involved with the Complainant nor endorsed by it. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, as the Respondent’s use of the disputed domain name is illicit, it does not qualify as a legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

Further, the Respondent’s contentions that the contents on his website are fictional and the site was being used for non-public purposes are simply not credible. The content was provided to the Complainant, via that website, when it first accessed that site. That content and the accompanying use of the disputed domain name in conjunction with that content were then of sufficient concern to the Complainant, from whose perspective the likely effect of the domain name and content are assessed, for the Complainant to demand that the Respondent cease and desist from any further use of both the Complainant’s mark FACEBOOK and the name and, after having received no satisfaction from the Respondent, ultimately initiate this proceeding.

Accordingly, based on the evidence presently before the Panel, the Respondent does not fall within any of circumstances under paragraph 4(c) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain name. Thus, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent’s actions, with respect to the disputed domain name, constitute bad

faith registration and use.

It is indisputable that the Respondent was well aware of the Complainant, its mark FACEBOOK and the extensive reputation which the Complainant exclusively has in its FACEBOOK marks when the Respondent registered the disputed domain name. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally chose and registered the disputed domain name for its potential to cause confusion with those marks and to opportunistically exploit that reputation for the Respondent's own commercial benefit. Relying on that confusion, the Respondent used the disputed domain name to direct Internet users to his own website, though incomplete at the time and based on a law firm website template apparently supplied by the Registrar, through which the Respondent likely would have provided information regarding his law firm. Though the Respondent's current website contains no content and the Respondent is passively holding the disputed domain name, the Respondent only recently removed that content after he was contacted by the Complainant and informed of this dispute.

It is well within reason for this Panel to conclude, based on the specific facts of record, that if the Respondent were to retain the disputed domain name then, in all likelihood, he would either: (a) consistent with his expressed intention of not selling or transferring the disputed domain name, restore the content he previously deleted from his website and supplement that content by incorporating additional informative content about his law firm in an effort to expand his use of the site for marketing his law firm, or (b) in spite of his expressed intention, continue to passively hold the domain name until a suitable opportunity arose where he could sell or transfer the domain name, at a sufficient profit, to a suitable third party who may well exploit the domain name in a similar exploitive manner to that which the Respondent had done. Under either scenario, the reputational harm which the Respondent had already inflicted on the reputation of the Complainant's marks through use of the domain name would not only persist but also likely intensify.

This conduct reflects bad faith registration and use under the general provisions of paragraph 4(a)(iii).

Thus, the Panel concludes that the Complainant has provided sufficient proof of its allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <patentfacebook.com> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: November 25, 2015