

ADMINISTRATIVE PANEL DECISION
IN THE MATTER OF KLRCA/ DNDR- 382-2016

BETWEEN

FACEBOOK, INC.
(Complainant)

AND

JOEY LEE
E-WEB SOLUTIONS
(Respondents)

CASE NO. KLRCA/ DNDR- 382-2016

1. The parties:

The complainant is Facebook, Inc., a registered incorporation having its registered address at 1601. Willow Road, Menlo Park California 94025, United States of America, represented by M/s Tay & Partners, Suite 6.01, 6th Floor, Plaza See Hoy Chan, Jalan Raja Chulan, 50200 Kuala Lumpur, Malaysia.

The respondents are Joey Lee, address not known and e-Web Solutions, having its business address at 2-0-1, Jln 1/93, Tmn Miharja, Off Jln Loke Yew, 55200, Kuala Lumpur, Wilayah Persekutuan.

2. The Domain name and registrar:

The disputed domain names are <**facebook.my**> and <**facebook.com.my**> and the Registrar is the Malaysian Network Information Centre (MYNIC).

3. Procedural history:

The complainant submitted its complaint with the Kuala Lumpur Regional Centre for Arbitration ("**the Centre**") on 23 March, 2016 pursuant to MYNIC's (.my) Domain

Name Dispute Resolution Policy ("**the policy**"), the Rules for MYNIC's (.my) Domain Name Dispute Resolution Policy ("**the rules**") and the MYNIC's (.my) Supplemental Rules ("**the Supplemental Rules**") in respect of the disputed domain name.

An examination of the material confirms that all technical requirements for the initiation of this proceeding have been satisfied. Having verified that the complaint satisfies the formal requirement, the proceedings formally commenced on April 14, 2016.

Notification of Commencement of Proceeding (NCP) was sent to respondents by the Centre informing them about the complaint filed against them before KLRCA and also directing them to file their response on or before May 6, 2016. But no response has been received from the respondents.

The Complainant having elected for a single member panel, the Centre appointed Mr.Saravanan Dhandapani as the sole panellist in conformity with the policy and the rules. The panellist has submitted a statement of Declaration of Impartiality and Independence as required by the Centre.

4. Factual Background:

4.1 The complainant is Facebook, Inc., founded in 2004, is the world's leading provider of online social networking services allowing internet users to stay connected with friends and family. The complainant claims that since its launch in 2004, it has more than 1.59 billion monthly active users. It also provides its services through mobile application.

4.2 The complainant claims that it has developed considerable reputation and goodwill worldwide in both its services and brands and that its trademark FACEBOOK is most famous online trademarks in the world.

4.3 The complainant states that its domain names consisting of Facebook trademark are not only heart of its business but also the main way for millions of users to avail themselves of its services.

4.4 The complainant claims that it has registered its trademark FACEBOOK around the world. Few of the registrations quoted by the complainant are Trademark No. 08005944 registered on 26 March 2008 in Malaysia for goods and services in Class 38; Trademark No. 08005946 registered on 26 March 2008 in Malaysia for goods and services in Class 42; Trademark No. 08005947 registered on 26 March 2008 in Malaysia for goods and services in Class 45. These registrations are also evident from the copies of trademark registrations attached by the complainant in Annexure-4.

4.5 The complainant claims that recently it was made aware of the fact that the respondent had registered the complainant's trademark under .my country code top level domain (ccTLD). The domain names facebook.my and facebook.com.my were registered on 31 May 2007 and 9 April 2008 by the respondents respectively. The complainant states that the domain names redirect the internet users to another website known as <http://www.dingit.tv/highlight/1068238> advertising live video games and commercial banners. The complainant has in annexure 12 attached the screen captures of the websites.

4.6 The complainant claims that in a search carried out by the complainant in the Internet Archive revealed that the domain names were previously pointing to parking pages containing sponsored links in English targeting the complainant's trademark.

4.7 The complainant claims that respondent is a company registered in Malaysia that operates in the e-commerce trading sector. The complainant claims that the respondent have previously registered other domain names infringing the complainant's trademark namely <facebok.com.my> and <faceboo.com.my>. There have been many domain name dispute resolution proceedings against the respondent.

4.8 The complainant claims that on 19 May 2015 it had through its lawyers notice sent cease and desist letter to the respondent to transfer the domain names to the complainant.

5. The Parties Contentions:

5.1 The Complainant:

5.1 (i) The complainant contends that the registration of the disputed domain names should be transferred to the complainant.

5.1 (ii) The complainant relies on the adduced facts and evidence and contents that it has fulfilled the requisite elements of paragraph 5.2 of the Policy, in particular:

- a. The disputed domain name is identical to and/ or confusingly similar with the complainant's trade marks to which the complainant has rights; and
- b. The respondent has registered and used the disputed domain name in bad faith.

5.1 (iii) In support of these contentions, the complainant asserts and maintains various points including the following:

5.1 (iv) The complainant states that the disputed domain names identically reproduce the complainants trademark FACEBOOK without the adornment under the .my ccTLD for Malaysia.

5.1 (v) The complainant stresses that the addition of ccTLD, such as .com or .my or .com.my is generally irrelevant when assessing whether a domain name is identical or confusingly similar to a trademark as it is a functional element.

5.1 (vi) The complainant states that the respondents cannot argue that they did not have knowledge of existence of complainant's trademark FACEBOOK as at the time of registration of disputed domain names in 2007 and 2008, the complainant had already had 50 million users of its websites.

5.1 (vii) The complainant stresses that the respondents in full knowledge of the complainant's existing rights registered the domain names. The complainant furthermore submits that it had not authorised the respondents to use the name Facebook or its trademark.

5.1 (viii) The complainant submits that the respondents registered the domain names not only to deny the complainant the benefit of goodwill and renown attached to its trademark but also to misappropriate for itself such goodwill and renown.

5.1 (ix) The complainant also claims that the respondents have engaged in pattern of registering many domain names and there are also decisions against them in the Policy.

5.1 (x) The complainant claims that the respondents intend to divert the internet users and also create confusion. According to the complainant, the internet users would find the complainant's official website dedicated to Malaysian users at domain names identically reproducing the Complainant's FACEBOOK trademark under .COM.MY and .MY country code extensions. Clearly, the respondents intend to derive the goodwill and reputation attached to the complainant's trademark.

5.1 (xi) The complainant further claims that the respondents intend to spread malware or malicious software using the domain name.

5.1 (xii) The complainant submits that the respondents are neither the licensee of the complainant nor has it been authorised by the complainant to use the trademark. It has also been found that the respondents have not taken any steps to secure or register the disputed domain name.

5.1 (xiii) Hence, the complainant asserts that the domain names are identical to the complainant's trademark, the respondents have registered the domain names in bad faith and are using them in bad faith and that they have not rights to use the same.

5.2 The respondents

The respondents have not submitted their response.

6. **Discussions and findings**

6.1 Rule 17 contemplates that the Panel is to decide the proceeding based on the documents and evidence submitted by the Parties; the Policy and Rules as well as any other rules and principles of law which are applied in Malaysia.

6.2 Paragraph 5 of the Policy provides that the complainant must establish both of the following elements in the complaint:

- i. The disputed domain name is identical or confusingly similar to trademark or service mark to which the Complainant has rights; and
- ii. The respondent has registered and/ or used the disputed domain name in bad faith.

The Panel will deal with each of the requirements of the Policy.

Identical or confusingly similar:

6.3 The panel finds that the complainant has adduced sufficient evidence to demonstrate that it has common law of rights in the trademark "FACEBOOK" and its variation thereof in Malaysia for the services. It has adduced evidence to show that it has registered the trademark FACEBOOK all over the world for providing online social networking services. Facebook was launched in 2004 that is almost 3-4 years prior to registration of the domain names by the respondents.

6.4 The panel finds that the disputed domain names <facebook.my> and <facebook.com.my> is identical to the complainant's trademark FACEBOOK. Facebook is not a dictionary word, however it was coined by the founders of the complainant company. Hence, undoubtedly, the disputed domain names are identical to the complainant's trademark.

Rights and Legitimate Interests:

6.5 Paragraph 7 of the Policy provides that in order for the respondent to rebut the allegation that the disputed domain name was registered and has been used in bad faith, the respondents may prove that it has rights and legitimate interests in the disputed domain names. Paragraph 7.2 of the Policy identified several types of evidence that could be adduced by the respondent to support its case and they include

- a) Before the date of communication of the complaint, the respondent has used or made preparations to use the disputed domain name in relation to a genuine offering of goods or services; or
- b) The respondent is commonly known by the disputed domain name; or
- c) The respondent is using the domain name for legitimate, non- commercial and/ or fair purposes and have no intention of using the same for profits or to deceive the public.

6.6 The complainant has established that it has in no way has any connection or link with the respondent. It has also established that it has not authorised or allowed or directed the respondents to use or register the said domain names. The respondents are in no way known by the disputed domain names. It is also seen that respondents have not taken any steps to secure any trademark rights in the domain names.

6.7 The respondents have not proved that prior to being informed of this dispute, they had used or had made demonstrable preparations to use, the domain names in connection with a genuine offering of goods and services. The domain names display website containing commercial banners and and spreading malware. Such use of domain name cannot be considered as genuine offering of goods. This view has

been supported by many prior panels, few being quoted by the complainant in its complaint.

6.8 The complainant has proved its point that the respondent is not making a legitimate non-commercial or fair use of the domain names without intention for commercial gain by misleading the customers. Hence, it is proved that the respondents have no rights or legitimate interests in the domain names.

Bad Faith:

6.9 The complainant has established that its trademark has been in existence since 2004 and had acquired quite publicity by 2007. It is seen from WHOIS report that the disputed domain names were registered in 2007 and 2008. Hence, the respondents even after being aware of the existence of the trademark registered the domain names in bad faith. The complainant has referred to eBay Inc. versus Sunho Hong (WIPO CASE No. D2000-1633) wherein it has held by the panels that actual or constructive knowledge of the complainant's rights in trademark is a factor supporting bad faith.

6.10 On perusal of annexure 14 and 15, it can be seen that the respondents are in habit of registering many domain names infringing rights of many parties and there are also decisions against the respondents under the Policy. Hence, it is proved that the respondents registered the domain names in bad faith.

6.11 The complainant has established that the respondents have registered the domain names and also using them only to spread malicious software. It can also be seen that the internet users in Malaysia on searching for the complainant's website will be automatically directed to the domain names. Hence, Internet traffic will be diverted to the respondents' domain names. Hence, the respondents will be unduly profited from the goodwill of the complainant.

6.12 Hence, the respondents have registered and are using the domain names in bad faith.

7. **Conclusion:**

7.1 Based on all the facts and evidence adduced and upon the reasoning provided above, the Panel decides that:

a) the disputed domain names are identical to the complainant's trademark "Facebook" to which the complainant has rights; and

b) the respondent has registered and/ or used the domain name in bad faith

7.2 Accordingly, the Panel directs that the disputed domain names **<facebook.my>** and **<facebook.com.my>** be transferred to the complainant.

SARAVANAN DHANDAPANI

Sole Panelist

19th May, 2016