

**IL-DRP PANEL  
FOR THE INTERNET SOCIETY OF ISRAEL**

In the matter of the **Domain <facebook.co.il>**

between

**Facebook, Inc.**  
1601 Willow Rd., Menlo Park  
California, 94025, USA  
Represented by Mr. David Taylor

(The "Petitioner")

and

**Mr. Gal Erel**  
31 Pri Megadim St.,  
PO Box 40026  
Mevaseret Zion, 90805, Israel

(The "Respondent" or "Holder")

**DECISION**

**I. Procedure**

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Name "facebook.co.il" be reallocated to the Petitioner.  
A Panelist was appointed in accordance with the Procedures for Alternative Dispute Resolution under the .ILccTLD IL-DRP Rules, in order to address the Petitioner's above request ([http://www.isoc.org.il/domains/ildrp\\_rules.html](http://www.isoc.org.il/domains/ildrp_rules.html)) (hereinafter – "the Rules").
2. Notification of the pending Petition, including copies of all submitted material, and notification of appointment of the Panel under the Rules, was sent on February 17, 2013, to the Respondent's email address as recorded in the ISOC Domain Name Registry. In accordance with section 9.3 of the Rules, the Respondent was allotted 15 days, concluding on March 4<sup>th</sup>, 2013, to submit a Statement of Response or any other relevant information to the Panel.
3. A reminder of the final date for submission of a Statement of Response was sent to the Respondent on March 3<sup>rd</sup>, 2013.
4. The Respondent did not provide any Response to this Petition.

## **II. Factual Background**

1. The Petitioner is a provider of online social networking services, whose services were first offered as an internal social networking service for Harvard University students as of February 2004, and later expanded to serve additional University communities.
2. On September 26<sup>th</sup>, 2006, Facebook opened its services to the public. By 2011, it provided social networking services in more than 70 languages to over 800 million users worldwide.
3. The Respondent registered the Disputed Domain on October 24<sup>th</sup>, 2006.
4. The Disputed Domain currently exhibits a website referring to four different Charity Organizations, dating from December 2010 to January 2011. None of the organizations seem to have any prima facie connection to the term "facebook". The website contains a disclaimer that it is not connected in any way to the social network facebook.com.
5. The Petitioner's lawyers contacted the Holder by phone trying to reach an agreement for transfer of the Disputed Domain (date unknown). In return, the Holder offered the Domain for sale for a sum of \$10,000. The Petitioner refused and counter-offered to pay \$3,000 for transfer of the Domain. The respondent then requested payment of \$8,000. The Petitioner refused this offer as well and filed this herein Petition.

## **III. The Parties' Claims**

### **A. The Petitioner**

1. The Petitioner claims to be the world's leading provider of online social networking services.
2. The Petitioner owns over 100 domain names consisting of the term "facebook", in different countries and different languages. Given the exclusively online nature of the Petitioner's services, the Petitioner's domain names, consisting of the term Facebook, are essential to its existence, and are the sole means by which millions of users partake of its services.
3. Petitioner's services have been offered since February 2004, and became available to the public in September 2006.
4. Petitioner indicates that evidence of the strength of the "Facebook" trademark can be gathered from a long list of cybersquatting attempts brought before WIPO and ruled in favor of "Facebook" , since 2007 (including attempts to register domains such as: <face-book.com>, <facebook.ie>, <facebook.me>, <facebook.info>, etc.).
5. The Petitioner notes that its services are provided worldwide, and as of 2011, it has provided social networking services in more than 70 languages to over 800 million active users worldwide.
6. Petitioner claims that in accordance with the requirements of the Rules, all elements exist indicating that the Domain should be transferred to the Petitioner, as follows:

- a. Disputed Domain is identical with Petitioner's trademark;
- b. Petitioner has rights in the name;
- c. Holder has no rights in the name; and
- d. Registration and/or use of the Domain are in bad faith.

## **6. The Respondent**

The Respondent failed to submit any Response to the Petition.

## **IV. Discussion**

1. The IL-DRP is an alternative dispute resolution procedure intended to provide expedited resolution to disputes regarding the allocation of Domain Names, in accordance with the Rules for Allocation of Domain Names under .IL. By registering a Domain, any Holder agrees to abide by these Rules.
2. In order for a case to be brought before a II-DRP Panel, the Petitioner must show that certain grounds exist.
3. Let it be noted that without Response on behalf of the Respondent, the Panel will not refute any insufficient claims stated by the Petitioner, but will instead proceed to review whether the information present is in itself sufficient to establish grounds for re-allocation of the Disputed Domains, based on aforementioned Rules.
4. Therefore we will proceed to review existence of the grounds for the request, as follows:

According to section 3 of the IL-DRP Rules, Disputes regarding allocation of a Domain Name by a Holder may be brought by a third party on the following grounds:

  - 3.1. the Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the complainant; and
  - 3.2. the Complainant has rights in the Name; and
  - 3.3. the Holder has no rights in the Name; and
  - 3.4. the application for allocation of the Domain Name was made or the Domain Name was used in bad faith.
4. Each of the claims above needs to be well established by Petitioner. In the following discussion we will address each claim, based on the Materials of the Petition and any other material available to the Panel.

### **a. Name is Same or Confusingly Similar**

The requirement in the Rules is that "the Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the complainant".

The Disputed Domain consists of the term "facebook" and of the suffix "co.il".

It has been previously ruled that the suffix "co.il" is to be disregarded for the purpose of determining similarity of a Domain to a Registered Mark, since it is a common suffix indicating that the domain is registered as a commercial Israeli website (see for example ISOC II-DRP case in the matter of <Crayola.co.il>).

Therefore the question remains whether the term "facebook" is the same or confusingly similar to a name of the Petitioner.

The Petitioner is a company registered as "Facebook Inc."

It owns multiple Domains worldwide consisting of the term <facebook>, including, inter alia, <facebook.com>, <facebook.org>, <facebook.ca>, <פייסבוק.co.il>, <facebook.biz>, <facebook.asia>, etc.

The Petitioner has registered many Trademarks under the same identical term (see below).

The Disputed Domain Name consists of the "facebook" name in its entirety, and is therefore the exact same as the company name of "Facebook Inc." and of the trademark "facebook"

Thus, the Panel finds that the Domain is the same as a trademark, registered company name and legal entity registration of the Petitioner, and therefore the first requirement under the rules, is fulfilled.

#### **b. Complainant has Rights in Name**

The following are clear indications of the Petitioner's Rights in the Disputed Domains:

- Petitioner has established that to date, "Facebook" is a well known trademark around the country and the world: It is strongly associated with Social Networking Services and has more than 800 million users worldwide and more than 30 billion pieces of content are shared each month on Facebook.
- The Petitioner holds numerous Registered Trademarks around the world, which are identical to the name – for example:
  - US Trademark FACEBOOK, number 3,041,791, filed February 2005, first used in commerce February 2004;
  - US Trademark FACEBOOK, number 3,122,052 filed February 2005, first used in commerce November 2004;
  - Israel Trademarks FACEBOOK, numbers 209768, 209770, 209771, 209771, 209773, filed March 2008.
- The Petitioner was incorporated under the name of Facebook, Inc., in Delaware on July 29<sup>th</sup>, 2004.
- The public, worldwide, clearly associates the term "Facebook" with the Petitioner's social networking services. This is evidenced not only by the amount of users on Facebook, but also by web information services

who ranked Facebook as the second most visited website in the world and the third highest level of traffic in Israel (according to [www.alexa.com](http://www.alexa.com) on 16/7/2012).

- Petitioners rights to the name can also be gathered from previous WIPO cases, in which attempts to use the "facebook" in various website name were not recognized by the WIPO panel, and the holders were required to transfer possession of the domains to the Petitioner (inter alia: *Facebook Inc.v. Privacy Ltd. Disclosed Agent for YOLAPT* WIPO case No. D2007-1193,

All of the above clearly indicates that to date, the Petitioner has clear rights in the name "Facebook", as a well-known mark, registered Trademark and Corporate Name.

For clarification, we would like to address the issue of timing: Let it be noted that the Corporate Registration was in July 2004. The Petitioner's services under the Domain <facebook.com> were first offered in February 2004 and opened to the public in September 2006. The Disputed Domain was registered on October 24, 2006.

Since the term "Facebook" consists of two words – "face" and "book", which together do not consist of a generic term and cannot be found in dictionaries, it is self evident that the Holder, when registering the Domain, knew and should have known of the existence of the Facebook name owned by the Petitioner and in use by it (see further discussion under "bad faith" below).

Therefore, the abovementioned registration and use of the Name both precede the registration date of the Disputed Domain, on October of 2006. The Rules do not require that Trademark registration necessarily precede Domain registration in order to guarantee Petitioner rights in a name. Such precedence might be relevant, if at all, only in relation to registration in bad faith (see similar circumstances in WIPO case *Facebook Inc. vs. Callverse Pty*, DAU2008-0007). It can suffice to state that even at the time of registration, the Petitioner already owned rights in the descriptive name "facebook" (see additional discussion below).

From all of the above it is evident that the Petitioner has established rights in the Disputed Domain.

**c. Respondent has no Rights in Name**

Respondent is a private citizen, lawyer by profession, who has no association whatsoever with the Petitioner or its products, and is in no way an authorized dealer, distributor or licensee of the Petitioner.

The Holder's business, a legal practice, is in no way connected with the term "Facebook", or with the Petitioner (other than in use of the social network services provided at facebook.com).

The website under the Disputed Domain consists of reference to four, non-related charitable organizations. None of the Organizations have any association or connection with the term "Facebook" (It is not even clear what relation they have to the Respondent). In the information submitted with this Petition, previous screenshots of the website indicated commercial reference to Facebook, including the Facebook Logo. To date, and as of the past several months (according to historic screenshots of the web page under the Internet Wayback Machine at [www.archive.org](http://www.archive.org)), these Logos have been removed from the web page.

The only current reference to "facebook", other than the Domain name, is a disclaimer stating, in Hebrew, that "this website is in no way or manner associated with the social networking site facebook.com".

As mentioned above, the term "facebook" is not a generic, dictionary term. There is no Prima Facie connection between the Holder (a private entity), the website and the distinctive term.

In previous communication between the Petitioner and the Holder, the Holder agreed to sell the Name, only for a substantial sum. This behavior clearly indicate that the holder has no interest in the Domain itself, thus indicating lack of rights to the Name.

The Holder failed to provide a Statement of Response to this Petition.

Therefore, in light of all the above, the Panel finds sufficient grounds to establish that the Holder has no rights in the name.

#### **d. Registration or Holding in Bad Faith**

Section 3.4 requires that "the application for allocation of the Domain Name was made or the Domain Name was used in bad faith". Though the Rule requires that either the registration or the use be in bad faith, it appears that in this case, there are multiple acts on behalf of the respondent which are indicative of bad faith both in registration and in use, as follows:

In Registration of the Name:

- The website Facebook.com became available for public use on September 2006. The Holder opened his own, personal Facebook account on the social network at Facebook.com, on October 23<sup>rd</sup>, 2006. The Disputed Domain was allocated on the following day (October 24<sup>th</sup>, 2006). Given the extent of press coverage of Facebook's opening to the public, together with the Holder's own, personal access and registration on Facebook.com, it is most highly unlikely that the Holder was not aware of Facebook.com, its existence, or its rights in the Name, at the time of registration.
- The term "Facebook" is not a generic word to be found in dictionaries, and has no relation to any services offered by the Respondent. Such

combination is a proprietary term commonly attributed the meaning created by the Petitioner for the Mark "Facebook" as an online social network. Therefore, use of it by the Respondent indicates an attempt to register a Mark already created and used by the Petitioner.

In Use of the Name:

- The Respondent holds a Domain containing reference to four charitable organizations. The site is barely active and has no connection whatsoever or in any way to the Facebook Name (other than a disclaimer stating that it is in no way connected to the social Network Facebook.com).
- Respondent originally registered a Domain and included commercial links in his website. By nature of these links, they are intended to create profit and gain for certain parties. According to Rule 4.1e, indication of Bad faith is seen when "by using the domain name, the Holder has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location". Possibly the Petitioner assumed that when looking for the social network "facebook.com", potential new customers will not be surprised to find social non-profit organizations, and therefore will be confused by the similarity of the Names. Also important to note that the Respondent, being a lawyer himself, might have become aware of this connection, and therefore recently removed confusing commercial links from his sight (to date – there are no commercial links on the website under the Disputed Domain, which was not the case at the time of the filing of the petition). Such behavior, of course, indicates that the Respondent might have been aware of the existence of circumstances indicting bad faith, and recently took action trying, unsuccessfully, to avoid them.
- The Holder offered, when contacted by phone by Petitioners lawyers (date not provided by Petitioner), to sell the Disputed Domain for \$10,000, which is an unreasonable sum and in no way reflects the actual cost of the registration of the Domain. After negotiation, Holder agreed to reduce said offer only to \$8,000, which is still significantly in excess of the cost of actual registration. As can be learned from the WIPO UDRP Policy Rules, sec. 4.1 c, evidence of registration in bad faith can be found in: " circumstances indicating that the Holder has requested allocation or holds the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name allocation to the complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name"  
In this case, Respondent clearly has no interest in holding the Domain or using it for any purpose of its own, but is solely interested in gaining profit from selling it at an unreasonable cost to the Party who has rights in the Name. Such behavior is clearly indicative of Registration in Bad Faith according to the Rules, and as has also been ruled numerous times both by previous II-DRP Panels (ie – *Colgate-Palmolive Co. v.*

*Tal Eisenbum* in the matter of פלמוליק.co.il) as well as WIPO Panels (ie - *Merck KGaA v. Sunmeet Jolly*, Case No. D2004-0195)

- The Respondent included a disclaimer on his web page indicating that it is in no way connected to the social network at facebook.com. This of itself clearly indicates that the Respondent is aware of potential confusion that might arise from his use of the Disputed Domain, and he tried, unsuccessfully, to abate it.
- The Petitioner failed to reply to this Petition. Thus all the above claims, as made by the Petitioner, remain unrebutted. Lack of response does not automatically prove bad faith, but particularly in cases regarding use of a distinctive term, evidence must be provided to indicate Holder's interests in the Distinctive Term. Lack thereof provides stronger indication of bad faith (see similar circumstances in WIPO UDRP case D2007-1193 *Facebook Inc. v. Privacy Ltd* regarding the name face-book.com).

The combination of all of the above is a sufficient indication of bad faith. Similar decisions have been reached by ISOC Panels in the past, based on similar circumstances. See for example ISOC II-DRP Decisions regarding the Domain מריוט.co.il or the Domain havaianas.co.il

Therefore the Panel concludes that the Respondent has acted in bad faith both in application for registration of the Domain, and in use thereof.

## **V. Decision**

In light of all of the above, Panel finds that the Disputed Domain is the same and identical to many well known and Registered Marks of the Petitioner, the Petitioner has established substantial circumstances supporting its rights to the Disputed Domain, the Respondent presented no rights in the Domain, and the Respondent has acted in bad faith in registering and in holding the Domain.

Therefore, the Panel concludes, in accordance with the Rules, that the Disputed Domain shall be re-assigned to the Petitioner, within 30 days of the date of this decision.

*Leehee Feldman, Adv.*  
Sole Panelist

Date: April 3rd, 2013