

**IN THE MATTER OF A COMPLAINT PURSUANT TO THE  
CANADIAN INTERNET REGISTRATION AUTHORITY  
DOMAIN NAME DISPUTE RESOLUTION POLICY**

Domain Names: *facebookstore.ca* and *facebook-deals.ca*

Complainant: Facebook Inc.

Registrant: Colin Chiat

Registrar: Go Daddy Domains Canada, Inc

Service Provider: Resolution Canada Inc.

Panel: Timothy C. Bourne (Chair), David Allsebrook, James Minns

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**A. The Parties**

1. The Complainant is Facebook Inc. The Registrant is Colin Chiat.

**B. Disputed Domain Name and Registrar**

2. The disputed domain names are *facebookstore.ca* and *facebook-deals.ca* (the "Domain Names"). The registrar with which the Domain Names are registered is Go Daddy Domains Canada, Inc (the "Registrar"). The Domain Names were registered by the Registrant on February 1, 2011.

**C. Procedural History**

3. This is an administrative dispute resolution proceeding pursuant to the *CIRA Domain Name Dispute Resolution Policy*, version 1.3 dated August 22, 2011 (the "Policy") and the *CIRA Domain Name Dispute Resolution Rules*, version

1.5 dated July 28, 2014 (the "*Rules*").

4. The Complainant filed a Complaint dated January 14, 2020 with Resolution Canada Inc. (the "Provider"). The Complainant also filed an Addendum to the Complaint dated February 12, 2020 simply stating that the Complainant did not wish to nominate a panel.
5. The Provider sent by e-mail to the Registrant English and French versions of the Notice of Complaint filed by the Complainant, along with electronic versions of the Complaint and annexes thereto, on February 13, 2020. That email bounced back to the Provider and thus the material was sent to the Registrant on February 20, 2020 by mail. The Registrant filed a Response on March 12, 2020.
6. On May 20, 2020, the Provider appointed the Panel.
7. Based on the information forwarded by the Provider, the Panel holds that all technical requirements for the commencement and maintenance of this proceeding have been established.
8. The Panel is not aware of any other legal proceeding or other arbitration in relation to the Domain Name that would create a need to alter the progress of the proceeding pursuant to paragraph 13.2 of the *Rules*.

**D. Panellist Impartiality and Independence**

9. As required by paragraph 7 of the *Rules*, each of the members of the Panel has submitted to the Provider a declaration of impartiality and independence for this dispute.

**E. Remedy Sought**

10. In accordance with paragraph 4.3 of the *Policy*, the Complainant has requested that the registrations for the Domain Names be transferred to the Complainant.

**F. Applicable Law**

11. In accordance with paragraph 12.1 of the *Rules*, the Panel shall apply the laws of Ontario and the laws of Canada applicable within Ontario. Also, as stated in paragraph 4.2 of the *Policy* and paragraph 3.2(m) of the *Rules*, the Panel will render its decision in accordance with the *Policy* and the *Rules*.

**G. Eligibility of the Complainant**

12. Under paragraph 1.4 of the *Policy*, a complainant must satisfy CIRA's *Canadian Presence Requirements for Registrants*, one of which is that the Complaint relates to a trademark registered in the Canadian Intellectual Property Office ("CIPO") and the complainant owns the trademark.
13. The Complainant owns a Canadian registration for the trademark FACEBOOK and thus is an eligible complainant under the *Policy*.

**H. Facts**

14. The facts within the Response are procedural in nature. The Registrant received a letter dated July 8, 2019 from counsel for the Complainant that notified the Registrant of the Complainant's trademark rights. The letter also included a list of proposed undertakings, including an undertaking to transfer the Domain Names to the Complainant at no cost. The letter was countersigned by the Registrant. A copy of the countersigned version of the

letter is included within the Registrant's submissions.

15. When the Registrant tried to send the countersigned letter to counsel for the Complainant, the e-mail was not received because an incorrect e-mail address was used. After receiving the Notice of Complaint, the Registrant notified the Provider that it had consented to the transfer of the registrations for the Domain Names to the Complainant. This message was relayed to the Complainant, which elected to continue with this dispute resolution proceeding.
16. The Response does not address most of the assertions from the Complaint:
  - the Complainant is the world's leading provider of online social networking services and was founded in 2004. It has more than 2.4 billion monthly active users and 1.47 billion daily active users on average globally. The Complainant's main website located at the URL <http://www.facebook.com> is currently ranked as the third most visited website in Canada;
  - in view of its significant global reach, the Complainant owns numerous domain names consisting of or including the trademark FACEBOOK, including the domain name *facebook.ca*;
  - the Complainant enjoys significant online renown, as is evidenced by the results of a GOOGLE search using its well-known trademark FACEBOOK;
  - upon becoming aware of the registrations for the Domain Names, the Complainant sent a message to the Registrant via CIRA's "Interested Party Contact: Message Delivery Form", which was not replied to;

- the Registrant also owns other domain name registrations, such as *google-bids.com*, *google-offers.com* and *googleoffersstore.com*; and
- the Complainant's lawyers did not receive a response to the July 8, 2019 letter sent to the Registrant.

## **I. Complainant's Contentions**

### **i. Domain Names are Confusingly Similar to a Mark in Which the Complainant Had Rights Prior to the Domain Name Registration Dates and Continues to Have Such Rights**

17. The Complainant owns a registration in Canada for the trademark FACEBOOK, which predates the registration of each of the Domain Names. The Domain Names are confusingly similar with the trademark FACEBOOK since the Domain Names fully incorporate that trademark and add the generic term "store" or "-deals".

### **ii. The Registrant Has No Legitimate Interest in the Domain Names**

18. The Complainant submits that none of the enumerated circumstances constituting a legitimate interest from paragraph 3.4 of the *Policy* exist with respect to the Registrant and the Domain Names.

### **iii. The Domain Name Was Registered in Bad Faith**

19. The Complainant submits that each of the circumstances enumerated in subparagraphs 3.5(b) and 3.5(d) of the *Policy* exist. The Complainant has provided detailed arguments in support of both bad faith grounds alleged.

**J. Discussion and Finding**

- 20. The most significant fact before the Panel is that the Registrant executed correspondence by which it agreed to transfer the registrations of the Domain Names to the Complainant. The Registrant's correspondence with the Provider confirms that it maintains a willingness to transfer the registrations for the Domain Names to the Complainant.
  
- 21. Moreover, even if the Registrant had not executed that letter and confirmed his willingness to transfer the registrations for the Domain Names to the Complainant, the Panel would have concluded, based on the material before it, that the Complainant had established the three elements of the basis for the Complaint under paragraph 4.1 of the Policy in accordance with their respective onuses.

**K. Conclusion and Decision**

- 22. Thus, for all of the reasons set out above, the Panel orders the transfer of the registrations for the Domain Names to the Complainant.

June 6, 2020



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Timothy C. Bourne, Chair



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David Allsebrook



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James Minns