

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

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Domain Name:           facebookshop.ca  
Complainant:           Facebook Inc.  
Registrant:             M&A Painting Ltd.  
Registrar:             Go Daddy Domains Canada, Inc.  
Panel:                  David Allsebrook  
Service Provider:      Resolution Canada, Inc.

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**DECISION**

**A.     The Parties**

1. The complainant is Facebook Inc., (the “Complainant”) located in Menlo Park, California.
2. The registrant for the domain name is M&A Painting Ltd. (the “Registrant”) whose location is or was in North Vancouver, British Columbia.

**B.     The Domain Name and Registrar**

3. The disputed domain name is facebookshop.ca (the “Domain Name”). The registrar for this domain name is Go Daddy Domains Canada, Inc. (the “Registrar”). The Domain Name was registered on January 1, 2013.

**C.     Procedural History**

4. This is a proceeding under the Canadian Internet Registration Authority (“CIRA”) *Domain Name Dispute Resolution Policy* (Version 1.3) (the “Policy”) and the CIRA *Domain Name Dispute Resolution Rules* (Version 1.5) (the “Rules”).
5. The history of the proceeding as provided by the dispute resolution service provider, Resolution Canada, Inc. (“Resolution Canada”), is that the Complainant filed a complaint

dated May 22, 2020 with Resolution Canada requesting that the current registration of the Domain Name be transferred to the Complainant.

6. Resolution Canada served notice of the complaint on the Registrant as required by paragraph 4.3 of the Rules. Service of the complaint on the Registrant was made by email on June 3, 2020.
7. The Registrant made no response or reply to the Complaint.

**D. Panellist Impartiality and Independence**

8. As required by paragraph 7 of the Rules, the panellist has submitted to Resolution Canada declarations of impartiality and independence in relation to this dispute.

**E. Canadian Presence Requirements**

9. The Complainant is a corporation located in the United States. Since 2009, it has been the registered owner of a registration for the trademark FACEBOOK in Canada (registration no. TMA742212). The Domain Name consists of this mark with the added generic word “shop”. The first issue is whether the Complainant satisfies the Canadian Presence Requirements. Paragraph 2(17) of the CIRA *Canadian Presence Requirements for Registrants*, Version 1.3 states:

“2. **Canadian Presence Requirements.** On and after November 8, 2000 only the following individuals and entities will be permitted to apply to CIRA (through a CIRA certified registrar) for the registration of, and to hold and maintain the registration of, a .ca domain name:

...

“17. **Trade-mark registered in Canada.** A Person which does not meet any of the foregoing conditions, but which is the owner of a trade-mark which is the subject of a registration under the *Trade-marks Act* (Canada) R.S.C. 1985, c.T-13 as amended from time to time, but in this case such permission is limited to an application to register a .ca domain name consisting of or including the exact word component of that registered trade-mark; or”

10. The domain name “facebokshop.ca” includes the exact word component of the Complainant’s registered trademark “FACEBOOK”. Accordingly, the Complainant meets the Canadian Presence Requirements.

**F. Factual Background**

11. The Complaint includes the following representations:

“The Complainant, **Facebook, Inc.**, (the “**Complainant**” or “**Facebook**”) is the world’s leading provider of online social networking services.... Since its launch in 2004, Facebook rapidly developed considerable renown and goodwill worldwide, with 1 million active users by the end of 2004, 100 million users in August 2008, 500 million users in July 2010, 1 billion users by September 2012 and 2.27 billion users as of September 2018.

“Today, Facebook has more than 2.4 billion monthly active users and 1.62 billion daily active users on average worldwide. Its main website [www.facebook.com](http://www.facebook.com) is currently ranked as the 3<sup>rd</sup> most visited website in Canada and 5<sup>th</sup> in the world according to information company Alexa.

“The Domain Name was registered on 1 January 2013. Currently, the Registrant's details are partially masked and the only available information is the Registrant's name, M&A Painting Ltd. Before the underlying details of the Domain Name became masked, the WHOIS record mentioned, among others, the Registrant's physical address [in Vancouver – details omitted from decision] and the email address [omitted from decision].

“The Domain Name used to point to an undeveloped page with the picture of a baby and the eyes of a woman, with a sentence in German meaning "there's a lot to discover" and a short text in Persian, which may be roughly translated as:

"My darling, my darling O my last love  
This crazy man was your love in madness  
Now that you are gone, Mahmoud Bebo  
dies. jaaaaa babyyyyyyyyyyyyyyy ja ja ja  
baby"

“The Domain Name stopped resolving to an active website after the Complainant sent the cease and desist letter [in January 2020]”

## **G. CIRA *Domain Name Dispute Resolution Policy***

**12.** Paragraph 4.1 of the Policy requires that the Complainant establish that:

- a) the Registrant’s dot ca domain name is Confusingly Similar to a Mark in which the Complainant had Rights prior to the date of registration of the domain name and continues to have such Rights;

- b) (b) the Registrant has registered the domain name in bad faith as described in section 3.5; and
  - c) (c) the Registrant has no legitimate interest in the domain name as described in section 3.4.
13. The Complainant must establish points (a) and (b) above on the balance of probabilities and for point (c) it must provide some evidence that the Registrant has no legitimate interest in the domain name. Even if the Complainant proves (a) and (b) and provides some evidence of (c), the Registrant will succeed in the proceeding if the Registrant proves, on a balance of probabilities, that the Registrant has a legitimate interest in the domain name as described in section 3.4 of the Policy.

## **H. Analysis**

### Rights to a Mark

14. Under paragraph 4.1(a) of the Policy, the Complainant has to show, on the balance of probabilities, that it had rights (and continues to have these rights) in a mark that was confusingly similar to the domain name, prior to the date of registration of the disputed domain name. “Mark” is defined in paragraph 3.2(c) of the Policy as:
- a) a trade-mark, including the word elements of a design mark, that is registered in CIPO;
15. The Domain Name was registered on January 1, 2013, four years after the trademark FACEBOOK was registered in Canada by the Complainant. The Complainant has established that it had rights in a mark prior to the date of registration of the Domain Name, and continues to have these rights.
16. The Domain Name consists of the words facebookshop.ca. The first element “FACEBOOK”, is the same as the only word the registered trademark. The descriptive or mis descriptive element “shop” and the “.ca” are disregarded for the purpose of this analysis.
17. Therefore, pursuant to paragraph 3.3 of the Policy, the Domain Name is confusingly similar to the mark FACEBOOK as it so nearly resembles the mark in appearance, sound and in the idea suggested by the mark as to be likely to be mistaken for the mark.

### Bad Faith

18. The Complainant is required to show, on the balance of probabilities, that the Domain Name was registered in bad faith. Paragraph 3.5 of the Policy deals with the grounds which constitute bad faith and it must be noted that these are not exhaustive; it is open to the panel to find other grounds which lead to a conclusion of bad faith conduct.

19. Paragraph 3.5 states as follows:

**“3.5 Registration in Bad Faith.** For the purposes of paragraphs 3.1(c) and 4.1(b), any of the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence that a Registrant has registered a domain name in bad faith:

1. “the Registrant registered the domain name, or acquired the Registration, primarily for the purpose of selling, renting, licensing or otherwise transferring the Registration to the Complainant, or the Complainant’s licensor or licensee of the Mark, or to a competitor of the Complainant or the licensee or licensor for valuable consideration in excess of the Registrant’s actual costs in registering the domain name, or acquiring the Registration;
2. “the Registrant registered the domain name or acquired the Registration in order to prevent the Complainant, or the Complainant’s licensor or licensee of the Mark, from registering the Mark as a domain name, provided that the Registrant, alone or in concert with one or more additional persons has engaged in a pattern of registering domain names in order to prevent persons who have Rights in Marks from registering the Marks as domain names;
3. “the Registrant registered the domain name or acquired the Registration primarily for the purpose of disrupting the business of the Complainant, or the Complainant’s licensor or licensee of the Mark, who is a competitor of the Registrant; or
4. “the Registrant has intentionally attempted to attract, for commercial gain, Internet users to the Registrant’s website or other on-line location, by creating a likelihood of confusion with the Complainant’s Mark as to the source, sponsorship, affiliation, or endorsement of the Registrant’s website or location or of a product or service on the Registrant’s website or location.”

20. None of these sections bears directly on the situation. The web page which appeared at facebookshop.ca, before the demand letter was sent, appears to offer no good or service. No attempt has been made to sell the domain name to the Complainant. No abusive pattern of domain name registrations is alleged. Nothing done with the name appears to disrupt the Complainant’s business. It is not evident how traffic to the web site would benefit the Registrant.

21. Nonetheless the overwhelming fame of Facebook could not be a coincidence in the choice of the Registrant’s domain name. The word “Facebook” is not a dictionary term and has no meaning apart from the trademark. The Registrant must have had the Complainant or its services in mind in choosing its domain name. The added element “shop” in the domain name suggests a commercial purpose at the time of the registration, to be pursued with a helping hand from the goodwill the Complainant had generated in its trademark FACEBOOK.

22. Accordingly, in the absence of any explanation by the Registrant, the Registration is found to have been made in bad faith.

### Legitimate Interest

23. In order to succeed, the Complainant also has to provide some evidence that the Registrant does not have a legitimate interest in the domain name. Paragraph 3.4 of the Policy lists six possible ways in which a Registrant may have a legitimate interest in a domain name which are as follows:

- (a) the domain name was a Mark, the Registrant used the Mark in good faith and the Registrant had Rights in the Mark;
- (b) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was clearly descriptive in Canada in the English or French language of:
  - (i) the character or quality of the wares, services or business;
  - (ii) the conditions of, or the persons employed in, production of the wares, performance of the services or operation of the business; or
  - (iii) the place of origin of the wares, services or business;
- (c) the Registrant registered the domain name in Canada in good faith in association with any wares, services or business and the domain name was understood in Canada to be the generic name thereof in any language;
- (d) the Registrant used the domain name in Canada in good faith in association with a non-commercial activity including, without limitation, criticism, review or news reporting;
- (e) the domain name comprised the legal name of the Registrant or was a name, surname or other reference by which the Registrant was commonly identified; or
- (f) the domain name was the geographical name of the location of the Registrant's non-commercial activity or place of business.

24. This list is not exhaustive as it is said to be "without limitation".

25. The Complaint need only raise a reasonable challenge to the legitimacy of the domain name registration to establish its case in the absence of a show of legitimacy by the Registrant. The Domain Name, and its use by the Registrant, do not appear to fit in any of the categories listed in paragraph 3.4 and no other ground of legitimacy suggests itself in the circumstances. The Complaint meets its light burden and the Registrant has offered no reply.

**I. Conclusion and Decision**

26. In conclusion, the panel finds that the Complainant has rights in the mark FACEBOOK which predate the registration of the Domain Name. The panel also finds that the Domain Name is confusingly similar to the Complainant's mark FACEBOOK, that the Domain Name was registered in bad faith and that the Registrant has no legitimate interest in the Domain Name.
27. The panel therefore orders, pursuant to paragraph 4.3 of the Policy, that the registration of the Domain Name facebookshop.ca be transferred to the Complainant.

Dated: July 28, 2020



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By: David Allsebrook