

ADMINISTRATIVE PANEL DECISION

Meta Platforms, Inc. v. Robert Goldman, A4M
Case No. D2022-3213

1. The Parties

Complainant is Meta Platforms, Inc., United States of America (“United States”), represented by Hogan Lovells (Paris) LLP, France.

Respondent is Robert Goldman, A4M, United States, represented by Paul Law Group, LLP, United States.

2. The Domain Names and Registrar

The disputed domain names <multiversefacebookads.com>, <multiversefacebookadvertising.com>, <multiverse-facebook.com>, <multiversefacebookcreative.com>, <multiversefacebookdatacenter.com>, <multiversefacebookdata.com>, <multiversefacebookdesigncompany.com>, <multiversefacebookdesigners.com>, <multiversefacebookdesigngroup.com>, <multiversefacebookdesignsolutions.com>, <multiversefacebookfiles.com>, <multiversefacebookgroup.com>, <multiversefacebookhelp.com>, <multiversefacebooklist.com>, <multiversefacebookmarketing.com>, <multiversefacebookmediagroup.com>, <multiversefacebookmediasolutions.com>, <multiversefacebooknetwork.com>, <multiversefacebookonline.com>, <multiversefacebook.com>, <multiversefacebookservice.com>, <multiversefacebookservices.com>, <multiversefacebookservicescompany.com>, <multiversefacebooksolutions.com>, <multiversefacebookvideo.com>, <multiversefacebookvideos.com>, <multiversefacebookweb.com>, <multiversefacebookwebsite.com>, <multiversemetafacebookadvertising.com>, <multiversemetafacebook.com>, <multiversemetafacebookcompany.com>, <multiversemetafacebookcreative.com>, <multiversemetafacebookdatabase.com>, <multiversemetafacebookdata.com>, <multiversemetafacebookdb.com>, <multiversemetafacebookdesign.com>, <multiversemetafacebookdesigners.com>, <multiversemetafacebookgraphics.com>, <multiversemetafacebookmarketing.com>, <multiversemetafacebookmedia.com>, <multiversemetafacebookmediagroup.com>, <multiversemetafacebooknetwork.com>, <multiversemetafacebookonline.com>, <multiversemetafacebookpro.com>, <multiversemetafacebooksales.com>, <multiversemetafacebook.com>, <multiversemetafacebooksearch.com>, <multiversemetafacebookservice.com>, <multiversemetafacebooksolutions.com>, <multiversemetafacebookstudio.com>, <multiversemetafacebooksupport.com>, <multiversemetafacebooktech.com>, and <multiversemetafacebookweb.com> (the “Domain Names”) are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 30, 2022. On August 31, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On August 31, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Names, which differed from the named Respondent (Registration Private, Domains By Proxy, LLC, United States) and contact information in the Complaint. The Center sent an email to Complainant on September 5, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on September 9, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), 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 Respondent of the Complaint, and the proceedings commenced on September 20, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2022. Upon request of the Respondent, the due date for Response was automatically extended to October 14, 2022, pursuant to the Rules, paragraph 5(b). The Response was filed with the Center on October 14, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on October 21, 2022. 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.

On October 26, 2022, Complainant sent the Center an unsolicited supplemental filing, asserting that there were items raised in the Response which could not have been reasonably anticipated in the original Complaint. On October 27, 2022, Respondent requested the opportunity to reply to Complainant’s supplemental filing, in the event the Panel were to admit Complainant’s supplemental submission.

On October 31, 2022, the Panel issued Procedural Order No. 1 which stated:

“The Panel has reviewed the submissions of the Parties and notes that on October 26, 2022, the Complainant submitted a supplemental filing to the Center.

Pursuant to its general powers under paragraphs 10 and 12 of the Rules, the Panel invites the Respondent to submit any comments on the Complainant’s supplemental filing by November 10, 2022, to the Center (copying the Complainant).

Any further submissions should be limited to the above request.

The due date for the Decision is hereby extended to November 20, 2022.”

Respondent timely submitted additional materials and arguments to the Center on November 10, 2022.

4. Factual Background

Complainant Meta Platforms, Inc., describes itself as a “social technology company” which operates, among other things, Facebook, Instagram, and WhatsApp. According to Complainant, its focus is “to bring the metaverse to life and to help people connect, find communities and grow businesses.” Complainant announced the launch of its META brand on October 28, 2021.

Facebook is an online social media service provider. Complainant has provided social networking services under the FACEBOOK trademark since 2004, and today is one of the world's largest social media firms. Complainant has more than 2.93 billion active monthly users and more than 1.97 billion active daily users around the world. Complainant's website, located at "www.facebook.com", is one of the most visited sites in the world.

The trademark FACEBOOK is registered in numerous jurisdictions, including United States Reg. No. 3,041,791, registered on January 10, 2006.

According to the Complainant, FACEBOOK is a famous trademark.

All 53 of the Domain Names at issue in this proceeding were registered on April 25, 2022 with the same registrar. All but two of the Domain Names resolve to registrar parking pages which contain pay-per-click ("PPC") hyperlinks. The other two Domain Names resolve to blank web pages. Respondent denies that he derives any income from the PPC links.

Annexed to the Response is an unsworn, un-notarized document entitled "Respondent's Affirmation of Certain Facts," in which Respondent makes various assertions. According to Respondent, he is the "co-founder and co-chair of the American Academy of Anti-Aging Medicine ("A4M") and numerous other health and fitness organizations." Respondent states that A4M "develops and supervises medical credentialing programs for physicians and other health professionals in a variety of medical fields, including preventative and mental health programming."

Respondent states further that "I have conferred with and am collaborating with a number of organizations and health care providers and practitioners to develop additional programming focused on mental health wellness and treatments and other wholistic health programs." He claims to have received funding commitments of "not less than" USD 5,000,000. In addition, he claims that "my organizations have entered into several letter agreements, letters of intent, memorandums of understanding and other similar documents in support of this venture" (which he defines as an "EMH venture"). The documentation surrounding this EMH venture "is currently confidential," according to Respondent.

Respondent states that, to date, he has spent more than USD 100,000 "to develop the programming," and that initial development costs will probably exceed USD 10,000,000. There is no hard evidence to support these alleged outlays and estimates.

According to Respondent, the purpose of registering the 53 Domain Names "is to provide organizational structure and virtual addressing for both the patient and the mental health professional." (As Respondent explains, mental health professionals with whom he has spoken "have emphasized the importance of developing virtual-world experiences which mirror that [sic] encountered in the real world, such as the importance of using actual real-world names in the virtual world.") Respondent states that the Domain Names "will be accessible only to patients and their mental health professionals."

Apparently, the goal is for the patient to land at web pages which he believes to be actual FACEBOOK pages, whereas in reality these pages are fake FACEBOOK pages. The patient's interactions on the faux FACEBOOK pages are to be monitored by the mental health professional, who may engage the patient through this medium. Again, Respondent asserts that it is important that the patient actually believe that he is interfacing with the real social media platform, and not some false platform.

Respondent states in his November 10, 2022 supplemental submission:

"Respondents are not internet trolls gobbling up domain names to make a quick buck, but rather, serious and accomplished professionals that intend to use the domain names to launch a needed and beneficial mental health care business. The URLs obtained by the Respondents directly correspond with various virtual mental health treatment simulations that will be offered to patients."

On July 29, 2022, Complainant's counsel sent Respondent (via the Registrar's contact form) 53 separate cease-and-desist notices (one per Domain Name). Respondent did not reply to Complainant's cease-and-desist notices. Put another way, he passed up the opportunity to make Complainant aware of his reason for registering 53 Domain Names containing META and FACEBOOK.

5. Parties' Contentions

A. Complainant

Complainant asserts that it has established all three elements required under the Policy for a transfer of each of the 53 Domain Names at issue.

B. Respondent

Respondent's position is reflected above in the "Factual Background" section.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to each of the Domain Names:

- (i) the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) the Domain Names have been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel concludes that Complainant has rights in the trademark FACEBOOK through registration and use demonstrated in the record. The Panel also concludes that each of the Domain Names are confusingly similar to that mark. The word "meta" (corresponding to META, a more recent trademark adopted by Complainant) also appears in each Domain Name, and this also supports a finding of confusing similarity. Other additional words and characters appearing in the various Domain Names (e.g. "multiverse", "ads", "advertising", "creative", etc.) do not prevent a finding of confusing similarity noting the fact that the famous mark FACEBOOK is clearly recognizable in each Domain Name.

Complainant has established Policy paragraph 4(a)(i).

B. Rights or Legitimate Interests

For each of the Domain Names, pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Names, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Domain Names or a name corresponding to the Domain Names in connection with a *bona fide* offering of goods or services; or
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Names, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are making a legitimate noncommercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Panel concludes that Respondent lacks rights or legitimate interests in connection with the Domain Names. The Panel sees enough evidence in the record to conclude that Respondent appears to be in the process of launching a legitimate business.

That fact, however, does not mean that Respondent is entitled to use Complainant's famous trademark FACEBOOK (and Complainant's newer META mark) in 53 Domain Names in order to advance his business. It is undisputed that Complainant has not licensed or otherwise authorized Respondent to register 53 Domain Names containing the marks FACEBOOK and META. According to Respondent's own account, he wants his clients to believe that the web pages he plans to create are genuine FACEBOOK pages. For the purposes of the UDRP, a respondent, however well motivated, simply cannot appropriate the famous trademarks of a complainant in order to imitate the complainant and mislead Internet users into believing that the web pages in question are related to the famous trademark.

Complainant has established Policy paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

For each of the Domain Names, paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation," are evidence of the registration and use of the Domain Names in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Names primarily for the purpose of selling, renting, or otherwise transferring the Domain Names registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Names; or
- (ii) that Respondent has registered the Domain Names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Names primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Names, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes that Respondent registered and used the Domain Names in bad faith under the Policy. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. Again, the Panel is prepared to assume that Respondent's business plan is genuine.

The problem here is that Respondent has registered 53 Domain Names with knowledge of the Complainant and its famous FACEBOOK mark precisely for the purpose of misleading its clients into believing that the web pages the clients are viewing are genuine pages from the famous FACEBOOK platform. The Panel presumes that Respondent intends to derive income from his new business. As such, the facts here fit within the above-quoted Policy paragraph 4(b)(iv).

This appears to be a case where Respondent should have approached Complainant for some sort of permission to use FACEBOOK in a series of Domain Names within the parameters of the business plan. Respondent's nascent business, if genuine, appears well motivated and worthwhile. In any event, Respondent did not do so, and "bad faith" under the UDRP does not require a finding of malice or ill motives – taking unfair advantage of a complainant's trademark, as is the case here, is sufficient.

Complainant has established Policy paragraph 4(a)(iii).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the following Domain Names be transferred to Complainant:

<multiversefacebookads.com>, <multiversefacebookadvertising.com>, <multiverse-facebook.com>, <multiversefacebookcreative.com>, <multiversefacebookdatacenter.com>, <multiversefacebookdata.com>, <multiversefacebookdesigncompany.com>, <multiversefacebookdesigners.com>, <multiversefacebookdesigngroup.com>, <multiversefacebookdesignsolutions.com>, <multiversefacebookfiles.com>, <multiversefacebookgroup.com>, <multiversefacebookhelp.com>, <multiversefacebooklist.com>, <multiversefacebookmarketing.com>, <multiversefacebookmediagroup.com>, <multiversefacebookmediasolutions.com>, <multiversefacebooknetwork.com>, <multiversefacebookonline.com>, <multiversefacebook.com>, <multiversefacebookservice.com>, <multiversefacebookservices.com>, <multiversefacebookservicescompany.com>, <multiversefacebooksolutions.com>, <multiversefacebookvideo.com>, <multiversefacebookvideos.com>, <multiversefacebookweb.com>, <multiversefacebookwebsite.com>, <multiversemetafacebookadvertising.com>, <multiversemetafacebook.com>, <multiversemetafacebookcompany.com>, <multiversemetafacebookcreative.com>, <multiversemetafacebookdatabase.com>, <multiversemetafacebookdata.com>, <multiversemetafacebookdb.com>, <multiversemetafacebookdesign.com>, <multiversemetafacebookdesigners.com>, <multiversemetafacebookgraphics.com>, <multiversemetafacebookmarketing.com>, <multiversemetafacebookmedia.com>, <multiversemetafacebookmediagroup.com>, <multiversemetafacebooknetwork.com>, <multiversemetafacebookonline.com>, <multiversemetafacebookpro.com>, <multiversemetafacebooksales.com>, <multiversemetafacebooks.com>, <multiversemetafacebooksearch.com>, <multiversemetafacebookservice.com>, <multiversemetafacebooksolutions.com>, <multiversemetafacebookstudio.com>, <multiversemetafacebooksupport.com>, <multiversemetafacebooktech.com>, and <multiversemetafacebookweb.com>.

/Robert A. Badgley/

Robert A. Badgley

Sole Panelist

Date: November 20, 2022