

ADMINISTRATIVE PANEL DECISION

Facebook Technologies, LLC v. Matinee Classics LLC Case No. D2022-1982

1. The Parties

Complainant is Facebook Technologies, LLC, United States of America (“United States”), represented by Tucker Ellis, LLP, United States.

Respondent is Matinee Classics LLC, United States.

2. The Domain Names and Registrar

The disputed domain names, <augmentedrealityoculus.com>, <avirtualrealityoculus.com>, <extendedrealityoculus.com>, <mixedrealityoculus.com>, <oculusalternatereality.com>, <oculusaugmentedreality.com>, <oculusecosystem.com>, <oculusports.com>, <oculusextendedreality.com>, <oculusmetaverse.com>, <oculusmixedreality.com>, <oculusvideogames.com>, <oculusvideogaming.com>, <oculusvirtuality.com>, <oculusvirtually.com>, <realityoculus.com>, and <virtualityoculus.com>, are registered with Rebel Ltd (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 31, 2022. On June 1, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On June 2, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on June 3, 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 June 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 June 10, 2022. In accordance with the Rules, paragraph 5, the due date for the Response was June 30, 2022. The Response was filed with the Center on June 27, 2022.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on July 5, 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.

4. Factual Background

Complainant is a subsidiary of Meta Platforms, Inc. (formerly Facebook, Inc). Complainant distributes and markets virtual reality headsets. It is the proprietor of numerous registrations comprising the term OCULUS, including the following:

- International Trademark Registration No. 1219324 for OCULUS (word mark), registered on June 12, 2014 for goods in class 28;
- United States Trademark No. 4991015 for OCULUS (word mark), registered on July 5, 2016 for services in class 42.

Complainant has registered and operates a business website at the domain name <oculus.com>, and has registered several domain names reflecting its OCULUS mark.

Respondent is engaged in the business of registering domain names and is a critic of Complainant. It is undisputed that there is no relationship between the Parties.

The disputed domain names are summarized below. According to information in the record, at the time that the Complaint was filed, all 17 disputed domain names redirected to <metaversedomains.com>, where 14 of the disputed domain names were offered for sale. The disputed domain names are summarized below:

Disputed domain name	Date of registration	Price listed on <metaversedomains.com>
<augmentedrealityoculus.com>	June 19, 2021	Was not listed for sale.
<avirtualrealityoculus.com>	September 28, 2021	USD 300,000
<extendedrealityoculus.com>	July 30, 2021	USD 500,000
<mixedrealityoculus.com>	June 19, 2021	Was not listed for sale.
<oculusalternatereality.com>	August 14, 2021	USD 300,000
<oculusaugmentedreality.com>	June 18, 2021	USD 300,000
<oculusecosystem.com>	August 17, 2021	USD 300,000
<oculusesports.com>	June 19, 2021	USD 300,000
<oculusextendedreality.com>	July 24, 2021	USD 300,000
<oculusmetaverse.com>	July 24, 2021	USD 750,000
<oculusmixedreality.com>	June 18, 2021	USD 300,000
<oculusvideogames.com>	June 18, 2021	USD 300,000
<oculusvideogaming.com>	June 18, 2021	USD 300,000
<oculusvirtuality.com>	July 31, 2021	USD 300,000
<oculusvirtually.com>	July 31, 2021	USD 300,000
<realityoculus.com>	July 11, 2021	Was not listed for sale. As of the Decision date, redirects to a pay-per-click (PPC) website

<virtualityoculus.com>	July 31, 2021	USD 300,000
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As of the date of the decision, the majority of the disputed domain names redirect to the domain name <facebookwhistleblowers.com>. The domain name <facebookwhistleblowers.com> resolves to a website containing information highly critical of Complainant's parent company Meta, Inc. Complainant states that it sent a cease-and-desist notice to the Respondent in early August 2021. The record contains copies of Respondent's email replies dated August 10, 2021 and August 24, 2021. In these replies, Respondent acknowledges registration of the disputed domain names and asserts that its objective was to criticize Complainant and its management, and that registering numerous domain names is an attempt to draw attention to this criticism.¹ Respondent states that, in relevant part:

"I own 60+ Metaverse and Virtual Reality type domain names, all of which forward to these protest websites of mine that I have alluded to previously and because Big Tech, which includes Facebook, are determined to censor my content and prevent the public from viewing the contents I will need to take the bull by the horns so to speak and market my domains for sale to the highest bidder by emailing every entity even remotely engaged in the subject matter, because by every knowledgeable organization, indications are that the 'Metaverse' and/or Virtual Reality will garner hundreds of billions of dollars in the future thereby making these specific domains 'PRICELESS' to say the least.

By notifying hundreds of organizations involved in these subjects by merely emailing the specific links MetaverseDomainNames.com and VirtualRealityDomainNames.com, which leaves no doubt about the true value, should instill tremendous interest in acquiring them by all forward thinking entities wishing to get in on the ground floor of this earth shattering and world altering endeavor. Some may even be your competitors.

Anyone in the know, which obviously includes Facebook, is completely aware of the significance of and the monetary importance of capitalizing on this to become the dominant player for decades to come in these massive interconnecting fields which will forever alter the internet and mobile interactions including Social Media!

Once they are gone there are no similar names available whatsoever!"

Respondent does not disclaim this correspondence in its Response.

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that it or its predecessor in interest has been in the business of promoting and distributing virtual reality headsets under the OCULUS brand since 2012. Complainant has sold over 1.5 million such headsets since 2019. The disputed domain names add various generic and descriptive terms to Complainant's OCULUS mark and are therefore confusingly similar thereto. Respondent has previously registered other domain names targeting Complainant's OCULUS mark.

Under the second element, Complainant states that Respondent is not authorized to use Complainant's OCULUS mark, nor does Respondent have any legal relationship with Complainant that would entitle it to use the OCULUS mark. Respondent is using the disputed domain names to redirect to the domain name <metaversedomainnames.com>, which lists hundreds of domain names for sale, including all but except three of the disputed domain names, for prices ranging from USD 150,000 to USD 750,000, amounts that far

¹ The Panel notes that these emails were signed by the same individual who provided the Response on behalf of Respondent, using the registrant email address as confirmed by the Registrar. As the email communications were sent from the registrant's email address, the Panel will therefore consider these emails as being sent by the Respondent.

exceed the registration costs. The disputed domain names are not being used in connection with a *bona fide* offering of goods or services, and Respondent is not commonly known by the disputed domain names. Complainant states that Respondent is legally barred from conducting business in the State of California, United States. Complainant states that Respondent stated that the disputed domain names were registered for the purposes of protest and that it would market the disputed domain names to the highest bidder, including to Complainant's competitor.

Under the third element, Complainant states that Respondent had knowledge of and deliberately targeted Complainant and its well-known OCULUS mark, as evidence by emails sent to Complainant. In these emails Respondent threatened to sell the disputed domain names "to the highest bidder," including to Complainant's competitors. Respondent has previously been involved in a UDRP proceeding involving the well-known mark of a third party.

Complainant requests transfer of the disputed domain names.

B. Respondent

Respondent's arguments may be summarized as follows: there are numerous federal trademark registrations of the United States comprising the term "oculus," including some owned by Complainant. Complainant cannot monopolize a dictionary term unless it pertains to a unique subject. Some of the disputed domain names, such as <oculusecosystem.com> and <oculusports.com> make no reference to virtual reality headsets and therefore cannot infringe Complainant's rights.

Respondent states that it registered the disputed domain names for the purpose of creating protest websites against Complainant and its management at the domain name <facebookwhistleblowers.com>. They are non-income-generating protest websites solely for public awareness of the harm to Internet users caused by Complainant. The disputed domain names are listed for sale at unreasonably high prices as a protest against Complainant. None of the disputed domain names have been sold. The content of the protest websites is such that no Internet user would believe that they are affiliated with Complainant, as they contain only information critical of Complainant. Respondent believes that Complainant and others previously caused its protest websites at other domain names to be blocked, therefore, it registered these domain names to ensure that Internet users would have access to this content.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed 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 disputed domain names; and
- (iii) Respondent has registered and is using the disputed domain names in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

A. Identical or Confusingly Similar

Complainant has provided evidence establishing that it has trademark rights in the OCULUS mark through registrations in the United States and other jurisdictions. Complainant thereby satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1.

In comparing Complainant's marks with the disputed domain names, the Panel finds that the disputed domain names are confusingly similar to Complainant's marks. Each disputed domain name reflects Complainant's OCULUS mark together with various dictionary terms. It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, where the relevant trademark is recognizable within the disputed domain names, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

Respondent argues that Complainant cannot claim exclusive rights in "oculus," which is a dictionary term. The Panel notes that, according to established UDRP practice, the first element functions primarily as a standing requirement, involving a side-by-side comparison of the disputed domain names and the relevant trademark. Noting the circumstances of the case, the Panel finds that Complainant has demonstrated its uncontroverted rights in the OCULUS mark. Under the circumstances, the strength of Complainant's mark has no bearing on the Panel's finding under the first element. See [WIPO Overview 3.0](#), section 1.7, and cases cited thereunder.

It is the well-established view of UDRP panels that the generic Top-Level Domain ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy in respect of all of the disputed domain names.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish rights to or legitimate interests in a domain name by demonstrating any of the following:

- (i) before any notice to it of the dispute, respondent's 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) respondent has been commonly known by the domain names, even if it has acquired no trademark or service mark rights; or
- (iii) respondent is 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 finds that there is no evidence that Respondent is commonly known by the disputed domain names or is using the OCULUS mark with the permission of Complainant, which expressly states that no such permission exists.

Respondent argues that it registered the disputed domain names for the purpose of publishing information critical of Complainant and that the offer to sell some of the disputed domain names at prices exceeding the costs of registration was intended to draw attention to its criticism of Complainant, and that therefore it is entitled to fair use of the disputed domain names as noncommercial free speech.

UDRP panels recognize a respondent's claim to a legitimate interest under Paragraph 4(c)(iii) of the Policy where the criticism is genuine and noncommercial. See [WIPO Overview 3.0](#), section 2.6.1.

The Panel, in considering Respondent's arguments in light of the Policy, Rules, and previous UDRP practice, finds that Respondent has failed to substantiate its claim to legitimate interests in respect of the disputed domain names.

As a threshold matter, registering a domain name reflecting the trademark of a third party, even where the domain name consists of a trademark plus an additional term, cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. On the other hand, domain names incorporating critical terms (such as “sucks”) would tend to communicate that there is no such affiliation. In this case, the disputed domain names may or may not trigger an inference of affiliation and the Panel therefore must examine the broader facts and circumstances of the case, including the associated website content, to assess potential rights or legitimate interests. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel finds that the disputed domain names target Complainant and do not signal that Respondent is engaging in protest activities. In some cases, they reflect Complainant’s mark together with terms that are directly connected to Complainant’s business (“virtual reality,” “metaverse,” “video games,” “video gaming,” “virtuality,” “virtually,” “reality.”) In other cases, the additional terms anticipate activities in which Complainant can reasonably be foreseen to engage in the future (“augmented reality,” “extended reality,” “mixed reality,” “alternate reality,” “extended reality”). See [WIPO Overview 3.0](#), Section 3.8.2. See also *Tencent Technology (Shenzhen) Co.Ltd v. Super Privacy Service c/o Dynadot*, WIPO Case No. [D2018-0391](#).

Respondent argues that the disputed domain names <oculusecosystem.com> and <oculusesports.com> have no connection to Complainant’s business and that they therefore do not infringe Complainant’s mark. The Panel finds that it cannot be discharged that terms such as “ecosystem” or “esports” could be perceived as associated to Complainant (even if those are not directly connected to its core business). In any case, the Panel notes that registering numerous similar domain names reflecting Complainant’s mark for the purpose of offering them for sale colors Respondent’s intention, and that Respondent has failed to establish rights or legitimate interests in any of the disputed domain names. Instead, as previous panels have found, “Respondent’s intent and purpose behind this conduct is illegitimate, thus precluding his use of these specific names as constituting a fair use under paragraph 4(c)(iii).” *Paul DiCocco v. Curtis Lee Mickunas / Curtis L. Mickunas / Curtis Mickunas*, WIPO Case No. [D2017-1982](#). The Panel finds that Respondent’s pattern of conduct in registering the disputed domain names and in offering them for sale is further evidence of Respondent’s lack of rights or legitimate interests. See *Travellers Exchange Corporation Limited v. WhoisGuard, Inc. / Lord Oxford*, WIPO Case No. [D2018-2231](#) and *Travellers Exchange Corporation Limited v. WhoisGuard, Inc. / Lord Oxford*, WIPO Case No. [D2018-1523](#). Therefore, the Panel finds that Respondent has not established rights or legitimate interests in the disputed domain names <oculusecosystem.com> and <oculusesports.com>.

Respondent does not dispute that it offered the disputed domain names for sale at a price exceeding its out-of-pocket costs, and that it has engaged in a pattern of registering numerous domain names reflecting Complainant’s mark. UDRP Panels tend to assess claimed respondent rights or legitimate interests in the present, *i.e.*, with a view to the circumstances prevailing at the time of the filing of the complaint. See [WIPO Overview 3.0](#), section 2.11. The Panel finds that the later redirection of the disputed domain names to a site critical of Complainant does not thereby establish Respondent’s rights in the disputed domain names. While the Respondent’s criticism of Complainant may be genuine (the Panel does not make a finding in this regard), the Panel finds that, in respect of these disputed domain names, the offer for sale bars Respondent from relying on its redirection to a criticism site as a pretext for fair use. See, for example, *Dover Downs Gaming & Entertainment, Inc. v. Domains By Proxy, LLC / Harold Carter Jr, Purlin Pal LLC*, WIPO Case No. [D2019-0633](#). See also *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#).

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that the following circumstances, “in particular but without limitation”, are evidence of the registration and use of a disputed domain name in bad faith:

(i) circumstances indicating that Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the documented out-of-pocket costs directly related to the domain name; or

(ii) Respondent has registered the disputed domain name 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) Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the disputed domain name, 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 finds that Complainant has demonstrated Respondent's bad faith registration of the disputed domain names. Complainant's rights in its OCULUS mark significantly predate the registration of the disputed domain names. The disputed domain names reflect Complainant's OCULUS mark in its entirety, together with dictionary terms. UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith on the part of Respondent. See [WIPO Overview 3.0](#), section 3.1.4.

To establish the third element, Complainant must also prove that Respondent not only registered, but also used the disputed names in bad faith. Respondent argues that its primary purpose in registering the disputed domain names was to publish information critical of Complainant. As discussed above, however, the Panel finds that Respondent has registered the disputed domain names primarily to sell them to Complainant or its competitor for sums that considerably exceed the costs of registration, thereby demonstrating bad faith use of the disputed domain names. See [WIPO Overview 3.0](#), section 3.1.1. The Panel finds that Respondent's threats to sell its portfolio of domain names "to the highest bidder" are "use" of the mark in bad faith under the Policy. See *World Wrestling Federation Entertainment, Inc. v. Michael Bosman*, WIPO Case No. D1999-0001.

Therefore, the Panel finds that Complainant has established bad faith use of the 14 disputed domain names that were offered for sale by Respondent on its website at <metaversedomains.com>.

In respect of <realityoculus.com>, the disputed domain name that was not offered for sale on Respondent's website at the domain name <metaversedomains.com>, the Panel finds that, consistent with established UDRP practice, the use of a domain name in connection with a website featuring pay-per-click links demonstrates Respondent's intention to attract, for commercial gain, Internet users to Respondent's website. Such use demonstrates bad faith. See [WIPO Overview 3.0](#), section 3.5. Moreover, this disputed domain name (together with the disputed domain names <augmentedrealityoculus.com> and <mixedrealityoculus.com>) redirected the Internet users to Respondent's website at the domain name <metaversedomains.com>, where a large number of domain names were offered for sale. The Panel finds that, together with the absence of any conceivable good-faith use of domain names reflecting Complainant's mark, such redirection is an example of bad-faith use. See [WIPO Overview 3.0](#), Section 3.1.4.

The Panel therefore finds that Complainant has established the third element under paragraph 4(a) of the Policy.

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 disputed domain names <augmentedrealityoculus.com>, <avirtualrealityoculus.com>, <extendedrealityoculus.com>, <mixedrealityoculus.com>, <oculusalternatereality.com>, <oculusaugmentedreality.com>, <oculusecosystem.com>, <oculusesports.com>, <oculusextendedreality.com>, <oculusmetaverse.com>, <oculusmixedreality.com>, <oculusvideogames.com>, <oculusvideogaming.com>, <oculusvirtuality.com>, <oculusvirtually.com>, <realityoculus.com>, and <virtualityoculus.com> be transferred to Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: July 26, 2022