

# **DISPUTE RESOLUTION SERVICE**

**D00021064**

**Decision of Independent Expert**

Facebook Technologies, LLC

and

Intellisupport Limited

## **1. The Parties:**

Complainant:  
Facebook Technologies, LLC  
1601 Willow Road  
Menlo Park  
California  
94025  
United States

Respondent:  
Intellisupport Limited  
Horley Green House  
Horley Green Road  
Halifax  
HX3 6AS  
United Kingdom

## **2. The Domain Names:**

oculus-rift-vr.co.uk  
oculus-simulator.co.uk  
oculus-simulators.co.uk  
oculus-uk.co.uk  
oculus-vr.co.uk  
oculusgamer.co.uk  
oculusgamer.uk  
oculusgames.co.uk  
oculusgames.uk  
oculusgaming.co.uk  
oculusgaming.uk

oculusgear.co.uk  
oculusracing.co.uk  
oculusrift-uk.co.uk  
oculusrift-vr.co.uk  
oculussimulator.co.uk  
oculussimulators.co.uk  
oculusuk.co.uk  
oculusvr-uk.co.uk

### **3. Procedural History and Procedural Matters:**

3.1 I confirm that I am independent of each of the Parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the Parties.

#### **3.2 Timeline**

The dispute was received by Nominet on 1 February 2019. On 4 February 2019, the Complaint was validated and notification of the Complaint was sent to the Parties. On 21 February 2019, a Response reminder was sent to the Respondent. The Respondent failed to submit a Response within the prescribed timeframe under the Policy and so on 26 February 2019, a notification of no Response was sent to the Parties. On 13 March 2019, payment for an Expert decision was received and the Expert, Ravi Mohindra, was appointed on 19 March 2019.

### **4. Factual Background**

4.1 The Complainant, an American corporation formerly known as Oculus VR, LLC, is a virtual reality technology company.

4.2 Founded in 2012, the Complainant was acquired by Facebook, Inc. ("Facebook") in March 2014. It is now a subsidiary of Facebook and is also the intellectual property rights holder for various technologies owned by Facebook.

4.3 The Complainant is the owner of numerous trade mark registrations for the terms OCULUS, OCULUS RIFT and OCULUS VR in many jurisdictions around the world. These include the following:

- United States trade mark No. 4891157, OCULUS, registered on 26 January 2016;
- European Union trade mark No. 014185441, OCULUS, registered on 17 December 2015;
- International trade mark No. 1186832, OCULUS RIFT, registered on 26 June 2013; and

- European Union trade mark No. 011936961, OCULUS VR, registered on 13 December 2015.
- 4.4 The Complainant is also the owner of numerous domain names consisting of the terms OCULUS, OCULUS RIFT and OCULUS VR under generic domain name extensions, such as <oculus.com>, <oculusrift.com> and <oculusvr.com>, as well as under a number of country code domain name extensions, such as <oculusvr.co.uk>.
- 4.5 The Domain Names were registered by the Respondent on various dates between 2014 to 2016. At the date of the Complaint, none of the Domain Names resolved to an active website.
- 4.6 The Respondent did not file a Response in this case.

## **5. Parties' Contentions**

- 5.1 A summary of the Complainant's contentions is set out below.

### Rights

- 5.2 The Complainant asserts that it has developed a virtual reality head-mounted display that uses advanced display technology enabling the sensation of presence and immersion. It markets and offers virtual reality products under the "Oculus" brand name via its website at [www.oculus.com](http://www.oculus.com).
- 5.3 The Complainant says that its Oculus Rift concept was first showcased at the Electronic Entertainment Expo 2012 (commonly known as E3 2012) in early June 2012, and, as a result, gained a considerable amount of notoriety and industry buzz. The Complainant submits that on 1 August 2012, a highly publicised campaign was launched to fund the development of the Oculus Rift product and on 29 March 2013, the Complainant announced the release of its first pre-production model to the public. On 25 March 2016, the first consumer version of the Oculus Rift virtual reality headset began shipping to customers in more than 20 countries and regions.
- 5.4 The Complainant asserts that it has also made substantial investments to develop a strong presence online, by being active under its brand name on different social media forums, such as Facebook, Instagram, Twitter, YouTube, Twitch and LinkedIn.
- 5.5 As a result, the Complainant asserts that it has acquired considerable goodwill and reputation worldwide in its OCULUS brand name, in connection with virtual reality software and apparatus (including the virtual reality headset product known as Oculus Rift).
- 5.6 The Complainant further asserts that the terms OCULUS, OCULUS RIFT or OCULUS VR are exclusively associated with the Complainant

in connection with its virtual reality software and apparatus, and that it is the owner of numerous trade mark and domain name registrations that incorporate these terms, as noted above.

- 5.7 The Complainant contends that the fame of its trade marks is also evidenced by the number of cybersquatters who have sought to unfairly and illegally exploit the very significant consumer recognition and goodwill attached to these marks. The Complainant argues that its valuable reputation offline and online is not only crucial to maintain the value and distinctiveness of its brand, but also vital to the success, integrity and protection of its business and customers. Accordingly, the Complainant submits that it devotes significant resources to protect its trade mark rights and goodwill in forums such as this administrative proceeding.
- 5.8 The Complainant has annexed to its Complaint a number of previous cases brought under other domain name dispute resolution procedures which involve one or more of the Complainant's trade marks and where the panels in those cases have ordered the transfer of the domain names in question to the Complainant.
- 5.9 The Complainant submits that the Domain Names incorporate its OCULUS, OCULUS RIFT or OCULUS VR trade mark in its entirety. Some of the Domain Names include the addition of generic terms, such as "gamer", "games", "racing" and "simulator(s)", which terms are considered to be associated with the Complainant's VR software and apparatus in the public mind.

#### Abusive Registration

- 5.10 The Complainant submits that the Domain Names were both registered and have been used in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights. It says that it has not authorised, licensed or otherwise allowed the Respondent to use its Oculus-related trade marks in a domain name or otherwise.
- 5.11 The Complainant asserts that its distinctive OCULUS, OCULUS RIFT and OCULUS VR trade marks have been continuously and extensively used by the Complainant since 2012 in connection with virtual reality headsets for video games, and that these marks have rapidly acquired considerable goodwill and renown worldwide.
- 5.12 In light of this, the Complainant submits that it would be inconceivable for the Respondent to argue that it did not have knowledge of the Complainant's Oculus-related trade marks at the time of registration of the Domain Names between 2014 and 2016. The fact that the Domain Names incorporate the Complainant's trade marks with the addition of generic or geographical terms closely associated with VR software and apparatus (e.g. "gaming", "racing" and "simulator") leaves no doubt as

to the Respondent's knowledge of the Complainant's Rights at the time of registration.

- 5.13 The Complainant therefore argues that the Respondent registered the Domain Names with prior knowledge of the Complainant's Rights, and with the intention of opportunistically and unfairly taking advantage of the Complainant's goodwill and renown.
- 5.14 The Complainant goes on to assert that the Respondent also owns a number of domain names infringing the Complainant's and third parties' trade marks, either under generic Top-Level-Domains (gTLDs) or under the .uk country code Top-Level-Domain (ccTLD). Given the number of infringing domain names, their similar naming pattern (i.e. trade mark + generic terms in connection with VR or with the geographical term UK), the Complainant says that it is clear that the Respondent has engaged in a pattern of conduct by registering domain names which correspond to well-known trade marks (25 of which incorporate the Complainant's trade marks) in which the Respondent has no apparent rights, and the Domain Names are part of that pattern in accordance with paragraph 5.1.3 of the DRS Policy.
- 5.15 The Complainant submits that the Domain Names were therefore registered in a manner which took unfair advantage of, and were unfairly detrimental to, the Complainant's rights, in accordance with paragraph 1(i) of the Policy.
- 5.16 Furthermore, the Complainant argues that the Respondent's serious interest in virtual reality is also evidenced by its registration of many domain names incorporating the acronym commonly used to describe virtual reality, namely 'VR'. The Complainant asserts that some of these domain names contain the well-known third party trade mark STEAM in its entirety (Steam is a digital distribution platform for purchasing and playing video games).
- 5.17 According to research conducted by the Complainant, it appears that the Domain Names have been passively held by the Respondent since their creation. The Complainant submits that given the nature of the Domain Names, which incorporate the Complainant's well-known trade marks with the addition of generic terms associated with its VR software and apparatus, such passive holding indicates that the Respondent is threatening to use the Domain Names in a way which is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant, as per paragraph 5.1.2 of the Policy.
- 5.18 The Complainant submits that the Domain Names have therefore been used in a manner which has taken unfair advantage of, and has been unfairly detrimental to, the Complainant's rights, in accordance with paragraph 1(ii) of the DRS Policy.

- 5.19 Prior to the filing of its Complaint, the Complainant's lawyers sent, on 23 May 2018, a cease and desist letter to the Respondent and its Director, asserting the Complainant's trade mark rights and requiring the Respondent to transfer the total 25 domain names (i.e. the 19 Domain Names and 6 other domain names) to the Complainant. The Respondent did not reply, despite the Complainant following up on 26 July 2018.
- 5.20 The Complainant says that it had no choice but to file the present Complaint in order to request the transfer of the Domain Names under the Policy to protect its legitimate business interests and rights and to protect internet users from confusion and any potential risk of fraud, given the blatantly abusive registration of the Domain Names.

### The Respondent

- 5.21 As noted above, the Respondent did not file a Response in this case.

## **6. Discussions and Findings**

### General

- 6.1 For the Complainant to succeed with its Complaint it is required under paragraph 2.2 of the Policy to prove to me, the Expert, on the balance of probabilities, that:
- I. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
  - II. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

### Complainant's Rights

- 6.2 Paragraph 1 of the Policy provides that Rights means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.3 Further, it is well accepted that the question of whether the Complainant has Rights falls to be considered at the time that the Complainant makes its Complaint and is a test with a low threshold to overcome.
- 6.4 The Complainant is the owner of numerous trade mark registrations for the terms 'OCULUS', 'OCULUS VR' and 'OCULUS RIFT' in various jurisdictions around the world. A number of these registrations pre-date the earliest registration of the Domain Names by the Respondent.

- 6.5 Further, the Complainant has provided evidence demonstrating trading activity under the OCULUS brand name.
- 6.6 I therefore find that the Complainant has Rights in respect of the marks 'OCULUS', 'OCULUS RIFT' and 'OCULUS VR'.
- 6.7 The Domain Names each incorporate one of the Complainant's OCULUS, OCULUS RIFT or OCULUS VR trade marks in its entirety, with the addition of generic terms which do not materially distinguish the Domain Names from the marks in which the Complainant holds Rights. Each of the additional terms are generic, non-distinctive and, in some cases, refer to elements of the Complainant's business (such as "gaming" and "simulator").
- 6.8 I therefore find that the Complainant has established that it has Rights in respect of names or marks which are similar to the Domain Name and accordingly the Complainant has satisfied the first limb of the Policy.

#### Abusive Registration

- 6.9 Paragraph 1 of the Policy defines "Abusive Registration" as a Domain Name which either:
- i. was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; or*
  - ii. has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*
- 6.10 This definition requires me to consider whether, at the time of registration or acquisition by the Respondent, or subsequently through the use that has been made of it by the Respondent, each of the Domain Names is an Abusive Registration.
- 6.11 Paragraph 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that each of the Domain Names is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that each of the Domain Names is not an Abusive Registration.
- 6.12 The Complainant relies on a number of the factors set out in paragraph 5 of the Policy in order to make out its case on Abusive Registration, including those which relate to the original registration of the Domain Names and those which relate to subsequent use. The Complainant also submits that the Respondent is not able to invoke any of the circumstances set out in paragraph 8 of the Policy, and provides

arguments to support its submission in this regard.

- 6.13 In the absence of a Response, it is not possible to state with certainty what the motives of the Respondent were when it registered the Domain Name.
- 6.14 However, the Complainant has submitted strong evidence showing use of the marks in which they hold Rights, namely OCULUS, OCULUS VR and OCULUS RIFT. This includes significant promotion of the Complainant's business and products under these marks through international channels, including news websites, digital platforms and social media. The common feature in all of these marks is the term 'Oculus'. While this term has a natural meaning in English language derived from its Latin origin, it is not in everyday use, and has been used extensively by the Complainant as a brand name in connection with its virtual reality business since 2012. It is also protected by a number of trade mark registrations held by the Complainant, which cover goods and services relevant to the Complainant's virtual reality business.
- 6.15 Each of the Domain Names incorporates one of the Complainant's marks in which it holds Rights, in one of the following forms:
- the Complainant's mark in its entirety (in the case of the Domain Name <oculus-vr.co.uk>);
  - the Complainant's mark with the addition of a generic, non-distinctive geographical identifier suffix (in the case of the Domain Names <oculusvr-uk.co.uk>, <oculus-uk.co.uk>, <oculusuk.co.uk> and <oculusrift-uk.co.uk>); and
  - the Complainant's mark with the addition of a generic, non-distinctive suffix which relates to the Complainant's business (in the case of the remaining Domain Names, for example <oculusgamer.co.uk>, <oculusracing.co.uk>, <oculussimulator.co.uk>).
- 6.16 The Respondent has failed to provide any explanation as to why it chose to register these Domain Names, all of which incorporate one of the Complainant's marks in which it has Rights.
- 6.17 Given the notoriety of the Complainant's marks at the time that the Domain Names were registered, and the form of the Domain Names as set out above, I have no doubt that the Respondent was entirely aware of the Complainant and its OCULUS, OCULUS RIFT and OCULUS VR marks when it registered the Domain Names, and that the Respondent had the Complainant's Rights in mind at the time of registration of each of the Domain Names.
- 6.18 Further, given the high degree of similarity between each of the Domain Names and the strength of the Complainant's well-established Rights at the date of registration of each of the Domain Names, I find it

improbable that the Domain Names were chosen and registered by the Respondent for any reason other than (i) to create a false association with the Complainant and its business operated under its marks in which it holds Rights, and (ii) to take some kind of advantage of the goodwill attached thereto.

- 6.19 In these circumstances I find that each of the Domain Names was registered in a manner which, at the time when the relevant registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights and therefore that each of the Domain Names, in the hands of the Respondent, is an Abusive Registration under paragraph 1(i) of the Policy.
- 6.20 In addition, while the Respondent does not appear to have made any active use of the Domain Names, I accept that confusion is likely between the Domain Names and the Complainant given the nature of these Domain Names as described above. That can only be disruptive of the Complainant's business and such disruption can only be unfair. I therefore also find that the Domain Names have been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.
- 6.21 Finally, and for completeness, I have considered the non-exhaustive list of factors set out in paragraph 8 of the Policy which may be evidence that a Domain Name is not an Abusive Registration. These relate to the Respondent's prior knowledge, or lack of the same, of the Complainant's cause for complaint and the possibility of the Respondent making fair use of the Complainant's marks. On the evidence before me and the arguments presented by the Complainant, I take the view that none of the provisions of paragraph 8 of the Policy can assist the Respondent.

## **7. Decision**

- 7.1 I find that the Complainant has proved that it has Rights in names or marks which are similar to the Domain Names and that each of the Domain Names, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I therefore direct that the Domain Names all be transferred to the Complainant.

Signed Ravi Mohindra

Dated 3 April 2019