

## **ADMINISTRATIVE PANEL DECISION**

Jamestown L.P. v. Matinee Classics LLC, Company  
Case No. D2022-0419

### **1. The Parties**

Complainant is Jamestown L.P., United States of America (“United States”), represented by Meunier Carlin & Curfman LLC, United States.

Respondent is Matinee Classics LLC, Company, United States, represented by Jim E. Salmon, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <jamestownmetaverse.com> (the “Domain Name”) is registered with Rebel Ltd (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2022. On February 8, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On February 8, 2022, the Registrar transmitted by email to the Center its verification response, disclosing registrant and contact information for the Domain Name which differed from the named Respondent and contact information in the Complaint. The Center sent an email to Complainant on February 15, 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 February 17, 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 February 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 10, 2022. The Response was filed with the Center on February 21, 2022.

The Center appointed Robert A. Badgley as the sole panelist in this matter on March 14, 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

Founded in 1983, Complainant describes itself as a “global, designed-focused real estate investment and management firm.” Complainant holds several United States Patent and Trademark Office (“USPTO”) registrations for the trademark JAMESTOWN, including: word mark JAMESTOWN, USPTO Reg. No. 2,522,550, registered on December 25, 2001 in connection with “real estate management and syndication services” and “real estate development services”; and stylized mark JAMESTOWN, USPTO Reg. No. 6,276,958, registered February 23, 2021 in connection with “consulting services in the area of sustainable business solutions,” as well as “investment advisory services” and related services.

According to Complainant, it has “extensively promoted events and services in the metaverse,” such as a virtual party at One Times Square in New York City, one of complainant’s best known properties. Annexed to the Complaint is a December 29, 2021 press release announcing that Complainant and Digital Currency Group would be hosting a virtual event called the “MetaFest 2022 global party” two days later to celebrate the new year.

Wikipedia describes the term “metaverse” as follows:

“A metaverse is a network of 3D virtual worlds focused on social connection. In futurism and science fiction, it is often described as a hypothetical iteration of the Internet as a single, universal virtual world that is facilitated by the use of virtual and augmented reality headsets.”

The Domain Name was registered on January 5, 2022, seven days after the press release noted above. The Domain Name resolves to Respondent’s website, located at <metaversedomainnames.com>, where numerous domain names are offered for sale. Many of these domain names reflect a single word followed by “metaverse.” Respondent has registered numerous domain names containing the names of Major League Baseball, National Football League, or National Basketball Association teams followed by “metaverse” (such as <oriolesmetaverse.com>, <jaguarsmetaverse.com>, and <pistonsmetaverse.com>).

Respondent’s website also lists as for sale domain names such as <buickmetaverse.com> and <platofarmmetaverse.com>. BUICK is a famous trademark owned by a major automobile manufacturer. PLATO FARM is a video game whose owner describes it as “a metaverse that uses blockchain technology to simulate the evolution of human civilization.”

The Domain Name is offered for sale at Respondent’s for USD 300,000.

The crux of the Response is reflected in the following passage:

“I seek out single, common, English language, dictionary noun words, mainly comprised of every day popular subjects such as animals, birds, geographical locations, current events etc. and add the additional word ‘Metaverse’ or ‘Virtual Reality’ in the .com designation. I anticipate these domains will become extremely sought after in the future because of the phenomenal public interest in this unique subject. As such a multitude of individuals and organizations will eventually desire to own these assets. I just happen to have the foresight to envision their potential popularity. When I acquire a ‘Metaverse’ domain name. I research a multitude of websites that may have any interest in becoming involved with the subject down the road and I proactively email them (including Complainant). I introduce my company and explain that I have invested in numerous domains (exact match and/or subject specific) that they may, or may not, wish to acquire as a purchase from my bone fide goods and services business. I always include that my domains are non-

trademark infringing. Most of the prospecting emails I send out are disregarded if the recipient is not interested in my offer. This is the first Complaint filed to disgorge me of my rightfully owned domain name.”

Respondent states that his business does not compete with Complainant’s real estate and investment business. Respondent states further that there are numerous third parties using the trademark JAMESTOWN, and that Jamestown is also a geographically descriptive term.

On January 4, 2022, Respondent sent an email to a number of executives at Complainant’s firm. The email stated in part:

“I just registered a new non trademark infringing domain name that I confirmed at the US Patent and Trademark Office (uspto.gov), that you may have an interest in owning based on your new business venture. There is no US Federal Trademark currently issued nor applied for regarding a Metaverse utilizing Jamestown as I conducted my due diligence research so anyone is legally allowed to register this specific domain name without being in violation of US Trademark law. JamestownMetaverse.com As everyone acknowledges the Metaverse is definitely here to stay! As such I took a slightly different approach for investing than the norm by registering 175+ one-of-a-kind, exact match, subject specific, non trademark infringing .com domain names related to this absolute phenomenon that I am offering for sale either individually or as a complete package whichever is your preference.”

In this email, Respondent offered to reduce the price to USD 29,000 per domain name if Complainant was interested in purchasing a whole portfolio of domain names.

## **5. Parties’ Contentions**

### **A. Complainant**

Complainant contends that it has established all three elements required under the Policy for a transfer of the Domain Name.

### **B. Respondent**

As noted above, Respondent asserts that it is engaged in a legitimate business of selling non-infringing domain names incorporating the word “metaverse.”

## **6. Discussion and Findings**

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

- (i) the Domain Name is 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 Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Panel concludes that Complainant has common law rights in the unregistered trademarks JAMESTOWN through use demonstrated in the record. The Panel finds that the Domain Name is confusingly similar to this trademark. The JAMESTOWN mark is entirely reproduced in the Domain Name, and is clearly recognizable within the Domain Name despite the additional word “metaverse.”

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

## **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, 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 Name or a name corresponding to the Domain Name 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 Name, 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 Name, 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 the Domain Name. Registering and selling domain names is not *per se* an illegitimate practice, as has been confirmed in numerous prior decisions under the UDRP. Targeting a trademark and seeking to sell a corresponding domain name to the trademark holder is, however, not legitimate. Here, Respondent admits that he was aware of Complainant's JAMESTOWN, and Respondent promptly sent an email to Complainant offering to sell the Domain Name for a massive profit, namely, USD 300,000.

Moreover, notwithstanding Respondent's claim to avoid trademark infringement when selecting domain names, Respondent's portfolio includes domain names such as <buickmetaverse.com> and <platofarmmetaverse.com>. As noted above, BUICK is a famous trademark which does not correspond to any common dictionary term, and PLATO FARM is a video game whose owner describes it as a "metaverse." These facts undermine Respondent's credibility and claim to engage in purely good-faith domain name registrations.

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

## **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 the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the 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 its documented out of pocket costs directly related to the Domain Name; or
- (ii) that Respondent has registered the 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) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the 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 concludes that Respondent has registered and used the Domain Name in bad faith. The Panel incorporates its discussion above in the "Rights or Legitimate Interests" section. As noted above, Respondent admits knowledge of the JAMESTOWN mark at the time the Domain Name was registered.

The Panel also notes that the Domain Name was registered within a week of Complainant's press release in which Complainant announced that it was co-hosting a major virtual New Year's Eve party in the "metaverse." This coincidence, coupled with Respondent's credibility problem (discussed above), leads the Panel to conclude on this record that Respondent more likely than not was targeting Complainant.

The Panel finds bad faith use under the above-quoted Policy paragraph 4(b)(i), because Respondent immediately reached out to Complainant with an offer to sell the Domain Name for USD 300,000, obviously far in excess of any out-of-pocket costs associated with the Domain Name.

Complainant has established Policy paragraph 4(a)(iii). In view of the Panel's findings, the Panel rejects Respondent's assertion that Complainant has engaged in Reverse Domain Name Hijacking.

## **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 Domain Name <jamestownmetaverse.com> be transferred to Complainant.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: March 20, 2022