



NATIONAL ARBITRATION FORUM

DECISION

The American Automobile Association, Inc. v. QTK Internet c/o James M. van Johns
Claim Number: FA0905001261364

PARTIES

Complainant is **The American Automobile Association, Inc.** (“Complainant”), represented by **Peter D. Saharko**, of **Covington & Burling LLP**, Washington, D.C., USA. Respondent is **QTK Internet c/o James M. van Johns** (“Respondent”), represented by **Ari Goldberger**, of **ESQwire.com Law Firm**, New Jersey, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <aaa.net>, registered with **Uk2 Group Ltd.**

PANEL

The undersigned certifies that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Michael A. Albert, Houston Putnam Lowry, and The Honourable Neil Anthony Brown QC as Panelists. Michael A. Albert, presiding.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on May 6, 2009; the National Arbitration Forum received a hard copy of the Complaint on May 7, 2009.

On May 14, 2009, Uk2 Group Ltd. confirmed by e-mail to the National Arbitration Forum that the <aaa.net> domain name is registered with Uk2 Group Ltd. and that the Respondent is the current registrant of the name. Uk2 Group Ltd. has verified that Respondent is bound by the Uk2 Group Ltd. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On May 20, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of June 9, 2009 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@aaa.net by e-mail.

Respondent requested an extension of seven days to the time in which to file the Response, and after that extension was granted, requested another extension to the filing

deadline. The second extension was also granted, with a final deadline for the filing of a Response of June 23, 2009.

A timely Response was received and determined to be complete on June 23, 2009.

An Additional Submission was received from Complainant on June 29, 2009, and was determined to be timely and complete in compliance with the National Arbitration Forum's Supplemental Rule 7.

An additional submission was received from Respondent on July 6, 2009, and was determined to be timely and complete.

On July 8, 2009, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Michael A. Albert, Houston Putnam Lowry, and The Honourable Neil Anthony Brown QC as Panelists.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant contends as follows:

The American Automobile Association, Inc. ("Complainant") has used AAA and associated marks in commerce since at least 1902, and has obtained a federally registered trademark for the mark AAA for automobile association services (US Reg. No. 829,265), travel agency services (US Reg. No. 2,158,654), and printed maps (US Reg. No. 3,162,780), among others. Complainant also owns several international trademark registrations.

The disputed domain name <**aaa.net**> is identical to Complainant's AAA marks.

QTK Internet ("Respondent") has no legal rights to or legitimate interest in the disputed domain name. Complainant has neither licensed nor authorized Respondent to use the AAA marks as part of a domain name. There is no evidence that Respondent is commonly known by the disputed domain name, and Respondent is not using the domain name in connection with a *bona fide* offering of goods or services, or for a legitimate noncommercial or fair use.

Respondent registered and is using the disputed domain name in bad faith. Respondent registered a domain name identical to Complainant's famous marks to attract Internet users for commercial gain, and has done so while attempting to conceal its identity, ultimately changing the WHOIS registry information the day it was served with the

Complaint. Respondent also has an extensive history of registering domain names that infringe trademark rights, which establishes a pattern of bad faith registration and use.

B. Respondent

Respondent contends as follows:

Respondent registered the disputed domain name on March 4, 1999, choosing <aaa.net> because “AAA” is a very desirable term, used for bond ratings, battery and shoe sizes, and a variety of organizations. It is also desirable because it is a three-letter string, of which there are relatively few. Respondent did not register the domain name with Complainant or Complainant’s marks in mind.

Respondent takes no position on the enforceability of Complainant’s trademarks but asserts that Complainant must prove that Respondent targeted its marks to establish that the disputed domain is identical or confusingly similar.

Respondent has rights and a legitimate interest in the domain name, both because it did not target Complainant’s trademark in registering the domain name and because Respondent has used the domain name in connection with legitimate pay-per-click advertisements that are unrelated to the goods and services covered by Complainant’s mark.

Complainant cannot demonstrate that Respondent registered and is using the domain name in bad faith because there is no evidence that Respondent registered the domain name with Complainant’s trademark in mind. Past domain name disputes involving Respondent are both irrelevant—since Respondent is not aiming to prevent Complainant from reflecting its marks in a corresponding domain name—and distinguishable. Similarly, the fact that Respondent changed the contact information for the disputed domain name is irrelevant, particularly since both the original and modified contact information enabled Complainant to contact Respondent. Also, although laches is not recognized under the Policy, the ten-year period between Respondent’s registration and Complainant’s Complaint indicates that Complainant did not truly believe the disputed domain name was registered in bad faith.

Complainant has abused the Policy and engaged in reverse domain name hijacking, since Complainant knew or should have known that it could not prove the essential elements required by the policy.

C. Additional Submissions

In its additional submission, Complainant responds that prior cases involving common terms are distinguishable because they did not involve famous marks like AAA, and that the timing of the Complaint is irrelevant to the dispute. There is no evidence of reverse domain name hijacking because Complainant’s claim satisfies the elements of the Policy and was brought in good faith. Additionally, Complainant asserts and submits additional

evidence suggesting that, contrary to Respondent's contentions, the disputed domain name has displayed advertisements related to goods and services covered by Complainant's mark. Respondent's bad faith is further evidenced by the fact that it once displayed "FUCK YOU" (hereinafter "the profanity") in giant block letters on the web site associated with the disputed domain name.

In its additional submission, Respondent asserts that it did not make a false statement regarding the links that have appeared on its web site, since it maintains only that it never knowingly displayed advertising related to Complainant's goods and services. The advertisements to which Complainant refers were auto-generated links of which Respondent had no knowledge. Respondent asserts that it has no idea how the profanity appeared on its web site and notes that the same message has appeared on many of its web sites, perhaps due to hacking.

FINDINGS

Complainant has trademark rights in the mark AAA by virtue of its registration with the United States Patent and Trademark Office, and also by virtue of its use in commerce since 1902 and foreign registrations.

The disputed domain name is identical to Complainant's mark.

Complainant has not established that Respondent lacks rights or legitimate interests in the domain name, or that the domain name has been registered and used in bad faith.

Complainant has not engaged in reverse domain name hijacking.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that the Complainant prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name;
and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The disputed domain name <aaa.net> is identical to Complainant's registered AAA mark. The only difference is the addition of the generic top-level domain ".net," which is not sufficient to distinguish the domain name from Complainant's mark. *See Pomellato*

S.p.A. v. Tonetti, D2000-0493 (WIPO July 7, 2000) (finding that the addition of a generic top-level domain is “not relevant” to the Policy ¶ 4(a)(i) inquiry because it is necessary and functional). Respondent’s reasons for registering the domain name are irrelevant to whether the domain name is identical to Complainant’s mark, and Respondent does not otherwise dispute the identity between its domain name and Complainant’s mark.

Rights or Legitimate Interests

Complainant must first make a *prima facie* showing that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show that it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006). While Complainant has established a *prima facie* case, Respondent has successfully rebutted the *prima facie* case, and thus Complainant has not proven that Respondent lacks rights or legitimate interests in the domain name.

Complainant asserts and Respondent does not deny that Respondent is not commonly known by the <aaa.net> domain name, which is registered to QTK Internet. Because the threshold for a *prima facie* showing under ¶ 4(a)(ii) is low, and because there is no evidence that Complainant has licensed or authorized Respondent’s use of the AAA mark, we conclude that Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in the disputed domain name. *See Magnetic Shield Corp. v. MuShield*, FA 1158545 (Nat. Arb. Forum Apr. 29, 2008).

The burden thus shifts to the Respondent to affirmatively demonstrate its rights or interests in the disputed domain name. Paragraph 4(c) of the Policy lists three representative circumstances that can demonstrate a registrant’s rights or legitimate interests. Of these, only ¶ 4(c)(i) is relevant here: “before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or name corresponding to the domain name in connection with a bona fide offering of goods or services” Policy ¶ 4(c)(i). There is no controversy over the relevant timing, as both parties agree that Respondent had long used the domain name for pay-per-click advertisements before the instant dispute arose. The only question is whether this advertising is a bona fide offering of goods or services under the Policy.

Complainant argues that a pay-per-click advertising site cannot give rise to a legitimate claim to a domain name, citing several prior cases in which Complainant was granted relief under the Policy. *See, e.g., Am. Auto Ass’n, Inc. v. CCG*, FA 1234708 (Nat. Arb. Forum Dec. 31, 2008). But in cases like *CCG*, the panel found that the registrant used pay-per-click advertisements for services that directly competed with services offered by AAA, and that the registrant capitalized on consumer confusion. We decline Complainant’s invitation to find that pay-per-click advertising is *per se* illegitimate, even where it is unrelated to goods or services associated with a trademark. Whether the advertising is a bona fide offering of goods or services thus turns on whether Respondent is exploiting Complainant’s mark by offering advertisements that confuse Internet users for commercial gain. *See id.* (finding that Respondent “exploit[ed] the international

recognition of Complainant's AAA mark to attract confused Internet users for commercial gain").

For two reasons, we conclude that Respondent's pay-per-click advertising is a bona fide offering of goods or services under the Policy, rather than an illegitimate exploitation of consumer confusion. First, while <aaa.net> is identical to Complainant's marks, it is also a desirable domain name for a variety of other reasons. "AAA" is the top rating for a bond, a battery and shoe size, and an acronym associated with many different organizations. It is also a short, three-letter string. *Kis v. Anything.com Ltd.*, D2000-0770 (WIPO Nov. 20, 2000) (recognizing the value of a three-letter domain name). Respondent may have registered <aaa.net> for any of a number of reasons that have nothing to do with Complainant's business. This distinguishes the instant case from cases cited by the Complainant, such as *The American Automobile Association, Inc. v. Transure Enterprise Ltd.*, FA 1234734 (Nat. Arb. Forum Jan. 9, 2009), where the disputed domain names were more clearly targeted at the relevant mark. *See id.* (resolving disputes over <aaa-insurance.net>, <aaatravelservice.com> and <tripleinsuranceagency.com>).

Second, Respondent's pay-per-click advertisements are generally not related to the goods or services associated with Complainant's mark. While Complainant has found among the sea of auto-generated advertisements some related to its business, these appear to be few, and do not seem likely to create or exploit consumer confusion, and on this record could plausibly have been inadvertent. For example, Complainant submitted one screenshot with over a dozen advertisements, two of which mentioned mortgages—links for "Bad Credit Mortgages" and "UK Mortgage Loans." Because such advertisements are auto-generated and rare, they do not appear to be targeted at Complainant's mark. The lack of targeted advertisements combined with the fact that <aaa.net> is a desirable domain name for reasons unrelated to Complainant's business suggest that Respondent's pay-per-click advertising is a bona fide offering of goods or services. *See EU Portfolio Ltd. v. Salvia Corp.*, FA 873726 (Nat. Arb. Forum Feb. 7, 2007) (holding that the use of pay-per-click advertising is a bona fide offering of goods or services).

Registration and Use in Bad Faith

Respondent has not registered or used the disputed domain name in bad faith. The Policy provides four representative circumstances that may constitute evidence of bad faith, and Complainant relies exclusively on ¶ 4(b)(iv). That paragraph provides:

by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site 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 your web site or location or of a product or service on your web site or location.

Policy ¶ 4(b)(iv). Whether Respondent's registration and use of the domain name falls within ¶ 4(b)(iv) depends on whether Complainant has established that Respondent had

an intent to create a likelihood of confusion as to the source, affiliation, or endorsement of the web site. For reasons similar to those discussed above, we find that Complainant has not shown bad faith.

The domain name <aaa.net> is desirable for a variety of reasons, and the lack of advertisements targeting goods or services offered by Complainant suggest that Respondent did not intend to confuse Internet users into thinking that Complainant was somehow associated with Respondent's web site. Without establishing any such intent, Complainant's claim cannot succeed under ¶ 4(b)(iv). See *HP Hood LLC v. hood.com*, FA 313566 (Nat. Arb. Forum Oct. 20, 2004) ("To prove bad faith registration under the Policy, it must be proven that a domain name was registered with Complainant's trademark in mind.").

Complainant cites three other factors as evidence of bad faith, but none is sufficient to carry Complainant's burden. First, Complainant explains that Respondent attempted to conceal its identity by registering under an alias and changing the WHOIS registry information when served with a complaint. This is probative of bad faith registration, but it is not by itself necessarily sufficient to prove that the domain name "has been registered *and is being used* in bad faith." Policy ¶ 4(a)(iii). See also *Grupo Televisa, S.A., de C.V. v. Autosya S.A. de C.V.*, DTV2001-007 (WIPO June 11, 2001) ("Although it is clear that supplying incorrect information cannot be considered by itself as an act of bad faith; when considered jointly with other elements, it can be interpreted as evidence of such bad faith.").

Second, Complainant cites Respondent's extensive history of registering domain names that allegedly infringe trademark rights, which is said to establish a pattern of bad faith registration and use. But even assuming that Complainant's factual allegation is accurate, the Policy does not invite us to consider a pattern of conduct except under ¶ 4(b)(ii). Complainant does not allege that Respondent's conduct falls within that paragraph and has proffered no evidence to suggest that Respondent "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." Policy ¶ 4(b)(ii). Even if it were proper to consider Respondent's alleged history of bad faith registration, it, by itself, would not be enough to establish bad faith registration and use here.

Third, Complainant cites the profanity that appeared on the web site associated with the disputed domain name as evidence of bad faith. By Complainant's own account, the profanity was "once displayed," suggesting that the profanity appeared on the web site for a very limited period of time. The fact that it appeared on sites located at several other of Respondent's domain names—themselves not alleged to be identical to famous marks like AAA—suggests that the profanity was not targeted at Complainant or its customers.

Bad faith is at its core a question of intent, whether proven under the representative circumstances of ¶ 4(b) or otherwise. Complainant has proffered evidence of Respondent's questionable practices, including supplying incorrect information during

registration. But taken together, the evidence on this record is insufficient to prove that Respondent had illicit motives in the instant case—regardless of past practices—and we cannot conclude that Respondent has both registered and used the disputed domain name in bad faith.

Reverse Domain Name Hijacking

Because Complainant has acted in good faith, it has not engaged in reverse domain name hijacking. The Rules provide that reverse domain name hijacking “means using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.” Rules ¶ 1. To demonstrate reverse domain name hijacking, Respondent must show that “Complainant knew of Respondent’s unassailable right or legitimate interest in the disputed domain name or the clear lack of bad faith registration and use, and nevertheless brought the Complaint in bad faith.” *Creative Software Specialists, LLC v. Printers Plus*, FA 1251542 (Nat. Arb. Forum Apr. 29, 2009). While we find that Respondent does have rights or a legitimate interest in the domain name and has not acted in bad faith, we nevertheless believe this case to be a close one. Additionally, Complainant is undisputedly the owner of a longstanding, federally registered trademark to which the disputed domain name is identical. Complainant reasonably believed that it should prevail on each element of the Policy, and it did not act in bad faith.

DECISION

Having failed to establish two of the three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.



Michael A. Albert, Esq.
Arbitrator



Honorable Neil Anthony Brown, Q.C.
Arbitrator

Michael A. Albert, presiding, Panelist, and The Honourable Neil Anthony Brown QC, Panelist.

Dated: July 25, 2009

SEPARATE DECISION BY THE HONOURABLE NEIL ANTHONY BROWN QC ON THE ISSUE OF REVERSE DOMAIN NAME HIJACKING

I agree with the majority opinion on the result in this proceeding, that the Complaint should be denied and the grounds on which that decision is reached, namely that Respondent has a right or legitimate interest in the disputed domain name and that Respondent did not register and use the domain name in bad faith.

However, I would also have made a finding of Reverse Domain name Hijacking against Complainant.

Paragraph 1 of the Rules defines Reverse Domain Name Hijacking as:

“using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.”

Paragraph 15(e) provides:

“If after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.”

I would have made a finding of Reverse Domain Name Hijacking for the following reasons.

First, I agree with the majority that there would be a finding of Reverse Domain Name Hijacking if “Complainant knew of Respondent’s unassailable right or legitimate interest in the disputed domain name or the clear lack of bad faith registration and use, and nevertheless brought the Complaint in bad faith.” *Creative Software Specialists, LLC v. Printers Plus*, FA 1251542 (Nat. Arb. Forum Apr. 29, 2009).

But on the facts of the case Complainant must be taken to have known or should have known that there was no bad faith registration or use on the part of Respondent and that to make the Complaint in those circumstances was itself an act of bad faith. That is so for the following reasons.

First, there were no facts to support the position that there was any such bad faith registration or use and the Panel has already dealt with those issues.

Secondly, the facts that were known or should have been known to Complainant showed the opposite, namely that Respondent had not used the domain name in bad faith. Complainant relied on, with approval, the comments in *Am. Auto. Ass’n, Inc v. CCG* NAF Case No.FA1234708 that “Respondent is exploiting the international recognition of Complainant’s AAA mark to attract confused Internet users for commercial gain.” However, it must have been apparent that whatever Respondent had done with the domain name in the 10 years since it had registered it, it had not used it to target Complainant or its services. It had not given the impression that it was the Complainant itself or was authorized by it to set up the website and had not sought to attract consumers by confusing them, all of which could easily be seen from using the WayBack machine at <www.archive.org> and other avenues of inquiry that were available to the Complainant.

Thirdly and more significantly, Complainant made some very serious accusations against the Respondent, namely that its conduct was “unsavoury”, that it was playing “fast with the facts and the law”, making “false statements” and “blatantly false” ones and that it had shown “willful blindness” even in registering the domain name. Allegations of that kind, like the allegation of bad faith itself, may of course be made in UDRP proceedings, but if they are not supported by facts, which is the case in the present proceeding, parties run the risk of adverse findings against them.

Finally, the fact that Complainant brought the Complaint some 10 years after the domain name was registered raises some additional questions. It is true that laches is not normally regarded as a defence in UDRP proceedings, as Respondent concedes, but it is wrong to say, as Complainant says, that the delay is irrelevant. It is very relevant in, for example, the present case, for it shows that an allegation that a domain name was registered 10 years before in bad faith, with all that that implies, could not be made or persisted with properly without some evidence to support it. In the present case, that evidence was not there. Moreover, the passage of such a lengthy time casts doubt on whether the Complainant could ever have believed that the allegation, or the allegation that Respondent was using the domain name in bad faith, was true.

The combination of all of these factors amounts to bringing the Complaint in bad faith within the meaning of *Creative Software Specialists, LLC v. Printers Plus*, FA 1251542 (Nat. Arb. Forum Apr. 29, 2009) and paragraph 15 (e) of the Rules.

As was said in the recent decision in *Shoe Land Group LLC v. Development, Services c/o Telepathy Inc.* No: FA0904001255365 (NAF Case, June 9, 2009) “Obviously, a panel should not lightly make a finding of Reverse Domain Name Hijacking against a complainant, but nor should it shy away from making such a finding in a clear case.”

For these reasons I would have made a finding of Reverse Domain name Hijacking.



Honorable Neil Anthony Brown, Q.C.
Arbitrator

The Honourable Neil Anthony Brown QC, Panelist
Dated: 25 July 2009

DISSENT

I would dissent from my brother panelists.

Identical and/or Confusingly Similar

Complainant registered the AAA mark with the United States Patent and Trademark Office (“USPTO”) on May 23, 1967 (Reg. No. 829,265). Complainant has established rights in the AAA mark through its registration of the mark with the USPTO pursuant to Policy ¶ 4(a)(i). *See Paisley Park Enters. v. Lawson*, FA 384834 (Nat. Arb. Forum Feb. 1, 2005) (finding that the complainant had established rights in the PAISLEY PARK mark under Policy ¶ 4(a)(i) through registration of the mark with the USPTO); *see also AOL LLC v. Interrante*, FA 681239 (Nat. Arb. Forum May 23, 2006) (finding that where the complainant had submitted evidence of its registration with the USPTO, “such evidence establishes complainant’s rights in the mark pursuant to Policy ¶ 4(a)(i).”).

Complainant contends the <aaa.net> domain name is identical to the AAA mark. The <aaa.net> domain name differs from Complainant’s mark only in that the generic top-

level domain (“gTLD”) “.net” has been added to the end of the mark. This single change does not suffice to distinguish a disputed domain name from a mark, and finds the <aaa.net> domain name is identical to the AAA mark pursuant to Policy ¶ 4(a)(i). See *SCOLA v. Wick*, FA 1115109 (Nat. Arb. Forum Feb. 1, 2008) (concluding that “the domain name at issue is identical to [the] complainant’s SCOLA mark, as the only alteration to the mark is the addition of the generic top-level domain “.com.”); see also *Katadyn N. Am. v. Black Mountain Stores*, FA 520677 (Nat. Arb. Forum Sept. 7, 2005) (“[T]he addition of the generic top-level domain (gTLD) “.net” is irrelevant for purposes of determining whether a domain name is identical to a mark.”).

While Respondent contends the disputed domain name is comprised of common, descriptive terms and as such cannot be found to be identical or confusingly similar to Complainant’s mark, such a determination is not necessary under Policy ¶ 4(a)(i) because this portion of the Policy considers only whether Complainant has rights in the mark and whether the disputed domain name is identical or confusingly similar to Complainant’s mark. See *Vance Int’l, Inc. v. Abend*, FA 970871 (Nat. Arb. Forum June 7, 2007) (finding that because the complainant had received a trademark registration for its VANCE mark, the respondent’s argument that the term was generic failed under Policy ¶ 4(a)(i)); see also *David Hall Rare Coins v. Tex. Int’l Prop. Assocs.*, FA 915206 (Nat. Arb. Forum Apr. 9, 2007) (“Respondent’s argument that each individual word in the mark is unprotectable and therefore the overall mark is unprotectable is at odds with the anti-dissection principle of trademark law.”).

Rights or Legitimate Interests

Complainant must first make a *prima facie* case Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. See *Document Techs., Inc. v. Int’l Elec. Commc’ns Inc.*, D2000-0270 (WIPO June 6, 2000) (“Although Paragraph 4(a) of the Policy requires that the Complainant prove the presence of this element (along with the other two), once a Complainant makes out a *prima facie* showing, the burden of production on this factor shifts to the Respondent to rebut the showing by providing concrete evidence that it has rights to or legitimate interests in the Domain Name.”); see also *AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

Complainant contends Respondent is not commonly known by the disputed domain names nor has it ever been the owner or licensee of the AAA mark (whether owned by this Complainant or anyone else with rights). The WHOIS record for the <aaa.net> domain name lists Respondent as “QTK Internet c/o James M. van Johns.” In its Additional Submission, Complainant also contends that, because of the famous nature of Complainant’s use of the AAA mark, Respondent cannot possibly claim rights or legitimate interests in the disputed domain name without making a showing that it’s

commonly known by that domain name. The WHOIS record suggests Respondent has never been commonly known by any variant on the AAA mark, and therefore Respondent is not commonly known by the <aaa.net> domain name pursuant to Policy ¶ 4(c)(ii). See *Am. W. Airlines, Inc. v. Paik*, FA 206396 (Nat. Arb. Forum Dec. 22, 2003) (“Respondent has registered the domain name under the name ‘Ilyoup Paik a/k/a David Sanders.’ Given the WHOIS domain name registration information, Respondent is not commonly known by the [<awvacations.com>] domain name.”); see also *Instron Corp. v. Kaner*, FA 768859 (Nat. Arb. Forum Sept. 21, 2006) (finding that the respondent was not commonly known by the <shoredurometer.com> and <shoredurometers.com> domain names because the WHOIS information listed Andrew Kaner c/o Electromatic a/k/a Electromatic Equip’t as the registrant of the disputed domain names and there was no other evidence in the record to suggest that the respondent was commonly known by the domain names in dispute); see also *Foot Locker Retail, Inc. v. Gibson*, FA 139693 (Nat. Arb. Forum Feb. 4, 2003) (“Due to the fame of Complainant’s FOOT LOCKER family of marks . . . and the fact that Respondent’s WHOIS information reveals its name to be ‘Bruce Gibson,’ the Panel infers that Respondent was not ‘commonly known by’ any of the disputed domain names prior to their registration, and concludes that Policy ¶ 4(c)(ii) does not apply to Respondent.”).

Respondent has used the disputed domain name to host a website that features links to third-party websites, and furthermore, that Complainant collects click-through fees and therefore gains commercially from this use. This Panelist finds that this use of the disputed domain name for the collection of click-through fees is evidence that Respondent is not making a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii). See *Bank of Am. Fork v. Shen*, FA 699645 (Nat. Arb. Forum June 11, 2006) (finding that the respondent’s use of a domain name to redirect Internet users to websites unrelated to a complainant’s mark is not a *bona fide* use under Policy ¶ 4(c)(i)); see also *Disney Enters., Inc. v. Kamble*, FA 918556 (Nat. Arb. Forum Mar. 27, 2007) (holding that the operation of a pay-per-click website at a confusingly similar domain name was not a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii)).

Respondent believes other have rights to the AAA mark. Based upon the information provided, this is almost certainly true. However, the question is whether or not Respondent has rights, not whether or not a third party has rights. See *Mattel, Inc. v. RanComp Ltd.*, FA579563 (Nat. Arb. Forum Nov. 29, 2005).

Registration and Use in Bad Faith

Complainant notes that in many previous proceedings, Respondent has been ordered to transfer domain names to the respective trademark holders in these cases. See *The Guess Who v. QTK Internet/Name Proxy, James M. van Johns*, D2007-0081 (WIPO April 5, 2007); see also *Transcontinental Media Inc. v. Infa Dot Web Servs./Mr. James M. van Johns*, D2001-0908 (WIPO Sept. 9, 2001); see also *Radisson Hotels Int’l, Inc. v. Damian Macafee d/b/a QTK Internet (Name Proxy)*, FA 652870 (Nat. Arb. Forum Apr. 19, 2006).

Complainant contends this is evidence Respondent has engaged in a pattern of bad faith registration and use that supports a conclusion Respondent has engaged in bad faith registration and use of the <aaa.net> domain name pursuant to Policy ¶ 4(b)(ii). While this Panelist believes this is close case, it agrees with Complainant's contentions. *See N.H. Sweepstakes Comm'n v. We Web Well, Inc.*, FA 197499 (Nat. Arb. Forum Nov. 3, 2003) (finding that the complainant's submission of WHOIS evidence that listed the respondent as the registrant of other domain names incorporating third-party trademarks was sufficient to establish that the respondent had a pattern of registering and using domain names in bad faith pursuant to Policy ¶ 4(b)(ii)); *see also Arai Helmet Americas, Inc. v. Goldmark*, D2004-1028 (WIPO Jan. 22, 2005 (finding that "Respondent has registered the disputed domain name, <aria.com>, to prevent Complainant from registering it" and taking notice of another Policy proceeding against the respondent to find that "this is part of a pattern of such registrations").

Complainant also contends Respondent is using the disputed domain name to gain commercially from the diversion of Internet customers from Complainant's business, through the collection of "click-through" fees. Respondent has registered and is using the disputed domain name in bad faith pursuant to Policy ¶ 4(b)(iv) by creating a likelihood of confusion as to Complainant's affiliation with the disputed domain name. *See Bank of Am. Fork v. Shen*, FA 699645 (Nat. Arb. Forum June 11, 2006) (holding that the respondent's previous use of the <bankofamericanfork.com> domain name to maintain a web directory was evidence of bad faith because the respondent presumably commercially benefited by receiving click-through fees for diverting Internet users to unrelated third-party websites); *see also Constellation Wines U.S., Inc. v. Tex. Int'l Prop. Assocs.*, FA 948436 (Nat. Arb. Forum May 16, 2007) (concluding that Internet users would likely be confused as to the source or sponsorship of the <blackstonewine.com> domain name with the complainant because the respondent was redirecting Internet users to a website with links unrelated to the complainant and likely receiving click-through fees in the process).

In its Additional Submission, Complainant also contends Respondent has used the <aaa.net> domain name to host a web page that displayed an obscenity in large block letters. Complainant contends that this was an attempt to tarnish Complainant's AAA mark, and is therefore evidence of bad faith registration and use on the part of Respondent pursuant to Policy ¶ 4(a)(iii). While Respondent denies knowingly doing this, it appears to have occurred. An obscenity in large block letters supports a finding of bad faith registration and use pursuant to Policy ¶ 4(a)(iii). *See CBS Broad., Inc. v. LA-Twilight-Zone*, D2000-0397 (WIPO June 19, 2000) ("[T]he Policy expressly recognizes that other circumstances can be evidence that a domain name was registered and is being used in bad faith"); *see also Advanced Research & Tech. Inst., Inc. v. LeVin*, FA 318079 (Nat. Arb. Forum Nov. 19, 2004) (finding bad faith where the respondent registered the <indianauniversity.net> and <indianauniversity.org> domain names for political purposes or to tarnish the complainant's mark).

Respondent's business model is to take generic words and/or letter combinations and to register them as domain names. Once someone wants to acquire the domain name,

Respondent will sell it (presumably at a profit, otherwise Respondent could not stay in business). This Panel believes such practices were intended to be prohibited by the policy, even though this case is a close call.

DECISION

Having established all three elements required under the ICANN Policy, this Panel would have concluded that relief should have been granted.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: July 25, 2009