



NATIONAL ARBITRATION FORUM

DECISION

America Online, Inc. v. Armen Sekepyan d/b/a Hitsmakers.com
Claim Number: FA0601000621129

PARTIES

Complainant is **America Online, Inc.** ("Complainant"), represented by **James R. Davis**, of **Arent Fox PLLC**, 1050 Connecticut Avenue, NW, Washington, DC 20036.
Respondent is **Armen Sekepyan d/b/a Hitsmakers.com** ("Respondent"), 1156 1/2 N. Kenmore Ave, Los Angeles, CA 90029.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**cashao.com**>, registered with **Enom, Inc.**

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on January 6, 2006; the National Arbitration Forum received a hard copy of the Complaint on January 9, 2006.

On January 6, 2006, Enom, Inc. confirmed by e-mail to the National Arbitration Forum that the <**cashao.com**> domain name is registered with Enom, Inc. and that Respondent is the current registrant of the name. Enom, Inc. has verified that Respondent is bound by the Enom, Inc. 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 January 10, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of January 30, 2006 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@cashao.com by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On February 6, 2006, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

1. Complainant America Online, Inc. ("AOL") is the owner of numerous trademark registrations worldwide for the mark AOL, including U.S. trademark registration Nos. 1,977,731 and 1,984,337, which were registered on June 4, 1996, and July 2, 1996, respectively. AOL registered and uses its AOL mark in connection with, among other things,

“computer services, namely leasing access time to computer databases, computer bulletin boards, computer networks, and computerized research and reference materials, in the fields of **business, finance**, news, weather, sports, computing and computer software, games, music, theater, movies, travel, education, lifestyles, hobbies and topics of general interest; computerized dating services; computer consultation services; computerized shopping via telephone and computer terminals in the fields of computer goods and services and general consumer goods” and

“telecommunications services, namely electronic transmission of data, images, and documents via computer terminals; electronic mail services; and facsimile transmission.” (emphasis added)

2. AOL uses its mark AOL.COM in connection with the official AOL Internet Web site. AOL owns federal trademark registration Nos. 2,325,291 and 2,325,292 for the mark AOL.COM. The mark AOL is used extensively at this Web site, which is a significant method of promoting AOL's service. As a result, consumers associate the mark AOL, when used in a domain name, with AOL's services.

3. Long prior to Respondent's registration of "CASHAOL.COM" and at least as early as 1989 for the mark AOL, and 1992 for the mark AOL.COM, AOL adopted and began using its marks in connection with computer online services and other Internet-related services. The distinctive AOL mark is used and promoted around the world in connection with providing a broad range of information and services over the Internet and at the proprietary AOL online system. AOL has used its famous and distinctive marks continuously and extensively in interstate and international commerce in connection with the advertising and sale of its Internet and computer-related services.
4. AOL has invested substantial sums of money in developing and marketing its services and marks. As a result, the AOL mark is one of the most readily recognized and famous marks used on the Internet.
5. With tens of millions of subscribers, AOL operates the most widely-used interactive online service in the world and each year millions of AOL customers worldwide obtain services offered under the AOL and AOL.COM marks; millions more are exposed to said marks through advertising and promotion.
6. The AOL and AOL.COM marks have been and continue to be widely publicized through substantial advertising throughout the United States and the world. Many millions of dollars have been spent in connection with such advertising, which has been disseminated through network and cable television programs, radio broadcasts, and in print media including newspapers and periodicals.
7. Sales of services under the AOL and AOL.COM marks have amounted to many billions of dollars. As a result, the general public has come to associate the AOL names and marks with services of a high and uniform quality.
8. Because of these substantial advertising expenditures and sales, the distinctive AOL and AOL.COM marks have become very well-known and famous among members of the purchasing public.
9. Many years after AOL's adoption and first use of its mark, Respondent registered the domain name "CASHAOL.COM" with a bad faith intent to profit from the registration and use of the domains. Respondent's actions are a clear and blatant violation of AOL's intellectual property rights. Respondent's bad faith actions demonstrate an utter disregard and contempt for AOL's legal rights and ICANN's Uniform Domain Name Dispute Resolution Policy.
10. The "CASHAOL.COM" domain is nearly identical and confusingly similar to the AOL and AOL.COM marks. Consumer confusion is particularly likely given that the domain names use the AOL mark as a suffix to the generic word "cash." Moreover, the domain name has been offered for sale for thousands of dollars and used in connection with a commercial Web site that made prominent use of the AOL brand. The AOL component of "CASHAOL.COM" serves as the sole distinctive element of the domain name and

consumers that see the domain name are likely to be misled into believing the underlying services are endorsed by or affiliated with AOL. By using the famous AOL mark in this manner, Respondent clearly is attempting to profit from the AOL name and mark and confuse and mislead consumers.

11. Respondent registered and uses the infringing domain with a bad faith intent to capitalize on AOL's famous names and marks, and profit from the international and domestic goodwill AOL has created in its famous marks.
12. Respondent has no rights or legitimate interests in the infringing domain. Respondent is not named or commonly known as AOL, nor is he licensed or authorized to use the AOL mark. The following is evidence of Respondent's bad faith registration and use of the domain:
 - (a) Respondent's bad faith registration of the "CASHAOL.COM" domain is evidenced by the fact that the domain was registered many years after the AOL Marks had become famous and well-known to consumers. The AOL mark had been registered for many years before the subject domain name was registered, and Respondent is deemed to have at least had constructive knowledge of AOL's rights as set forth in those registrations. Respondent registered the domain name for the sole purpose of attempting to sell it and use it to provide commercial online services under the AOL mark in a manner that would confuse and mislead consumers. Such actions constitute a bad faith registration and use of the domain name.
 - (b) Respondent's bad faith use of the domains is demonstrated by the commercial services and content provided at the subject Web sites. Respondent's use of the AOL mark in a domain name to route unassuming consumers to a commercial Web site that makes prominent use of the AOL mark violates Paragraph 4(b)(iv) of the UDRP and constitutes a bad faith use of the domains.
 - (c) Respondent's bad faith intent and use of the domains is shown by the fact that Respondent has attempted on at least two different occasions to sell the domain name for thousands of dollars. Screen shots of the eBay and Afternic auctions were included. In the description of the eBay auction, Respondent concedes that AOL contacted him and objected to his ownership of the infringing domain name (he claims to be "sure they [AOL] will be back soon wanting to get this domain."). *Id.* By attempting to sell the infringing domain name for an amount that far exceeds the actual registration costs, Respondent has violated Paragraph 4(b)(i) of the UDRP.
 - (d) Respondent's bad faith intent is further demonstrated by his communications with AOL's attorney, in which he initially agreed to settle the matter by transferring the domain name and then reneged and continued to attempt to sell the domain name via the online auctions referenced above.

- (e) Respondent's bad faith registration and use of the domain is shown by numerous prior UDRP decisions stating that the use of the AOL mark in this manner is a violation of ICANN's rules. See, for example, *America Online, Inc. v. Cucamonga Electric Corp.* ("in this age it is not a coincidence when a firm uses the acronym AOL in any new setting. In the absence of a credible explanation, I will infer that its purpose is to mislead Internet users into thinking that whatever activities are carried on on the site, AOL Inc. has some connection with them"); *America Online, Inc. v. Viper*, WIPO Case D2000-1198 ("it is well past the day when Internet users would not make the assumption that use of AOL as part of a domain name links that site in the mind of the user to Complainant"). Respondent similarly is using the famous AOL mark to promote and operate a commercial Web site solely so that Respondent can benefit from the international goodwill and fame AOL has created in its AOL mark. See also *America Online, Inc. v. Alliance For Online Living*, NAF Case 414567 ("aolcybersex.com" transferred); *America Online, Inc. v. Grandtotal Finances8Ltd.*, NAF Case 250749 ("xxxaol.com" transferred); *America Online, Inc., v. Yeteck Communication, Inc.*, WIPO D2001-0055 (Respondent held to have acted in bad faith despite claims that "aolcasino.com" was an acronym for "Adults On Line Casino"); *America Online, Inc. v. East Coast Exotics*, WIPO D2001-0661 (bad faith registration and use despite Respondent's claim that AOL is an acronym for "Amateurs On Line"); *America Online, Inc. v. USACOOB.COM* NAF Case 105763 (bad faith registration and use of "aolmalls.com" despite claim that AOL is an acronym for Americans On Line Malls).
- (f) Based upon (1) the fame of the AOL marks; (2) AOL's trademark registrations; (3) Respondent's use of the domain to route to a commercial Web site; (4) Respondent's attempts to sell the domain name; and (5) Respondent's misleading and fraudulent claim to seek an amicable resolution by transferring the domain name, Respondent cannot in good faith claim that he had no knowledge of AOL's rights in its very famous AOL marks. Furthermore, Respondent cannot claim in good faith that he made a legitimate noncommercial or fair use of the subject domain, or that he is commonly known as AOL.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, America Online, Inc. ("AOL") owns numerous trademark registrations worldwide for the AOL mark, including United States Patent and Trademark Office ("USPTO") Registration Nos. 1,977,731 and 1,984,337, registered on June 4, 1996, and July 2, 1996, respectively. Complainant uses its registered AOL mark for a variety of goods and services, including telecommunication services, instant message services, computer services, computer bulletin boards, computer networks, and computerized research and reference materials.

Respondent registered the <cashao.com> domain name on March 23, 2005. Respondent is using the domain name in connection with its commercial website that purports to offer AOL Instant Messenger users payment in exchange for incorporating various commercial advertisements into their Instant Messages.

On two separate occasions, Respondent has tried to sell the <cashao.com> domain name registration on online auction sites. On December 28, 2005, Respondent offered the <cashao.com> domain name registration on eBay with a starting bid of \$5,000. On January 5, 2006, after the seven-day eBay auction had ended, Respondent listed the domain name on Afternic.com with an asking price of \$25,000.

DISCUSSION

Paragraph 15(a) of 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."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that Complainant must 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 Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) 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

Complainant has established rights in the AOL mark through its numerous trademark registrations worldwide, including USPTO Registration Nos. 1,977,731 and 1,984,337, registered on June 4, 1996, and July 2, 1996, respectively. *See Vivendi Universal Games v. XBNetVentures Inc.*, FA 198803 (Nat. Arb. Forum Nov. 11, 2003) ("Complainant's federal trademark registrations establish Complainant's rights in the BLIZZARD mark."); *see also Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004)

(“Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark.”).

Respondent’s <**cashao.com**> domain name is confusingly similar to Complainant’s AOL mark, pursuant to Policy ¶4(a)(i), because it combines Complainant’s mark (“AOL”) with a generic word (“cash”). *See Arthur Guinness Son & Co. (Dublin) Ltd. v. Healy/BOSTH*, D2001-0026 (WIPO Mar. 23, 2001) (finding confusing similarity where the domain name in dispute contains the identical mark of the complainant combined with a generic word or term); *see also AXA China Region Ltd. v. KANNET Ltd.*, D2000-1377 (WIPO Nov. 29, 2000) (finding that the <axachinaregion.com> domain name “is confusingly similar to the Complainant's trade mark ‘AXA’” because “common geographic qualifiers or generic nouns can rarely be relied upon to differentiate the mark if the other elements of the domain name comprise a mark or marks in which another party has rights”) ; *see also Brambles Indus. Ltd. v. Geelong Car Co. Pty. Ltd.*, D2000-1153 (WIPO Oct. 17, 2000) (finding that the domain name <bramblesequipment.com> is confusingly similar because the combination of the two words "brambles" and "equipment" in the domain name implies that there is an association with the complainant’s business).

The Panel finds Policy ¶4(a)(i) satisfied.

Rights or Legitimate Interests

Complainant has alleged Respondent does not have rights or legitimate interests in the <**cashao.com**> domain name. Complainant has the initial burden of proof in asserting Respondent has no legitimate interests in the domain name, and once Complainant makes a *prima facie* case in support of its allegations, the burden then shifts to Respondent to show it does have a right or legitimate interest in the disputed domain name. *See Lush LTD v. Lush Environs*, FA 96217 (Nat. Arb. Forum Jan. 13, 2001) (finding that even when the respondent does file a response, the complainant must allege facts, which if true, would establish that the respondent does not have any rights or legitimate interests in the disputed domain name); *see also Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (once the complainant asserts that the respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the respondent to provide “concrete evidence that it has rights to or legitimate interests in the domain name at issue”).

Respondent’s failure to answer Complainant’s complaint raises a presumption that Respondent has no rights or legitimate interests in the <**cashao.com**> domain name. *See Am. Express Co. v. Fang Suhendro*, FA 129120 (Nat. Arb. Forum Dec. 30, 2002) (“[B]ased on Respondent's failure to respond, it is presumed that Respondent lacks all rights and legitimate interests in the disputed domain name.”); *see also Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding it appropriate for the panel to draw adverse inferences from the respondent’s failure to reply to the complaint).

Moreover, Respondent is using the disputed domain name, which is confusingly similar to Complainant's mark, to operate a commercial website that exists specifically to trade off of the fame of Complainant's mark. Such use does not constitute a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i), or a legitimate noncommercial or fair use of the domain name pursuant to Policy ¶4(c)(iii). *See Am. Online, Inc. v. Advanced Membership Servs., Inc.*, FA 180703 (Nat. Arb. Forum Sept. 26, 2003) ("Respondent's registration and use of the <gayaol.com> domain name with the intent to divert Internet users to Respondent's website suggests that Respondent has no rights to or legitimate interests in the disputed domain name pursuant to Policy Paragraph 4(a)(ii)."); *see also U.S. Franchise Sys., Inc. v. Howell*, FA 152457 (Nat. Arb. Forum May 6, 2003) (holding that the respondent's use of the complainant's mark and the goodwill surrounding that mark as a means of attracting Internet users to an unrelated business was not a *bona fide* offering of goods or services); *see also Disney Enters., Inc. v. Dot Stop*, FA 145227 (Nat. Arb. Forum Mar. 17, 2003) (finding that the respondent's diversionary use of the complainant's mark to attract Internet users to its own website, which contained a series of hyperlinks to unrelated websites, was neither a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain names).

There is also no evidence in the record Respondent is commonly known by the <cashao.com> domain name. Therefore, Respondent has not established rights or legitimate interests in the <cashao.com> domain name pursuant to Policy ¶4(c)(ii). *See Gallup, Inc. v. Amish Country Store*, FA 96209 (Nat. Arb. Forum Jan. 23, 2001) (finding that the respondent does not have rights in a domain name when the respondent is not known by the mark); *see also Wells Fargo & Co. v. Onlyne Corp. Services11, Inc.*, FA 198969 (Nat. Arb. Forum Nov. 17, 2003) ("Given the WHOIS contact information for the disputed domain [name], one can infer that Respondent, Onlyne Corporate Services11, is not commonly known by the name 'wellsfargo' in any derivation.").

Respondent's effort to sell the <cashao.com> domain name registration through two online auction sites suggests that Respondent lacks rights or legitimate interests in the domain name. *See Wal-Mart Stores, Inc. v. Stork*, D2000-0628 (WIPO Aug. 11, 2000) (finding the respondent's conduct purporting to sell the domain name suggests it has no legitimate use); *see also Mothers Against Drunk Driving v. Hyun-Jun Shin*, FA 154098 (Nat. Arb. Forum May 27, 2003) (holding that under the circumstances, the respondent's apparent willingness to dispose of its rights in the disputed domain name suggested that it lacked rights or legitimate interests in the domain name). Respondent highlighted the fact the domain name infringed on Complainant's mark while trying to auction it.

The Panel finds Policy ¶4(a)(ii) satisfied.

Registration and Use in Bad Faith

Respondent is using the disputed domain name, which is confusingly similar to Complainant's mark, to operate a commercial service. Internet users accessing Respondent's website may become confused as to Respondent's affiliation with

Complainant. The Panel finds such use constitutes bad faith registration and use pursuant to Policy ¶4(b)(iv). *See Amazon.com, Inc. v. Shafir*, FA 196119 (Nat. Arb. Forum Nov. 10, 2003) (“As Respondent is using the domain name at issue in direct competition with Complainant, and giving the impression of being affiliated with or sponsored by Complainant, this circumstance qualifies as bad faith registration and use of the domain name pursuant to Policy ¶4(b)(iv).”); *see also G.D. Searle & Co. v. Celebrex Drugstore*, FA 123933 (Nat. Arb. Forum Nov. 21, 2002) (finding that the respondent registered and used the domain name in bad faith pursuant to Policy ¶4(b)(iv) because the respondent was using the confusingly similar domain name to attract Internet users to its commercial website); *see also Identigene, Inc. v. Genetest Labs.*, D2000-1100 (WIPO Nov. 30, 2000) (finding bad faith where the respondent's use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site).

Respondent's bad faith registration is further illustrated by its several attempts to sell the domain name registration for thousands of dollars through two online auction sites, eBay and Afternic.com. Since Respondent attempted to sell the domain name registration for a far greater amount than the actual registration costs, Respondent has violated Policy ¶4(b)(i). *See Bank of Am. Corp. v. Nw. Free Cmty. Access*, FA 180704 (Nat. Arb. Forum Sept. 30, 2003) (“Respondent's general offer of the disputed domain name registration for sale establishes that the domain name was registered in bad faith under Policy ¶4(b)(i).”); *see also Dollar Rent A Car Sys., Inc. v. Jongho*, FA 95391 (Nat. Arb. Forum Sept. 11, 2000) (finding that the respondent demonstrated bad faith by registering the domain name with the intent to transfer it to the complainant for \$3,000, an amount in excess of its out of pocket costs); *see also Step2 Co. v. Softastic.com Corp.*, D2000-0393 (WIPO June 26, 2000) (finding that the respondent's attempt to sell the domain name in question on <greatdomains.com>, a domain name auction site, for \$100,000 constitutes bad faith). Respondent even highlighted the fact the domain name infringed on Complainant's mark during the auction (suggesting this made the domain name more valuable).

The Panel finds Policy ¶4(a)(iii) satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <cashool.com> domain name be **TRANSFERRED** from Respondent to Complainant.


Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: February 15, 2006

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