



NATIONAL ARBITRATION FORUM

DECISION

AOL LLC v. Pending Domains a/k/a Domain Admin
Claim Number: FA0701000894499

PARTIES

Complainant is **AOL LLC** ("Complainant"), represented by **James R. Davis**, of **Arent Fox LLP**, 1050 Connecticut Avenue, NW, Washington, DC 20036. Respondent is **Pending Domains a/k/a Domain Admin** ("Respondent"), 5863 Leslie Street #450, Toronto, ON M2H1J8, CA.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are **<netscapepoker.com>**, registered with **A Mountain Domains**, and **<aoltmz.com>** and **<tmzaol.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 23, 2007; the National Arbitration Forum received a hard copy of the Complaint on January 23, 2007.

On January 23, 2007, Enom, Inc. confirmed by e-mail to the National Arbitration Forum that the **<aoltmz.com>** and **<tmzaol.com>** domain names are registered with Enom, Inc. and that Respondent is the current registrant of the names. 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 24, 2007, A Mountain Domains confirmed by e-mail to the National Arbitration Forum that the **<netscapepoker.com>** domain name is registered with A Mountain Domains and that Respondent is the current registrant of the name. A Mountain Domains has verified that Respondent is bound by the A Mountain Domains registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On January 25, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of February 14, 2007

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@netscape poker.com, postmaster@aoltmz.com, and postmaster@tmzaol.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 19, 2007, 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 names be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

Trademark/Service Mark Information:

Complainant and its affiliates own the marks AOL, NETSCAPE and TMZ, and numerous other marks that incorporate AOL, NETSCAPE and TMZ. The marks are used in connection with, among other things, providing services and general interest information on the Internet.

FACTUAL AND LEGAL GROUNDS

This Complaint is based on the following factual and legal grounds:

1. Complainant AOL LLC and its affiliates (collectively "AOL") owns exclusive worldwide rights to the marks AOL, NETSCAPE and TMZ (collectively the "AOL Marks"). AOL owns numerous trademark registrations and applications around the world for the AOL Marks, including several registrations in the United States and Canada for AOL and NETSCAPE.

2. AOL also uses its AOL Marks in connection with its domain names for its various Web sites, *i.e.*, AOL.COM, NETSCAPE.COM and TMZ.COM. AOL owns federal trademark registrations for the marks AOL.COM and NETSCAPE.COM. The AOL Marks are used extensively at these Web sites, which are a significant method of promoting AOL's goods and services.
3. Long before Respondent's registration of the domain names at issue in the proceeding, AOL adopted and began using its AOL, NETSCAPE and TMZ marks in connection with providing computer and Internet-related goods and services. Since their first adoption, these distinctive marks have been used continuously and extensively in interstate and international commerce in connection with the advertising and sale of AOL's goods and services.
4. AOL has invested substantial sums of money in developing and marketing its services.
5. Each year millions of AOL customers worldwide obtain goods and services offered under the AOL Marks; millions more are exposed to said marks through advertising and promotion.
6. The AOL 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 Marks have amounted to many millions of dollars. As a result, the general public has come to associate these names and marks with services of a high and uniform quality.
8. Because of these substantial advertising expenditures and sales, the distinctive AOL Marks have become well-known and famous among members of the purchasing public.
9. Long after AOL's adoption and first use of its AOL Marks, and long after these marks became well-known and famous, Respondent registered the domain names "NetscapePoker.com" "AOLTMZ.COM" and "TMZAOL.COM" (collectively the "Infringing Domains") for the bad faith purpose of profiting from the goodwill AOL has created in its AOL Marks. Specifically, Respondent is using the Infringing Domains to route to commercial Web sites. Respondent, therefore, has registered and is using the Infringing Domains for the sole purpose of confusing and leading unknowing consumers to Respondent's commercial Web sites.
10. The Infringing Domains are confusingly similar or nearly identical to the AOL Marks. Consumer confusion is particularly likely because Respondent's domain names use the AOL Marks with a generic word ("NetscapePoker.com") or in combination with each

other (“AOLTMZ.com” and “TMZAOL.com”). Consumers therefore are likely to believe AOL endorses or is affiliated with Respondent or the subject Web sites, or that Respondent offers the AOL, NETSCAPE or TMZ services.

11. Respondent registered and used the Infringing Domains in bad faith to capitalize on the famous AOL Marks and to confuse consumers. Respondent is not licensed or otherwise authorized to register or use domain names that are nearly identical to the AOL Marks.
12. Respondent has no rights or legitimate interests in respect to the Infringing Domains. The following is evidence of Respondent’s bad faith registration and use of the domain names:
 - (a) Respondent’s bad faith registration of the Infringing Domains is evidenced by the fact that the domains were registered long after the AOL Marks were first used and many years after the AOL and NETSCAPE marks were registered with the United States Patent and Trademark Office and the Canadian trademark office, and long after the AOL Marks had become famous associated with Internet services. Respondent is deemed to have had at least constructive knowledge of AOL’s rights by virtue of the existing AOL trademark registrations with the United States Patent & Trademark Office. *The American National Red Cross v. Inter-Net Research, Inc. a/k/a Martin Palmer*, NAF Case FA0205000114438. The use of the AOL Marks in these domain names shows that Respondent registered the domains to play off AOL’s distinctive marks and benefit from any traffic created when an Internet user types one of the Infringing Domains while trying to visit an authentic AOL site. Therefore, Respondent’s registration of the Infringing Domains was made in bad faith to play off the already famous AOL Marks and profit from the international goodwill AOL has created in its brands.
 - (b) Respondent’s bad faith use of the Infringing Domains is demonstrated by its use of some of the domains to route to commercial Web sites. As set forth above and in the exhibits to this complaint, AOL has used its AOL Marks for many years in connection with providing online services that are identical or very similar to those provided by Respondent at Web sites associated with the Infringing Domains. The commercial use of the AOL Marks in this manner demonstrates Respondent’s bad faith intent to confuse consumers and profit off the confusion created by these infringing domains.
 - (c) In an attempt to resolve this matter amicably, counsel for AOL sent Respondent two letters and left Respondent voice mail messages. Respondent, however, failed to respond to any of AOL’s communications and continued to use the infringing domain names. Respondent actions demonstrate its willful and knowing infringement of the AOL Marks

- (d) Respondent's bad faith intent is further shown by a significant pattern of cybersquatting. In addition to the three domain names at issue in this case, Respondent owns domain names that infringe upon famous marks like GOOGLE ("GOOGLEpt.com") and eBay ("pornEBAY.com"). As with the domain names at issue in this proceeding, these domain names infringe upon famous Internet-related trademarks. This pattern of cybersquatting constitutes a bad faith use of the Infringing Domain Names pursuant to Para. 4(b)(ii) of the UDRP.
- (e) Based upon (1) the fame of the AOL Marks as used in connection with online services; (2) AOL's various trademark registrations and applications; (3) Respondent's bad faith pattern of infringing upon the AOL Marks and other famous marks owned by third party Internet companies; and (4) Respondent's use of the Infringing Domains to route to Respondent's own commercial Web site, Respondent cannot in good faith claim that it had no knowledge of AOL's rights in its very famous AOL Marks. Furthermore, Respondent cannot claim in good faith that it made a legitimate noncommercial or fair use of the subject domains, or that Respondent is commonly known as any of the AOL Marks.

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

FINDINGS

Complainant, AOL LLC, is a global provider of computer services and general interest information on the Internet. In connection with its Internet-related goods and services, Complainant has registered numerous marks with the United States Patent and Trademark Office ("USPTO"), including the AOL (Reg. No. 1,977,731 issued June 4, 1996) and NETSCAPE (Reg. No. 2,027,552 issued December 31, 1996) marks. Complainant has provided evidence it operates a website at the <tmz> domain name in connection with its AOL mark. Complainant has acquired common law rights to the <tmz> domain name.

Respondent registered the <tmzaol.com> and <aoltmz.com> domain names on November 10, 2005, and the <netscapepoker.com> domain name on April 24, 2006. Respondent's disputed domain names each resolve to a holding page with sponsored links to third-party web sites.

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 and NETSCAPE marks pursuant to Policy ¶4(a)(i) through its registration of the marks with the USPTO. *See 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."); *see also 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.").

Respondent's <tmzaol.com> and <aoltmz.com> domain names are confusingly similar to Complainant's AOL mark pursuant to Policy ¶4(a)(i) because the domain names contain the AOL mark in its entirety and add the letters "t," "m," and "z." Because Complainant operates a website at the <tmz> domain name and has acquired common law trademark rights in connection with its AOL mark, the letters have a direct relationship to Complainant's business and fail to sufficiently distinguish the domain name from the mark under Policy ¶4(a)(i). *See Am. Int'l Group, Inc. v. Ling Shun Shing*, FA 206399 (Nat. Arb. Forum Dec. 15, 2003) (finding that the addition of the term "assurance," to the complainant's AIG mark failed to sufficiently differentiate the name from the mark under Policy ¶4(a)(i) because the appended term related directly to the complainant's business); *see also Space Imaging LLC v. Brownell*, AF-0298 (eResolution Sept. 22, 2000) (finding confusing similarity where the respondent's domain name combines the complainant's mark with a generic term that has an obvious relationship to the complainant's business).

Respondent's <**netscapepoker.com**> domain name is confusingly similar to Complainant's NETSCAPE mark pursuant to Policy ¶4(a)(i) because the domain name contains the NETSCAPE mark in its entirety and adds the generic term "poker," which is not a distinguishing difference. *See Am. Online, Inc. v. Anytime Online Traffic Sch.*, FA 146930 (Nat. Arb. Forum Apr. 11, 2003) (finding that the respondent's domain names, which incorporated the complainant's entire mark and merely added the descriptive terms "traffic school," "defensive driving," and "driver improvement" did not add any distinctive features capable of overcoming a claim of confusing similarity); *see also 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).

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

Rights or Legitimate Interests

Complainant asserts Respondent lacks rights or legitimate interests in the <**netscapepoker.com**>, <**aoltmz.com**>, and <**tmzaol.com**> domain names, and thus it has established a *prima facie* case. Once Complainant makes a *prima facie* case in support of its allegations, the burden then shifts to Respondent to show it does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). Because Respondent has failed to respond to the Complaint, the Panel assumes Respondent does not have rights or legitimate interests in the disputed domain names. *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (holding that, where the complainant has asserted that respondent does not have rights or legitimate interests with respect to the domain name, it is incumbent on respondent to come forward with concrete evidence rebutting this assertion); *see also 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."). Out of an abundance of caution, the Panel will examine the record to determine if Respondent has rights or legitimate interests under Policy ¶4(c).

Complainant asserts Respondent is not licensed or otherwise authorized to use Complainant's AOL and NETSCAPE marks and Respondent is not associated with Complainant in any way. Respondent's WHOIS information does not suggest, nor does any additional information in the record suggest Respondent is commonly known by the <**netscapepoker.com**>, <**aoltmz.com**>, and <**tmzaol.com**> domain names. Therefore, the Panel finds Respondent is not commonly known by the disputed domain names under 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 Wells Fargo & Co. v. Onlyne Corp. Services II, 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 ‘welsfargo’ in any derivation.”).

Respondent is using the <netscapepoker.com>, <aoltmz.com>, and <tmzaol.com> domain names, which are confusingly similar to Complainant’s marks, to divert Internet users to websites containing sponsored links to third-party websites. Such use of the disputed domain names does not constitute a *bona fide* offering of goods and 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 *MSNBC Cable, LLC v. Tsys.com*, D2000-1204 (WIPO Dec. 8, 2000) (finding no rights or legitimate interests in the famous MSNBC mark where the respondent attempted to profit using the complainant’s mark by redirecting Internet traffic to its own website); 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).

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

Registration and Use in Bad Faith

Respondent is using the <netscapepoker.com>, <aoltmz.com>, and <tmzaol.com> domain names, which are confusingly similar to Complainant’s marks, to divert Internet users seeking Complainant’s products and services to websites containing links to unrelated commercial websites. The Panel infers Respondent earns click-through revenues for diverting Internet users to the third-party websites. Such use for Respondent’s own commercial gain is evidence of bad faith registration and use pursuant to Policy ¶4(b)(iv). See *State Farm Mut. Auto. Ins. Co. v. Northway*, FA 95464 (Nat. Arb. Forum Oct. 11, 2000) (finding that the respondent registered the domain name <statefarmnews.com> in bad faith because the respondent intended to use the complainant’s marks to attract the public to the web site without permission from the complainant); see also *G.D. Searle & Co. v. Celebrix 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 *Am. Univ. v. Cook*, FA 208629 (Nat. Arb. Forum Dec. 22, 2003) (“Registration and use of a domain name that incorporates another’s mark with the intent to deceive Internet users in regard to the source or affiliation of the domain name is evidence of bad faith.”).

In addition, it appears Respondent has engaged in a pattern of registering the trademarks of others as domain names. This is also evidence of bad faith.

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

DECISION

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

Accordingly, it is Ordered that the <**netscapepoker.com**>, <**aoltmz.com**>, and <**tmzaol.com**> domain names be **TRANSFERRED** from Respondent to Complainant.

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: Tuesday, February 27, 2007

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