



NATIONAL ARBITRATION FORUM

DECISION

AOL LLC v. Goran Josipovic
Claim Number: FA0907001274301

PARTIES

Complainant is **AOL LLC** ("Complainant"), represented by **James R. Davis**, of **Arent Fox LLP**, Washington D.C., USA. Respondent is **Goran Josipovic** ("Respondent"), California, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**reg-aol.com**>, registered with **Melbourne It, Ltd.** d/b/a **Internet Names Worldwide**.

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 July 16, 2009; the National Arbitration Forum received a hard copy of the Complaint on July 20, 2009.

On July 21, 2009, Melbourne It, Ltd. d/b/a Internet Names Worldwide confirmed by e-mail to the National Arbitration Forum that the <**reg-aol.com**> domain name is registered with Melbourne It, Ltd. d/b/a Internet Names Worldwide and that Respondent is the current registrant of the name. Melbourne It, Ltd. d/b/a Internet Names Worldwide has verified that Respondent is bound by the Melbourne It, Ltd. d/b/a Internet Names Worldwide 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 July 22, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of August 11, 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@reg-aol.com by e-mail.

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

On August 17, 2009, 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:

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

1. Complainant AOL LLC ("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.”

2. AOL uses its mark AOL.COM in connection with the AOL portal Web site. AOL owns U.S. 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 the infringing domain name "Reg-AOL.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 in the U.S. and around the world in connection with providing a broad range of information and services over the Internet. 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 registered users, AOL operates one of 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. *America Online, Inc. v. Amigos On Line RJ*, NAF Case 115041 (registrant's use of "aolrj.com" infringed upon AOL's rights even though registrant claimed domain name was an acronym for "Amigos On Line Rio de Janeiro"); *Online, Inc. v. RAM a/k/a Ramakrishna Purnachandra*, NAF Case 136310 (registrant's use of "AOL-India.com" infringed upon AOL's rights even though registrant claimed AOL is an acronym for Akhila Officers Lobby of India). Many millions of dollars have been spent in connection with such advertising, which has been disseminated through a wide variety of media, including the Internet.
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 "Reg-AOL.com" with a bad faith intent to profit from the registration and use of the domain. 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 domain name "Reg-AOL.com" is nearly identical and confusingly similar to the AOL and AOL.COM marks. Consumer confusion is particularly likely given that the domain name is comprised of the famous AOL mark and the three letter term "reg," which is a commonly truncated version of "registration" or "regulation." The AOL component, therefore, serves as the sole distinctive element of the domain name "Reg-AOL.com" and consumers that encounter the infringing domain name are likely to be misled into believing the underlying services are endorsed by or affiliated with AOL, or that AOL operates Respondent's infringing commercial Web site. By using the famous AOL mark in this way Respondent clearly is attempting to emphasize 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 (Goran Josopovic) is not named or commonly known as AOL, nor is he licensed or authorized to use the AOL mark in this manner. The following is evidence of Respondent's bad faith registration and use of the domain:
 - (a) Respondent's bad faith registration of "Reg-AOL.com" is evidenced by the fact that the domain was registered on September 25, 2008, many years after the AOL Marks were registered and had become famous and well-known to consumers. Respondent sometimes uses an AOL email address and, therefore, he has actual knowledge of AOL's trademark rights. Moreover, AOL federal trademark registrations constitute constructive knowledge of AOL's trademark rights. Respondent therefore registered the domain name for the sole purpose of providing commercial online services under the AOL mark and profiting from the consumer confusion that would be created by this unauthorized use of the AOL Marks. Such actions constitute a bad faith registration and use of the domain name.
 - (b) Respondent's bad faith use of the domain name is shown by the commercial Web site operated at www.Reg-AOL.com. This Web site is associated with Respondent's site at www.MLBPrime.com and provides links so visitors can purchase tickets to sporting events and entertainment shows. Respondent is profiting directly from the infringing domain "Reg-AOL.com." As noted above, AOL's federal trademark registrations cover the sporting, entertainment and ticket services that Respondent is providing and Respondent's services directly conflict and compete with AOL's. This constitutes a bad faith commercial use of the domain name and violates Paragraph 4(b)(iv) of the UDRP.

- (c) In an attempt to resolve this matter amicably, counsel for AOL sent Respondent a cease and desist letter to the privacy service that was managing the domain name. On that same day the privacy service was lifted and AOL's counsel sent Respondent a letter to his mailing address in Illinois. Respondent has since changed his address again and now uses a different California address. Respondent did not respond to AOL's counsel, nor did he transfer or deactivate the domain name. Respondent's actions clearly demonstrate that he is acting in bad faith and with actual knowledge of AOL's rights.
- (d) Respondent's bad faith actions are further demonstrated by his significant pattern of registering and using infringing domain names. In addition to the domain name at issue in this dispute, Respondent owns several domain names that infringe upon the third party trademarks MLB (owned by Major League Baseball), NFL (owned by the National Football League), and the Chicago Cubs. Respondent therefore has violated Para. 4(b)(ii) of the UDRP. It is noteworthy that Respondent uses an AOL email address for some of these registrations. *Id.* Respondent therefore clearly has actual knowledge of AOL and its trademarks.
- (e) Respondent's bad faith registration and use of the domain name 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"). In anticipation that Respondent may claim AOL is an acronym, AOL notes that UDRP panelists have repeatedly rejected such arguments. See, e.g., *America Online, Inc. v. Amigos On Line RJ*, NAF Case 115041 (Brazilian registrant's use of "aolrj.com" infringed upon AOL's rights even though registrant claimed domain name was an acronym for "Amigos On Line Rio de Janeiro"); *America Online, Inc. v. Darell Blandshaw*, NAF 444475 (transfer of "AOL-HipHop.com" even though registrant claimed AOL is an acronym for All Online); *America Online, Inc. v. Inetekk.com, Inc.*, NAF 231685 (transfer of "AOLms.com" even though registrant claimed AOL is acronym for Advanced Online Marketing Systems); *America Online, Inc. v. Bernhard Hieke d/b/a Archimedis ag*, NAF 154097 (transfer of "AOL.tv" even though registrant claimed AOL is an acronym for All Of Linux); *America Online, Inc. v. Jeffrey Berns*, NAF 273412 (transfer of "AOLove.com" even though registrant claimed AOL is an acronym for An Only Love); *America Online, Inc. v. Dolphin @ Heart*, WIPO D2000-0713 (transfer of "AOLIreland.com" and other domains even though registrant claimed AOL is an acronym for Always On Line); *America Online, Inc. v. USACOO.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 name with a commercial Web site that provides pay-per-click links to AOL’s competitors’ Web sites; (4) Respondent’s pattern of cybersquatting; (5) Respondent’s use of an AOL email address; and (6) Respondent’s failure to negotiate an amicable resolution or respond to AOL’s counsel’s letters, 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 Respondent is commonly known as AOL.

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

FINDINGS

Complainant AOL LLC provides computer online services and other Internet-related services, such as sporting, entertainment, and ticket services. Complainant offers these services under its AOL.COM mark, and has done so since 1989. Complainant holds multiple trademark registrations with the United States Patent and Trademark Office (“USPTO”) for its AOL.COM mark (i.e., Reg. No. 2,325,291 issued April 1, 1998).

Respondent registered the <reg-aol.com> domain name on September 25, 2008. The disputed domain name resolves to a website associated with Respondent’s independent website. Respondent’s website provides links for the purchase of tickets for sporting events and entertainment shows.

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 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 holds multiple trademark registrations with the USPTO for the AOL.COM mark (i.e., Reg. No. 2,325,291 issued April 1, 1998). Previous panels have held trademark registrations with the USPTO is sufficient to establish rights in a mark pursuant to Policy ¶4(a)(i). Therefore, the Panel finds Complainant has established rights in the AOL.COM mark under Policy ¶4(a)(i) through its registrations with the USPTO and other governmental trademark agencies. *See Metro. Life Ins. Co. v. Bonds*, FA 873143 (Nat. Arb. Forum Feb. 16, 2007) (finding that a trademark registration adequately demonstrates a complainant's rights in a mark under Policy ¶4(a)(i)); *see also Am. Int'l Group, Inc. v. Morris*, FA 569033 (Nat. Arb. Forum Dec. 6, 2005) ("Complainant has established rights in the AIG mark through registration of the mark with several trademark authorities throughout the world, including the United States Patent and Trademark office ('USPTO')").

Complainant contends Respondent's <reg-aol.com> domain name is confusingly similar to Complainant's AOL.COM mark. The disputed domain name contains Complainant's mark in its entirety and simply adds the generic term "reg" and a hyphen between the generic term and Complainant's mark. The Panel finds the additions of a generic term and hyphen fail to adequately distinguish the <reg-aol.com> domain name from Complainant's AOL.COM mark under the special facts and circumstances of this case. *See Google Inc. v. Xtraphus Corp.*, D2001-0125 (WIPO Apr. 16, 2001) (finding that the respondent's domain names were confusingly similar to Complainant's GOOGLE mark where the respondent merely added common terms such as "buy" or "gear" to the end); *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); *see also Health Devices Corp. v. Aspen S T C*, FA 158254 (Nat. Arb. Forum July 1, 2003) ("[T]he addition of punctuation marks such as hyphens is irrelevant in the determination of confusing similarity pursuant to Policy ¶4(a)(i)."). Therefore, the Panel concludes the disputed domain name is confusingly similar to Complainant's mark pursuant to Policy ¶4(a)(i).

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

Rights or Legitimate Interests

Complainant has alleged Respondent does not have any rights or legitimate interests in the <reg-aol.com> domain name. The burden shifts to Respondent to prove it does have rights or legitimate interests when Complainant makes a *prima facie* case in support of its allegations under Policy ¶4(a)(ii). The Panel finds Complainant has made a sufficient *prima facie* case. Respondent's failure to respond to the Complaint allows the Panel to infer Respondent does not have rights or legitimate interests in the <reg-aol.com> domain name. However, the Panel will examine the record to determine whether Respondent has rights or legitimate interests in the disputed domain name under Policy ¶4(c). See *Intel Corp. v. Macare*, FA 660685 (Nat. Arb. Forum Apr. 26, 2006) (finding the "complainant must first make a *prima facie* case that [the] respondent lacks rights and legitimate interests in the disputed domain names under Policy ¶4(a)(ii), and then the burden shifts to [the] respondent to show it does have rights or legitimate interests."); see also *Desotec N.V. v. Jacobi Carbons AB*, D2000-1398 (WIPO Dec. 21, 2000) (finding that failing to respond allows a presumption that the complainant's allegations are true unless clearly contradicted by the evidence).

The <reg-aol.com> domain name resolves to a website that, Complainant alleges, is associated with Respondent's competing website resolving from the <www.mlbprime.com> domain name. Respondent's competing website provides links for Internet users to purchase tickets to sporting events and entertainment shows. Complainant provides similar services under its AOL.COM mark. The Panel finds Respondent's use of the disputed domain name is not a *bona fide* offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use of the disputed domain name pursuant to Policy ¶4(c)(iii). See *Ameritrade Holdings Corp. v. Polanski*, FA 102715 (Nat. Arb. Forum Jan. 11, 2002) (finding that the respondent's use of the disputed domain name to redirect Internet users to a financial services website, which competed with the complainant, was not a *bona fide* offering of goods or services); see also *Computerized Sec. Sys., Inc. v. Hu*, FA 157321 (Nat. Arb. Forum June 23, 2003) ("Respondent's appropriation of [Complainant's] SAFLOK mark to market products that compete with Complainant's goods does not constitute a *bona fide* offering of goods and services.").

Complainant asserts Respondent is not commonly known by the <reg-aol.com> domain name pursuant to Policy ¶4(c)(ii). Complainant provides the WHOIS information, which lists Respondent as "Goran Josipovic." Complainant emphasizes that Respondent has never been authorized to use the AOL.COM mark or any mark relating to Complainant's mark. Respondent fails to respond to Complainant's allegations and has not provided any evidence that Respondent is commonly known by the <reg-aol.com> domain name. Furthermore, the Panel fails to find any evidence in the record that would suggest Respondent is commonly known by the disputed domain name. Therefore, the Panel finds Respondent is not commonly known by the <reg-aol.com> domain name pursuant to Policy ¶4(c)(ii). See *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."); *see also Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding no rights or legitimate interests where (1) the respondent is not a licensee of the complainant; (2) the complainant's prior rights in the domain name precede the respondent's registration; (3) the respondent is not commonly known by the domain name in question).

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

Registration and Use in Bad Faith

Respondent uses the <reg-aol.com> domain name to resolve to a website closely associated with Respondent's competing website in the sporting, entertainment, and ticket services industries. Complainant offers similar services through its AOL.COM mark, and Complainant contends Respondent's website appropriates customers interested in Complainant and Complainant's similar services. The Panel finds this use of the confusingly similar disputed domain name constitutes a disruption of Complainant's Internet services business, which is evidence of bad faith registration and use pursuant to Policy ¶4(b)(iii). *See DatingDirect.com Ltd. v. Aston*, FA 593977 (Nat. Arb. Forum Dec. 28, 2005) ("Respondent is appropriating Complainant's mark to divert Complainant's customers to Respondent's competing business. The Panel finds this diversion is evidence of bad faith registration and use pursuant to Policy ¶4(b)(iii)."); *see also S. Exposure v. S. Exposure, Inc.*, FA 94864 (Nat. Arb. Forum July 18, 2000) (finding the respondent acted in bad faith by attracting Internet users to a website that competes with the complainant's business).

Complainant alleges, and the Panel presumes, Respondent profits from the close association between Respondent's website and the website resolving from the <reg-aol.com> domain name. Internet users searching for Complainant may become confused as to Complainant's affiliation with the resolving website; and Respondent is attempting to profit from that confusion. The Panel finds Respondent's use of the disputed domain name constitutes bad faith registration and use under Policy ¶4(b)(iv). *See Drs. Foster & Smith, Inc. v. Lalli*, FA 95284 (Nat. Arb. Forum Aug. 21, 2000) (finding bad faith where the respondent directed Internet users seeking the complainant's site to its own website for commercial gain); *see also Nokia Corp. v. Private*, D2000-1271 (WIPO Nov. 3, 2000) (finding bad faith registration and use pursuant to Policy ¶4(b)(iv) where the domain name resolved to a website that offered similar products as those sold under the complainant's famous mark).

Finally, Respondent has a pattern or practice of using other people's famous trademarks in Respondent's domain names. This, coupled with the fact the initial registration was a

“private” registration, creates a rebuttable presumption of bad faith registration and use of the <reg-aol.com>. Respondent’s silence cannot overcome this presumption.

The Panel finds Policy ¶4(a)(iii) is 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 <reg-aol.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: Tuesday, August 25, 2009

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