



## NATIONAL ARBITRATION FORUM

### DECISION

AOL LLC v. Phil Edgell  
Claim Number: FA0612000869463

#### PARTIES

Complainant is **AOL LLC** ("Complainant"), represented by **James R. Davis**, of **Arent Fox PLLC**, 1050 Connecticut Avenue, NW, Washington, DC 20036. Respondent is **Phil Edgell** ("Respondent"), 2015 Basin St., Blytheville, AR 72315-4845.

#### REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**thewinamp.com**>, <**yourwinamp.com**> and <**winampas.com**>, registered with **Schlund+Partner Ag**.

#### 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 December 14, 2006; the National Arbitration Forum received a hard copy of the Complaint on December 18, 2006.

On December 18, 2006, Schlund+Partner AG confirmed by e-mail to the National Arbitration Forum that the <**thewinamp.com**>, <**yourwinamp.com**> and <**winampas.com**> domain names are registered with Schlund+Partner AG and that Respondent is the current registrant of the names. Schlund+Partner AG has verified that Respondent is bound by the Schlund+Partner AG 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 December 19, 2006, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of January 8, 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@thewinamp.com, postmaster@yourwinamp.com and postmaster@winampas.com by e-mail.

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

On January 16, 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:

This Complaint is based on the following factual and legal grounds: ICANN Rule 3(b)(ix).

1. Complainant AOL LLC ("AOL") owns the WINAMP mark, including several federal trademark registrations for that mark.
2. AOL also owns and uses WINAMP.COM to provide a wide variety of online services. The WINAMP mark is used extensively at the WINAMP.COM Web site, which is a significant method of promoting the WINAMP services. *Id.*
3. At least as early as 1997, many years prior to Respondent's registration of the domain names at issue in the proceeding, AOL and its predecessor-in-interest adopted and began using the WINAMP mark in connection with computer and Internet-related goods and services. Since its first adoption, the distinctive WINAMP mark has 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 customers worldwide obtain goods and services offered under the WINAMP mark; millions more are exposed to the mark through advertising and promotion.

6. The WINAMP mark has been and continues to be widely publicized through substantial advertising throughout the United States and the world. Significant money and resources have been spent in connection with such advertising.
7. Sales of advertising and services under the WINAMP mark have been significant and the general public has come to associate the mark with services of a high and uniform quality.
8. Because of these substantial advertising expenditures and sales, the distinctive WINAMP mark has become well-known and famous among members of the purchasing public.
9. Many years after AOL's adoption and first use of its WINAMP mark, and long after the WINAMP mark became well-known and famous, Respondent registered the domain names "TheWinamp.com" "YourWinamp.com" and "Winampas.com" with the bad faith purpose of profiting from the goodwill AOL has created in its WINAMP mark. Specifically, Respondent uses the infringing domain names with a commercial Web site that promotes mortgage services and collects confidential information from consumers. Respondent, therefore, has registered and is using the infringing domains for the sole purpose of confusing and leading unknowing consumers to Respondent's commercial and pornographic Web sites.
10. The infringing domain names are confusingly similar or nearly identical to the WINAMP mark. The likelihood of consumer confusion is enhanced because Respondent's domain names are comprised solely of the famous WINAMP mark and generic words, i.e., "the" "your" and "as." WINAMP, therefore, serves as the sole distinctive element of the domain names, and is likely to confuse and mislead consumers that visit Respondent's commercial Web site.
11. Respondent registered, used, and continues to use the infringing domain names in bad faith to capitalize on the famous WINAMP mark and to confuse consumers. Respondent is not licensed or otherwise authorized to register or use a domain name that is nearly identical to the WINAMP mark, and Respondent (Phil Edgell) is not named or commonly known as WINAMP.
12. Respondent has no rights or legitimate interests in respect to the infringing domain names. The following is evidence of Respondent's bad faith registration and use of the domain names:
  - (a) Respondent's bad faith registration of "TheWinamp.com" "YourWinamp.com" and "Winampas.com" is evidenced by the fact that he registered the domain names many years after the WINAMP mark had become famous and well-known to consumers. Therefore, Respondent's registration of the domain names was made in bad faith to play off the already famous WINAMP mark and profit from the international goodwill AOL had created in its brand.

- (b) Respondent's bad faith use of "descargar-winamp.net" is shown by the Web sites that Respondent uses in connection with the domain. Specifically, Respondent uses the domain to route to commercial Web sites that use the WINAMP mark and logo and provide online music services and links to, among other things, adult Web sites. Many of the sites promoted at "descargar-winamp.net" are owned by Respondent. One of the pornographic sites and Whois records shows Respondent owns the domain "befaamsmodels.com." Respondent is using "descargar-winamp.net" to promote his own commercial and pornographic Web sites and consumers are likely to see the WINAMP mark in the infringing domain and Respondent's Web sites and believe falsely that AOL endorses or is affiliated with Respondent, his Web sites, or the companies that are promoted at Respondent's Web sites. This is an obvious attempt by Respondent to profit off the consumer confusion created as a result of the infringing domain.
- (c) In an attempt to resolve this matter amicably, counsel for AOL contacted Respondent and asked him to cease the infringing conduct and transfer the domain. Respondent initially agreed to cooperate, but subsequently reactivated the domain and Web site with pornographic links. As a result, AOL had no choice but to file this complaint to protect consumers from being misled and confused by Respondent's bad faith actions.
- (d) Based upon (1) the fame of the WINAMP mark; (2) AOL's federal trademark registrations; (3) Respondent's use of the WINAMP marks and logo at the subject Web sites; (4) correspondence between AOL and Respondent; and (5) Respondent's use of the infringing domains in connection with commercial and pornographic Web sites, Respondent cannot in good faith claim that he had no knowledge of AOL's rights in its famous WINAMP mark. 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 WINAMP.

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

## **FINDINGS**

Complainant, AOL LLC, has continuously and extensively used the WINAMP mark since as early as 1997 in reference to computer and Internet-related products and services. Complainant maintains a website at the <winamp.com> domain name promoting products and services under the mark.

Complainant has registered the WINAMP mark with the United States Patent and Trademark Office ("USPTO") (Reg. No. 2,809,981 issued February 3, 2004; Reg. No. 2,557,585 issued April 9, 2002; Reg. No. 2,734,590 issued July 8, 2003).

Respondent registered the disputed domain names on May 31, 2006. Respondent is using the disputed domain names to promote mortgage services at a website unrelated to Complainant. Respondent's website also attempts to collect personal and financial information from Internet users, including their contact information and their current mortgage balance and interest rate.

## **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**

Through registration of the WINAMP mark with the USPTO, Complainant has sufficiently demonstrated its rights in the mark for purposes of satisfying Policy ¶4(a)(i). *See Miller Prods. Co. v. Grozinger*, FA 823231 (Nat. Arb. Forum Dec. 5, 2006) ("Rights in a trademark can be shown in several ways, including by way of a U.S. trademark registration. A trademark registration constitutes prima facie evidence of its ownership and validity of the mark."); *see also Microsoft Corp. v. Burkes*, FA 652743 (Nat. Arb. Forum Apr. 17, 2006) ("Complainant has established rights in the MICROSOFT mark through registration of the mark with the USPTO.").

As the <thewinamp.com>, <yourwinamp.com> and <winampas.com> domain names fully incorporate Complainant's registered WINAMP mark and merely add letters or

common terms, Respondent has failed to alleviate the confusing similarity between the disputed domain names and the mark. Consequently, the Panel finds the disputed domain names to be confusingly similar to the mark pursuant to Policy ¶4(a)(i). See *Amazon.com, Inc. v. Ikhizamah*, D2002-1168 (WIPO Mar. 17, 2003) (holding that the <zamazon.com> domain name was confusingly similar to the complainant's AMAZON.COM mark); see also *Marriott Int'l, Inc. v. Stealth Commerce*, FA 109746 (Nat. Arb. Forum May 28, 2002) (“[T]he addition of the [article] ‘the’ to the beginning of the domain names fails to make them separate and distinct, as distinguishable from Complainant’s marks.”); see also *Wells Fargo Home Mortgage v. domains Ventures*, FA 810215 (Nat. Arb. Forum Nov. 14, 2006) (finding the addition of the term “your” to the WELLS FARGO mark in the <yourwellsfargomortgage.com> domain name to be insufficient to distinguish the disputed domain name from the complainant’s mark under Policy ¶4(a)(i)).

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

### **Rights or Legitimate Interests**

Complainant asserts Respondent has no rights or legitimate interests in the contested domain names. Complainant must first make a *prima facie* case in support of its allegations, and then the burden shifts to Respondent to show it does have rights or legitimate interests pursuant to Policy ¶4(a)(ii). See *Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); see also *Document Tech., 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.”).

Respondent’s failure to answer the Complaint raises a presumption Respondent has no rights or legitimate interests in the contested domain names. See *Am. Online, Inc. v. AOL Int’l*, D2000-0654 (WIPO Aug. 21, 2000) (finding no rights or legitimate interests where the respondent fails to respond); see also *BIC Deutschland GmbH & Co. KG v. Tweed*, D2000-0418 (WIPO June 20, 2000) (“By not submitting a response, Respondent has failed to invoke any circumstance which could demonstrate, pursuant to ¶4(c) of the Policy, any rights or legitimate interests in the domain name”). Out of an abundance of caution, the Panel will now examine the record to determine if Respondent has rights or legitimate interests under Policy ¶4(c).

Respondent has registered the domain name under the name “Phil Edgell,” and there is no other evidence in the record suggesting Respondent is commonly known by the

contested domain names. Thus, Respondent has not established rights or legitimate interests in the contested domain name pursuant to Policy ¶4(c)(ii). *See M. Shanken Commc'ns v. WORLDTRAVELERSONLINE.COM*, FA 740335 (Nat. Arb. Forum Aug. 3, 2006) (finding that the respondent was not commonly known by the <cigaraficionada.com> domain name under Policy ¶4(c)(ii) based on the WHOIS information and other evidence in the record); *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 ‘welsfargo’ in any derivation.”).

The contested domain names, each of which includes Complainant’s entire WINAMP mark, appear to be part of a fraudulent phishing scheme through which Respondent promotes its mortgage services through domain names confusingly similar to others’ trademarks and prompts Internet users to provide their personal and financial information. The Panel finds Respondent is deceiving Internet users as to its affiliation with Complainant in order to obtain personal and financial information from consumers, which does not constitute a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶4(c)(iii). *See Capital One Fin. Corp. v. Howel*, FA 289304 (Nat. Arb. Forum Aug. 11, 2004) (defining “phishing” as “a practice that is intended to defraud consumers into revealing personal and proprietary information” and concluding that the respondent’s practice of imitating the complainant’s website in order to fraudulently acquire personal information from Internet users was not a *bona fide* offering of goods or services under UDRP Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶4(c)(iii)); *see also Allianz of Am. Corp. v. Bond*, FA 690796 (Nat. Arb. Forum June 12, 2006) (holding that the respondent’s use of the <allianzcorp.biz> domain name to fraudulently acquire the personal and financial information of Internet users seeking Complainant’s financial services was not a *bona fide* offering of goods or services pursuant to Policy ¶4(c)(i) or a legitimate noncommercial or fair use of the disputed domain name pursuant to Policy ¶4(c)(iii)).

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

### **Registration and Use in Bad Faith**

Respondent has incorporated Complainant’s WINAMP mark in its entirety in the contested domain names and is using them to acquire personal and financial data from Internet users who may believe there is some affiliation or association between Respondent’s mortgage services and Complainant’s products and services under the WINAMP mark. Respondent is no doubt attempting to take advantage of the confusing similarity between the contested domain names and Complainant’s mark in order to profit from the goodwill associated with the mark. Such use provides evidence of bad faith registration and use pursuant to Policy ¶4(b)(iv). *See MySpace, Inc. v. Myspace Bot*, FA 672161 (Nat. Arb. Forum May 19, 2006) (holding that the respondent registered and used

the <myspacebot.com> domain name in bad faith by diverting Internet users seeking the complainant's website to its own website for commercial gain because the respondent likely profited from this diversion scheme); *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.").

Respondent's attempts to collect the personal and financial data of Internet users who are misleadingly diverted to Respondent's website suggests that Respondent is engaged in a fraudulent phishing scheme. Respondent purports to provide mortgage services and asks for the contact information and mortgage balance and interest rate of potential consumers. The Panel finds Respondent's fraudulent conduct further establishes its bad faith registration and use in accordance with Policy ¶4(a)(iii). *See Wells Fargo & Co. v. Maniac State*, FA 608239 (Nat. Arb. Forum Jan. 19, 2006) (finding bad faith where the respondent registered the <wellsbankupdate.com> domain name in order to fraudulently acquire the personal and financial information of the complainant's customers); *see also Hess Corp. v. GR*, FA 770909 (Nat. Arb. Forum Sept. 19, 2006) (finding that the respondent demonstrated bad faith registration and use because it was attempting to acquire the personal and financial information of Internet users through a confusingly similar domain name).

Respondent has also given fictitious or false WHOIS information. All physical mail was returned, marked "attempted – not known." This raises the presumption of bad faith registration and use, *Agent Host v. Host Dot Com Investments* AF-0343 (10/16/2000), *The Procter & Gamble Company v. Hong Gil Dong*, FA0510000572962 (11/16/2005), *Mattel, Inc. v. RanComp Ltd.*, FA0510000579563 (11/29/2005), *Zappos.com, Inc. v. RENATA Svensdotter*, FA0601000624407 (2/22/2006), *Delta Corporate Identity, Inc. and Delta Air Lines, Inc. v. Yong Li*, FA0510000576550 (3/27/2006), *Ulysses Learning Corporation v. G. Sone and Associates, Inc.*, FA0602000645878 (3/27/2006), *Microsoft Corporation v. Marine Safety Network Weather*, FA0603000655480 (4/26/2006), *Target Brands, Inc. v. Domains Ventures*, FA0603000671035 (5/15/2006), *Ebynum Enterprises, Inc. v. Tag-Board.com Corporation*, FA0610000817104 (12/15/2006) and *Valiant Trust Company v. Valiant Trust*, FA0611000844658 (1/11/2007). This Panel elects to accept that presumption of bad faith.

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

## **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 <thewinamp.com>, <yourwinamp.com> and <winampas.com> domain names be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.  
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist  
Dated: January 30, 2007

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