



NATIONAL ARBITRATION FORUM

DECISION

AOL LLC v. Sunset Enterprise, LLC
Claim Number: FA0906001270630

PARTIES

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

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**video-aol.com**>, registered with **Godaddy.com, 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 June 25, 2009; the National Arbitration Forum received a hard copy of the Complaint on June 29, 2009.

On June 26, 2009, Godaddy.com, Inc. confirmed by e-mail to the National Arbitration Forum that the <**video-aol.com**> domain name is registered with Godaddy.com, Inc. and Respondent is the current registrant of the name. Godaddy.com, Inc. has verified Respondent is bound by the Godaddy.com, 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 June 29, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of July 20, 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@video-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 July 23, 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:

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." (emphasis added).
2. AOL uses the mark AOL VIDEO in connection with offering video services via the Internet. See Annex D. AOL also 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 "VIDEO-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 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, including its provision of video-related services at www.AOLVIDEO.COM. As a result of AOL's marketing efforts the AOL mark is one of the most readily recognized and famous marks used on the Internet.
5. With tens of millions of 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 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. *America Online, Inc. v. Amigos On Line RJ*, NAF Case 115041; *Online, Inc. v. RAM a/k/a Ramakrishna Purnachandra*, NAF Case 136310. 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 VIDEO 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 VIDEO 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 "VIDEO-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 "VIDEO-AOL.COM" domain name is nearly identical and confusingly similar to the AOL and AOL VIDEO marks, and AOL's domain name "AOLVIDEO.COM." Consumer confusion is particularly likely given that the domain name is comprised of two parts: the word VIDEO, which is separated from AOL with a hyphen to emphasize the famous AOL mark. AOL therefore serves as the sole distinctive portion of the domain name. Consumers that encounter the "VIDEO-AOL.COM" domain are likely to be misled into believing the underlying services are endorsed by or affiliated with AOL, or that AOL owns the domain name. By using the famous AOL mark in a domain name

in this manner 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 (Sunset Enterprise) is not named or commonly known as AOL, nor is it licensed or authorized to use the AOL mark. The following is evidence of Respondent's bad faith registration and use of the domain name:
 - (a) Respondent's bad faith registration of the "VIDEO-AOL.COM" domain is evidenced by the fact that the domain name was registered in 2005, many years after the AOL Marks were registered and had become famous and well-known to consumers. As a US resident, Respondent is deemed to have at least had constructive knowledge of AOL's trademark rights by virtue of its many federal trademark registrations that predate the 2005 registration date of "VIDEO-AOL.COM." 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 mark. Such actions constitute a bad faith registration and use of the domain name.
 - (b) Respondent's bad faith use of the domain is demonstrated by the commercial content provided in connection with the "VIDEO-AOL.COM" domain. Respondent is using the domain name with a commercial Web site that includes links to various third party Web sites, including several that offer services that compete with AOL's. *Id.* AOL is not associated with Respondent's Web site or the third party linked sites. Respondent therefore registered and is using "VIDEO-AOL.COM" with a bad faith intent to trade upon the famous AOL brand. Respondent's use of the AOL mark in a domain name to route consumers to a commercial Web site violates Paragraph 4(b)(iv) of the UDRP and constitutes a bad faith use of the domain.
 - (c) 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"). In

anticipation that Respondent may claim that AOL is a legitimate acronym, AOL notes that numerous UDRP panelists have rejected such arguments. *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"). *See also 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. USACOOOP.COM* NAF Case 105763 (bad faith registration and use of "aolmalls.com" despite claim that AOL is an acronym for Americans On Line Malls).

- (d) Based upon (1) the fame of the AOL marks; (2) AOL's trademark registrations; and (3) Respondent's use of the domain name with commercial content, 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 or VIDEO AOL.

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

FINDINGS

Complainant provides internet services, including video services and information relating to videos. Complainant registered the AOL mark with the United States Patent and Trademark Office ("USPTO") on June 4, 1996 (Reg. No. 1,977,731). Complainant has used the AOL mark in connection with providing a broad range of information and services over the Internet since at least as early as 1989. Complainant now has tens of millions of users worldwide.

Respondent registered the <**video-aol.com**> domain name on December 27, 2005. The disputed domain name resolves to a website featuring links to third-party websites, some of which compete with Complainant.

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

The Panel finds Complainant has established rights in the AOL mark through its registration with the USPTO. *See Miller Brewing Co. v. Miller Family*, FA 104177 (Nat. Arb. Forum Apr. 15, 2002) (finding that the complainant had established rights to the MILLER TIME mark through its federal trademark registrations); *see also Honeywell Int'l Inc. v. r9.net*, FA 445594 (Nat. Arb. Forum May 23, 2005) (finding the complainant's numerous registrations for its HONEYWELL mark throughout the world sufficient to establish the complainant's rights in the mark under the Policy ¶4(a)(i)).

Complainant contends Respondent's <video-aol.com> domain name is confusingly similar to its AOL mark. The <video-aol.com> domain name differs from Complainant's mark in three ways: (1) the term "video," which describes services offered by Complainant, has been added to the beginning of the mark; (2) a hyphen has been added to the mark; and (3) the generic top-level domain ("gTLD") ".com" has also been added to the mark. The Panel agrees with previous decisions that neither the addition of a descriptive term nor the addition of a hyphen will distinguish a domain name from a mark. *See Constellation Wines U.S., Inc. v. Tex. Int'l Prop. Assocs.*, FA 948436 (Nat. Arb. Forum May 16, 2007) (finding that the addition of the descriptive term "wine" to the

complainant's BLACKSTONE mark in the <blackstonewine.com> domain name was insufficient to distinguish the mark from the domain name under Policy ¶4(a)(i); *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).”). The Panel also finds that despite the addition of a gTLD, a disputed domain name may still be confusingly similar or identical to a mark, because every domain name must contain a gTLD. *See Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 153545 (Nat. Arb. Forum May 27, 2003) (“The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.”). Therefore, the Panel finds these alterations to Complainant's AOL mark have not sufficiently distinguished it from Respondent's <video-aol.com> domain name, and therefore, the disputed domain name is confusingly similar to Complainant's AOL mark pursuant to Policy ¶4(a)(i).

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

Rights or Legitimate Interests

Complainant contends Respondent lacks all rights and legitimate interests in the disputed domain name. Under Policy ¶4(a)(ii), after the complainant makes a *prima facie* case against the respondent, the respondent then has the burden of showing evidence it has rights or legitimate interests in the disputed domain name. The Panel finds Complainant has made a *prima facie* case under Policy ¶4(a)(ii). *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 SEMCO Prods., LLC v. dmg world media (uk) ltd*, FA 913881 (Nat. Arb. Forum Apr. 9, 2007) (concluding that under Policy ¶4(a)(ii) and the factors listed in Policy ¶4(c), a complainant must first make a *prima facie* case that the respondent has not used or made demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services, that the respondent is not commonly known by the disputed domain name, and that the respondent is not making a legitimate noncommercial or fair use of the disputed domain name before the burden shifts to the respondent to show otherwise).

Complainant contends Respondent is not commonly known by the disputed domain name, nor has it ever been the owner or licensee of the AOL mark. The WHOIS record for the disputed domain name lists Respondent as “Sunset Enterprise, LLC” Because of the lack of evidence that Respondent has ever been known by any variant on Complainant's AOL mark, along with the fact Respondent has failed to show any evidence contrary to Complainant's contentions, the Panel finds Respondent is not commonly known by the disputed domain name pursuant to Policy ¶4(c)(ii). *See Reese v. Morgan*, FA 917029 (Nat. Arb. Forum Apr. 5, 2007) (concluding that the respondent was not commonly known by the <lilpunk.com> domain name as there was no evidence in

the record showing that the respondent was commonly known by that domain name, including the WHOIS information as well as the complainant's assertion that it did not authorize or license the respondent's use of its mark in a domain name); *see also Am. Online, Inc. v. World Photo Video & Imaging Corp.*, FA 109031 (Nat. Arb. Forum May 13, 2002) (finding that the respondent was not commonly known by <aolcamera.com> or <aolcameras.com> because the respondent was doing business as "Sunset Camera" and "World Photo Video & Imaging Corp.").

Respondent maintains a website at the disputed domain name that features links to third-party websites that compete with Complainant for business. The competitive nature of the content of the website that resolves from the disputed domain name compel the Panel to find that this use of the disputed domain name is neither a *bona fide* offering of goods or services under Policy ¶4(c)(i) nor a legitimate noncommercial or fair use under Policy ¶4(c)(iii). *See Tesco Pers. Fin. Ltd. v. Domain Mgmt. Servs.*, FA 877982 (Nat. Arb. Forum Feb. 13, 2007) (finding that the respondent was not using the <tesco-finance.com> domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use by maintaining a web page with misleading links to the complainant's competitors in the financial services industry); *see also Jerry Damson, Inc. v. Tex. Int'l Prop. Assocs.*, FA 916991 (Nat. Arb. Forum Apr. 10, 2007) (concluding that the use of a confusingly similar domain name to operate a portal with hyperlinks to various third-party websites, some of which may be in direct competition with a complainant, does not constitute a *bona fide* offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶4(c)(iii)).

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

Registration and Use in Bad Faith

Complainant contends Respondent's use of the <**video-aol.com**> domain name to link to third-party websites in competition with Complainant is a diversion of Internet users that disrupts Complainant's business intentionally. The Panel finds Respondent has taken advantage of Internet users' confusion to disrupt Complainant's business, and that this disruption is evidence of Respondent's bad faith registration and use pursuant to Policy ¶4(b)(iii). *See Instron Corp. v. Kaner*, FA 768859 (Nat. Arb. Forum Sept. 21, 2006) (finding that the respondent registered and used the disputed domain names in bad faith pursuant to Policy ¶4(b)(iii) by using the disputed domain names to operate websites that compete with the complainant's business); *see also David Hall Rare Coins v. Tex. Int'l Prop. Assocs.*, FA 915206 (Nat. Arb. Forum Apr. 9, 2007) (finding that the respondent registered and used the disputed domain name in bad faith pursuant to Policy ¶4(b)(iii) because respondent used the disputed domain name to advertise goods and services of complainant's competitors, thereby disrupting the complainant's business).

Complainant also contends Respondent is collecting "click-through fees" from the third parties who receive confused Internet visitors from the links on the website that resolves from the disputed domain name. The Panel finds Respondent is commercially gaining

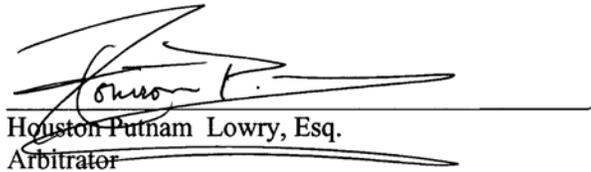
from the use of the disputed domain name, and that Respondent therefore has registered and used the <**video-aol.com**> domain name in bad faith pursuant to Policy ¶4(b)(iv). *See Dell Inc. v. Innervision Web Solutions*, FA 445601 (Nat. Arb. Forum May 23, 2005) (finding evidence of bad faith under Policy ¶4(b)(iv) where the respondent was using the <dellcomputerssuck.com> domain name to divert Internet users to respondent's website offering competing computer products and services); *see also Zee TV USA, Inc. v. Siddiqi*, FA 721969 (Nat. Arb. Forum July 18, 2006) (finding that the respondent engaged in bad faith registration and use by using a domain name that was confusingly similar to the complainant's mark to offer links to third-party websites that offered services similar to those offered by the complainant).

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 <**video-aol.com**> domain name be **TRANSFERRED** from Respondent to Complainant.



Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: August 5, 2009

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