



NATIONAL
ARBITRATION
FORUM

ELIGIBILITY REQUIREMENTS DISPUTE RESOLUTION POLICY

DECISION

America Online, Inc. v. AD 2000 D.Com aka Adrian Paul Miles
Claim Number: FA0203000108377

PARTIES

Complainant is **America Online, Inc.**, Dulles, VA (“Complainant”) represented by **James R. Davis**, of **Arent Fox Kintner Plotkin & Kahn, PLLC**. Respondent is **Adrian Paul Miles**, Wolverhampton, UK (“Respondent”) of **AD 2000D.com**.

REGISTRAR AND DISPUTED REGISTERED NAMESS

The Registered Names (contested domain names) at issue are <**aim5.instantmessenger.name**> and <**instant.messenger.name**>, both registered with **Bulkregister**.

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.

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Eligibility Requirements Dispute Resolution Policy (“EDRDP” or simply the “Policy”) available at <http://www.gnr.com/corporate/downloads/erdrp.pdf> which was adopted by Global Name Registry (“GNR”), as the registry operator; and in accordance with the Rules of Procedure for the ERDRP (the “ERDRP Rules”) adopted by GNR and as supplemented by the National Arbitration Forum ERDRP Supplemental Rules for then in effect (the “ERDRP Supplemental Rules”).

The Complainant submitted a Complaint to the National Arbitration Forum (“the Forum”) electronically on March 29, 2002; the Forum received a hard copy of the Complaint on April 1, 2002.

On April 4, 2002, Bulkregister confirmed by e-mail to the Forum that the Registered Names <aim5.instantmesenger.name> and <instant.messenger.name> are registered with Bulkregister and that Respondent is the current registrant of those names. Bulkregister has verified that Respondent is bound by the Bulkregister registration agreement and has thereby agreed to resolve registered name disputes brought by third parties in accordance with the Policy.

On April 5, 2002 the Forum issued a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification") which set a deadline of April 25, 2002 by which the Respondent could file a Response to the Complaint and which was transmitted to the Respondent in compliance with 2(a) of the ERDRP Rules .

A timely Response was received and determined to be complete on April 25, 2002.

On May 2, 2002, pursuant to ERDRP Rule 6(b), the Forum appointed Mr. Peter L. Michaelson, Esq. as the single Panelist.

RELIEF SOUGHT

Complainant requests that the Registered Names be cancelled pursuant to paragraph 5(f)(i)(A) of the Policy.

PARTIES' CONTENTIONS

A. Complainant

The Complainant contends that by registering the Registered Names, the Respondent violated Paragraph 4(b) of the Policy. Specifically, the Complainant states that neither of these names corresponds to either of the Respondent's legal names (i.e., those legal names being "AD 2000D.Com" or "Adrian Paul Miles"). Furthermore, the Complainant asserts that it is unlikely that either of the Registered Names corresponds to any person's legal name. As such, the Complainant concludes that paragraph 4(b)(i) of the Policy has been violated.

In addition, the Complainant asserts that the Registered Names violate paragraph 4(b)(ii) of the Policy inasmuch as neither of these names is a name of a fictional character or service mark owned by the Respondent. In that regard, the Complainant states that it owns trademark rights to the marks "AIM" (through its US trademark registrations 2,423,367 and 2,423,368) and to the term "INSTANT MESSENGER", both of which are used in connection with the Complainant's, AOL's, famous real-time communications service. In Annex B to the Complaint, the Complainant has provided hard-copies of various web pages, from its web site, regarding these services. The Complainant states that currently it is distributing version 4.7 of its "AIM" software. Therefore, the Complainant contends that the Respondent has registered the contested domain names "in bad

faith to trade off the international goodwill AOL has created in its famous Internet communications marks, and lead consumers to believe falsely that the services provided under 'AIM5' are the latest version of AOL's communications software".

Finally, the Complainant asserts that the individual "Adrian Paul Miles", has not been commonly known by either of the names: "Instant Messenger" or "AIM5". In that regard, the Complainant states these terms are not even names; they are famous trademarks which it owns.

Thus, the Complainant concludes that the Respondent was never eligible to register the contested domain names "aim5.instantmessenger.name" or "instant.messenger.name" and has violated the ".name" Registration Agreement, which expressly restricts which domains may be registered or used under the ".name" generic top level domain.

B. Respondent

The Respondent states that "it accepts the two disputed domain names do not meet the required .NAME Eligibility Requirements". Hence, the Respondent concedes that it has "no right to retain these disputed Registered Domain Names in particular".

As to the requested remedy, first the Respondent contends that the term "instant messenger" is not a fully registered and active trademark of the Complainant, nor should it be, the Respondent requests that the Panel deny the remedy of either transfer or defensive registration by the Complainant.

Second, the Respondent contends that if the Registered Names are found not to fulfill the .NAME Eligibility Requirements, then they should not be maintained by either the Respondent or the Complainant. However, if the Panel finds that these names are maintainable under the .NAME top level domain, then the Respondent requests that it retain and use the Registered Name "instant.messenger.name" for the Respondent's ("Ady's") Independent Messaging Site and transfer the Registered Name "aim5.instantmessenger.name" to the Complainant.

Lastly, the Respondent requests the Panel to issue an appropriate order to GNR for it to cancel or delete the registrations for the Registered Names.

• FINDINGS -- FACTUAL BACKGROUND

The Respondent registered that contested domain names "aim5.instantmessenger.name" and "instant.messenger.name" on January 9 and February 21, 2002, respectively.

The Respondent does not dispute that its legal names are "AD 2000D.Com" or "Adrian Paul Miles", neither of these names constituting all or a part of either of

the Registered Names. The Respondent does not dispute the Complainant's assertion that neither of the Registered Names is or includes the name of a fictional character in which the Respondent has trademark or service mark rights. Furthermore, the Respondent does not dispute that it is not commonly known by any name corresponding to the Registered contested domain names.

Furthermore, the Respondent expressly concedes that not only do the contested domain names not meet the .NAME Eligibility Requirements but moreover it has no rights to retain these names.

DISCUSSION

Paragraph 15(a) of the ERDRP 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."

Paragraph 4(b) of the ERDRP requires that the Complainant prove each of the following elements in order to establish that the Registered Name was registered in violation of the Eligibility Requirements and obtain an order that a Registered Name should be cancelled:

- (1) the name corresponding to the Registered Name is not the legal name of Respondent; and
- (2) the name corresponding to the Registered Name is not the name of a fictional character in which the Respondent has trademark or service mark rights; and
- (3) the Respondent has not been commonly known by the name corresponding with the Registered Name.

Respondent's Eligibility

Inasmuch as the Respondent expressly concedes that neither of the Registered Names meets any of the Eligibility Requirements, the Panel sees no reason to provide any detailed discussion of each of the individual requirements.

Furthermore, since the Complainant has only requested the Panel to cancel the registrations of the Registered Names, then the issue as to whether the Complainant has met those requirements as to entitle it to either of those names is not before the Panel. As such, the Panel expresses no opinion on that issue.

Since the Respondent agrees with the Complainant's request to have the Registered Names canceled, the Panel shall so order it.

DECISION

In accordance with the EDRDP Rules, the relief sought by the Complainant is hereby GRANTED.

The Panel now orders that the registrations for the Registered Names, <aim5.instantmessenger.name> and <instant.messenger.name>, be CANCELED.

Mr. Peter L. Michaelson, Esq., Panelist
Dated: May 6, 2002