



## DECISION

America Online, Inc. v John Deep d/b/a Buddy USA Inc.  
Claim Number: FA0103000096795

### **PARTIES**

The Complainant is **America Online, Inc.**, Dulles, VA, USA (“Complainant”) represented by **James R. Davis, II**, of **Arent Fox Kintner Plotkin & Kahn**. The Respondent is **John Deep Buddy USA Inc.**, Albany, NY, USA (“Respondent”) represented by **Alexandre A. Montagu**.

### **REGISTRAR AND DISPUTED DOMAIN NAMES**

The domain names at issue are "**aimster.com**", "**aimstertv.com**", "**aimstertv.net**", "**a1mster.com**", "**icqster.com**", "**ic2ster.com**", registered with **Network Solutions, Inc.**

### **PANEL**

The undersigned certifies that they have acted independently and impartially and to the best of their knowledge, have no known conflict in serving as Panelists in this proceeding.

Mr. Peter L. Michaelson, Esq, Hon. James A. Carmody and Mr. G. Gervaise Davis III, Esq. as Panelists.

### **PROCEDURAL HISTORY**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“Policy”), available at <http://www.icann.org/services/udrp/udrp-policy-24oct99.htm>, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“Rules”) as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“Supplemental Rules”).

The Complainant submitted a Complaint to the National Arbitration Forum (“the Forum”) electronically on March 1, 2001; the Forum received a hard copy of the Complaint on March 2, 2001 together with Annexes A-J. Through the Complaint, the Complainant elected to have the dispute heard before a single panelist.

On March 2, 2001, Network Solutions, Inc. (NSI) confirmed by e-mail to the Forum that the domain names "**aimster.com**", "**aimstertv.com**", "**aimstertv.net**", "**a1mster.com**", "**icqster.com**", "**ic2ster.com**" are all registered with Network Solutions, Inc. and that the Respondent is the current registrant of the name. NSI has verified that the Respondent is bound by the NSI version 5.0 registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the Policy.

On March 7, 2001, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of April 4, 2001 by which the Respondent could file a Response to the Complaint, was transmitted to the Respondent via e-mail, post and facsimile, to all entities and persons listed on the Respondent’s registration as technical, administrative and billing contacts, and to postmaster@aimster.com, postmaster@aimstertv.com, postmaster@aimstertv.net, postmaster@a1mster.com, postmaster@icqster.com, and postmaster@ic2ster.com by e-mail.

A Response, together with Annexes 1-4, was timely received and determined to be complete on April 3, 2001. Through the Response, the Respondent, notwithstanding the Complaint's desire to utilize a single panelist, elected to have the dispute decided by a three-member panel and submitted the additional fee required to do so.

On April 11, 2001, the Forum timely received a second submission from the Complainant together with Annexes A-E. This submission also provided the Complainant's selection of acceptable panelists from five prospective panelists proposed by the Forum.

Thereafter, on April 11, 2001, the Forum received, by facsimile, a second submission from the Respondent.

On April 12, 2001, pursuant to Respondent’s request, the Forum appointed Mr. Peter L. Michaelson, Esq., Hon. James A. Carmody and Mr. G. Gervaise Davis, III, Esq. as Panelists. As such, under the Rules, the date on which the decision was then due was initially set to April 26, 2001.

Subsequent to the appointment of the Panel, on April 16, 2001, the Panel received a third submission from the Complainant. Inasmuch as this submission occurred outside the deadline for further submissions, the Forum considered this submission to be noncompliant with paragraph 7 of the Supplemental Rules.

Furthermore, later on April 16, 2001, the Forum received a third submission from the Respondent. Here too, this submission occurred outside the deadline for further submissions and also was not accompanied by the proper fee and was not served on the Complainant (or at least did not include an indication that it was so served). Accordingly the Forum also considered this submission as noncompliant with paragraph 7 of the Supplemental Rules.

Nevertheless, the Forum forwarded all the submissions by both parties, including both Complainant's and Respondent's third submissions, to the Panelists.

Even though the third submissions from both the Complainant and Respondent were deficient in one way or another under paragraph 7 of the Supplemental Rules, nevertheless, the Panel has reviewed and considered all the submissions of the parties.

Furthermore, in a telephone conference call held on April 20, 2001, the Panel, given the issues involved and the anticipated effort by each of the panelists, as well as scheduling conflicts amongst the panelists, extended the due date for its decision from April 26, 2001 to May 7, 2001, and with a further one-week extension to May 14, 2001, so as to afford the Panel with sufficient time to properly prepare its reasoned decision.

## **RELIEF SOUGHT**

The Complainant requests that all six contested domain names be transferred from the Respondent to the Complainant.

## **PARTIES' CONTENTIONS**

Both parties have filed voluminous submissions with copious allegations. Hence, for the sake of brevity, the Panel will only summarize those that it sees are principal to the dispute.

### **A. Complainant**

#### **1. Confusing similarity**

The Complainant contends that the contested domain names are nearly identical and hence confusingly similar to the Complainant's "ICQ" and "AIM" marks, therefore satisfying the confusing similarity requirement in paragraph 4(a) of the Policy.

In that regard, the Complainant takes the position that the addition of the suffix "ster" to each of those marks is insignificant and hence insufficient to prevent consumer confusion. Moreover, the Complainant contends that such confusion is particularly likely because the Respondent is using the contested domain names in connection with services that are very closely related to those with the Complainant provides under its "ICQ" and

"AIM" marks. In that regard, the Complainant points to the Respondent's admission, as indicated in various articles and press releases -- copies of which were provided in Annex I to the Complaint, that it created the Aimster service to interact with the Complainant's AIM service.

## 2. Legitimacy

The Complainant contends that the Respondent has no rights or legitimate interests in any of the six contested domain names.

In that regard, the Complainant contends that the Respondent registered and uses at least one of the contested domain names, specifically, "**aimster.com**", in connection with its web site -- as indicated in a hard-copy version of corresponding web pages as provided in Annex D to the Complaint, that provides a service which interacts and/or integrates with the Complainant's AIM service, despite the fact that the Complainant has not authorized or licensed the Respondent to provide such a service.

Based upon the Respondent's public statements and press releases -- those provided in Annex I to the Complaint, the Complainant contends that the Respondent registered the remaining five contested domain names for its future use in connection with similar services that will interact and/or integrate with the Complainant's AIM and ICQ services, when again it was not authorized or licensed by the Complainant to do so.

Hence, the Complainant concludes that the Respondent cannot demonstrate any rights or legitimate interests in any of the contested domain name pursuant to paragraph 4(a) of the Policy.

## 3. Bad Faith

The Complainant contends that the Respondent registered and is using each of the contested domain names in bad faith.

Specifically, the Complainant contends that the Respondent registered and used the contested domain names to intentionally confuse consumers and capitalize on the Complainant's "ICQ" and "AIM" marks and, by so doing, profit from the goodwill which the Complainant has established in those marks.

In that regard, the Complainant points to the Respondent's having registered the contested domain names many years after the Complainant's adoption and first use of its "ICQ" and "AIM" marks. In addition, the Complainant points to statements evidenced in various articles and press releases appearing in Annex I to the Complaint, made by the Respondent, through which the Respondent publicly stated its intention to use other domain names that may be similar to the Complainant's ICQ or other marks -- apparently including the "ICQ" based domain names, in connection with services that respectively interact and/or integrate with and are based upon the Complainant's ICQ or other services

(as well as with similar services provided by others, e.g., MSN and Yahoo, that are not parties to the present proceeding).

Given this, the Complainant contends that the Respondent is using the Complainant's famous "ICQ" and "AIM" marks to promote Respondent's own online services even though the Complainant has neither licensed nor authorized the Respondent to use any of those marks. Hence, the Complainant concludes that this action by the Respondent shows a bad faith intent to mislead and confuse consumers into believing that the Complainant endorses or is affiliated with Respondent, when in fact it is not.

The Complainant also contends that bad faith use is shown by the Respondent's use of the contested domain name "**aimster.com**" in connection with a web site (copies of web pages therefrom are provided in Annex D to the Complaint) called "Aimster" that prominently displays the Complainant's "AIM" mark and/or expressly states that it integrates with the Complainant's instant messenger (AIM) service, and its admission of that specific usage (see the press releases in Annex I to the Complaint). Similarly, news articles (also in Annex I) explain that "Aimster" was designed to piggyback on the Complainant's instant messenger (AIM) service.

The Complainant also contends that the Respondent registered the contested domain names in bad faith in order to profit from the goodwill which the Complainant has created in its marks. In that regard, the Complainant points to a link provided on the home page of the Respondent's web site that links to "Investor Relations" portion of the Respondent's web site.

Furthermore, the Complainant contends that bad faith registration is also shown by the Respondent having registered multiple domain names, specifically "**aimster.com**", "**aimstertv.com**", "**aimstertv.net**" and "**a1mster.com**" that are nearly identical or confusingly similar to the Complainant's "AIM" marks and "**icqster.com**" and "**ic2ster.com**" that are nearly identical or confusingly similar to the Complainant's "ICQ" marks; hence, establishing a pattern of conduct. This conduct, as the Complainant believes, prevented it from reflecting its marks in domain names; therefore, contravening paragraph 4(b)(ii) of the Policy.

Additionally, the Complainant asserts that its "AIM" and "ICQ" marks are famous (presumably as defined under the § 43 (c) of the Lanham Act). Given this, the Complainant contends that bad faith registration and use is evidenced by the Respondent's actions in having registered the contested domain name that are similar to those marks and then using those domain names in connection with providing services that trade on the fame of those marks and which interact with the Complainant's services then being offered under those marks. As such, the Complainant contends that this activity amounts to an attempt to "piggy-back" on the goodwill and brand recognition created by the Complainant in its marks and is intended to confuse consumers into

believing the services provided by the Respondent are affiliated with or endorsed by the Complainant, when, in fact, that is not the case.

Moreover, based upon the fame attendant to the Complainant's "ICQ" and "AIM" marks, the Complainant's federal registrations for these marks, the Respondent's pattern of registering multiple domain names that are similar to these marks, and the admissions of the Respondent that it registered these domain names in an effort to create services that interact with the Complainant's services provided under its marks, and the federal registrations, the Complainant contends that the Respondent can not claim, in good faith, that it had no knowledge of the Complainant's rights in its "ICQ" and "AIM" marks.

Lastly, given the actions of the Respondent in offering commercial services, the Complainant contends that the Respondent cannot claim, in good faith, that it made a legitimate noncommercial or fair use of any of the contested domain names.

Therefore, the Complainant concludes that the Respondent's conduct, with respect to each of the contested domain names, amounts to bad faith under paragraph 4(a) of the Policy.

## B. Respondent

In its Response, the Respondent expressly relinquished the contested domain names "**icqster.com**" and "**ic2ster.com**" (the "ICQ" based domain names). Hence, the following discussion will only address the remaining four contested domain names, i.e., the "AIM" based domain names.

### 1. Confusing similarity

In contrast to the Complainant's position, the Respondent contends that each of the four contested "AIM" based domain names is neither identical nor confusingly similar to the Complainant's "AIM" mark.

In that regard, the Respondent points to the fact that the word "AIM" is a common dictionary word and, at best is a weak and descriptive mark, significantly diluted by extensive third-party use. Such third-party use being evidenced by, e.g., numerous inter-operable, add-on programs using the word "aim" as part of their trademark). The Respondent asserts that the Complainant's "AIM" mark is not famous.

Furthermore, the Respondent contends that, under its assessment of the facts in the dispute, the Complainant can not satisfy any of the eight Polaroid factors for determining whether confusion is likely to occur, in this context between any of the contested domain names and the Complainant's "AIM" mark.

## 2. Legitimacy

Also, in contrast to the Complainant's position, the Respondent contends that its use of each of the four contested "AIM" based domain names is legitimate.

Specifically, the Respondent asserts that it is using or intends to use each of the contested "AIM" based domain names in connection with a software product that uses peer-to-peer technology in a targeted manner and which is available free of charge on the Internet. In that regard, the Respondent points to the Complainant's admission that the latter has never developed or commercially used or distributed targeted peer-to-peer technology similar to the Respondent's Aimster service.

Furthermore, the Respondent contends that since the date it registered the contested domain name "**aimster.com**" on June 24, 2000, it has been using that name in connection with offering the Aimster targeted, peer-to-peer file sharing service, long before it received notice of this dispute or even before it received the Complainant's cease and desist letter, dated September 20, 2001. To support this, the Respondent also points to the articles in, e.g., Annex I to the Complaint. As to the other contested "AIM" based domain names, the Respondent states that these, being variants of "**aimster.com**", were registered in connection with the Respondent's plan to offer the "Aimster" service through different media (e.g., television (**aimstertv.net** and **aimstertv.com**)) and in connection with an offering of an encrypted version of Aimster, or as protective registration ("**aimster.com**"). Therefore, before any notice to the Respondent of the dispute, the Respondent contends that its use of **aimster.com**, along with its demonstrable preparations to use the other contested "AIM" based domain names, was in connection with a bona fide offering of the Respondent's services.

## 3. Bad Faith

Again, in contrast to the Complainant's position, the Respondent contends that it acted in good faith in registering and using each of the four contested "AIM" based domain names.

In that regard, the Respondent contends that it adopted the term AIMSTER as its mark for use in connection with a bona fide service, and registered the contested domain name "**aimster.com**" to promote its legitimate business interest.

The Respondent states that it coined the name, AIMSTER, to promote its targeted peer-to-peer technology which is inter-operable with many instant messaging systems, including, Complainant's "AIM" service. To that end, the Respondent states that its inclusion of the common word "aim" into the Respondent's mark "AIMSTER" (and hence into each of the contested "AIM" based domain names) was intended to reflect a "targeting" feature of the Respondent's file sharing technology.

Furthermore, the Respondent contends that, at the time of it adopted its AIMSTER mark, the Respondent was aware of the existence of various third-party "AIM" based marks and reasonably believed that the use of a transformative mark such as AIMSTER does not infringe any of those marks.

In addition, the Respondent states that it did not register **aimster.com** (or any of the other contested domain names) with any intent to sell that names to the Complainant or anyone else.

Furthermore, the Respondent contends that its registration of the contested domain name **aimster.com** did not prevent the Complainant from registering its own "Aim" domain name.

Also, the Respondent contends that, since there is no evidence that the Complainant ever used, or had plans to use, the mark AIMSTER, the Respondent did not intend to disrupt the Complainant's business by usurping the name.

Moreover, by registering the contested domain name "**aimster.com**", the Respondent did not intend to divert traffic from the Complainant's site. In that regard, the Respondent's web site -- even as evidenced by the articles submitted by the Complainant in Annex I to the Complaint, is very popular and has attracted approximately 3 million users. The Respondent contends that the absence of a single instance of actual confusion in a nine-month period between the date of registration of Respondent's domain name and the filing of the Complaint confirms its view that the Respondent, in fact, does not divert traffic from the Complainant's site or ever intended to divert such traffic.

Lastly, the Respondent contends that the Complainant's actions in initiating this proceeding constitutes an attempt at reverse domain name hijacking.

### C. Additional Submissions

#### 1. Complainant's second submission

The Complainant argues that the Respondent did not choose the contested domain name to describe a "targeting" function of its Aimster service but rather as an attempt to attract, for commercial gain, Internet users to its site by creating a likelihood of confusion with the Complainant's registered trademark "AIM"; hence, constituting bad faith registration and use.

Contrary to the Respondent's assertion that its use of the contested "AIM" based domain names is not a reference to the Complainant's "AIM" mark, the Complainant points to various references in, inter alia, the "**aimster.com**" web site that references the Complainant's AIM service and/or links to the Complainant's site for those Internet users, seeking to utilize the Respondent's "Aimster" service, to first link to and download

software from the Complainant to install its AIM service and then download and install the Respondent's "Aimster" software. The Complainant points to other instances where the Respondent has referenced the Complainant's AIM service with respect to the Respondent's "Aimster" service; hence, signifying the integration between the two.

The Complainant takes issue with the Respondent's assertion that it used the contested domain name "**aimster.com**" in connection with a bona fide service offering. The Complainant states that in September 2000, it notified the Respondent of its objections to piggy-backing the Aimster service off of the Complainant's AIM service.

## 2. Respondent's second submission

The Respondent states that the download instructions with respect to Aimster software and statements to which the Complainant cites were posted by an anonymous user to another user in a user-created chat room on the **aimster.com** web site, and not by the Respondent; thus, not indicative of any bad faith on the part of the Respondent. Further, the Respondent states that, from the discussions involved, the two users were unambiguously aware of the distinction between the Complainant's AIM product and the Respondent's Aimster peer-to-peer software. As such, the Respondent claims that this discussion indicates that the public is not confused as to source or origin of the Respondent.

Furthermore, the Respondent states that although its Aimster software can be downloaded free of charge, this is not evidence of bad faith.

The Respondent acknowledges that its activities with respect to its Aimster software are commercial, hence profit-making, in nature.

## 3. Complainant's third submission

This submission contains a declaration of Mark Feldman who is a Senior Manager in Business Affairs for the Complainant. Through his declaration, Mr. Feldman declares that representatives of the Complainant and Respondent did meet on September 20, 2000 to discuss a proper business relationship and that he stated that the Respondent would be receiving a letter from the Complainant's counsel regarding the Respondent's improper use of the Complainant's "AIM" mark.

## 4. Respondent's third submission

Through this submission, the Respondent confirms the September 20, 2000 meeting it held with the Complainant but disputes that any statements were made to it at the time regarding improper use of the Complainant's "AIM" mark.

## FINDINGS

Upon consideration of the record before it, the Panel makes the following findings.

The Complainant currently owns the following valid and subsisting U.S. trademark registrations on which this dispute is based. The Complainant has provided a copy of each of these registrations, as issued by the United States Patent and Trademark Office (PTO), in Annexes B and C to the Complaint. For ease of reference, the Panel will refer to marks (a) and (b) as the "AIM" marks, and (c) as the "ICQ" mark.

- a) mark: AIM (block letters)  
registration 2,423,368; registered January 23, 2001

This trademark was registered, for use in connection with: "Computer operating programs and computer operating systems; pre-recorded computer programs for accessing computer networks, computer online systems", in international class 9. This mark claims first use and first use in inter-state commerce of April 30, 1997.

- b) mark: AIM (block letters)  
registration 2,423,367; registered January 23, 2001

This servicemark was registered, for use in connection with: "Computer services, namely, providing multiple-user access to computer networks for the transfer and dissemination of a wide range of information; electronic transmission of data, images, and documents via compute networks; electronic mail services; providing on-line chat rooms for transmission of messages among computer users concerning a wide variety of fields", in international class 38. This mark claims first use and first use in inter-state commerce of April 30, 1997.

- c) mark: ICQ (block letters)  
registration: 2,411,657; registered December 12, 2000

This mark was registered, in multiple classes, for use in connection with:

- (a) "Computer operating programs that may be downloaded from a computer information network; computer software and prerecorded computer programs for accessing computer networks and computer systems comprising computer hardware and computer software for electronic communications that may be downloaded from a computer information network; and computer software for accessing online electronic diaries, online databases, web sites, online chat rooms, and electronic yellow pages that ay be downloaded from a computer information network", in international class 9;
- (b) "Online directory of businesses and people; and providing employment information via computer networks" in international class 35;
- (c) "Providing financial information via electric means" in international class 36;
- (d) "Telecommunications services, namely, services relating to electronic

transmission of data, images and documents via computer terminals, electronic mail services, facsimile transmission, personal communication services, paging services, store and forward messaging service; providing multiple-user access to computer information networks, in and electronic bulleting boards and chat rooms for the transmission of messages among computer users concerning topics of general interest", in international class 38;

(e) "Providing entertainment, arts, sports and music information via electronic means" in international class 41; and

(f) "Providing information in the field of personal advice, romance, general interest news, health, computes and technology via computer networks" in international class 42.

This mark claims first use and first use in inter-state commerce in all its classes of November 30, 1996.

The Complainant also owns trademark registrations counterpart to its United States ICQ mark in numerous foreign countries on a worldwide basis, as evidenced by the copies of those registrations provided in Annex C to the Complaint.

The Complainant uses its "AIM" and "ICQ" marks in connection with, among other things, providing real time communications services.

The Complainant also uses its domain names "icq.com" and "aim.com" in connection with providing its ICQ and AIM services, respectively, over the Internet. The "ICQ" and "AIM" marks are used extensively at these web sites, which, as the Complainant states, are significant methods of promoting its "ICQ" and "AIM" services. As a result, consumers associate the marks "ICQ" and "AIM", when used in domain names, with the Complainant's corresponding services.

The Respondent registered, through NSI, "**ic2ster.com**" on September 13, 2000, "**icqster.com**" on August 12, 2000; "**aimster.com**" on October 31, 2000; "**aimstertv.net**" on December 23, 2000; "**aimstertv.com**" on December 23, 2000 and "**aimster.com**" on June 24, 2000.

Prior to the Respondent's registration of the contested domain names, and at least as early as 1996 for the "ICQ" mark and 1997 for the "AIM" marks, the Complainant or its predecessor in interest adopted and began using those marks in connection with communications and computer online services. The Complainant has used these marks continuously and extensively in interstate and international commerce in connection with the advertising and sale of its communications and online computer-related services.

The Complainant has invested substantial sums of money in developing and marketing its services and marks.

With over 80 million registrants each, both the ICQ and AIM services are large and fast growing, world-wide, online communications service. More than 9 million people a day use the ICQ service. See copies in Annex G of various web pages from the Complainant's web site regarding the ICQ and AIM services. Each year, millions of the Complainant's customers worldwide obtain these services offered under the "ICQ" and "AIM" marks; millions more are exposed to these marks through the Complainant's advertising and promotion.

The "ICQ" and "AIM" marks have been and continue to be widely publicized through substantial advertising throughout the United States and the world. The Complainant has spent many millions of dollars 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.

Sales of services under the "ICQ" and "AIM" marks have been substantial and, as a result, the general public has come to associate the "ICQ" and "AIM" marks with services of a high and uniform quality.

Because of these substantial advertising expenditures and sales, the "ICQ" and "AIM" marks have become distinctive, well-known and have acquire fame among members of the purchasing public.

The Complainant has never authorized or licensed the Respondent to use any of the "AIM" or "ICQ" marks.

Respondent's business consists of distributing AIMSTER software, a software program that uses peer-to-peer file sharing technology. This software has been downloaded, apparently at no charge to its users, approximately 1.5 million times since late June 2000. See John Deep Affidavit in Annex 1 to the Response.

Aimster allows its users to target groups of other users (referred to as "Buddies") by creating a "buddy list." Once an AIMSTER user has created a buddy list, that user can select targeted files on his or her hard drive for sharing, using AIMSTER, but only with his or her "Buddies" and apparently no one else. The targeted files can be text files, jpg, gif or files created and stored in any other file format. AIMSTER also has a search feature that allows users to search for targeted files. This targeting at Buddies and their files is the central feature of AIMSTER's peer-to-peer technology. The mark "AIMSTER", the Respondent's logo which features a prominent and distinctive target, and the "aimster.com" web site which opens onto a page encouraging users to click on a bulls-eye target to download the Aimster software, are intended to reflect the "aiming" or "targeting" feature of the Aimster technology as a source identifying element of Aimster. See Respondent's web site at [aimster.com](http://aimster.com), copies of various pages of which appear in Annex D to the Complaint. The Panel notes that the target aspect of the logo is apart from the word "Aimster".

The AIMSTER service, once the corresponding software is installed at a user computer, interacts with and effectively layers over popular instant messaging services, including the Complainant's Instant Messenger (AIM), MSN Messenger, and Yahoo Messenger services, to permit peer-to-peer file sharing to occur over those services.

The Respondent registered the contested domain name "**icqster.com**" to offer and expand its Aimster service. Like AIMSTER, ICQster was designed to be available, at no charge, to Internet users, of any of multiple messaging systems, to allow them to inter-operate with each other and with the ICQ service, and would have enabled file-sharing across private searchable networks of messaging Buddies. See Annex I to the Complaint, "File Swapping Aimster to Tap into ICQ, Napster," CNET, September 14, 2000. The Respondent also registered "Yimster" and "Mimster", for AIMSTER-like services intended to inter-operate respectively with Yahoo's and MSN's instant messaging services.

Lastly, the Panel, on its own initiative and on April 28, 2001, reviewed the **aimster.com** web site. On that site, the Respondent acknowledged that it is not affiliated with the Complainant, but this acknowledgement does not appear on the home page but rather well into the web site and then in a rather inconspicuous fashion. Specifically, in response to a question posed in a list of Frequently Asked Questions on an FAQ section accessible by clicking on a Help link in the home page, the following question is listed: "Is Aimster part of AOL?". On the sixth of eight pages in the FAQ section, the answer appears: "Aimster is not a product of AOL and is not affiliated with AOL in any way". The type, in terms of its font, size and prominence, of the question and the answer does not differ from that used for any other question and answer in this section. Moreover, there is no indication on the home page whatsoever that AIMSTER is affiliated or not with the Complainant, or that an Internet user can access the FAQ section from the Help page to learn that whether such affiliation exists or, as here, not. The Panel reached this question and its answer simply and only as a result of its own curiosity in seeing what information was available through the "Help" section, as it did with all other links on the **aimster.com** home page; however, nothing on higher level pages of the site directed the Panel to this section to gain any insight on whether the Respondent and Complainant were affiliated with each other.

## **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."

Paragraph 4(a) of the Policy requires that the 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 the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the 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.

As noted above, the Respondent expressly relinquished the two contested "ICQ" based domain names, specifically "**icqster.com**" and "**ic2ster.com**". Therefore, the Panel will not comment any further on these two domain names and will simply order these particular domain names transferred to the Complainant. Hence, the following discussion will only address the four contested "AIM" based domain names.

#### Identical and/or Confusingly Similar

It is beyond question, to a majority of the Panel, that confusion would likely arise when and if the Respondent, or any third-party not affiliated with the Complainant to which the Respondent were to transfer any of the contested "AIM" based domain names, were to start using that name in conjunction with services similar to those of the Complainant.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant's web site, but who reach a web site through any of the contested domain names, to think that an affiliation of some sort exists between the Complainant and the Respondent or its third-party transferee, when, in fact, no such relationship would exist at all. See *American Home Products Corporation vs. Ben Malgioglio* D2000-1602 (WIPO Feb. 19, 2001); *Dollar Financial Group, Inc. v VQM NET* FA 96101 (Nat. Arb. Forum Jan. 25, 2000); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.* D2000-1463 (WIPO Jan. 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales Corp.* FA 95856 (Nat. Arb. Forum Dec. 18, 2000) and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.* AF-0145 (eResolution May 3, 2000).

A majority of the Panel categorically rejects the Respondent's claim that the Complainant's "AIM" marks are not sufficiently distinctive as to support valid trademark rights and, in some measure, are descriptive of a "targeting" or similar connotation when used in conjunction with the Complainant's AIM services. Given the 80+ million user community of each of the AIM and ICQ services with, at least for the ICQ services, 9 million such users accessing that service daily (with the AIM service in all likelihood having similar daily access), coupled with the extensive and repeated advertising and promotion which the Complainant undertakes, the majority of the Panel believes that the mark "AIM" is an acronym for "AOL Instant Messenger" and is so known by all its users. While the term "Instant Messenger" itself may be highly descriptive, even generic, of an Internet-based messaging service, that term is not the Complainant's mark. The Complainant's mark is "AIM". It is simply beyond question that the Complainant's mark

"AOL" is an exceedingly strong, highly distinctive and extremely well-known, if not famous, mark associated with the Complainant's service offerings.

The majority of the Panel can not see how the mark "AIM", as that mark is widely known by the Complainant's user community and for that matter the Respondent's user community as well, which references and incorporates "AOL" through use of the letter "A", can be any less distinctive and enjoy any less protection than does the mark "AOL" itself. While the Respondent points to numerous other marks that incorporate the term "AIM", all of these marks are distinguishable from the Complainant's mark inasmuch as none of the former, amongst their corresponding consumers, carries a connotation of any linkage with "AOL", and hence none of them enjoys the substantial goodwill and extremely wide reputation associated with the mark "AOL".

Further, the US PTO is charged, in the first instance during examination of a federal trademark application, with ensuring that the mark, if registration is sought on the Principal Register (as the Complainant has sought and ultimately achieved for its "AIM" marks) that, under §2(e)(1) of the Lanham Act (15 U.S.C. §1052(e)(1)), that the mark is not "merely descriptive or deceptively misdescriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services". The majority of the Panel notes here that the PTO, through normal exercise of its responsibility and expertise, issued two separate trademark registrations to the Complainant for its mark "AIM".

The PTO, as an official governmental body having specialized expertise, is accorded a very strong presumption that, in furtherance of its official duties -- here being issuing a trademark registration, it correctly carried out its duties, i.e., it properly (a) examined both underlying "AIM" trademark applications and (b) reached a conclusion of registrability for each. The Respondent has simply not provided any proof that calls into question the validity of either of the "AIM" registrations, let alone enough to overturn the presumption accorded to the PTO. As such, the Panel strongly defers to the determination by the PTO that the Complainant's "AIM" marks are sufficiently distinctive.

The majority of the Panel notes that, although the "AIM" based domain names were registered before the Complainant's trademark registrations issued for the "AIM" marks, the Complainant can base its rights under the Policy on its common law trademark rights.

Regarding any distinction in coverage between registered and unregistered marks, paragraph 4(a) of the Policy simply recites: "You are required to submit to a mandatory administrative proceeding in the event that a third party (a "complainant") asserts to the applicable Provider, in compliance with the Rules of Procedure, that ... (i) your domain name is identical or confusingly similar to a *trademark or service mark in which the complainant has rights*" [emphasis added]. Nowhere does the Policy contain a restriction that specifically limits its reach to only registered marks. Therefore, given the apparent

inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence a protectable interest under the Policy, lies with national trademark law that governs the Respondent's actions that are the subject of the Complaint. Under American law, rights accrue in unregistered, so-called "common law", marks as a result of usage, though limited by geographic and product markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: "Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce *any word, term, name, symbol, or device*, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act." [emphasis added].

Numerous panels, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the Panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.* FA 95560 (Nat. Arb. Forum Nov. 2, 2000) held: "ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required -- unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy". See, e.g., *Bridal Rings Company v. Abert Yemenian / Albert Yemenian* FA 95608 (Nat. Arb. Forum Oct. 26, 2000); *CMG Worldwide Inc. v. Naughty Page* FA 95641 (Nat. Arb. Forum Nov. 8, 2000); *Home Properties v. SMSOnline* FA 95639 (Nat. Arb. Forum Nov. 2, 2000); *Missing Children Minnesota v. Run Yell Tell, Ltd.* FA 95825 (Nat. Arb. Forum Nov. 20, 2000); *Mike Warner 2001 v. Mike Larson* FA 95746 (Nat. Arb. Forum Nov. 15, 2000). Furthermore, the Panel in *United States Postal Service v. Consumer Information Organization* FA 95757 (Nat. Arb. Forum Nov. 27, 2000) held: "The UDRP does not discriminate between registered and unregistered marks." In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE* AF-0536 (eResolution, Dec. 11, 2000) the Panel recognized: "It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark." In that regard, also see *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.* FA 95832 (Nat. Arb. Forum Nov. 30, 2000) and *Sand Hill Wholesale of Ohio v. Chris Hatton d/b/a Sand Hill Wholesale Cedar Lod Furniture* FA 95970 (Nat. Arb. Forum Dec. 18, 2000). Similarly, see *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company* D2000-0014 and 2000-0015 (WIPO Mar. 11, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs* D2000-0131 (WIPO Apr. 13, 2000); *Cho Yong Pil v. ImageLand, Inc.* D2000-0229 (WIPO May 10, 2000), and a case similar to that at present, *American Home Products Corporation v. Healthy Futures* D2000-0454 (WIPO Aug. 3, 2000).

Given this, the Panel believes that if a complainant puts forth an appropriate showing of prior, continuous use in a given product and territorial market of an unregistered mark or a tradename over a sufficiently long period to evidence the acquisition of common law trademark rights, then those rights are susceptible of protection under paragraph 4(a) of the Policy to the same extent as are those emanating from registered marks.

The Complainant here, given its prior activities with respect to its "AIM" based marks, has clearly made such a showing here, with the territorial market being the entire United States as well as other countries that recognize trademark rights based on prior use.

All that is necessary is that the domain name misappropriate sufficient textual components from the mark(s), whether registered or unregistered, such that an ordinary Internet user who is familiar with the goods or services distributed under the mark(s) would upon seeing the domain name likely think that owing to the visual and/or phonetic similarity between the mark(s) and the domain name that an affiliation exists between the site identified by that domain name and the owner or licensed user of the mark(s). See, *American Home Products Corp. v. Malgioglio*, cited *supra*.

With respect to a test for "confusing similarity", § 5.01[3], page 5-15 of J. Gilson et al, Trademark Protection and Practice (© 1996, Matthew Bender & Co., Inc.) states:

"When one trademark is said to be 'confusingly similar to another', it is so similar to the other that, when it is used on products, the purchasing public is likely to be confused. The term [confusingly similar] is simply another way to express the fact that confusion is likely."

In assessing whether sufficient similarity exists between two marks, Gilson, at § 5.02[1], professes: "If a word trademark sounds similar to the plaintiff's mark courts often find likelihood of confusion, especially if the associated product is typically ordered orally. Visual similarity frequently causes confusion if there is sufficient resemblance in overall appearance. Even if word trademarks neither sound alike nor look alike, similarity in meaning may cause confusion.". In its seminal decision on the issue, *In re E.I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973) , the United States Court of Customs and Patent Appeals (predecessor to the United States Court of Appeals for the Federal Circuit), in its definitive listing of factors for assessing if the likelihood of confusion exists or not, enumerated as its first factor: "(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression."

A majority of the Panel finds that such similarity clearly exists here inasmuch as each of the contested domain names includes the mark "AIM" in which the Complainant has acquired trademark rights, both at common law and through its registrations. Confusing similarity is not dispelled by virtue of the Respondent appending the suffix "ster" (or similar) to the Complainant's mark (or to "a1m" -- which is clearly a minor variant, as the

Respondent implicitly admits to the term "AIM", but which it registered in the context of "**AImster.com**" as, in its own words, a "protective registration" -- see Response, page 8) to form each of the contested domain names.

Specifically, various panels have faced the issue of determining whether a domain name is confusingly similar to a trademark where the domain name, here being a composite domain name, is formed by either appending or prepending a term to a mark (ignoring inclusion of a top level domain). While, in certain instances, the addition of that term may be sufficient to fundamentally change the character of the domain name vis-à-vis the mark so as to successfully ameliorate any likelihood of user confusion by reducing that likelihood to a de minimus level thus precluding a finding of trademark infringement, in other instances, depending on the nature of the term and the mark, it may not. Furthermore, the question of confusion is also assessed in connection with the products or services being offered under the domain name and the mark. While concurrent use of two identical marks is permitted under the Lanham Act as well as concurrent use of a mark and a domain name is permitted under the Policy, the determinant of the allowability of such concurrent use hinges on whether users seeing one mark, in the context of use with its goods or services, will be confused by seeing the other mark or domain name when it is used in conjunction with its corresponding goods or services. See Gilson, § 5.01[3], *cited supra*.

Clearly, given the uniqueness of each situation, the issue of whether that additional term is sufficient or not, in any one instance, to realistically dispel such confusion must be determined strictly on a case-by-case basis. There is no hard and fast rule as to the exact quanta of change which that term must bring to the mark, when the resulting domain name is viewed as a whole, and which will suffice across all situations.

Where extremely strong marks are at issue, such as the Complainant's mark "AIM", that exhibit substantial consumer recognition, and hence enjoy very broad trademark rights, much more will need to be added to any of these marks to form a composite domain name that will not engender confusion with any of those marks. To succeed, those additions must, of necessity, be sufficiently "radical" to fundamentally change user perception of the domain name, when it is viewed as a whole, away from connoting a linkage of some type between the domain name and the mark and thus not confuse the users. If the domain name and the mark are used in conjunction with the same or related goods or services -- and such is clearly the case here inasmuch as the Complainant uses its "AIM" in conjunction with instant messaging and the Respondent uses its "Aimster" mark in conjunction with a file sharing service that interacts with and utilizes the Complainant's instant messaging service -- then such changes would need to be even more striking to adequately dispel user confusion that would otherwise result through concurrent use of both. Conversely, where rather weak marks are involved, e.g., marks that are not highly distinctive and thus do not enjoy wide consumer recognition, much less needs to be added to any of these marks in forming a composite domain name that will not be confusingly similar to that mark.

The majority of the Panel believes that, under the facts of this dispute, the file-sharing service being offered by the Respondent under its mark "AIMSTER", and particularly given that this service requires the use of the Complainant's AIM service, is so highly related to the Complainant's service that the addition of the term "ster" in the composite domain name "Aimster" (including its variants "Aimsterv" and "A1mster") is insufficient to ameliorate user confusion arising from concurrent use of both.

Various panels have faced this issue in the context of domain names containing generic or other terms, either as prefixes or suffixes, or country names that have been added to marks.

As for prefixes, see, e.g., *General Electric Company v. Pars International Computer, Inc.* D2000-0368 (WIPO July 25, 2000) where a panel found confusing similarity existed between the mark "ge" and a domain name formed of "1-800" combined, as a prefix, with the mark so as to form a domain name "1-800ge.com". There, the panel held that "[c]ombining the prefix with 'ge' creates the impression that this domain name is associated with a toll-free telephone number of General Electric; therefore, ... the domain name registered by Respondent is confusingly similar to Complainant's mark." Similarly, see *Gorstew Ltd. & Unique Vacations, Inc. v. Berkshire Trust* FA 95430 (Nat. Arb. Forum Oct. 20, 2000). In *Inter-IKEA Systems B. V. v. Technology Education Center* D2000-0522 (WIPO Aug. 7, 2000), a panel held that the addition of "e" by a respondent to a complainant's service mark "IKEA" was insufficient to distinguish the two and hence rendered the domain name ("e-ikea.com") confusingly similar to the mark. Similarly, see *Ty Inc. v. Parvin*, D2000-0688 (WIPO Nov. 9, 2000) as to the addition of "e" as a prefix to a trademark in forming a domain name being insufficient to prevent confusion. Also, consider *National Academy of Recording Arts & Sciences, Inc. v. Las Vegas Computer Journal* FA 95168 (Nat. Arb. Forum Aug. 18, 2000) where the addition of "cyber" by the respondent to the complainant's registered mark "Grammy" in forming the domain name "'cybergrammy.com' conveyed an impression that the complainant there had a presence in cyberspace and thus was likely to cause an observer to be confused, misled or deceived when encountering 'cybergrammy.com'." Further, in *Park Place Entertainment Corp. v. Conille* FA 95492 (Nat. Arb. Forum Oct. 6, 2000) the panel found confusingly similarity as a result of the respondent prepending the term "casino" to the complainant's mark "parislasvegas" in forming the domain name "casinoparislavegas.com". For similar results, see *America Online, Inc. v. Anson Chan* D2001-0004 (WIPO Feb. 22, 2001), *America Online Inc. v. Neticq.com LTD* D2000-1606 (WIPO Feb. 12, 2001), *America Online, Inc. v. Go2North.Com, Inc.* D2000-0810 (WIPO Dec. 15, 2000), and, in accord on a finding of confusing similarity, *America Online, Inc. v. Vadim Eremeev* D2001-0003 (WIPO Feb. 15, 2001).

In addition, see *Nokia Corp. v. Private* D2000-1271 (WIPO Nov. 3, 2000) where the panel found "wwwnokia.com" was confusingly similar to the complainant's registered trademark "Nokia"; and *State Farm Mut. Auto. Ins. Co. v. LaFaive* FA 95407 (Nat. Arb. Forum Sept. 27, 2000) where the panel there found confusingly similarity between the contested domain name "STATEFARM-CLAIMSHELP.COM" and the complainant's registered trademark "STATE FARM" and, in doing so, specifically noted:

"The Panel finds that the parties' services are competitive, or if not competitive at the very least complimentary. Complainant provides insurance underwriting services, and handles claims made by its casualty policy holders. Respondent assists policy holders in making casualty loss claims to numerous insurance companies. From these observations, the panel also concludes that the potential customers for the parties' services overlap to a great extent. The parties also promote their services within the same, if not largely overlapping, channels of trade.

Respondent's continued use of the disputed domain name in the fashion shown from Complainant's submissions, and based upon the Panel's own observations, will likely result in consumer confusion. By the very nature of Respondent's contested domain name and the use he presently is making of it on his web site, contrary to Respondent's assertions, Internet users are likely to experience initial interest confusion. That is, users will think that Respondent's services provided in connection with the STATEFARM-CLAIMSHELP.COM domain name are somehow associated with Complainant, which confusion will be exacerbated when users arrive at Respondent's site and see information and links to insurance claims services."

The majority of the Panel believes that the considerations underlying the panel's findings in *LaFaive* are just as applicable in the present case.

As for suffixes, see *Digital City v. Smalldomain* D2000-1283 (WIPO Nov. 6, 2000), where a panel did not find confusing similarity as a result of a respondent adding a generic suffix "map" to a complainant's mark "digital city". In reaching this finding, the panel stated a three-point test, viz. that consumers are not likely to be confused where: (1) a domain name comprises a mark and a suffix; (2) where that mark is essentially generic within the online world and has not acquired such distinctiveness as to merit broader protection; and (3) where the suffix (or the domain name as a whole) does not relate specifically to the business of the Complainant. However, when applied to the present facts, this test is not met. Specifically, the Panel views the "AIM" mark as highly distinctive and not generic. Moreover, the Panel views the suffix "ster" as suggesting a relation between the domain name and the instant messaging service provided by the Complainant, AOL -- a relationship that exists in fact. The Panel takes notice of Funk and Wagnall's New Practical Dictionary (© 1962, Funk and Wagnall's Company) which, on page 1278, defines the suffix "ster" as "profession, occupation, or agency of, originally the feminine form of - ER; often with depreciation or disapproval"; Webster's

New World Dictionary (© 1972, The World Publishing Co.) which, on page 421, defines the suffix "ster" as "a suffix meaning one who is, does or creates (something specified), as in oldster, punster"; and The Oxford English Dictionary, 2d Edition (© 1989, Oxford University Press) which, on page 645, describes the suffix "ster" as "forming nouns of action ... In the modern English, ... [t]he formation here imitates that of trade designations; hence the disparaging sense, e.g., in rhymester, jokester as compared with rhymer, joker."

With respect to country names, see *eBay Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.* D2000-1463 (WIPO Jan. 10, 2001) where the panel found confusing similarity to the mark "eBAY" as a result of domain names that appended various country names, such as Greece, Turkey, America, New Zealand, United Kingdom to the mark. Also, see *AT&T Corp. v. WorldclassMedia.com* D2000-0553 (WIPO July 28, 2000) where the panel found confusing similarity to the mark AT&T by domain names formed by including a geographic descriptor following the term ATT. In addition, see *America Online, Inc. v. Dolphin@Heart* D2000-0713 (WIPO Aug. 24, 2000) in which the panel there held: "The addition of the name of a place to a service mark, such as the addition of 'France' to 'AOL' is a common method for specifying the location of business services provided under the service mark. The addition of a place name generally does not alter the underlying mark to which it is added." In that case, the panel further concluded: "A consumer or user of the Internet viewing the address 'www.aolfrance.com' is likely to assume that Complainant is the sponsor of or associated with the web site identified by the disputed domain name, particularly in light of the fact that Complainant routinely uses its 'AOL' service mark in combination with country names in its advertisements on the Internet." Also, for similar holdings, see, *Bloomberg, L.P. v. Electronic Media Services* FA 96438 (Nat. Arb. Forum Feb. 19, 2001), *Wal-Mart Stores, Inc. v. Walmarket Canada* D2000-0150 (WIPO May 2, 2000) and *Cellular One Group v. Brien* D2000-0028 (WIPO Mar. 10, 2000).

Hence, the majority of the Panel believes that the addition of the term "ster" to the Complainant's mark "AIM" (or "A1M") in each of the contested "AIM" based domain names not only fails to ameliorate the confusion, but also, by virtue of the Complainant and the Respondent offering highly related messaging services and taken in view of the common dictionary meaning of the term "ster", likely increases its occurrence. In that regard, Internet users who learn of the Respondent's service would naturally think that this suffix implies that a relationship, affiliation or sponsorship of some sort exists between that service and the Complainant when, in actuality, no such linkage exists at all. This confusion is compounded by the fact that the Respondent buries this information within its site causing the user to be rather hard-pressed to discern the truth.

As such, the majority of the Panel finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy for each of the contested "AIM" based domain names.

#### Rights or Legitimate Interests

Based on its federal trademark registrations, the Complainant has acquired exclusive rights to use its "AIM" marks. Furthermore, by virtue of the registrations of these marks, as discussed above, the US PTO has implicitly recognized that each of these marks has acquired appropriate secondary meaning in the marketplace.

The majority of the Panel believes that the Respondent has yet to provide any basis that would legitimize any claim it has to any of the contested "AIM" based domain names. In fact, it is extremely unlikely that the Respondent can even make such a claim.

The simple reason is that the contested domain name includes the Complainant's "AIM" marks under which the Complainant provides its services, and has been doing so for several years. The Complainant has never authorized the Respondent to utilize its registered "AIM" marks, nor does the Complainant have any relationship or association whatsoever with the Respondent. Hence, any use to which the Respondent were to put the "AIM" marks, in connection with the goods or services set forth in the Complainant's registrations or those related thereto -- as is the case here, would directly violate the exclusive trademark rights now residing in the Complainant, both in terms of its federal rights and those at common law. See, e.g., *America Online, Inc. v. Xianfeng Fu* D2000-1374 (WIPO Dec. 11, 2000), and *Treeforms, Inc. v. Cayne Ind. Sales Corp.*, cited *supra*.

Even if the majority of the Panel accepts the Respondent's assertion that the Complainant does not currently offer peer-to-peer file sharing capabilities, such functionality, by virtue of its being a specific type of real-time communications as well as more specifically multi-user network access and information dissemination, fall squarely within the category of services encompassed by the Complainant's common law rights as well as those within the service description in its registrations; hence, constituting trademark infringement.

In light of the above findings, the majority of the Panel is not persuaded that the Respondent has any or, based on current facts provided to the Panel, is likely to acquire any legitimate rights in any of the contested "AIM" based domain names, whether on a commercial or non-commercial basis.

An argument can be made, as the Respondent seems to imply, that its use of the Complainant's mark "AIM" constitutes fair use by simply identifying a particular service, i.e., the Complainant's AIM service, to which the Respondent's own service is functionally associated, with the former being effectively an underlying component part or ingredient, and, as such, each of the Respondent's "AIM" based domain names simply reflects that functional linkage. However, a majority of the Panel is not persuaded. In that regard, the majority finds that the Respondent's efforts in intentionally selecting and then registering each of the contested "AIM" based domain names, particularly in light of the tight functional relationship that exists between its services and those of the

Complainant, does not constitute, under paragraph 4(c) of the Policy, a legitimate non-commercial or fair use without any intent to misleadingly divert consumers or tarnish the trademark or service mark at issue. In fact, the Panel believes such use constitutes just the opposite, i.e., that these domain names were intentionally selected, then registered and are being used by the Respondent due to their high degree of similarity to the Complainant's marks and hence for their potential to mislead the Complainant's users to the benefit of the Respondent. As discussed below, clearly the Respondent could have chosen other domain names that engendered far less, if any, user confusion -- though perhaps the service linkage would not be as explicit to its users; yet it intentionally chose the contested "AIM" based names, without the authorization of the Complainant, which incorporated the Complainant's registered marks "AIM", either identically (in the case of "Aimster.com", "Aimstertv.net" and "Aimstertv.com") or nearly so (in the case of "A1mster.com") to enhance its own consumer recognition at the expense of the Complainant.

Thus, the majority of the Panel finds that the Respondent has no rights or legitimate interests in any of the contested "AIM" based domain names within paragraph 4(a)(ii) of the Policy.

#### Registration and Use in Bad Faith

The majority of the Panel finds that the Respondent intentionally chose each of the contested "AIM" based domain names to financially benefit from its close resemblance and ensuing user confusion with respect to the Complainant's marks "AIM" and continues to use each of those names to further that purpose. Thus, the Panel finds that the Respondent registered and uses each of the contested "AIM" based domain names in bad faith.

It strains credulity to think the Respondent was not well aware of the Complainant's "AIM" mark when it intentionally selected its mark "Aimster" for any reason other than for its inclusion of the term "AIM" in order to highlight the functional intimacy between the Complainant's and Respondent's services, and in doing so to avail itself and hence financially benefit from the Complainant's extensive recognition and goodwill in its "AIM" mark.

As noted above, the services offered by the Complainant and the Respondent are intimately linked in a functional sense inasmuch as the Aimster service, for its operation, requires as an essential component prior installation and current operation of the Complainant's AIM software and its associated service. Aimster will simply not provide its peer-to-peer file-sharing capability without the Complainant's AIM service executing essentially in background as a lower layer transport conduit. While these services are not directly competitive, they are unquestionably complementary to each other and very closely related at that, so much so that users could reasonably, realistically and readily think that both services emanate from the Complainant. Therefore, it was certainly

incumbent on, if not a clear duty of, the Respondent here to have selected a mark and a domain name for use with its service that would minimize, rather than enhance, the potential for such confusion -- an action which the Respondent intentionally failed to do.

Internet users seeing any of the "AIM" based domain names are likely to think that the Respondent's service, or its web site, is somehow related to, affiliated with or sponsored by the Complainant, when in fact it is not.

By relying on this confusion, the Respondent is intentionally attracting, for its own commercial gain, Internet users, thinking they are accessing a service provided by the Complainant, to its own web site rather than the Complainant's.

If the goal of the Respondent was not to obtain future pecuniary gain from its actions, then why would it have chosen domain names that incorporate, verbatim or nearly so, the Complainant's well-known mark "AIM"? Clearly, the Respondent could have selected a different domain name, i.e., one which did not include the mark "AIM" but suggested, though not as explicitly, a functional interaction between its program and the Complainant's "AIM" service, but it intentionally decided not to do so. The reason is rather simple. The Respondent is a start-up venture. Hence, it is reasonable to think that it is now or will soon be seeking additional capital funding. Therefore, it stands to reason that, even though the Respondent is distributing its Aimster software free of charge to any requesting user and has done so approximately 1.5 million times, the Respondent will clearly benefit, financially, in the form of a higher corporate valuation -- when and if it should seek additional capital funding, based on wide and rapid user recognition of its service. Unfortunately for the Respondent, the Panel believes it is obtaining this recognition and ultimate financial gain by spring-boarding off, i.e., capitalizing on, the extensive reputation, recognition and goodwill enjoyed by the Complainant. In that regard, see *American Online, Inc. v. Anson Chan, America Online Inc. v. Neticq.com LTD*, and *America Online, Inc. v. Go2North.Com, Inc.*, all cited *supra*. While bad faith use was not found in *America Online v. Vadeem Eremeev*, cited *supra*, the respondent's conduct there, as found by the panel, was apparently free of any commercial use and conducted in a manner, not present here, that dispelled confusion from occurring; hence, that case is quite distinguishable from that presently before this Panel. Also, see *NIIT Ltd. v. Parthasarathy Venkatram* D2000-0497 (WIPO Aug. 4, 2000) where the panel in finding bad faith registration and use of the domain name "MYNIIT.COM" in view of the registered trademark "NIIT" states, in pertinent part: "Further, the Panel concludes that it is most unlikely that the Respondent would use the web site for the alleged purpose since he could have registered the domain name 'myiit' which contains the abbreviation for the Indian Institute of Technologies, instead of 'myniit' which contains the Complainant's trademark."

Had the Respondent chosen the term "IMSTER" (or the like such as "1MSTER") rather than "AIMSTER" (or correspondingly "A1MSTER") for inclusion in its domain names, the Panel opines that, in view of the generic nature of the term "IM", as found by the

U. S. District Court in *America Online Inc. v. A T & T Corp.* 64 F. Supp. 2d 549, 51 U.S.P.Q.2d 1865 (DC EVa 1999) to mean "instant message", then, in all likelihood, this would have led to an entirely different, and in fact directly opposite, result from that which the majority of the Panel reached here. *Id* at 1873 and 1877-1878. However, the Respondent did not choose "IMSTER", it intentionally chose "AIMSTER".

The Respondent acknowledged that it registered the domain names "MIMSTER.COM" and "YIMSTER.COM" for use with instant messaging services respectively provided by Microsoft and Yahoo, hence possibly availing itself of the terms "MIM" and "YIM" as potential acronyms for Microsoft Instant Messaging and Yahoo Instant Messaging, and that doing so implicitly justifies its conduct here. It does not. This issue of whether the terms "MIM" and "YIM" are trademarks of Microsoft and Yahoo, respectively, is not before this Panel, while the term "AIM" is such a trademark and is entitled, by virtue of its acquired secondary meaning and distinctiveness, to be accorded protection from infringement, here being inclusion in a domain name, that is likely to cause user confusion.

Hence, the majority of the Panel finds that the Complainant has shown a sufficient basis to establish bad faith registration and use of each of the contested "AIM" based domain names under paragraph 4(a)(iv) of the Policy.

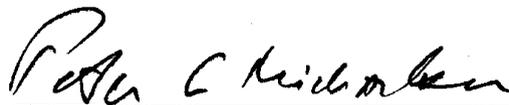
Inasmuch as the majority of the Panel finds for the Complainant, the issue of reverse domain name hijacking is now moot.

## **DECISION**

In accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the relief sought by the Complainant is hereby granted in full.

All the contested "ICQ" based domain names, namely "**icqster.com**" and "**ic2ster.com**", are ordered transferred to the Complainant.

Furthermore, all the contested "AIM" based domain names, namely "**aimster.com**", "**aimstertv.com**", "**aimstertv.net**" and "**aimster.com**" are also ordered transferred to the Complainant.



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PETER L. MICHAELSON, ESQ.  
ARBITRATOR

  
HONORABLE JAMES A. CARMODY  
ARBITRATOR

Dated: May 14, 2001

## DISSENT OF G. GERVAISE DAVIS III

I respectfully dissent from the well written opinion prepared for the panel by Chairman Peter L. Michaelson and concurred in by James A. Carmody. Inasmuch as the Respondent agreed to relinquish the contested "ICQ" domain names, my dissent is limited to the contested "AIM" based domain names.

I have no disagreement with the facts as stated by the Majority. My disagreement primarily relates to their conclusions of law whereby the Majority concludes that the Respondent lacked a legitimate use or right to use the AIMSTER domain name and denied the Respondent's claim that it was fair use since it merely described a relationship to an existing Internet service. The ICANN UDRP § 4(a) sets up three requirements that the Complainant must prove: (i) similarity to Complainant's mark, (ii) lack of legitimate use, and (iii) bad faith registration and use.

I would agree with the Majority that the domain name AIMSTER.COM is similar to AOL's AIM trademark, but believe that the issue of confusing similarity is an issue of fact more appropriately determined in a court of law, rather than in a summary arbitration proceeding where there is no opportunity for the relevant facts to be developed and where the arbitrators must simply speculate as to whether or not the similarity would, in fact, cause confusion as to source since there is none of the usual survey evidence as would be the case in a trial. I also disagree with the Majority's finding of bad faith, which similarly requires detailed factual information in a case like this far beyond that which can be presented to the Panel in the limited written documentation available in an ICANN proceeding.

There is no question that the AIMSTER was selected by Respondent because it brought to mind the AOL Instant Messenger (AIM) service as to which AOL obtained a trademark in January, 2001, seven months after Respondent had registered and began to use the AIMSTER domain name. The Majority decision states and Respondent quite correctly notes in its pleadings that its peer-to-peer services piggyback, or interact, with the AOL Instant Messenger service. In my view this is why it is perfectly legitimate for Respondent to bring to the mind of the user a nominative reference to the AIM service.

Contrary to AOL's argument that it has not licensed or authorized the Respondent to provide an interactive service interacting with the AOL AIM service, I am aware of no law which requires a business entity to obtain a license in order to make use of another service where it merely interacts with and permits a legitimate user of the first service to have a supplemental service provided by others. Thus, if a business creates an answering service that works with the Pacific Bell telephone system, that business is not required to obtain a license from Pacific Bell to assist a legitimate Pacific Bell user in adding services to his telephone. Nor is it prevented by the trademark laws from making a reference to the Pacific Bell trademarks that identify the services. This is a lawful nominative or fair use of a trademark. Similarly, people who have an

aftermarket in parts for automobiles surely are not prevented from stating in their advertising and even in the names of their businesses that they provide add-on part to Volkswagen owners, for example. There is really no alternative to use of the trademark to describe what the add-on or aftermarket parts makers do, as with the AIMSTER domain name. AOL simply does not own all references to the AIM mark.

The basic problem I have with the Majority's decision and its conclusions of law is that it disregards the long established principles of "fair use" as eloquently set forth by Ninth Circuit Judge Alexander Kozinski in the *New Kids on the Block* decision where he wrote, concerning a similar problem:

Since at least the middle ages, trademarks have served primarily to identify the source of goods and services, "to facilitate the tracing of 'false' or defective wares and the punishment of the offending craftsman." F. Schechter, *The Historical Foundations of the Law Relating to Trade-marks* 47 (1925). The law has protected trademarks since the early seventeenth century, and the primary focus of trademark law has been misappropriation - the problem of one producer's placing his rival's mark on his own goods. See, e.g., *Southern v. How*, 79 Eng. Rep. 1243 (K.B. 1618). The law of trademark infringement was imported from England into our legal system with its primary goal the prevention of unfair competition through misappropriated marks. See, e.g., *Taylor v. Carpenter*, 23 F. Cas. 742 (C.C.D. Mass. 1844) (Story, J.). Although an initial attempt at federal regulation was declared unconstitutional, see the *Trade-Mark Cases*, 100 U.S. 82, 25 L. Ed. 550 (1879), trademarks have been covered by a comprehensive federal statutory scheme since the passage of the Lanham Act in 1946.

Throughout the development of trademark law, the purpose of trademarks remained constant and limited: Identification of the manufacturer or sponsor of a good or the provider of a service. And the wrong protected against was traditionally equally limited: Preventing producers from free-riding on their rivals' marks. Justice Story outlined the classic scenario a century and a half ago when he described a case of "unmitigated and designed infringement of the rights of the plaintiffs, for the purpose of defrauding the public and taking from the plaintiffs the fair earnings of their skill, labor and enterprise." *Taylor*, 23 F. Cas. at 744. The core protection of the Lanham Act remains faithful to this conception. See 15 U.S.C. § 1114 (prohibiting unauthorized use in commerce of registered marks). Indeed, this area of the law is generally referred to as "unfair competition" - unfair because, by using a rival's mark, the infringer capitalizes on the investment of time, money and resources of his competitor; unfair also because, by doing so, he obtains the consumer's hard-earned dollar through something akin to fraud. See Paul Heald, *Federal Intellectual Property Law and the Economics of Preemption*, 76 Iowa L. Rev. 959, 1002-03 (1991).

The benefit of the brand name is analogous to that of designating individuals by last as well as first names, so that, instead of having to say "the Geoffrey who teaches

constitutional law at the University of Chicago Law School - not the one who teaches corporations," you can say "Geoffrey Stone, not Geoffrey Miller."

A trademark is a limited property right in a particular word, phrase or symbol. And although English is a language rich in imagery, we need not belabor the point that some words, phrases or symbols better convey their intended meanings than others. See *San Francisco Arts & Athletics, Inc. v. U.S.O.C.*, 483 U.S. 522, 569, 97 L. Ed. 2d 427, 107 S. Ct. 2971 (1987) (Brennan, J., dissenting) ("[A] jacket reading 'I Strongly Resent the Draft' would not have conveyed Cohen's message."). Indeed, the primary cost of recognizing property rights in trademarks is the removal of words from (or perhaps non-entrance into) our language. Thus, the holder of a trademark will be denied protection if it is (or becomes) generic, i.e., if it does not relate exclusively to the trademark owner's product. See, e.g., *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 83 L. Ed. 73, 59 S. Ct. 109 (1938) ("shredded wheat"); *Eastern Air Lines, Inc. v. New York Air Lines, Inc.*, 559 F. Supp. 1270 (S.D.N.Y. 1983) ("air-shuttle" to describe hourly plane service). This requirement allays fears that producers will deplete the stock of useful words by asserting exclusive rights in them. n4 When a trademark comes to describe a class of goods rather than an individual product, the courts will hold as a matter of law that use of that mark does not imply sponsorship or endorsement of the product by the original holder.

A related problem arises when a trademark also describes a person, a place or an attribute of a product. If the trademark holder were allowed exclusive rights in such use, the language would be depleted in much the same way as if generic words were protectable. Thus trademark law recognizes a defense where the mark is used only "to describe the goods or services of [a] party, or their geographic origin." 15 U.S.C. § 1115(b)(4). "The 'fair-use' defense, in essence, forbids a trademark registrant to appropriate a descriptive term for his exclusive use and so prevent others from accurately describing a characteristic of their goods." *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185 (5th Cir. 1980). Once again, the courts will hold as a matter of law that the original producer does not sponsor or endorse another product that uses his mark in a descriptive manner. See, e.g., *Schmid Laboratories v. Youngs Drug Products Corp.*, 482 F. Supp. 14 (D.N.J. 1979) ("ribbed" condoms).

With many well-known trademarks, such as Jell-O, Scotch tape and Kleenex, there are equally informative non-trademark words describing the products (gelatin, cellophane tape and facial tissue). But sometimes there is no descriptive substitute, and a problem closely related to genericity and descriptiveness is presented when many goods and services are effectively identifiable only by their trademarks. For example, one might refer to "the two-time world champions" or "the professional basketball team from Chicago," but it's far simpler (and more likely to be understood) to refer to the Chicago Bulls. In such cases, use of the trademark does not imply sponsorship or endorsement of the product because the mark is used only to describe the thing, rather than to identify its source.

Indeed, it is often virtually impossible to refer to a particular product for purposes of comparison, criticism, point of reference or any other such purpose without using

the mark. For example, reference to a large automobile manufacturer based in Michigan would not differentiate among the Big Three; reference to a large Japanese manufacturer of home electronics would narrow the field to a dozen or more companies. Much useful social and commercial discourse would be all but impossible if speakers were under threat of an infringement lawsuit every time they made reference to a person, company or product by using its trademark.

A good example of this is *Volkswagenwerk Aktiengesellschaft v. Church*, 411 F.2d 350 (9th Cir. 1969), where we held that Volkswagen could not prevent an automobile repair shop from using its mark. We recognized that in "advertising [the repair of Volkswagens, it] would be difficult, if not impossible, for [Church] to avoid altogether the use of the word 'Volkswagen' or its abbreviation 'VW,' which are the normal terms which, to the public at large, signify appellant's cars." *Id.* at 352. Church did not suggest to customers that he was part of the Volkswagen organization or that his repair shop was sponsored or authorized by VW; he merely used the words "Volkswagen" and "VW" to convey information about the types of cars he repaired. Therefore, his use of the Volkswagen trademark was not an infringing use.

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Cases like these are best understood as involving a non-trademark use of a mark - a use to which the infringement laws simply do not apply, just as videotaping television shows for private home use does not implicate the copyright holder's exclusive right to reproduction. See *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 447-51, 78 L. Ed. 2d 574, 104 S. Ct. 774 (1984). n6 Indeed, we may generalize a class of cases where the use of the trademark does not attempt to capitalize on consumer confusion or to appropriate the cachet of one product for a different one. Such nominative use of a mark - where the only word reasonably available to describe a particular thing is pressed into service - lies outside the strictures of trademark law: Because it does not implicate the source-identification function that is the purpose of trademark, it does not constitute unfair competition; such use is fair because it does not imply sponsorship or endorsement by the trademark holder. "When the mark is used in a way that does not deceive the public we see no such sanctity in the word as to prevent its being used to tell the truth." *Prestonettes, Inc. v. Coty*, 264 U.S. 359, 368, 68 L. Ed. 731, 44 S. Ct. 350 (1924) (Holmes, J.).

*The New Kids on the Block v. News America Publishing, Inc.*, 971 F.2d 302 , 305-308 [Emphasis added].

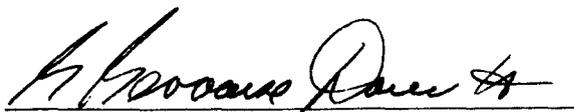
Simply put, I believe the issues in this case are far too involved in the necessary factual determinations of whether or not the use to which Respondent put the AIM name in its AIMSTER domain name is confusingly similar and whether or not it is a fair or nominative use. These issues are more properly determined by a trial court rather than a panel of three lawyers spending a few hours on the case and relying solely upon affidavits and pleadings by the parties. In fact, the pleadings here are limited as to length to ten pages by the rules, plus supplements.

As I stated in an earlier dissent, *J. Crew v. Crew.com*, D2000-0054 (WIPO Apr. 20, 2000), the purpose of the ICANN UDRP is to deal with simple, clear, abusive registrations of domain names, and not complex trademark disputes or to inject the Panel's views that someone should not be doing this since it might be wrong or unfair. This case is not, in my judgment, a case of abusive registration of a domain name — the only types of cases intended to be within the ambit of the ICANN summary arbitration rules. It is a mistake for this Panel to undertake such complex findings and conclusions in the context of a simple arbitration proceeding. It is also unfair to the parties and the public.

I am also concerned that there is an element in this case in which the Majority is reflecting its distaste for peer-to-peer user services, similar to Napster, because of the fact that they may border on copyright infringement or at least contribute to copyright infringement. Such considerations are not properly to be taken into consideration before an arbitration panel in an ICANN domain name proceeding, regardless of the possible validity of the Majority's concern about such issues. In fact, AOL might well prevail in litigation relating to these AIMSTER domain names, but without a trial of the issues, I feel the Respondent is being improperly denied his rights under a summary proceeding which was never intended for cases like this.

In the final analysis, AOL appears to me to be objecting to the AIMSTER domain name not so much because of the concern over confusion as to source, but because it wishes to continue to control its AOL Instant Messaging business, just as it has tried to do in disputes with other business entities like Microsoft. Even today, this specific type of Internet instant messenger service is proprietary and inconsistent with other instant messaging services provided by other parties. I do not feel this factor, either, is an appropriate basis for instituting an ICANN domain name proceeding by AOL.

I therefore respectfully dissent from the decision of the Majority.



G. GERVAISE DAVIS III, ESQ.  
ARBITRATOR

Dissenting Panelist