



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

America Online, Inc. v. Curtis Woods

Case No. D2001-0555

1. The Parties

The Complainant is America Online, Inc., 22000 AOL Way, Dulles, Virginia 20166, USA.

The Respondent is Curtis Woods, 256 Newport Road, Knoxville, Tennessee 37922, USA.

2. The Domain Names and Registrar

The Contested Domain Names are <aolboxoffice.com>, <aoltheatres.com>, <aolmovie.com>, <aollovesmovies.com> and <aolstevecase.com>.

The Registrar is Network Solutions, Inc. (NSI), 505 Huntmar Drive, Herndon, Virginia 20170, USA.

3. Procedural History

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), 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 and by the World Intellectual Property Organization Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 ("Supplemental Rules").

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") by email on April 18, 2001, and in hard copy, with Annexes A-H, as well as the appropriate payment on April 20, 2001. The Complainant's attorney, stated that he separately served, by certified mail, a copy of the Complaint together with a copy of the cover sheet, on the Respondent and, by email, on the Registrar, NSI.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single member panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, determined whether the Complaint fully complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on April 19, 2001, the Center requested confirmation from NSI of information set forth in the Complaint relative to each of the contested domain names; specifically, contact and registrant information for each such domain name, as well as whether NSI received a copy of the Complaint from the Complainant. The Center also requested NSI to specify: (a) whether the ICANN Policy applies to each of the contested domain names, and (b) the current status of that domain name. On April 24, 2001, NSI provided its response to the Center through which, for each of the contested domain names, NSI provided contact information pertinent to that name from its WHOIS database, confirmed that NSI is the registrar of that name, stated that the Policy is in effect (through Network Solutions' version 5.0 registration agreement) for the domain names, and the domain names were then in an "active" status.

On April 26, 2001, the Center notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint, both in email and hard copy form, to the Respondent (with the latter method forwarding a copy of all the annexes as well). In that regard, the file contains a copy of an email transmission report evidencing that the Complaint was indeed sent to the Respondent. The Complaint, and its accompanying documents, and all subsequent communications associated therewith were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on April 26, 2001 under paragraph 4(c) of the ICANN Policy, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and succeeding correspondence between the Center and NSI, in detail, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20-calendar day period, expiring on May 15, 2001 to file its response with the Center and serve a copy of the response on the Complainant.

As of May 18, 2001, the Center had not received a substantive response to the Complaint from the Respondent; hence, the Center, in an email letter dated May 18, 2001, notified the Complainant and Respondent of the default of the Respondent.

Accordingly, pursuant to the Rules and Supplemental Rules, on May 23, 2001, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as a sole panelist for this dispute. On May 25, 2001, Mr. Michaelson accepted and returned, by facsimile to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter

dated May 28, 2001, notified the parties of the appointment of Mr. Michaelson as the panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision was to be issued by the Panel to the Center on or before June 11, 2001.

Owing to a recent illness of the sole Panelist, the Panel slightly extended the due date for this decision from June 11, 2001 to June 15, 2001. The Center, in turn, through an email dated June 11, 2001, appropriately notified the parties.

This dispute concerns five domain names, specifically: <aolboxoffice.com>, <aoltheatres.com>, <aolmovie.com>, <aollovesmovies.com> and <aolstevecase.com>.

The language of this proceeding is English.

4. Factual Background

Inasmuch as the Respondent, Curtis Woods, has failed to respond to the Complaint as required by the Policy and Rules, all the factual representations alleged by the Complainant, America Online, Inc. (AOL), will be accepted as undisputed. For convenience of the reader, factual allegations from the Complaint are reproduced below.

A copy of the WHOIS registration record for each of the contested domain names appears in Annex F to the Complaint. As indicated on these records, the Respondent registered all five contested domain names with NSI on January 10, 2000.

The Complainant owns numerous trademark registrations worldwide for the mark "AOL" on which this dispute is based. For this mark, the Complainant points to the following two illustrative United States registrations for which it has provided, in Annex B to the Complaint, a hard copy printout of the corresponding registration records listed in the publicly web-accessible Trademark Electronic Search System (TESS) maintained by the United States Patent and Trademark Office (PTO).

a) AOL (block letters)

US registration 1,984,337; registered July 2, 1996

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 October 31, 1989.

b) AOL (block letters)

US registration 1,977,731; registered June 4, 1996

This trademark was registered, for use in connection with: "Telecommunications services, namely electronic transmission of data, images, and documents via computer terminals; electronic mail services; and facsimile transmission", in international class 38;

"Electronic storage and retrieval of data and documents in the fields of business, finance, news, weather, sports, computing and computer software, games, music, theater, movies, travel, education, lifestyles, hobbies and topics of general interest" in international class 35; and.

"Computer services, namely leasing access time to computer databases, computer bulletin boards, computer networks, and computerized research and reference materials, in the fields of business, finance, news, weather, sports, computing and computer software, games, music, theater, movies, travel, education, lifestyles, hobbies and topics of general interest; computerized dating services; computer consultation services; computerized shopping via telephone and computer terminals in the fields of computer goods and services and general consumer goods" in international class 42.

This mark claims, for all its classes, first use and first use in inter-state commerce of October 2, 1989.

The Complainant also owns the mark "AOL.COM" as a domain name for its portal Website. In that regard, the Complainant owns two United States trademark registrations 2,325,291 and 2,325,292 for the mark "AOL.COM", as indicated below with hard copy printouts for the corresponding registration records from TESS being provided in Annex C to the Complaint.

c) AOL.COM (block letters)

US registration 2,325,292; registered March 7, 2000

This trademark was registered, for use in connection with: "Telecommunications services, namely, electronic transmission of data, images and documents via computer terminals; electronic store-and-forward messaging; electronic mail services, and facsimile transmission", in international class 38. This mark claims first use and first use in inter-state commerce of October 19, 1992.

d) AOL.COM (block letters)

US registration 2,325,291; registered March 7, 2000

This trademark was registered, for use in connection with: "Computer services, namely, providing multiple user access to computer networks and bulletin boards for the transfer and dissemination of a wide range of information; providing a wide range of general interest information via computer networks", in international class 42. This mark claims first use and first use in inter-state commerce of October 19, 1992.

The mark "AOL" is used extensively at the Complainant's portal website, which is a significant method of promoting the Complainant's service. As a result, consumers associate the mark "AOL", when used in a domain name, with the Complainant's services.

Long prior to the Respondent's registration of the contested domain names with NSI on January 10, 2000, and at least as early as 1989 for the mark "AOL", and 1992 for the

mark "AOL.COM", the Complainant adopted and began using its "AOL" and "AOL.COM" marks in connection with computer online services and other Internet-related services. The Complainant has used its marks continuously and extensively in interstate and international commerce in connection with the advertising and sale of its Internet and computer-related services.

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

With over twenty-eight million subscribers, the Complainant operates the most widely-used interactive online service in the world and each year millions of AOL customers worldwide obtain services offered under the "AOL" and "AOL.COM" marks; with millions more being exposed to these marks through the Complainant's advertising and promotions.

The "AOL" and "AOL.COM" marks have been and continue to be widely publicized through substantial advertising conducted by the Complainant throughout the United States and the world. AOL states that it 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 the Complainant's services under the "AOL" and "AOL.COM" marks have amounted to many billions of dollars. As a result, the general public has come to associate the "AOL" name and marks with services of a high and uniform quality.

Because of these substantial advertising expenditures and sales, the "AOL" and "AOL.COM" marks have become distinctive, well-known and famous among members of the online purchasing public, if not the general public.

As part of its Entertainment Channel, and through its Moviefone service, AOL provides information and services related to movies and theater. See hard copies of various web pages, from the Complainant's website, provided in Annex G to the Complaint.

Steve Case, the current Chairman of the Board of AOL Time Warner, the parent company of AOL, is a co-founder and former Chairman and Chief Executive Officer of AOL. In that regard, see corresponding descriptive material regarding Stephen M. Case provided, in hard copy form in Annex H to the Complaint, from the Complainant's website.

The Respondent is not named Steve Case. Furthermore, the Complainant states that it has neither licensed nor authorized the Respondent to utilize the "AOL" mark.

Counsel for the Complainant sent the Respondent a letter via Federal Express that set forth the Complainant's rights in its "AOL" and "AOL.COM" marks and requested that the Respondent cease using these marks (a copy of this letter appears in Annex E to the Complaint) and transfer the contested domain names to the Complainant. The letter was subsequently returned by the courier as either refused or undeliverable. Complainant's counsel has provided a copy of returned courier envelope, bearing the "undeliverable/refused" notations noted by the courier, in Annex D to the Complaint.

5. Parties' Contentions

A. Complainant

i. Similarity

The Complainant takes the position that the contested domain names are nearly identical and confusingly similar to its marks "AOL" and "AOL.COM" as to likely confuse Internet users who may believe they are doing business with the Complainant or with an entity whose services are endorsed by, sponsored by, or affiliated with the Complainant; hence, satisfying the confusing similarity requirement in paragraph 4(a)(i) of the Policy.

In that regard, the Complainant contends that consumer confusion is particularly likely because the Respondent is using the distinctive mark "AOL" with generic words such as "movie" and "theatres" and the Complainant provides information and services concerning movies and theaters under its mark "AOL".

In addition, the Complainant states that the Respondent's registration of the contested domain name "stevecaseaol.com" is likely to cause confusion because Steve Case is the co-founder of AOL and his name is nearly synonymous with the mark "AOL".

ii. Legitimacy

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

Specifically, the Complainant contends that the Respondent is not commonly known by either any of the contested domain names or the name Steve Case and is neither licensed nor authorized by the Complainant to use the mark "AOL".

In addition, the Complainant contends that based upon the fame of the Complainant's marks, the Complainant's trademark registrations for the "AOL" and "AOL.COM" marks, the Respondent's use of Mr. Case's name in connection with an "AOL" domain name, and the Respondent's pattern of registering infringing domains, the Respondent cannot, in good faith, claim that it had no knowledge of the Complainant's rights in its marks "AOL" and "AOL.COM". Accordingly, the Complainant concludes that the Respondent cannot claim, in good faith, that he made a legitimate noncommercial or fair use of the domain name, or that he is commonly known by the names "AOL" or Steve Case.

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

iii. Bad Faith

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

First, the Complainant contends that the Respondent registered and used the contested domain names with a bad faith intent to capitalize on the famous marks "AOL" and

"AOL.COM", and profit from international and domestic goodwill which AOL has created in those famous marks.

Second, the Complainant points to the following acts of the Respondent where each evidences bad faith registration and use of the contested domain names:

- (a) Respondent's registration of the contested domain names many years after the Complainant's adoption and first use of its marks "AOL" and "AOL.COM", and long after the mark "AOL" was registered in the United States.
- (b) Respondent's registration of multiple domain names, where each such name infringes upon and incorporates the Complainant's mark "AOL" as well as Mr. Case's name. The Complainant contends that registration of multiple domain names constitutes a pattern of conduct by the Respondent which prevented the Complainant trademark owner from reflecting its mark in domain names; hence, violating paragraph 4(b)(ii) of the Policy.
- (c) Respondent's failure to either provide its correct mailing address to the registrar, or Respondent's refusal to accept mail, particularly the cease and desist letter sent by Complainant's counsel, at the address provided in the Whois records. The Complainant contends that these acts have been viewed by other panels as being consistent with bad faith registration and use of domain names that infringe upon third party marks.

Therefore, the Complainant concludes that the Respondent's conduct in registering and using each of the contested domain names constitutes bad faith registration and use under paragraph 4(a)(iii) of the Policy.

B. Respondent

The Respondent has not filed any substantive Response to the allegations raised in the Complaint.

6. Discussion and Findings

In view of the lack of a response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(e), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed representations. In that regard and apart from judging this proceeding through mere default of the Respondent, the Panel makes the following specific findings.

i. Similarity

No doubt exists whatsoever that each of the contested domain names is nearly identical to the Complainant's "AOL" and "AOL.COM" marks. The primary difference between each of these domain names and the registered marks is simply the inclusion of a generic word or the name "steve case" in the latter. Specifically, the contested domain names are formed by separately concatenating the generic terms "box office", "theatres", "movie" and "loves movies" and the name "steve case" to the term "aol" and appending the top level domain, ".com", to the result. Given that the Complainant does

provide information and services related to movies and theaters, it is eminently clear to this Panel that these differences are utterly inadequate to preclude any confusion from occurring.

In that regard, it is beyond question 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 the contested domain name, or were to start using the contested domain name in conjunction with goods and/or services similar to those of the Complainant.

Such confusion, should it occur, would undoubtedly cause Internet users intending to access the Complainant's website, but who reach a website through any one 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, e.g., Ticketmaster Corporation vs. DiscoverNet, Inc.* WIPO Case No. D2001-0252 (April 9, 2001); *Dollar Financial Group, Inc. v VQM NET* FA 96101 (Nat. Arb. Forum January 25, 2001); *eBAY Inc. v. G L Liadis Computing, Ltd. and John L. Liadis d/b/a G L Liadis Computing Ltd.* WIPO Case No. D2000-1463 (January 10, 2001); *Treeforms, Inc. v. Cayne Industrial Sales, Corp.* FA 95856 (Nat. Arb. Forum December 18, 2000) and *The Pep Boys Manny, Moe and Jack of California v. E-Commerce Today, Ltd.* AF-0145 (eResolution May 3, 2000).

Therefore, the Panel finds that each of the contested domain names, i.e., <aolboxoffice.com>, <aoltheatres.com>, <aolmovie.com>, <aollovesmovies.com> and <aolstevecase.com>, sufficiently resembles the Complainant's registered marks as to cause confusion.

Accordingly, the Panel also finds that sufficient similarity exists under paragraph 4(a)(i) of the Policy for each of the contested domain names.

ii. Illegitimacy

Based on its federal service mark registrations, the Complainant has acquired exclusive rights to use its marks "AOL" and "AOL.COM". Furthermore, by virtue of the registration of these marks, the US PTO has implicitly recognized that each of these marks has acquired appropriate secondary meaning in the marketplace.

The Respondent has not provided any basis that would legitimize any claim it has to the contested domain name. In fact, the Panel believes that, under the present facts, it is extremely unlikely that the Respondent can even make such a claim.

As noted above, each of the contested domain names incorporates the Complainant's marks "AOL" and "AOL.COM" under which the Complainant provides its services.

Since the Complainant has never authorized the Respondent to utilize either of the marks "AOL" or "AOL.COM" in any manner, nor does the Complainant have any relationship, affiliation or association whatsoever with the Respondent, then any use to which the Respondent were to put of the term "AOL" or "AOL.COM", in connection with services identical or similar to those with which the Complainant is using its marks, would directly violate the exclusive trademark rights now residing in the Complainant -- rights which began accruing to the Complainant over 10 years prior to the date on which all the contested domain names were registered. As such, the Respondent is not commonly known by any of the marks "AOL" or "AOL.COM".

Thus, its continued use of each of the contested domain names violates paragraph 4(c)(ii) of the Policy. See, e.g., *MSNBC Cable, LLC v. Tsysys.com* WIPO Case No. D2000-1204 (December 8, 2000) and *Cabletron Systems, Inc. v. DSL Enterprises* WIPO Case No. D2000-0571 (August 18, 2000).

Furthermore, there is no evidence whatsoever in the record before this Panel that, prior to receiving notice of this dispute, the Respondent, in connection with a bona fide offering of goods or services, was either actually using any of the contested domain names with an existing website or making demonstrable preparations to use that name with such a site.

In light of the above findings, 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 interests in any of the contested domain names, whether on a commercial or non-commercial basis.

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

iii. Bad Faith

The Panel, pursuant to Rule 14(b), infers from the lack of any Response that the Respondent intentionally chose each of the five contested domain names for its substantial and confusing resemblance to the Complainant's mark "AOL".

Clearly, the Panel believes that in registering multiple domain names, where each of which unquestionably infringes the Complainant's famous mark "AOL", the Respondent's primary intention in doing so was, at some point in the future, to likely effectuate either one of two goals. First, the Respondent may well have intended, at some point in time, to sell, rent or otherwise transfer that domain name to the Complainant or to its competitor, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly related to the domain name; hence, violating paragraph 4(b)(i) of the Policy.

If the goal of the Respondent was not to obtain future pecuniary gain from its actions, then why would it have chosen each of the contested domain names that incorporates, verbatim, the Complainant's well-known and famous mark "AOL"? Given the lack of any Response, the Panel believes that, if the Respondent did not harbor this goal, the Respondent would have had no reason to choose any of these names and, in all likelihood, would not have done so.

Alternatively, since registration of five infringing domain names undeniably evidences a "pattern" of conduct, the Respondent may well have intended to prevent the Complainant from reflecting its "AOL" mark in a corresponding domain name; hence violating paragraph 4(b)(ii) of the Policy, and possibly with a goal toward again attaining excessive compensation from the Complainant and/or harm the Complainant in some, yet to be determined, fashion.

Furthermore, given the long, widespread notoriety and extensive consumer recognition and fame attendant to the Complainant's mark "AOL" with use of this mark starting over 10 years prior to the date on which the Respondent registered each of the contested domain names, the Panel infers, and it strains credulity to think otherwise, that the Respondent was well aware of the Complainant's mark "AOL" but deliberately chose,

in spite of that knowledge, to register all the contested domain names where each identically incorporated this mark, and with the intent of misappropriating and financially benefiting, to the detriment of the Complainant, from the goodwill inherent in its "AOL" mark. See, e.g., *Ticketmaster Corporation vs. DiscoverNet, Inc.*, cited *supra*.

Hence, the Respondent's acts in registering each of the contested domain names clearly constituted bad faith registration.

As to bad faith use, the Panel infers, based on a lack of any evidence to the contrary in the present record, that, since registering the contested domain names on January 10, 2000 -- some 18 months ago, the Respondent has not yet made any use whatsoever of any of the five contested domain names -- let alone in conjunction with any activities aimed at developing a website reachable through any of these domain names for the bona fide offering of goods or services.

There is simply no evidence whatsoever in the record before the Panel that the Respondent ever intended or now intends to develop such a site or utilize any of the contested domain names to any further extent that it is now doing. Moreover, given the Complainant's exclusive trademark rights in its marks "AOL" and "AOL.COM", the Respondent, in all likelihood, is simply precluded from posting such a site for any products competitive with those set forth in the Complainant's trademark registrations without infringing either of these marks.

Furthermore, the Respondent either failed to update his registration records at NSI with his correct, current address, as required by its registration agreements, or simply refused to accept the correspondence (cease and desist letter) addressed to him from the Complainant. As a result of either cause, the Respondent effectively frustrated an attempt by the Complainant to apprise him of the Complainant's lawful rights in the five contested domain names.

As indicated above, the Panel infers that the Respondent deliberately chose each of the contested domain names fully aware and in spite of the Complainant's rights in its registered mark "AOL". Hence, at the time the Respondent would have received the Complainant's correspondence -- had he accepted it, the Respondent already had such knowledge of the Complainant's rights, but chose to utterly ignore those rights. Consequently, the Panel infers that the Respondent's motivations at that point were simply to: (a) increase the time, to as long as possible, during which he retained the contested domain names, and (b) force the Complainant to expend further time and resources, in the form of initiating this proceeding, to ultimately retrieve these names.

In view of these factors taken collectively, the Respondent's continuing retention and non-use of each of the contested domain names, now over a period stretching in excess of approximately 18 months, amounts to passive holding which unquestionably reflects bad faith use.

Various panels have held that passive holding, coupled with a respondent's knowledge of trademark rights of a complainant in the name being so held, can amount to bad faith use. In that regard, see, e.g., *Awesome Kids LLC and/or Awesome Kids L.L.C. v. Selavy Communications* WIPO Case No. D2001-0210 (April 16, 2001); *Liberty Public Limited Company v. Thomas Guarrera* FA 95103 (Nat. Arb. Forum August 17, 2000); *V & S Vin & Spirit Aktiebolag v. Gunnar Hedenlans Peev* FA 95078 (Nat. Arb. Forum August 9, 2000); and *Telstra Corporation Limited v. Nuclear Marshmallows* WIPO

Case No. D2000-0003 (February 18, 2000). Under the present facts, this Panel sees no reason to depart from that view, particularly since the Respondent here compounded the "bad faith" nature of its conduct by deliberately preventing (through one way or another) the Complainant's correspondence from reaching him, which, in turn, forced the Complainant to institute this proceeding. Hence, the Respondent's post-registration activities regarding each of the contested domain names clearly constitute bad faith use.

Therefore, the Panel finds that the Complainant has shown a sufficient basis to establish bad faith registration and use of each of the contested domain names under paragraph 4(a)(iii) of the Policy.

Thus, the Panel concludes that the Complainant, even apart from default of the Respondent, has provided sufficient proof of its allegations to establish a prima facie case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

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

Each of the contested domain names, specifically: <aolboxoffice.com>, <aoltheatres.com>, <aolmovie.com>, <aollovesmovies.com> and <aolstevecase.com>, is ordered transferred to the Complainant.

Peter L. Michaelson, Esq.
Sole Panelist

Dated: June 13, 2001