

1.

ORGANISATION MONDIALE
DE LA PROPRIÉTÉ INTELLECTUELLE

Centre d'arbitrage et de médiation de l'OMPI



WORLD INTELLECTUAL
PROPERTY ORGANIZATION

WIPO Arbitration and Mediation Center

October 31, 2000

**Re: Case No. D2000-0991 –
[<aolmex.com>]
Notification of Decision**

Please find attached the full text of the decision issued on October 15, 2000 by the Administrative Panel in the above-referenced case.

The Administrative Panel's finding is as follows:

"The Sole Panelist concludes (a) that the Domain Name <aolmex.com> is confusingly similar to Complainant's registered trademarks AOL, AOL.COM and AOLMEXICO, (b) that Respondent has no rights or legitimate interest in the Domain Name and (c) that Respondent registered and used the Domain Name in bad faith. Therefore, pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the Sole Panelist orders that the Domain Name be transferred to America Online, Inc."

Pursuant to Paragraph 4(k) of the Uniform Domain Name Dispute Resolution Policy, the Registrar identified below shall proceed to implement the above decision on the tenth business day (as observed in the location of that Registrar's principal office) after receiving this notification. The concerned Registrar will not implement the decision if, before the 10-day waiting period has expired, the Respondent submits official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) to the Registrar demonstrating that it has commenced a legal proceeding against the Complainant in a jurisdiction to which the Complainant has submitted under Paragraph 3(b)(xiii) of the Rules for Uniform Domain Name Dispute Resolution Policy (the *Rules*).

Pursuant to Rules, Paragraph 16(a), the Registrar is directed to inform the Complainant, the Respondent, the Internet Corporation for Assigned Names and Numbers (ICANN) and the WIPO Arbitration and Mediation Center as soon as possible of the specific date on which the Administrative Panel's decision will be implemented, absent a notification by the Respondent in accordance with the above.

Yours sincerely,

2.

Tom Takahashi
Case Manager

3.

COMMUNICATIONS

This notification is being communicated to the Complainant in accordance with the following contact details:

Complainant

America Online, Inc.
Represented by:
James R. Davis, II
Arent Fox Kintner Plotkin & Kahn
1050 Connecticut Avenue, NW
Washington, DC 20036
Tel: +1 202 857 6169
Fax: +1 202 857 6395
E-mail: davisr@arentfox.com

By the following methods:

- Post/Courier (with original enclosure)
- Facsimile (with attachment)
- E-mail (with attachment)

This notification is being communicated to the Respondent in accordance with the following contact details:

Respondent

Registrant:
Pedro Alex Jimenez (AOLMEX-DOM)
1010 Beale Ave
Bakersville, CA 93305
E-mail: hispa2000@aol.com
Tel: +1 661 634 9870
Fax: +1 510 939 5016

Administrative Contact:
Jimenez, Pedro (PJZ17) hispa2000@AOL.COM
Pedro Jimenez
1010 Beale Avenue
Bakersfield , CA 93305
(661) 634-9870

Technical Contact, Zone Contact:
Mindspring Domreg (MDP-ORG) domreg@MINDSPRING.COM
Earthlink Inc
1430 West Peachtree St. NW, Ste. 400
Atlanta, GA 30309

4.

US
888-932-1997

Billing Contact:

Domain Administrator (MDB5-ORG) domain.billing@MINDSPRING.COM
Earthlink Inc.
1430 W Peachtree St NW Ste 400
Atlanta, GA 30309
US
800-719-4664

By the following methods:

- Post/Courier (with original enclosure)
- Facsimile (with attachment)
- E-mail (with attachment)

This notification is being communicated to the Internet Corporation for Assigned Names and Numbers (ICANN) by the following methods:

- Post/Courier (with original enclosure)
- Facsimile (with attachment)
- E-mail (with attachment)

A copy has also been communicated to the Registrar(s) listed below:

Network Solutions, Inc.

By the following methods:

- Post/Courier (with original enclosure)
- Facsimile (with attachment)
- E-mail (with attachment)



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

America Online, Inc. v. Pedro Alex Jimenez

Case No. D2000-0991

1. The Parties

Complainant is America Online, Inc. ("AOL") a Delaware corporation with its principal place of business located at 22000 AOL Way, Dulles, Virginia, 20166 USA.

Respondent is Pedro Alex Jimenez ("Jimenez") located at 1010 Beale Avenue, Bakersville, California, 93305 USA.

2. The Domain Name(s) and Registrar(s)

The domain name at issue is <aolmex.com> (the "Domain Name"). The registrar is Network Solutions, Inc. (the "Registrar") 505 Huntmar Park Drive, Herndon, Virginia, 20170 USA.

3. Procedural History

The WIPO Arbitration and Mediation Center (the "Center") received the Complaint of Complainant via email on August 9, 2000. On August 11, 2000, the Center received hardcopy of the Complaint.

On August 15, 2000, the Center sent an Acknowledgment of Receipt of Complaint to Complainant. The Complainant paid the required fee.

On August 21, 2000, after sending a Request for Verification to the Registrar requesting verification of registration data, the Registrar confirmed, *inter alia*, that it is the registrar of the Domain Name and that the Domain Name is registered in the Respondent's name.

On August 21, 2000, the Center verified that the Complaint satisfies the formal requirements of the ICANN Uniform Domain Name Dispute Resolution Policy (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

On August 25, 2000, the Center sent a Notification of Complaint and Commencement

of Administrative Proceeding to the Respondent together with copies of the Complaint, with a copy to the Complainant. This notification was sent by the methods required under paragraph 2(a) of the Rules.

On September 15, 2000, the Center advised Respondent that it was in default for failing to file its Response. No Response has been received.

On September 29, 2000 after the Center received a completed and signed Statement of Acceptance and Declaration of Impartiality and Independence from Richard W. Page (the "Sole Panelist"), the Center notified the parties of the appointment of a single-arbitrator panel consisting of the Sole Panelist.

4. Factual Background

AOL is the owner of numerous trademark registrations worldwide for the mark AOL, including U.S. Registration Nos. 1,977,731 and 1,984,337, which were registered on June 4, 1996, and July 2, 1996, respectively.

AOL also owns federal trademark registration Nos. 2,325,291 and 2,325,292 for the mark AOL.COM. The mark AOL is used extensively at this portal Web site, which is a significant method of promoting AOL's service. As a result, consumers associate the mark AOL, when used in a domain name, with AOL's services.

AOL frequently uses AOL as a prefix in its marks, e.g., AOL ANYWHERE, AOLTV (all the AOL marks hereinafter collectively the "AOL Marks"). AOL also uses AOL as a prefix in marks used in connection with its international online services, e.g., AOL MEXICO.

Long prior to Respondent's registration of the domain name <aolmex.com>, and at least as early as 1989 for the mark AOL and 1992 for the mark AOL.COM, AOL adopted and began using its marks in connection with computer online services and other Internet-related services. AOL has used its famous and distinctive marks continuously and extensively in interstate and international commerce in connection with the advertising and sale of its Internet and computer-related services.

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

With over twenty-two million subscribers, AOL 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 Marks; millions more are exposed to said marks through advertising and promotion.

The AOL Marks have been and continue to be widely publicized through substantial advertising throughout the United States and the world. Many millions of dollars have been spent in connection with such advertising, which has been disseminated through network and cable television programs, radio broadcasts, and in print media including newspapers and periodicals.

Sales of services under the AOL 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 distinctive AOL Marks have become well-known and famous among members of the purchasing public.

On December 2, 1999, long after AOL's adoption and first use of the AOL Marks, Respondent registered the Domain Name <aolmex.com> using the Registrar and began using it in connection with a commercial website in Spanish that contains links to adult pornographic websites.

5. Parties' Contentions

- A. Complainant contends that it has registered trademarks in AOL, AOL.COM and AOLMEXICO. Complainant further contends that the Domain Name is identical with and confusingly similar to the AOL, AOL.COM and AOLMEXICO trademarks pursuant to the Policy paragraph 4(a)(i).

Complainant contends that Respondent has no rights or legitimate interest in the Domain Name pursuant to the Policy paragraph 4(a)(ii).

Complainant contends that Respondent registered and is using the Domain Names in bad faith in violation of the Policy paragraph 4(a)(iii).

- B. Respondent does not contest Complainant's assertion that it has registered trademarks in AOL, AOL.COM and AOLMEXICO or that the Domain Name is identical with and confusingly similar to the trademarks.

Respondent failed to contest Complainant's assertion that Respondent has no rights or legitimate interest in the Domain Name.

Respondent failed to contest Complainant's assertion that Respondent registered and used the Domain Name in bad faith.

6. Discussion and Findings

Even though Respondent has failed to file a Response or to contest Complainant's assertions, the Sole Panelist will review the evidence proffered by Complainant to verify that the essential elements of the claims are met.

Identity or Confusing Similarity

The Domain Name <aolmex.com> uses the AOL and AOL.COM trademarks. In addition, the Domain Name uses the common abbreviation "mex" for Mexico. The Sole Panelist finds that the Domain Name is confusingly similar with each of the AOL, AOL.COM and AOLMEXICO trademarks pursuant to the Policy paragraph 4(a)(i).

Rights or Legitimate Interest

Complainant contends that Respondent has no rights or legitimate interest in the Domain Name pursuant to the Policy paragraph 4(a)(ii).

Respondent has no relationship with or permission from Complainant for the use

of the AOL, AOL.COM or the AOLMEXICO trademarks.

The Policy paragraph 4(c) allows three non-exclusive methods for Respondent to demonstrate that it has rights or a legitimate interest in the Domain Names:

- (i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
- (iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Respondent has offered no evidence that the use of the Domain Name meets the elements for any of the non-exclusive methods provided for in the Policy paragraph 4(c). Therefore, the Sole Panelist finds that Respondent has no rights or legitimate interest in the Domain Name pursuant to the Policy paragraph 4(a)(ii).

Bad Faith

Complainant contends that Respondent registered and is using the Domain Names in bad faith in violation of the Policy paragraph 4(a)(iii).

The Policy paragraph 4(b) sets forth four non-exclusive criteria for Complainant to show bad faith registration and use of domain names:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product

Respondent registered the Domain Name on December 2, 1999, long after AOL's adoption and first use of the AOL Marks and long after the mark AOL was registered in

the United States. Respondent continues to use the Domain Name despite having received a letter from AOL's counsel, explaining AOL's rights in its marks and objecting to Respondent's registration and use of the Domain Name. Furthermore, Respondent's email address is hispa2000@aol.com. The Sole Panelist finds that the Respondent has actual knowledge of the AOL Marks and that Respondent's continued use of the Domain Name in this manner shows that Respondent is intentionally attracting Internet users to his website by creating confusion with the AOL Marks.

Respondent has not contested the allegations of AOL that he is using the Domain Name in connection with a commercial website in Spanish with links to adult pornographic websites. Therefore, the Sole Panelist finds that Respondent is engaged in commercial activities through his website.

The Sole Panelist finds that Complainant has shown the elements of the Policy paragraph 4(b)(iv) and finds that the Domain Name was registered and used in bad faith pursuant to the Policy paragraph 4(a)(iii).

7. Decision

The Sole Panelist concludes (a) that the Domain Name <aolmex.com> is confusingly similar to Complainant's registered trademarks AOL, AOL.COM and AOLMEXICO, (b) that Respondent has no rights or legitimate interest in the Domain Name and (c) that Respondent registered and used the Domain Name in bad faith. Therefore, pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the Sole Panelist orders that the Domain Name be transferred to America Online, Inc.

Richard W. Page
Presiding Panelist

Dated: October 15, 2000