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ORGANISATION MONDIALE  
DE LA PROPRIÉTÉ INTELLECTUELLE



WORLD INTELLECTUAL  
PROPERTY ORGANIZATION

Centre d'arbitrage et de médiation de l'OMPI

WIPO Arbitration and Mediation Center

October 6, 2000

**Re: Case No. D2000-0979 –**  
[<icqpornjokes.com><icqsexchat.com><freeicqsex.com>]  
**Notification of Decision**

Please find attached the full text of the decision issued on October 4, 2000 by the Administrative Panel in the above-referenced case.

The Administrative Panel's finding is as follows:

- "(a) that the domain names registered by the Respondent are confusingly similar to the trademark to which the Complainant has rights;**
- (b) that the Respondent has no rights or legitimate interests in respect of the domain names; and**
- (c) the Respondent's domain names have been registered and are being used in bad faith.**

**Accordingly, pursuant to paragraph 4(i) of the Policy, the Panel requires that the registration of the domain names "icqpornjokes.com", "icqsexchat.com" and "freeicqsex.com" be transferred to the Complainant."**

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 at which the Administrative Panel's decision will be implemented, absent a notification by the Respondent in accordance with the above.

Yours sincerely,

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Tom Takahashi  
Case Manager

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**COMMUNICATIONS**

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

**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:

Belmont Studios, Ltd.  
Brian Erickson  
210 Ste. Catherine St. E., Suite 201  
Montreal, QC H2X 1L1  
Canada  
Tel.: +1 514 393 144x228  
Fax: +1 514 393 1231  
E-mail: admin@belmont.com

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)

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- 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. Belmont Studios Ltd**

**Case No. D2000-0979**

#### **1. The Parties**

The Complainant is America Online Inc., a Delaware corporation with its principal place of business at 22000 AOL Way, Dulles, Virginia, U.S.A. The Complainant is represented by Mr. James R. Davis II of Arent Fox Kintner Plotkin & Kahn, Attorneys of Washington, DC, U.S.A.

The Respondent is Belmont Studios Ltd, a Canadian corporation of 210 Ste. Catherine St. E. Suite 201, Montreal, Quebec, Canada. The Respondent is represented by Mr. Brian Erickson of the same address.

#### **2. The Domain Name and Registrar**

The domain names at issue are "icqpornjokes.com", "icqsexchat.com" and "freeicqsex.com". The domain names are registered with Network Solutions Inc., 505 Huntmar Park Drive, Herndon, Virginia 20170, U.S.A. ("NSI"). The names were registered on April 15, 1999.

#### **3. Procedural History**

The Complaint submitted by America Online Inc. was received on August 8, 2000, (electronic version) and August 10, 2000, (hard copy) by the World Intellectual Property Organization Arbitration and Mediation Center ("WIPO Center").

On August 16, 2000, a request for Registrar verification was transmitted by the WIPO Center to NSI, requesting it to:

Confirm that a copy of the Complaint had been sent to it by the Complainant as required by the WIPO Supplemental Rules for Uniform Dispute Resolution Policy ("Supplemental Rules"), paragraph 4(b).

Confirm that the domain names at issue are registered with NSI.

Confirm that the person identified as the Respondent is the current registrant of the

domain names.

Provide full contact details, i.e., postal address(es), telephone number(s), facsimile number(s), email address(es), available in the Registrar's WHOIS database for the registrant of the disputed domain names, the technical contact, the administrative contact and the billing contact for the domain names.

Confirm that the Uniform Domain Name Dispute Resolution Policy was in effect.

Indicate the current status of the domain names.

By email dated August 21, 2000, NSI advised WIPO Center as follows:

NSI had received a copy of the Complaint from the Complainant.

NSI is the Registrar of the domain name registrations "icqpornjokes.com", "icqsexchat.com" and "freeicqsex.com".

Belmont Studios Ltd is shown as the "current registrant" of the said domain names. The registrant is identified in NSI records as being at the address shown in paragraph 1 hereof.

The administrative contact is Jack Wasserman. The technical, zone and billing contact is Michael Watt. Both are at the same address as given for the registrant.

NSI's 5.0 Service Agreement is in effect.

The said domain name registrations are in "Active" status.

NSI has currently incorporated in its agreements the policy for Uniform Domain Name Dispute Resolution adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN").

The advice from NSI that the domain names in question are still "active", indicates the Respondent has not requested that the domain names at issue be deleted from the domain name database. The Respondent has not sought to terminate the agreement with NSI. Accordingly, the Respondent is bound by the provisions of NSI's Domain Name Dispute Resolution Policy, i.e., the ICANN policy. The Respondent has not challenged the jurisdiction of the Panel.

Having verified that the Complaint satisfied the formal requirements of the Uniform Policy and the Uniform Rules, the WIPO Center on August 24, 2000, transmitted by post/courier and by email a notification of Complaint and Commencement of Administrative Proceedings to the Respondent. A copy of the Complaint was also emailed to NSI and ICANN.

The Complainant elected to have its Complaint resolved by a single panel member: it has duly paid the amount required of it to the WIPO Center.

The Respondent was advised that a Response to the Complaint was required within 20 calendar days (i.e., by September 12, 2000). The Respondent was also advised that any Response should be communicated, in accordance with the Rules, by four sets of hard copy

and by email. After several communications between the Respondent and WIPO Center, the Respondent filed a Response by email on September 14, 2000 and by hard copy (one copy only) on September 18, 2000.

On September 21, 2000, the WIPO Center invited the Honourable Sir Ian Barker QC of Auckland, New Zealand, to serve as Sole Panelist in the case. It transmitted to him a statement of acceptance and requested a declaration of impartiality and independence.

On September 21, 2000, the Honourable Sir Ian Barker QC advised his acceptance and forwarded to the WIPO Center his statement of impartiality and independence. The Panelist finds that the Administrative Panel was properly constituted in accordance with the Rules and the Supplemental Rules.

On September 22, 2000, WIPO Center forwarded to the Honourable Sir Ian Barker QC by courier the relevant submissions and the record. These were received by him on September 29, 2000. In terms of Rule 5(b), in the absence of exceptional circumstances, the Panel would have been required to forward its decision by October 5, 2000.

The Panel has independently determined and agrees with the assessment of WIPO Center that the Complaint meets the formal requirements of the Rules for Uniform Domain Name Dispute Resolution Policy as approved by ICANN on October 24, 1999, ("the Rules") and the Supplemental Rules.

The language of the administrative proceeding is English, being the language of the registration agreement.

#### **4. Factual Background**

The Complainant is the owner of trademark registrations for the mark "ICQ" in 10 different countries (including China). It has pending trademark applications in some 50 other countries, including the United States. The mark has been used at least since 1996 in connection with telecommunications services, namely, services relating to electronic transmission of data, images and documents via computer terminals, electronic storage and retrieval of data and documents, electronic mail services, facsimile transmission, personal communication services paging services and messaging services; 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, websites, online chat rooms, and electronic yellow pages that may be downloaded from a computer information network; and computer services, namely, providing multiple user access to computer information networks and online communication networks; providing online services, namely, electronic yellow pages, and providing general interest information via computer networks.

The Complainant also owns numerous trademarks, service marks and trade names, which include the mark "ICQ" (e.g., "ICQ Phone", "ICQ Radio"). It uses the mark "icq.com" as the domain name for its portal website. "ICQ" marks are used extensively at this portal website.

From at least as early as 1996, the Complainant and its predecessor-in-interest adopted and

began using ICQ marks in connection with computer online and other internet-related services.

With some 50 million subscribers, the Complainant claims to be the world's largest online communications provider, with millions of people world-wide obtaining services offered under "ICQ" marks.

Advertising and promotions in a variety of languages expose many millions more to ICQ's offerings with the result that ICQ's mark must be well-known in many countries of the globe. The Complainant's sales have amounted to many millions of dollars, with large sums having been spent by it in promotional activities and in development.

When the Respondent registered the disputed domain names on April 15, 1999, it had no authority from the Complainant to do this. The Respondent has never been licensed by the Complainant to have any interest in any of its marks.

On July 27, 2000 the Complainant's lawyers wrote to the Respondent informing it of the Complainant's intellectual property rights and objecting to its use of the disputed domain names. The Respondent claims that it did not receive this letter and that in any event the letter gave only 5 days for reply, including a weekend.

The Respondent has registered other domain names that make unauthorized use of trademarks and/or well-known persons. The Complainant cites in this category "mp@yahoosex.com" and "pamela-anderson-pics.com".

#### **5. Parties' Contentions**

The Complainant submits that the only possible conclusion must be the Respondent registered and is using its world-famous mark, "ICQ", in bad faith. It claims that:

- (a) The domain names are confusingly similar to its numerous ICQ marks. The addition of the words "pornjokes", "sexchat" and "free...sex" tarnish the mark and lead users of the internet to believe that the Complainant endorses or is affiliated with pornographic websites.
- (b) The Respondent has no rights or legitimate interest in respect of the domain names.
- (c) Registration and use in bad faith is shown by:
  - (i) The registration of the domain names by the Respondent on April 15, 1999, years after the Complainant's first use of the mark "ICQ".
  - (ii) The Respondent's failure to reply to the Complainant's letter of July 27, 2000 and its failure to cease to use the names.
  - (iii) The world-wide fame of the mark.
  - (iv) The Respondent's website clearly indicates a connection between that website and the Complainant's.
  - (v) The Respondent's registration of other names which associate well-known

marks with suggestive connotations.

The Respondent submitted:

- (a) The "cease and desist" letter of the Complainant is evidence of bad faith in that there was no proof of its having been mailed or delivered and that the letter gave an unreasonable time for reply.
- (b) The Complainant does not hold a trademark in Canada where the registrant does business.
- (c) The Respondent does not offer services related to those promoted by the Complainant's mark. The disputed domain names contain "adult-oriented text stories", whereas the Complainant's mark relates to telecommunications and computer networks.
- (d) The Complainant's website for its ICQ product does not refer to its trademark.
- (e) The letters "ICQ" are used in 1,674 top level domain names. Thus, the number of registered domain names exceeds the number of domain names for other trademarked products.
- (f) There are over 44 competing computer communication programs using the ICQ protocol or the letters "ICQ" in their name.
- (g) The Complainant has a "history of bad faith dealings" in relation to domain names. The Respondent submitted as an exhibit a report of dealings involving domain names over which the Complainant had procured transfer or cancellation. However, the Respondent claims that the disputed domain names were of little value to it. Therefore, it offered, *inter alia*, to transfer the domain names to the Complainant for the registration fees -- i.e., \$210 or, alternatively, to "unregister" them.

The Panel accordingly instructed WIPO Center to inquire of the Complainant whether it wished a decision in the circumstances of the matter being apparently capable of resolution.

WIPO Center advised the Complainant's attorneys accordingly.

On September 28, 2000, the Complainant's attorneys wrote to the Respondent. The Complainant refused to reimburse the Respondent for the registration fees, but was prepared to withdraw the proceedings if the Respondent transferred the names to it. As at October 2, 2000 the Complainant's attorneys had received no response from the Respondent.

Accordingly, on October 3, 2000, the Complainant's attorneys advised WIPO Center, which duly advised the Panel, that it wished a decision to be issued.

## 6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the 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”.

The burden for the Complainant, under paragraph 4(a) of the ICANN Policy, is to show:

- That the domain names registered by the Respondent are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- That the Respondent has no rights or legitimate interests in respect of the domain names; and
- That the domain names have been registered and are being used by the Respondent in bad faith.

The domain names “icqpomjokes.com”, “icqsexchat.com” and “freeicqsex.com” are, in the judgment of the Panel, confusingly similar to the Complainant’s mark “ICQ”. The additions of the suggestive sexual words does nothing to deflect the impact on the viewer of the mark “ICQ”. I refer to my discussion of relevant trademark law on the wording of infringing marks in *AT&T Corp v Tala Alamuddin* (WIPO Case No. D2000-0249) in section 6 of that decision. Rather, the Complainant’s mark is severely tarnished by references that might cause the internet user to believe that the Complainant either endorses or is associated with pornographic websites.

Likewise, the Panel decides that the Respondent has no rights or legitimate interests in the domain names at issue. The Respondent has never suggested to the contrary. The Panel so decides. The Respondent has offered no evidence that it is known by any of the names.

Paragraph 4(b) of the ICANN Policy states:

“For the purposes of Paragraph 4(a)(iii), the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (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 online 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 or service on your web site or location.”

It should be noted that the circumstances of bad faith are not limited to the above.

The Panel considers that the Respondent has registered and used the disputed domain names in bad faith for the reasons set out in its summary of the Complainant's submissions and in particular:

- (a) The letters "ICQ" are obviously connected with services provided by the Complainant's world-wide business. Their very use by someone with no connection with the Complainant suggests opportunistic bad faith.
- (b) Because of the extensive operations of the Complainant, the Panel infers that the registration was in bad faith. The Respondent clearly looked for a famous mark on which to add its pornographic offerings.
- (c) The Respondent's use of the names and its refusal to desist indicates bad faith use.

The present situation is similar to that in *Educational Tertiary Service v. TOEFL* (WIPO Case D2000-0044) where the learned Panelist said:

"The value which Respondent seeks to secure from sale of the domain name is based on the underlying value of Complainant's trademark. This value is grounded in the right of Complainant to use its mark to identify itself as a source of goods or services. Respondent has failed to establish any legitimate domain name-related use for Complainant's trademark, in a context in which such legitimization might be possible. The Respondent having failed to present any such justification, the Panel may reasonably infer that Respondent neither intended to make nor has made any legitimate use of Complainant's trademark in connection with the [domain name] at issue."

The Respondent's submissions are without merit:

- (a) There is no obligation on a Complainant to issue a "cease and desist" letter. One is quite usual, but in a blatant case such as the present, it is not necessary.
- (b) The fact that the Complainant may not hold a trademark in Canada is irrelevant. The test under the Policy is that the Complainant owns a registered mark. The country of registration is unimportant under paragraph 4(a)(i) of the Policy.
- (c) The fact that the Respondent's products are not the same as the Complainant's is hardly a factor in favor of the Respondent. The addition of an obvious pornographic element to the Complainant's mark is a clear tarnishing of that mark.
- (d) The fact that there may be other persons using the letters "ICQ" in domain names is irrelevant. The Panel is concerned only with the facts of this Complaint.
- (e) The Panel is not entitled to consider any dealings of the Complainant in relation to other domain names alleged to have infringed its mark(s).

In any event, the attitude of the Respondent that it does not wish to continue using the disputed names and would be prepared (at the time of the Response) to have transferred them for \$210, is a virtual capitulation and an indication that the Respondent must realize that its defence is unlikely to succeed.

Accordingly, for all the various reasons discussed above, the Panel finds that the disputed domain names have been registered and are being used by the Respondent in bad faith.

#### 7. Legal Considerations

Although entitled to consider principles of law deemed applicable, the Panel finds it unnecessary to do so in any depth. The jurisprudence which is being rapidly developed by a wide variety of WIPO Panelists under the ICANN Policy provides a fruitful source of precedent. Blatant attempts to hijack or tarnish names which enjoy world-wide acceptance have been vigorously discouraged.

The decisions of United States Courts cited by the Complainant indicate that the Respondent's use of the disputed domain name dilutes unlawfully the Complainant's mark. The mark appears to meet the criteria for being "famous" found in the US Federal Trademark Dilution Act 1995: see *Hasbro Inc. v. Internet Entertainment Group Ltd*, 1996 WL 84853 (W.D. Wash. 1996). The Respondent is tarnishing and therefore diluting the Complainant's mark by linking it to an "adult" website.

A similar situation to the present came before the High Court of New Zealand in *New Zealand Post Ltd v Leng* [1999] 3 NZLR 219. There, the New Zealand postal administration, known as NZ Post, objected to the defendant's registration of a domain name "nzpost.com". The site contained links directing the browser to pornographic material. The Court granted the injunction sought by NZ Post, holding that the defendant's domain name was an instrument of deception, if not of fraud. The Court followed English and US authorities to similar effect. See also this Panelist's decision in *Singapore Airlines Limited v. Robert Nielson (trading as Pacific International Distributors)* (WIPO Case No. D2000-0644).

#### 8. Decision

For the foregoing reasons, the Panel decides:

- (a) that the domain names registered by the Respondent are confusingly similar to the trademark to which the Complainant has rights;
- (b) that the Respondent has no rights or legitimate interests in respect of the domain names; and
- (c) the Respondent's domain names have been registered and are being used in bad faith.

Accordingly, pursuant to paragraph 4(i) of the Policy, the Panel requires that the registration of the domain names "icqpornjokes.com", "icqsexchat.com" and "freeicqsex.com" be transferred to the Complainant.

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Hon Sir Ian Barker QC  
Presiding Panelist

Dated: October 4, 2000