

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 10, 2000

Re: Case No. D2000-0978 –
[<dicq-it.com>]
Notification of Decision

Please find attached the full text of the decision issued on September 29, 2000 by the Administrative Panel in the above-referenced case.

The Administrative Panel's finding is as follows:

“For all of the foregoing reasons, the Panel decides that the domain name registered by Respondent is identical and confusingly similar to the trademarks and service marks in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name at issue, and that the Respondent's domain name has been registered and is being used in bad faith. Accordingly, pursuant to Paragraph 4,i of the Policy, the Panel requires that the registration of the domain name <icq-it.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 on which the Administrative Panel's decision will be implemented, absent a notification by the Respondent in accordance with the above.

Yours sincerely,

Tom Takahashi
Case Manager

2.

COMMUNICATIONS

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

American 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:

Registrant:
Connect at 50 Plus (ICQ-IT-DOM)
601 Tiffin Avenue
Findlay, OH 45840
US
Tel: +1 419 422 6021
E-mail: rah45840@sprynet.com
Webmaster@connectat50plus.com

Administrative Contact, Technical Contact, Zone Contact, Billing Contact:
Wallace, R.A (RW8642) rah45840@SPRYNET.COM
Connect at 50 Plus
601 Tiffin Avenue
Findlay, OH 45840
Tel: +1 419-422-6021 (FAX) NA

By the following methods:

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

3.

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. Connect at 50 Plus

Case No. D2000-0978

1. The Parties

The Complainant is America Online, Inc., a corporation organized under the laws of the State of Delaware, United States of America, having its principal place of business at 22000 AOL Way, Dulles, Virginia, United States of America.

The Respondent is Connect at 50 Plus, an entity having an address at 601 Tiffin Avenue, Findlay, Ohio, United States of America.

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

The domain name at issue is <icq-it.com>, which domain name is registered with Network Solutions, Inc., based in Herndon, Virginia, United States of America.

3. Procedural History

A Complaint was submitted electronically to the World Intellectual Property Organization Arbitration and Mediation Center (the "WIPO Center") on August 8, 2000, and the signed original together with four copies was received on August 10, 2000. An Acknowledgment of Receipt was sent by the WIPO Center to the Complainant, dated August 15, 2000.

On August 16, 2000, a Request for Registrar Verification was transmitted to the registrar, Network Solutions, Inc. ("NSI") requesting it to: (1) confirm that the domain name at issue is registered with NSI; (2) confirm that the person identified as the Respondent is the current registrant of the domain name; (3) provide the full contact details (i.e., postal address(es), telephone number(s), facsimile number(s), e-mail address(es)) available in the registrar's Whois database for the registrant of the disputed domain name, the technical contact, the administrative contact and the billing contact; (4) confirm that the Uniform Domain Name Dispute Resolution Policy (the "Policy") is in effect; (5) indicate the current status of the domain name.

On August 21, 2000, NSI confirmed by reply e-mail that the domain name at issue is registered with NSI, is currently in active status, and that the Respondent is the current registrant of the name. The registrar also forwarded the requested Whois details, and confirmed that the Policy is in effect.

The WIPO Center determined that the Complaint satisfies the formal requirements of the Policy, the Rules for Uniform Domain Name Dispute Resolution Policy (the "Uniform Rules") and the Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules"). The Panel has independently determined and agrees with the assessment of the WIPO Center that the Complaint is in formal compliance with the requirements of the Policy, the Uniform Rules, and the Supplemental Rules. The required fees for a sole Panelist were paid on time and in the required amount by the Complainant.

No formal deficiencies having been recorded, on August 24, 2000, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification") was transmitted to the Respondent (with copies to the Complainant, NSI and ICANN), setting a deadline of September 12, 2000, by which the Respondent could file a Response to the Complaint. The Commencement Notification was transmitted to the Respondent by e-mail to the e-mail addresses indicated in the Complaint and specified in NSI's confirmation. In addition, the complaint was sent by express courier to the postal address given. Having reviewed the communications records in the case file, the Administrative Panel finds that the WIPO Center has discharged its responsibility under Paragraph 2(a) of the Uniform Rules "to employ reasonably available means calculated to achieve actual notice to Respondent."

On September 15, 2000, not having received any response, the WIPO Center sent the parties a formal Notification of Respondent Default.

On September 22, 2000, in view of the Complainant's designation of a single Panelist, the WIPO Center appointed M. Scott Donahey to serve as sole Panelist.

4. Factual Background

Complainant has registered the marks "ICQ" and "ICQ IT!" in connection with telecommunications services, computer operating programs, and computer services in ten countries worldwide and has pending trademark applications in at least fifty other countries, including the United States.

Complainant has used the ICQ mark in connection with such goods and services since at least as early as November 1996, and has used the ICQ IT! mark in connection with an Internet search engine since at least as early as December 1998.

The ICQ mark is used extensively on Complainant's portal web site located at www.icq.com.

Complainant has invested substantial sums of money in developing and marketing its services. ICQ is the world's largest online communications community, with more than fifty million subscribers, and many millions of dollars have been spent in connection with advertising and promoting the mark.

On October 30, 1999, Respondent registered the domain name <icq-it.com>.

Respondent has used the domain name to develop a web site that offers online dating services and links to adult content web sites.

On March 16, 2000, Complainant has sent Respondent a letter requesting transfer of the domain name at issue.

In response to this letter, On March 27, 2000, Respondent sent Complainant an email refusing to transfer the domain name at issue and offering to sell it to Complainant.

5. Parties' Contentions

Complainant contends that Respondent has registered as a domain name a mark which is identical or confusingly similar to the trade mark and service mark registered and used by Complainant, that Respondent has no rights or legitimate interests in respect of the domain name at issue, and that Respondent has registered and is using the domain name at issue in bad faith.

Respondent has not contested the allegations of the Complaint.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: "A Panel shall 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."

Since both the Complainant and Respondent are domiciled in the United States, and since United States' courts have recent experience with similar disputes, to the extent that it would assist the Panel in determining whether the Complainant has met its burden as established by Paragraph 4(a) of the Policy, the Panel shall look to rules and principles of law set out in decisions of the courts of the United States.

Paragraph 4(a) of the Policy directs that the Complainant must prove **each** of the following:

- 1) that the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; **and,**
- 2) that the Respondent has no legitimate interests in respect of the domain name; **and,**
- 3) that the domain name has been registered and is being used in bad faith.

The panel finds that the domain name at issue <icq-it.com> is identical to Complainant's ICQ IT! mark and confusingly similar to Complainant's ICQ mark. *SeekAmerica Networks Inc. v. Tariq Masood and Solo Signs*, ICANN Case No.

D2000—0131 (<seek-america.com> found identical to SeekAmerica mark); *InfoSpace.com, Inc. v. Delighters, Inc. d/b/a Joe's Internet Café*, ICANN Case No. D2000-0068 (<myinfospace.com> found confusingly similar to INFOSPACE).

Complainant has alleged and Respondent has failed to deny that Respondent has no legitimate interests in respect of the domain name at issue. *Alcoholics Anonymous World Services, Inc. v. Raymond*, WIPO Case No. D2000-007; *Bronson Plc v. Unimetal Sanayai ve Tic. A.S.*, WIPO Case No. D2000-0011.

Complainant has alleged and the Panel finds that Respondent's use of the domain name at issue to resolve to a web site where services are offered to Internet users is likely to confuse the user and to cause the user to believe that Complainant is the source of or is sponsoring the services offered at the site. This constitutes evidence of bad faith registration and use under the Policy. Policy, Paragraph 4(b)(iv). *InfoSpace.com, Inc. v. Hari Prakash*, ICANN Case No. D2000-0076. The fact that the domain name at issue resolves to a web site which links to sexually explicit web sites has been held to constitute bad faith registration and use. *Bass Hotels & Resorts, Inc. v. Mike Rodgerall*, ICANN Case No. D2000-0568.

7. Decision

For all of the foregoing reasons, the Panel decides that the domain name registered by Respondent is identical and confusingly similar to the trademarks and service marks in which the Complainant has rights, that the Respondent has no rights or legitimate interests in respect of the domain name at issue, and that the Respondent's domain name has been registered and is being used in bad faith. Accordingly, pursuant to Paragraph 4,i of the Policy, the Panel requires that the registration of the domain name <icq-it.com> be transferred to the Complainant.

M. Scott Donahey
Panelist

Dated: September 29, 2000