



February 27, 2001

Re: Case No. D2001-0004
<icqroaming.com>
Notification of Decision

Please find attached the full text of the decision issued on February 22, 2001 by the Administrative Panel in the above-referenced case.

The Administrative Panel's finding is as follows:

“Pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the panel requires the domain name <icqroaming.com> to 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,

Shalini Edirisinghe
Case Manager

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
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By the following methods:

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

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

Anson Chan ansonchan@netzard.com

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Shatin, 852
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Phone: 9656 5621

Administrative Contact: ansonchan@netzard.com

Anson Chan
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By the following methods:

- Post/Courier (with original enclosure)

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)

E-mail (with attachment)

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

Register.com. Inc.

By the following methods:

Post/Courier (with original enclosure)

E-mail (with attachment)



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

America Online, Inc. v. Anson Chan

Case No. D2001-0004

1. The Parties

The Complainant is America Online, Inc., of 22000 AOL Way, Dulles, Virginia 20166, United States of America, represented by James R. Davis, II of Arent Fox Kintner Plotkin & Kahn of Washington, DC .

The Respondent is Anson Chan of Pok Hong Estate, Shatin, 852, Hong Kong, SAR of China.

2. The Domain Name and Registrar

The disputed domain name is < iccroaming.com > and the Registrar is Register.com of New York.

3. Procedural History

This is an administrative proceeding pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”) adopted by the Internet Corporation for Assigned Names and Numbers (“ICANN”) on August 26, 1999, in accordance with the Rules for the Policy, approved by ICANN on October 24, 1999, (“the Rules”) and the Supplemental Rules for the Policy (“the Supplemental Rules”) of the WIPO Arbitration and Mediation Center (“the Center”).

The Complaint was received by the Center by email on January 2, 2001 and in hard copy on January 4, 2001. The Center acknowledged receipt on January 9, 2001 and the next day sought registration details from the Registrar. On January 12, 2001 the Registrar noted that it did not receive a copy of the Complaint from the Complainant, as required by the Supplemental Rules, paragraph 4(b), and confirmed that the Respondent is the registrant and that the Policy is applicable to the disputed domain name. The Registrar’s records indicate that the record was created on August 23, 2000 and that the status of the disputed domain name is “active”.

On January 16, 2001, the Center satisfied itself that the Complainant had complied with all formal requirements of the Rules, including payment of the prescribed fee and that day formally notified the Respondent by post/courier and email of the Complaint and of the commencement of this administrative proceeding and sent copies to the Complainant, the Registrar and ICANN.

The formal date of the commencement of the proceeding was accordingly January 16, 2001. The last day specified in the notice for a response was February 4, 2001. On February 6, 2001, no Response having been filed, the Center notified the Respondent of its default.

On February 13, 2001, the Center notified the parties of the appointment of Alan L Limbury as the administrative panel, Mr. Limbury having submitted a Statement of Acceptance and Declaration of Impartiality. The Center nominated February 26, 2001, as the date by which, absent exceptional circumstances, the panel is required to forward its decision to the Center.

The language of the proceeding was English.

The panel is satisfied that the Complaint was filed in accordance with the requirements of the Rules and Supplemental Rules; payment was properly made; the panel agrees with the Center's assessment concerning the Complaint's compliance with the formal requirements of the Rules; the Complaint was properly notified in accordance with paragraph 2(a) of the Rules; no Response was filed within the time specified by the Rules and the single-member administrative panel was properly constituted.

4. Factual Background

The Complainant is the owner of at least 22 trademark registrations worldwide for the mark ICQ, including registrations in the United States, Australia, Austria, Australia, Benelux, Chile, China, Denmark, Finland, France, Germany, Iceland, Israel, South Korea, Mexico, New Zealand, Norway, Panama, Portugal, Slovenia, Spain, Sweden, and Switzerland.

The mark ICQ has been used since at least as early as November 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" and

"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 chatrooms, 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 on-line services, namely, electronic yellow pages, and providing general interest information via computer networks."

The Complainant is the owner of numerous trademarks, service marks, and trade names that include the mark ICQ, e.g., ICQ Games, ICQ Phone, ICQmail, ICQ Search, ICQ Radio (collectively the ICQ Marks). AOL also uses the mark ICQ.COM as the domain name for its portal Web site for the ICQ service. The ICQ Marks are used extensively at this portal Web site, which is a significant method of promoting the ICQ service.

Long prior to Respondent's registration of the disputed domain name and at least as early as 1996, the Complainant and its predecessor-in-interest adopted and began using many of its ICQ Marks in connection with computer online services and other Internet-related services. Specifically, the ICQ Marks are used in connection with an online service that allows Internet users to meet and communicate through the ICQ service. The distinctive ICQ Marks have been used continuously and extensively in interstate and international commerce in connection with the advertising and sale of these Internet-related services.

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

With over one hundred million subscribers worldwide, ICQ is the world's largest online communications community and each year millions of ICQ customers worldwide obtain services offered under the ICQ Marks; millions more are exposed to said marks through advertising and promotion.

The ICQ 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.

The disputed domain name "icqroaming.com" was registered by the Respondent on August 23, 2000. The Respondent began using it in connection with a commercial Web site called ICQRoaming that provides software services that interact with the Complainant's service. The site provides links to various Internet-related sites that contain commercial advertisements for services that compete with or are similar to the ICQ service.

5. Parties' Contentions

A. Complainant

Sales of services under the ICQ Marks have amounted to many millions of dollars. As a result, the general public has come to associate the Complainant's names and marks with services of a high and uniform quality. Because of these substantial advertising expenditures and sales, the distinctive ICQ Marks have become well-known and famous among members of the purchasing public.

The disputed domain name is confusingly similar to the ICQ Marks, including the famous mark ICQ. The disputed domain name is particularly confusing because it is being used in connection with a Web site that makes prominent use of the ICQ mark and flower logo.

The Respondent has no rights or legitimate interests in respect to the disputed domain name.

The Respondent registered and used the disputed domain name in bad faith to capitalize and profit from the famous mark ICQ and the goodwill the Complainant has built up in its ICQ mark.

The following is evidence of the Respondent's bad faith registration and use of the domain name:

- (a) the Respondent registered "icqroaming.com" many years after the Complainant's adoption and first use of its ICQ Marks;
- (b) on December 1, 2000, Counsel for the Complainant sent the Respondent a letter, explaining the Complainant's rights in its ICQ marks and requesting that the Respondent cease its infringing use of the ICQ mark. The Respondent failed to cease its infringing activity and did not respond to the Complainant's correspondence;
- (c) the Respondent's bad faith use of the disputed domain name is further evidenced by its prominent use of the ICQ mark and flower logo at "icqroaming.com". For example, the Respondent has incorporated portions of the actual ICQ Web site into the ICQRoaming site. This pervasive and unauthorized use of the ICQ mark increases the likelihood that consumers will be confused into believing that the Complainant endorses or is affiliated with the Respondent, or the operators of the Web sites that are promoted at ICQRoaming. The Respondent's prominent use of the ICQ mark at a Web site called ICQRoaming aggravates the Respondent's infringement and is likely to lead consumers falsely to believe that the Complainant endorses or is affiliated with the Respondent or its Web site;
- (d) The Respondent's prominent references to the Complainant's ICQ service prove that the Respondent has knowledge of the ICQ service and mark and that the Respondent is using the domain name "icqroaming.com" and the name ICQRoaming in an effort to confuse consumers and divert them to the Respondent's Web site. The Respondent's registration and use of the disputed domain name in this manner demonstrates its bad faith attempt to profit from the goodwill that the Complainant has created in its ICQ mark;
- (e) in numerous similar ICANN proceedings, the arbitration panel has determined that the Respondent's actions constitute a bad faith registration and use of the ICQ mark. See, e.g., *America Online, Inc. v. OICQ.com, Ltd.* (FA-0004000094420); *America Online, Inc. v. Tencent Communications* (FA0002000093668); *America Online, Inc. v. Chinese ICQ Network* (D2000-0808); *America Online, Inc. v. Shenzhen JZT Computer Software Co., Ltd.* (D2000-0809);

- (f) based upon the correspondence sent by the Complainant, the references to the ICQ service at the Respondent's Web site, and the fame of the mark ICQ, the Respondent cannot, in good faith, claim that it had no knowledge of the Complainant's rights in the mark ICQ. Furthermore, the Respondent cannot claim, in good faith, that it made a legitimate noncommercial or fair use of the domain name.

B. Respondent

There was no response filed.

6. Discussion and Findings

To qualify for cancellation or transfer, a Complainant must prove each element of paragraph 4(a) of the Policy, namely:

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

Failure to file a response

Numerous cases under the Policy have adopted and applied the principle that a Respondent's failure to dispute the allegations of the Complainant permits the inferences that the Complainant's allegations are true and that the Respondent knows its website is misleading. See, for example, *Hewlett-Packard Company v. Full System* (FA 0094637); *David G. Cook v. This Domain is For Sale* (FA0094957) and *Gorstew Jamaica and Unique Vacations, Inc. v. Travel Concierge* (FA0094925).

A somewhat broader statement of principle is contained in *Reuters Limited v. Global Net 2000, Inc.* (D2000-0441):

“The Panel draws two inferences where the Respondent has failed to submit a response: (a) “the Respondent does not deny the facts which the Complainant asserts” and (b) “the Respondent does not deny the conclusions which the Complainant asserts can be drawn from those facts”.”

Rights

The Complainant has produced copies of its numerous registrations of the trademark ICQ and has established that it has rights in that mark.

Identity or confusing similarity

“Essential” or “virtual” identity is sufficient for the purposes of the Policy: see e.g. *The Stanley Works and Stanley Logistics, Inc v. Cam Creek. Co., Inc.*, (D2000-0113) and *Nokia Corporation v. Nokiagirls.com* (D2000-0102).

US cases have adopted the same approach, see *Sporty’s Farm L.L.C. v. Sportsman’s Market, Inc.*, 202 F.3d 489, 497-98 (2d Cir. 2000) (the differences between the trademark “sporty’s” and the domain name <sportys.com> – specifically, an apostrophe in the trademark and the addition of .com in the domain name – are “inconsequential”, such that the domain name is “indistinguishable” from and “certainly ‘confusingly similar’ to the protected mark”).

The test of confusing similarity under the Policy, unlike trademark infringement or unfair competition cases, is confined to a consideration of the disputed domain name and the trademark: *AltaVista Company v. S.M.A., Inc.*, (D2000-0927); *Gateway, Inc. v. Pixelera.com, Inc. (formerly Gateway Media Productions, Inc.)* (D2000-0109).

Here, the disputed domain name incorporates the whole of the Complainant’s mark ICQ. In the minds of millions of Internet users, to whom the ICQ mark is extremely well known, the addition of the words “roaming” and “.com” do nothing to detract from and indeed are likely to reinforce the strong association between the word ICQ and the Complainant.

The panel finds the disputed domain name to be confusingly similar to the Complainant’s trademark. The Complainant has established this element.

Illegitimacy

Paragraph 4(c) of the Policy sets out, without limitation, circumstances which, if proved, establish a registrant’s rights or legitimate interests to a disputed domain name. The Complainant has the onus of proof on this, as on all issues.

The Complainant has not authorized the Respondent to use any of its marks nor to include them in any domain names.

As to Policy 4(c)(i), the Respondent commenced use of the disputed domain name in connection with its ICQRoaming website before it received notice of this dispute by way of the Complainant’s attorneys’ letter of December 1, 2000. However:

“Use which intentionally trades on the fame of another cannot constitute a ‘bona fide’ offering of goods or services”: *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and “Madonna.com”*(D2000-0847)[madonna.com].

The Respondent’s website home page describes the service as follows:

“**ICQRoaming** is a handy, free service that solves the problem of migrating your ICQ contact list to new installations of ICQ.”

The Internet user who has arrived at this web page is thus assumed by the Respondent already to know of ICQ. The service offered by the Respondent is an adjunct to the Complainant's service. The use of the disputed domain name by the Respondent is therefore properly to be regarded as intentionally trading off the fame of the Complainant's mark.

As to 4(c)(ii), the Respondent's name is not ICQ and there is no evidence that the Respondent has been commonly known by the domain name.

As to 4(c)(iii), the Respondent's website offers for sale software licences to be used in connection with the Complainant's services. Such use of the disputed domain name infringes the Complainant's mark and cannot therefore establish a legitimate interest in the domain name: *Chanel, Inc. v. Estco Technology Group* (D2000-0413).

The Complainant has established that the Respondent has no rights or legitimate interest in the disputed domain name.

Bad faith

In *SportSoft Golf, Inc. v. Hale Irwin's Golfers' Passport* (NAF case FA94956) a finding of bad faith was made where the Respondent "knew or should have known" of the registration and use of the trade mark prior to registering the domain name. Likewise, similar findings were made in, *Marriott International, Inc. v. John Marriot* (FA94737); *Canada Inc. v. Sandro Ursino* (AF-0211) and *Centeon L.L.C./Aventis Behring L.L.C. v. Ebiotech.com* (FA95037).

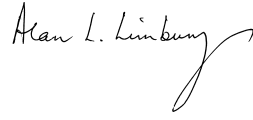
The Respondent must be taken to have known of the Complainant's mark before he registered the disputed domain name because his website addresses users on the assumption that they already know of that mark and of the services offered by the Complainant. There is, of course, nothing wrong with the offering of services as adjuncts to those offered by another provided that, in doing so, one does not pretend to be or to be associated with or approved by that other, just as there is nothing wrong with criticising an entity so long as one does not identify oneself as that entity: see *Monty and Pat Roberts, Inc. v. Bill Keith* (D2000-0299).

The panel finds that, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of his website and of the services on his website. This is evidence of both bad faith registration and use: Policy 4(b)(iv).

In the absence of any countervailing evidence, the panel finds that the Complainant has proved that the disputed domain name was registered and is being used in bad faith.

7. Decision

Pursuant to paragraphs 4(i) of the Policy and 15 of the Rules, the panel requires the domain name <icqroaming.com> to be transferred to the Complainant.



Alan L Limbury
Sole Panelist

Dated: February 22, 2001