Panel Decision for dispute CAC-ADREU-004037

Case number	**CAC-ADREU-004037**
Time of filing	**2007-01-02 12:21:06**
Domain names	**aolireland.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

Organization / Name	**AOL UK, Mr Nity Raj**

Respondent

Organization / Name	**World Online Endeavours Limited, See Organization below**

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel is not aware of any other legal proceedings relating to the disputed domain name.

FACTUAL BACKGROUND

1 The Complainant is AOL (UK) Limited, a company registered in the United Kingdom under company registration number 03462696.

2 The Complainant asserts that it is part of the America Online group of companies, which also includes AOL LLC, a United States corporate entity.

3 AOL LLC is the proprietor of the following trade mark registrations:

(a) Community Trademark 118,547 for the mark AOL (registered 1998);
(b) UK Trademark 2,011,484 for the mark AOL (registered 1996);
(c) Community Trademark 972,604 for the mark AOL.COM (registered 2000); and
(d) Irish Trademark 166,932 for the mark AOL (registered 1995).

4 The Complainant has used the mark AOL and has provided AOL branded services to customers in the UK and elsewhere in Europe for a significant period of time. Members of the America Online group of companies own numerous domain name registrations comprising the mark AOL, including the domain names www.aol.co.uk and www.aol.ie, although none of these (or any of the other registrations referred to by the Complainant) appears to be owned by the Complainant.

5 The Respondent is World Online Endeavours Ltd, an organisation with address in Sweden.

6 On 7 April 2006, the first day of the Land Rush period, the Respondent applied for registration of the disputed domain name AOLIRELAND, which registration was subsequently blocked by EURid.

7 On 29 December 2006, the Complainant issued the Complaint in the present ADR proceedings. Having been notified of the Complaint, the Respondent did not submit a response to the Complaint within the required time period. The Czech Arbitration Court reminded the Respondent by a Nonstandard Communication dated 7 March 2007 that the time by which a Response must be submitted would expire on 12 March 2007. On 13 March 2007, the Czech Arbitration Court issued a Notification of Respondent's Default.

8 The Panel invited the Complainant by Nonstandard Communications dated 5 April and 17 April 2007 to respond to specific issues raised by the Panel, and at the same time provided the Respondent with further opportunities to submit a Response. These

communications from the Czech Arbitration Court and from the Panel notwithstanding, the Respondent failed to file any Response in these proceedings.

A. COMPLAINANT

1 The Complainant, AOL (UK) Limited, seeks a decision transferring the registration of the disputed domain name to the Complainant. The Complainant contends that it is part of the America Online group of companies, which also includes AOL LLC (formerly known as America Online Inc.). AOL provides interactive online services on a subscription basis to millions of AOL members in numerous countries around the world. The AOL service is freely accessible from every country that has access to the internet through a number of public website portals including (in Europe) the sites at www.aol.co.uk, www.aol.fr, www.aol.de, and www.aol.ie, and also through www.aol.com. AOL branded services are provided to customers in the UK and elsewhere in Europe by the Complainant.

2 AOL LLC is the registered proprietor of numerous trademark registrations for the mark AOL in the UK, Europe, the US and worldwide (including those identified above in the factual background). AOL uses the AOL mark in connection with a broad portfolio of domain names connected with AOL's business, including, for example, the domain names aol.eu, aol.com, aol.co.uk, myaol.com, aolnews.com, aolfantasysports.com, aolatschool.com, aolinstantmessenger.com, aolireland.com, aolfrance.com, aolgermany.com, and aolitaly.com.

3 AOL has been operating under the AOL mark in Europe for many years and frequently uses AOL as a prefix in connection with the country name as a mark for the AOL service in a particular country, e.g., AOL UK, AOL Germany, AOL France and AOL Spain. By way of example, AOL has provided an AOL branded internet service in the UK since 1996 and has operated an AOL branded service in Germany, France, and Spain for over 10 years.

4 Since its first adoption, the AOL mark has been used continuously and extensively in commerce in connection with the advertising and sale of AOL's goods and services in Europe and worldwide. AOL has invested substantial sums of money in developing and marketing its services in Europe and worldwide. In the UK alone, in the three years to March 2004, AOL spent in excess of £100 million advertising the AOL services. The AOL name has featured prominently in such advertising.

5 Each year millions of customers worldwide obtain goods and services offered under the AOL mark; millions more are exposed to the mark through advertising and promotion. AOL operates one of the most widely used interactive online services in the world. AOL has approximately 2.1 million users in the UK alone.

6 By reason of the use of the AOL mark in connection with the provision of online services, the AOL mark has become well known and famous among members of the purchasing public. As a result, consumers associate the mark AOL, when used in a domain name, with AOL's services.

7 The Complainant further submits that the domain name AOLIRELAND.eu is confusingly similar to the AOL mark. The addition of the word 'Ireland' will not distinguish the Domain Name from the AOL mark in any meaningful way. The Complainant believes that the internet using public will simply see the word 'Ireland' as in some way relating to the provision of the AOL service by AOL in Ireland.

8 The Complainant asserts that the Respondent has no rights or legitimate interest in the disputed domain name for the following reasons:

(a) the Respondent is not licensed or otherwise authorised to register or use a domain name that is confusingly similar to the AOL mark;
(b) the Respondent has not used the disputed domain name or a name incorporating the domain name in connection with the offering of goods or services, and could not lawfully do so;
(c) the Respondent has not been and could not lawfully be known by the domain name (whether by reference to a registered right or otherwise);
(d) given AOL's registered and unregistered rights in the AOL mark, any use of the AOL mark by the Respondent is highly likely to be unlawful in that it is highly likely to infringe AOL's registered trademark rights and/or amount to passing off or unfair competition under relevant laws; and
(e) the Respondent has not made any legitimate non-commercial use of the Domain Name. As of the date of the Complaint, the disputed domain name is not in use by the Respondent. The Complainant relies in this regard on a screenshot of an MSN search page stating “We can’t find www.aolireland.eu”.

9 The Complainant contends further that the Respondent has registered the disputed domain name in bad faith and that the domain name was registered or acquired primarily for the purpose of either selling, renting, or otherwise transferring the domain name to AOL at a profit, or for the purpose of intentionally attracting internet users to a website owned or operated by the Respondent, or another website, or other on-line location. Such users are likely to be attracted to a website accessible via the disputed domain name by reason

of the identity/confusing similarity of the domain name with the AOL mark. At the time of registration the Respondent will have been well aware of the reputation and widespread recognition of the AOL mark worldwide.

10 The Complainant refers the Panel to a WIPO panel decision dated 24 August 2000 in case number D2000-0713, in which, as the Complainant asserts, the panel transferred the disputed domain names aolspain.com, aolgermany.com, and aolireland.com to America Online Inc in similar circumstances.

11 The Complainant concludes its submissions by reference to a letter dated 16 August 2006 from the Complainant's Authorized Representatives to the Respondent (sent by email) in which the Complainant set out its rights and requested the Respondent's consent to a transfer of the disputed domain name to AOL. The Complainant states that the Respondent failed to respond to this letter and that this lack of response was further evidence of bad faith.

12 The Complainant summarises its submissions as follows:

(a) the disputed domain name is confusingly similar to AOL's registered and unregistered trade marks and its registered domain names, all of which carry rights which are recognized and established by Community law;
(b) the Respondent has no legitimate interest in the domain name, has never used the domain name, and has registered the Domain Name in bad faith; and
(c) any use of the Domain Name by the Respondent would infringe the Complainant's registered and unregistered trademark rights.

13 In its response to the Panel's Nonstandard Communication dated 5 April 2007, the Complainant on 12 April 2004 filed further submissions in relation to its rights in the mark AOL within the meaning of Art 21 of Regulation (EC) 874/2002. In addition to placing reliance on common law unregistered rights, the Complainant explained that it is licensed to use the AOL registered and unregistered trademarks in the United Kingdom and other European territories pursuant to a licence agreement between it and AOL Europe S.A.R.L dated 22 December 1999. Clause 3.1 of the licence grants the Complainant the right to use the AOL mark. AOL Europe S.A.R.L was itself authorised to grant such licences of the AOL marks pursuant to Clause 3.1 of a licence between it and AOL Inc. (the previous name of AOL LLC) dated 22 December 1999. The Complainant annexed unsigned copies of both licence agreements to its submissions.

14 The Complainant also annexed company registration documentation to its further submissions dated 12 April 2007 to show that it meets the general eligibility requirements within the meaning of Art 22.11 of EC Regulation 874/2004 and Art 4(2)(b) of EC Regulation 733/2002.

15 Finally, in response to the Panel's further Nonstandard Communication dated 17 April 2007, the Complainant on 20 April 2007 submitted signed copies of the license agreements.

B. RESPONDENT

The Respondent did not file a Response to the Complaint.

DISCUSSION AND FINDINGS

1 The Panel has reviewed and considered the Complainant's submissions and annexed documents in detail and has further taken note of the decisions in ADR cases 3896, 4039 and 4040 in arriving at a decision.

2 Article 22.10 of Commission Regulation (EC) No 874/2004 (the "Regulation") and Paragraph B.10(a) of the ADR Rules provide that if, as in the present case, a party fails to respond within the given deadlines, the Panel shall proceed to a decision on the Complaint, and may consider the failure to respond as grounds to accept the claims of the counterparty.

3 However, the Panel does not consider that the Regulation or the ADR Rules envisage the Panel simply upholding the Complaint in all cases where a Respondent fails to respond. Rather, in order for the Complaint to succeed, the Complainant must still demonstrate that the requirements of Article 21.1 of the Regulation and Paragraph B.11(d)(1) of the ADR Rules are satisfied.

4 In accordance with Article 21.1 of the Regulation and Paragraph B.11(d)(1) of the ADR Rules, in order to succeed, the Complainant must establish that:

(a) the disputed domain name is identical or confusingly similar to a name in respect of which a right (of the Complainant) is recognised or established by national and/or Community law; and either
(b) the domain name has been registered by the Respondent without rights or legitimate interest in the domain name; or

(c) the domain name has been registered or is being used in bad faith.

5 The Complainant has adduced evidence to show that AOL LLC is the registered proprietor of relevant trademark registrations for the mark AOL and of domain names comprising the mark AOL. There is no evidence before the Panel to show that the Complainant is itself the proprietor of trademark registrations for the mark AOL, or of the domain names to which the Complainant refers.

6 The Complainant has sought to argue that it was part of the America Online group of companies and that it was entitled to use the mark AOL by virtue of its corporate relationship with the rights holder AOL LLC. The Panel does not accept that the simple existence of a corporate relationship with the rights holder would give the Complainant rights to the mark AOL within the meaning of Article 21.1 of the Regulation and Paragraph B.11(d)(1) of the ADR Rules. In any event, the evidence submitted by the Complainant does not prove the existence of such a corporate relationship. The Hoover's family tree, to which the Complainant refers, shows that a company in the name of AOL Services (UK) Ltd is a member of the America Online group of companies but it makes no reference to the Complainant.

7 However, the Complainant has established that it is entitled to use the mark AOL in the United Kingdom and Ireland by virtue of the license agreements referred to above. The Panel finds that the Complainant's rights as licensee constitute rights in the mark AOL which are "recognised or established by national and/or Community law" within the meaning of Article 21.1 of the Regulation and Paragraph B.11(d)(1) of the ADR Rules.

8 The Panel accepts the Complainant's submission that the addition of the word IRELAND to the mark AOL does not distinguish the disputed domain name in a meaningful way from the mark AOL but that the addition of a country name to the mark AOL would lead the general public to relate the name AOLIRELAND to the services provided by the Complainant in Ireland. The Panel accordingly finds that the disputed domain name is "confusingly similar" to a name in respect of which a right (of the Complainant) is recognised within the meaning of Article 21.1 of the Regulation and Paragraph B.11(d)(1) of the ADR Rules.

9 Absent any Response from the Respondent, first, to the letter sent by the Complainant's Authorised Representatives prior to the commencement of these proceedings and, second, to the Complaint in these proceedings, the Panel accepts the Complainant's case that the Respondent has no legitimate rights or interest in the disputed domain name.

10 In light of these findings, the Panel does not need to consider whether the Complainant has common law unregistered rights in the mark AOL and whether, if such rights existed, they would (a) be of a nature so as to entitle the Complainant to seek the transfer of the disputed domain name to itself and would (b) have been infringed by the Respondent's application to register the disputed domain name as a matter of the applicable law.

11 Neither is the Complainant required to show, or the Panel required to consider, whether the Respondent applied for the disputed domain name in bad faith. However, the Panel notes that the fact that the Respondent does not appear to use or have used the disputed domain name, or of a name corresponding to it, for goods and services, and the Respondent's failure to respond both to the letter sent by the Complainant's Authorised Representatives prior to the commencement of these proceedings, and to the Complaint in these proceedings, are indicative of the existence of bad faith.

12 In light of these findings, the Panel concludes that the Complainant has satisfied the requirements of Article 21.1 of the Regulation (EC) Paragraph B.11(d)(1) of the ADR Rules.

13 Since the Complainant has further adduced evidence establishing that it is a UK registered company and based in the UK, the Complainant also satisfies the general eligibility criteria set out in Article 4.2(b) of Regulation (EC) No 733/2002 and referred to in Article 22.11 of the Regulation. The Complainant is therefore entitled to the transfer of the disputed domain name to the Complainant.

DECISION

For all the foregoing reasons, and in accordance with Paragraph B.12(b) and (c) of the ADR Rules, the Panel orders that the disputed domain name AOLIRELAND.eu be transferred to the Complainant.

PANELISTS

Name	**Klein Solicitors, Gregor Kleinknecht, LLM MCIArb**

DATE OF PANEL DECISION 2007-04-26

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant seeks the transfer of the disputed domain name AOLIRELAND.eu to the Complainant. The Respondent failed to respond to the Complaint within the applicable time limits, or at all. The Complainant has established that the disputed domain name is confusingly similar to the mark AOL in respect of which the Complainant has a right which is recognised or established by national and/or Community law. The Panel found that the Respondent had no rights or legitimate interest in the disputed domain name. Since the Complainant also fulfils the general eligibility criteria, it was entitled to the transfer of the disputed domain name.