Panel Decision for dispute CAC-ADREU-004039

Case number	**CAC-ADREU-004039**
Time of filing	**2007-01-02 12:20:22**
Domain names	**aolmail.eu, aolspain.eu**

Case administrator

Name	**Tereza Bartošková**

Complainant

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

Respondent

Organization / Name	**Name Battery, Ltd, 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

There are no other legal proceedings of which the Panel is aware that are pending or decided and that relate to the disputed domain name.

FACTUAL BACKGROUND

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

2. The Complainant claims to be one of a number of group companies owned by US parent company AOL LLC.

3. AOL LLC is the registered proprietor of both UK and Community trade marks for the name AOL. The Complainant uses the AOL trade mark in the UK. AOL LLC also uses the trade mark AOLMAIL for its email service, which has 2 million users in the UK.

4. On 7 April 2006, the first day of the Land Rush period, the AOLMAIL and AOLSPAIN domain names were registered in the name of the Respondent, Name Battery, Ltd.

5. On 29 December 2006, the Complainant issued its complaint in these ADR proceedings. The Respondent did not submit a response to the complaint by the required deadline, or at all. The Czech Arbitration Court issued a notification of the Respondent's default on 26 February 2007.

A. COMPLAINANT

AOL (UK) Limited (the Complainant) is part of the America Online group of companies including AOL LLC (formally America Online Inc.) (together referred to as "AOL"). AOL provides internet services to millions of people worldwide. The AOL service is a range of interactive online services which include flat rate and metered narrowband, broadband and mobile services, email and messaging services, access to various online communities and a number of channels of online content. The AOL service is available on a subscription basis to AOL members in numerous countries around the world, and 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 (see screen shots at Annex A) and through www.aol.com. AOL branded services are provided to customers in the UK and elsewhere in Europe by the Complainant.

AOL is the owner of numerous trademark registrations for the mark AOL in the UK, Europe, the US and worldwide including:

(a) Community Trademark 118,547 for "AOL" (registered in 1998);
(b) UK Trademark 2.011,484 for the mark "AOL" (registered in 1994); and

(c) Community Trademark 972,604 for "AOL.com" (registered in 2000).

The Complainant contends the following:
(1) that AOL uses the AOL mark in connection with a broad portfolio of domain names connected with the AOL business, and that the AOL domain name portfolio comprises many hundreds of domain names containing the AOL mark, including, for example, aol.eu, aol.com, aol.co.uk, aolinstantmessanger.com, aol.ie, aol.de.

(2) that AOL has been operating under the AOL trade mark in Europe for many years. 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.

(3) that AOL 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.

(4) that, 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.

(5) that AOL has invested substantial sums of money in developing and marketing its services in Europe and worldwide, and, in the UK alone, in the three years to March 2004 that AOL spent in excess of £100 million advertising the AOL services.
(6) that members of the AOL group have spent substantially more than this advertising their services and products elsewhere in the EU. This advertising, in which the AOL name has featured prominently, has taken the form of online advertising and offline advertising through campaigns in the national press, local press, magazines, television, radio, outdoor advertising, direct marketing campaigns and sponsorship of high profile events and venues.

(6) that each year millions of customers worldwide obtain goods and services offered under the AOL mark, and millions more are exposed to the mark through advertising and promotion.
(7) that AOL has approximately 2.1 million users in the UK alone.

(8) that 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.

Specifically in relation to the AOL MAIL trade mark, the Complainant contends the following:

(1) that the AOL MAIL mark is used by AOL as the brand name of the AOL proprietary email service. AOL MAIL customers are provided with: an email account (e.g. xxxx@aol.com) through which they can send and receive email; a screen name through which they can send and receive instant messages through the AIM instant messaging service; and other services. AOL MAIL is used by over 2 million people in the UK alone, and many millions more worldwide. A screen shot of the AOL MAIL branding on AOL's website is at Annex D.

(2) that customers using the AOL MAIL service are able to access their email account from any computer in the world using the URL http://aolmail.aol.com.

The Complainant claims that the domain aolmail.eu is identical to the AOL MAIL mark used by AOL, and is confusingly similar to the AOL mark used by AOL.
The complainant claims that the domain name aolspain.eu is confusingly similar and nearly identical to the AOL mark and that the addition of the word “spain” will not distinguish the AOL mark in any meaningful way and the internet using public will simply see the word “spain” as in some way relating to the provision of the AOL service by AOL in Spain.

The Complainant contends that the Respondent has no right or legitimate interest in the Domain Names for the following reasons:
(1) The Respondent is not licensed or otherwise authorised to register or use a domain name that is confusingly similar or identical to either the AOL mark or the AOL MAIL mark.

(2) The Respondent has not used either of the Domain Names or a name incorporating either of the Domain Names in connection with the offering of goods or services, and could not lawfully do so (see paragraph 19 below).

(3) The Respondent has not been known by either of the Domain Names (whether by reference to a registered right or otherwise) and

could not lawfully be so (see paragraph 19).

(4) Given AOL's registered and unregistered rights in the AOL mark, and in the mark AOL MAIL, 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.

(5) The Respondent has not made any legitimate non-commercial use of the Domain Names. As of the date of this complaint, the Domain Names are not in use by the Respondent (see Annex E).

The Complainant contends that the Respondent has registered the Domain Names in bad faith for the following reasons:

(1) The Complainant believes that the Domain Names were registered or acquired primarily for the purpose of either selling, renting or otherwise transferring the Domain Names 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 Domain Names by reason of the identity/confusing similarity of the Domain Names with the AOL mark and the AOL MAIL mark.

(2) At the time of registration the Respondent will have been well aware of the reputation and widespread recognition of the AOL mark worldwide.

The Complainant attempted to resolve this matter amicably without recourse to the ADR process. By letter dated 16 August 2006 from the Complainant's Authorized Representatives to the Respondent (sent by email) the Complainant set out its rights and requested the Respondent's consent to a transfer of the Domain Names to AOL. The Complainant claims that the respondent failed to reply. The Complainant puts this lack of response as further evidence of bad faith.

In summary, the Complainant contents that:

(1) The Domain Names www.aolmail.eu and www.aolspain.eu are identical or confusingly similar to AOL's registered and unregistered trade marks and its registered domain names, both of which carry rights which are recognized and established by Community law;

(2) The Respondent has no legitimate interest in the Domain Names, has never used the Domain Names, and, the Complainant believes, has registered the Domain Names in bad faith; and

(3) Any use of the Domain Names by the Respondent would infringe the Complainant's registered and unregistered trade mark rights.

The Complainant therefore requested that the Panel issue a decision to transfer the registration of the Domain Names to the Complainant.

B. RESPONDENT

The Respondent has not responded to the complaint.

DISCUSSION AND FINDINGS

1. The Respondent has not responded to the Complaint. Article 22.10 of Commission Regulation (EC) No 874/2004 and Paragraph B10(a) of the ADR Rules are clear that, in a situation where the Respondent does not respond to the Complaint, this may be considered by the panel as grounds to accept the claims of the Complainant. This does not mean a Complaint should be upheld whenever a Respondent fails to respond. In order to succeed on its complaint, the Complainant is still required to demonstrate that the requirements of Article 21.1 of Commission Regulation (EC) No 874/2004 and Paragraph B11(d)(1) of the ADR Rules are satisfied.

2. The Complainant must, in accordance with Article 21.1 of Commission Regulation (EC) No 874/2004 and Paragraph B11(d)(1) of the ADR Rules, demonstrate that the AOLSPAIN and AOLMAIL domain names are 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: (i) the Respondent has registered the domain names without rights or legitimate interests in them; or (ii) the domain names have been registered or are being used in bad faith.

3. The Complainant has provided evidence that its US parent company is the registered proprietor of trade marks for the name “AOL”.

The US parent company is not the registered proprietor of a trade mark which includes all words used in the domain names.

4. The Complainant has provided no evidence that it is licensed to use its parent company's "AOL" trade mark. In addition, evidence provided by the Complainant of its relationship with its parent company does not show the relationship (a UK company called AOL Services (UK) Ltd is referred to in the evidence, not the Complainant). Given this, and the fact that Carphone Warehouse purchased the AOL UK business at the end of 2006, the panel is concerned that the Complainant does not have a right to use the AOL name in a way that is recognised or established by national and/or Community law.

5. However, an independent review of the AOL UK website by the panel reveals that: (a) the AOL name is used on the website; and (b) the website is operated by the Complainant. In light of this, and in the absence of a response from the Respondent, the panel is prepared to accept that the Complainant is validly licensed to use the name "AOL".

6. The Complainant does not claim that it is the proprietor or licensee of registered trade marks for the names AOLMAIL and AOLSPAIN. The Complainant therefore needed to show either that AOLMAIL and AOLSPAIN are confusingly similar to the registered trade mark AOL, or that it has unregistered rights in AOLMAIL and/or AOLSPAIN.

7. The Complainant provided evidence that AOLMAIL is the name of an email service offered by AOL, which has 2 million users in the UK alone. The panel is therefore persuaded that the Complainant has unregistered rights to use the name AOLMAIL. The existence of unregistered rights in the trade mark "AOLMAIL" means that the domain name is identical to the name in which the Complainant has rights. As a result, the Complainant is not required to demonstrate confusion. However, even if the Complainant did not have such unregistered rights, the panel is persuaded that the use (in the domain name) of the registered trade mark AOL, together with a well known product of the complainant, namely mail (i.e. email), means that the domain name is confusingly similar to the registered trade mark.

8. The Complainant does not claim that AOLSPAIN is used by AOL as a trade mark. However, the Panel accepts the Complainant's position that AOLSPAIN is confusingly similar to the AOL name. The reputation in the trade mark AOL is sufficient that the addition of a country name to the end of the trade mark will lead the public to consider the new trade mark to be commercially linked to AOL.

9. The Complainant has provided evidence that it wrote to the Respondent and claims not to have received a response to that letter. It also asserts that the Respondent does not have any rights or legitimate interests in either AOLMAIL or AOLSPAIN. In the absence of a response from the Respondent, either to the Complainant's earlier letter or to the Complaint, the panel finds that the Respondent accepts the Complainant's assertion that it does not have rights or legitimate interests in AOLMAIL or AOLSPAIN.

10. The above finding that the Respondent does not have rights or legitimate interests in the domain names is enough to satisfy the requirements of Article 21.1 of Commission Regulation (EC) No 874/2004 and Paragraph B11(d)(1) of the ADR Rules. However, for completeness, it is necessary to consider whether the domain name was registered or is being used in bad faith.

11. The Complainant has not provided any evidence that "the domain name has been registered or is being used in bad faith". However, the domain names are not in use and the Respondent has not responded to the letter written by the Complainant. It would therefore have been impossible (or at least exceedingly difficult) for the Complainant to obtain any evidence that the Respondent registered or intends to use the domain name in bad faith. The Complainant has asserted that the Respondent registered the domain name in bad faith and, in the absence of a response from the Respondent, the panel again finds that the Respondent has accepted the Complainant's assertion.

12. The Complainant has satisfied the requirements of Article 21.1 of Commission Regulation (EC) No 874/2004 and Paragraph B11(d)(1) of the ADR Rules. It is therefore entitled to obtain revocation of the domain name. The Complainant has additionally requested the transfer of the domain name. The Complainant is a UK registered company and is based in the UK and therefore satisfies the criteria set out in Article 4.2(b) of Regulation (EC) No 733/2002. It is therefore also entitled to transfer of the domain name.

DECISION

For all the foregoing reasons, in accordance with Paragraphs B12(b) and (c) of the Rules, the Panel orders that the domain names AOLMAIL and AOLSPAIN be transferred to the Complainant.

PANELISTS

Name	**Isabel Davies**

DATE OF PANEL DECISION 2007-04-10

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant brought ADR proceedings against the Respondent on 29 December 2006, claiming that the Respondent's registration of the domain names AOLMAIL.eu and AOLSPAIN.eu should be annulled and that it was entitled to a transfer of the domain names.

The Complaint maintained that the Complainant had rights to use the trade mark AOL and provided evidence that AOL was a registered UK and Community trade mark. The Complaint also maintained that the Complainant had unregistered rights to use the name AOLMAIL, and that AOLMAIL and AOLSPAIN were confusingly similar to the AOL trade mark.

The Respondent registered the domain names on the first day of the Land Rush period of registration. The Complaint asserts that the Respondent does not have any rights or legitimate interests in AOLMAIL and AOLSPAIN. The Complaint also asserts that the Respondent registered the domain name in bad faith.

The Respondent failed to file a Response. As a result, and in accordance with Article 22.10 of Commission Regulation (EC) No 874/2004 and Paragraph B10(a) of the ADR Rules, the Panel was entitled to consider this grounds to accept the claims of the Complainant. However, the Panel still required that the Complainant demonstrate that the requirements of Commission Regulation (EC) No 874/2004 and the ADR Rules were satisfied.

The Panel held:

(1) The Complainant is licensee of the registered trade mark AOL in the UK and is owner of unregistered rights in the trade mark AOLMAIL. The domain names AOLMAIL and AOLSPAIN are confusingly similar to the Complainant's rights.

(2) The Respondent does have rights or legitimate interests in the names AOLMAIL and AOLSPAIN. The Complainant asserted this is the case both in its complaint and in a letter to the Respondent, which was provided as evidence by the Complainant. The Respondent has not responded to the Complaint or the letter.

(3) The Respondent registered the domain name in bad faith. Again, this was asserted by the Complainant in both the letter to the Respondent and in the Complaint, neither of which were responded to.

(4) The Complainant is a UK registered company and therefore satisfied the criteria set out in Article 4.2(b) of Regulation (EC) No 733/2002.

Accordingly, the Panel ordered the transfer of the domain names AOLMAIL and AOLSPAIN to the Complainant.