

DISPUTE RESOLUTION SERVICE

D00017525

Decision of Independent Expert

AOL Inc.

and

john smith

1. The Parties:

Lead Complainant: AOL Inc.
22000 AOL Way
Dulles
VA
20166
United States

Respondent: John Smith
95 Nelson Drive
Little Plumstead
Norfolk
NR13 5FL
United Kingdom

2. The Domain Name(s):

aolcontactnumber.co.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

Chronology:

31 May 2016 15:30 Dispute received
01 June 2016 11:07 Complaint validated
01 June 2016 11:39 Notification of complaint sent to parties
20 June 2016 02:30 Response reminder sent
23 June 2016 08:37 No Response Received
23 June 2016 08:37 Notification of no response sent to parties
05 July 2016 02:30 Summary/full fee reminder sent
08 July 2016 14:49 Notification of no response sent to parties
12 July 2016 08:36 Expert decision payment received
12 July 2016 Keith Gymer appointed as Expert, with effect from 15 July 2016

4. Factual Background

The Complainant, AOL INC. ("AOL"), is a provider of Internet services worldwide.

AOL owns trademark registrations for and containing the mark AOL in the UK, Europe, the US and worldwide, including: (a) UK Trademarks 2011484 and 2046170 for AOL, registered in 1996; (b) EU Trademark 118547 for AOL, registered in 1998; and (c) EU Trademark 972604 for AOL.com, registered in 2000, each covering a range of computer and internet related services.

AOL has been operating under the AOL mark in the UK since 1996, and prior to that in the United States since at least as early as 1989.

AOL maintains phone numbers where consumers can contact AOL to ask questions and seek assistance with various issues. The official AOL contact numbers are promoted online to make it easy for consumers to reach AOL.

The AOL service is available worldwide and in many languages via a number of different AOL-specific URLs, including www.AOL.com, www.AOL.fr and www.AOL.de.

The Respondent registered the Domain Name "AOLContactNumber.co.uk" under the name of "john smith" on 15 April 2016, and used it with a commercial Web site that purported to provide AOL's UK toll-free phone number (it was not in fact an AOL number).

5. Parties' Contentions

Complainant

The Complainant asserts that the Domain Name in dispute is identical or similar to AOL's trademarks, including AOL, and AOL's domain names and online services, and that, in the hands of the Respondent, it is an Abusive Registration.

The Complainant argues substantially as follows:

As noted under Section 4 above, the Complainant has long been a provider of Internet services to millions of people worldwide under the AOL name and mark. Each year millions of customers worldwide obtain goods and services offered by the Complainant under the AOL mark. Many others are exposed to the AOL mark through advertising and promotion. With millions of users worldwide, the Complainant operates one of the most widely used interactive online services in the world.

The Complainant owns numerous trademark registrations for AOL, including those cited above, with Complaint relevant register extracts included with the Complaint.

The Complainant maintains phone numbers where consumers can contact AOL to ask questions and seek assistance with various issues. The official AOL contact numbers are promoted online to make it easy for consumers to reach AOL. [Expert note: the Official UK contact number is identified online as 0808-234-9279.]

The Complainant has invested substantial sums of money in developing and marketing its services in the UK and worldwide. Marketing and advertising, in which the AOL mark has featured prominently, has taken the form of online and offline advertising through campaigns in the press, online, and sponsorship of high profile events.

Owing to such use, the AOL mark has become well known and famous among members of the public. As a result, consumers associate the AOL mark, including when used in a domain name, with the services of Complainant.

The Respondent's registration and use of the Domain Name "AOLContactNumber.co.uk" includes AOL's name and mark, and falsely and deceptively suggests that consumers who visit the website are able to contact AOL at the phone number promoted at that site.

The Respondent is not licensed or otherwise authorized to register or use a domain name that is identical or confusingly similar to the AOL mark. The Respondent has not been known as "AOL", "AOL Contact Number" or "AOLContactNumber.co.uk". Given the Complainant's registered and unregistered rights in the AOL marks, any use of those marks by Respondent is highly likely to infringe AOL's registered trademark rights, and breach its common law right to prevent passing off.

Previous Nominet Dispute Resolution Service decisions in which the Complainant has prevailed reflect the fact that the reputation of the AOL Mark is well established. The Complainant refers, by way of example, to a decision [DRS 05484] of 17 April 2008, in which it was held in similar circumstances that "AOLmail.co.uk" was an Abusive Registration. That decision also held that "AOL is a famous mark amongst members of the public for Internet services."

On becoming aware of the Respondent's actions, the Complainant's counsel sent a letter to Respondent's first website hosting company. The hosting company shut down the site, on evidence of the infringing and deceptive nature of the Domain Name and website; however, upon learning of the suspension, the Respondent moved the Domain Name to a new host that has since ignored counsel's letters and refused to suspend the Respondent's website. This demonstrates the

Respondent's bad faith intent, and knowing and willful infringement of the Complainant's rights.

The Complainant asserts that the registration/acquisition and subsequent use of the AOL mark in the Domain Name "AOLContactNumber.co.uk" by the Respondent constitutes an Abusive Registration.

Referring to Section 3(a) of the DRS Policy:

Blocking registrations (DRS Policy 3(a)(i)(B) and unfair disruption (DRS Policy Section 3(a)(i)(C)). The website www.AOLContactNumber.co.uk routes to a commercial website that falsely and deceptively suggests it is providing a UK toll-free phone number where consumers can contact AOL. The registration also prevents the Complainant from using the "AOLContactNumber.co.uk" Domain Name in connection with its own products and services.

The Complainant contends that, on the balance of probabilities, the Respondent has registered (acquired or used) the Domain Name "AOLContactNumber.co.uk", in which AOL has Rights, in such a manner that it constitutes an Abusive Registration because: (a) the registration must have been made to block AOL from use of the Domain Name; and/or (b) the registration must have been made to unfairly disrupt AOL's business; and/or (c) the Respondent's use of the Domain Name demonstrates that Respondent is engaging in a pattern of registering and using infringing domain names for the purpose of profiting off of their use.

Remedy Requested

Transfer of domain name to AOL INC.

Respondent

The Respondent made no Response to the Complaint.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both that it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant has asserted valid earlier registered trade mark rights in the mark AOL.

The disputed Domain Name comprises the identical mark "AOL" with the addition of the element "contactnumber", together with the SLD domain suffix .co.uk. It is obvious that ordinary English readers will perceive the domain name to be read as

“AOL contact number” – i.e. that “contactnumber” will simply be recognised as a descriptive reference to the provision of this contact means for the Complainant’s services. The mark “AOL” has clearly been selected and incorporated in the Domain Name in expectation of that association by the Complainant’s (AOL) customers.

Consequently, the Expert finds that the Complainant has Rights in respect of a name or mark, which is identical or similar to the Domain Name, and that the conditions of Paragraph 2a.i. of the Policy are met.

Abusive Registration

The Complainant also has to show that the disputed Domain Name is an Abusive Registration. Paragraph 1 of the Policy defines “Abusive Registration” as a Domain Name which either:

- (i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; OR
- (ii) has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant’s submissions, the following examples appear to be principally applicable in this case:

- 3a.i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - ...
 - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant;
- 3a.ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;
- 3a.iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;...

Paragraph 4 of the Policy additionally provides observations on “How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration”, of which the following may be considered pertinent to the present Complaint:

- 4.a.i. Before being aware of the Complainant’s cause for complaint (not necessarily the ‘complaint’ under the DRS), the Respondent has:

- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
- B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- C. made legitimate non-commercial or fair use of the Domain Name;...

The factors listed in Paragraphs 3 and 4 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In accordance with the Policy Paragraph 2b, it is for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

The Respondent made no Response to challenge the Complainant's evidence and assertions, and offered no explanations to demonstrate why the Domain Name should not be considered an Abusive Registration.

In the Expert's opinion, the evidence of the nature of the associated website, which was linked using the Domain Name, itself clearly supports the Complainant's contention that there is some abusive intent to the Respondent's actions.

The contact number shown on the website is not the genuine AOL contact number for the UK. In the Expert's view, this strongly suggests that it could intended for the purpose of phishing for AOL users passwords, or as a means to get users to allow hackers, masquerading as AOL "support" engineers, access to customers' computers to install malware and possibly to demand "ransom" payments for removing alleged viruses, which is a frequently reported scam.

There is no evidence that any of the factors identified under Paragraph 4 of the Policy might conceivably provide a basis to argue that the Domain Name is not an Abusive Registration.

The Expert found it odd that the Complaint did not make any mention of attempts to contact the Respondent himself, rather than his website hosting companies. However, it is to be noted that the copy of the Complaint, which was sent by post to the Respondent's recorded street address, was returned to Nominet marked "address incomplete", and a check on the official Royal Mail postcode site established that the house number given does not exist. Given that "john smith" is a common name, which is also commonly adopted as an alias, in the Expert's experience, it appears likely that the Respondent has also provided false contact details.

The Expert therefore considers that, on the balance of probability, the Complainant has made out its case. Paragraphs 3.a.i.C and 3.a.ii of the Policy are most obviously applicable (the Expert does not consider the Complainant's claims under Paragraphs 3.a.1.B or 3.a.iii are supported); the registration and use of the disputed Domain Name by the Respondent has taken unfair advantage of, and been unfairly detrimental to, the Complainant's Rights; and the Domain Name is

therefore to be considered as an Abusive Registration; and that the conditions of Paragraph 2a.ii. of the Policy are met.

7. Decision

Having found that the Complainant has Rights, and that the disputed Domain Name, aolcontactnumber.co.uk, is an Abusive Registration in the hands of the Respondent, the Expert orders that the disputed Domain Name should be transferred to the Complainant.

Signed: Keith Gymer

Dated: 28 July, 2016