



NATIONAL ARBITRATION FORUM

DECISION

AOL LLC v. Loto LLC
Claim Number: FA0709001075473

PARTIES

Complainant is **AOL LLC** ("Complainant"), represented by **Blake R. Bertagna**, of **Arent Fox LLP**, 1050 Connecticut Avenue, NW, Washington, DC 20036. Respondent is **Loto LLC** ("Respondent"), represented by **Diane Chan**, 39-07 Prince Street, Suite 3K, Flushing, NY 11354.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**eicq.net**>, registered with **Network Solutions, Inc.** (the "Registrar").

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Mr. Peter L. Michaelson, Esq. as Panelist.

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy ("Policy"), available at <icann.org/services/udrp/udrppolicy24oct99.htm>, which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999, and approved on October 24, 1999, and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy ("Rules") as approved on October 24, 1999, as supplemented by the National Arbitration Forum Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect ("Supplemental Rules").

Complainant submitted a Complaint to the National Arbitration Forum ("Forum") electronically on September 7, 2007; the National Arbitration Forum received a hard copy of the Complaint, along with Exhibits 1-18, on September 10, 2007.

On September 10, 2007, Network Solutions, Inc. confirmed by e-mail to the National Arbitration Forum that the <**eicq.net**> domain name is registered with Network Solutions, Inc. and that the Respondent is the current registrant of the name. The Registrar also verified that Respondent is bound by the Network Solutions, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with the "Policy."

On September 11, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of October 1, 2007 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@eicq.net by e-mail.

A timely Response was received and determined to be complete on October 1, 2007.

On October 5, 2007 and in compliance with Supplemental Rule 7, Complainant timely submitted an additional submission to the Forum.

Also on October 5, 2007, and pursuant to Complainant's request to have the dispute decided by a single-member Panel, the Forum appointed Mr. Peter L. Michaelson, Esq. as Panelist and set a due date of October 19, 2007 to receive the decision from the Panel.

Subsequently, on October 8, 2007 and in compliance with Supplemental Rule 7, Respondent timely submitted its additional submission to the Forum.

Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Panel, by its order dated October 19, 2007, extended the due date for this decision to November 2, 2007.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

1. Confusing similarity/identity

Complainant contends that the disputed domain name is confusingly similar to its ICQ Mark inasmuch as the name consists of the Complainant's mark ICQ prepended by the letter E and thus is unable to sufficiently distinguish the resulting name from the mark so as to dispel confusion of Internet users.

Hence, Complainant concludes that it has met the requirements of paragraph 4(a)(i) of the Policy.

2. Rights and legitimate interests

Complainant contends that Respondent has no rights or legitimate interests in the disputed domain name under paragraph 4(a)(ii) of the Policy.

Specifically, Respondent is using the name in conjunction with a website that provides goods and services that directly compete with those provided by Complainant under its ICQ Mark. Inasmuch as the name, being confusingly similar to Complainant's mark, acts to divert Internet users who are interested in Complainant's ICQ-branded goods and services to Respondent's site instead, that use is not a *bona fide*, a legitimate noncommercial or a fair use of the domain name under the Policy.

Furthermore, inasmuch as the WHOIS record for the disputed domain name lists "Loto LLC" as the registrant, there is no evidence that Respondent is commonly known by the mark EICQ or by the domain name.

3. Bad faith use and registration

Complainant contends that, for any one of various reasons, Respondent has registered and is using the disputed domain name in bad faith, hence in violation of paragraph 4(a)(iii) of the Policy.

Specifically, Complainant contends that Respondent, through use of its domain name that is confusingly similar to the ICQ Mark, is attempting to divert Internet users who seek Complainant's ICQ-branded chat service to Respondent's commercial website which offers those users competitive products, particularly those that are the same or similar to those offered by Complainant, to Complainant's detriment. These actions also disrupt Complainant's business.

Further, Respondent, through its offer to sell various assets, including the disputed domain name, to Complainant for US \$ 500,000 -- which is a sum well in excess of its costs of registration.

Lastly, since the domain name was registered several years after Complainant began widely using its ICQ Mark, Respondent registered the name with knowledge of that mark and Complainant's service offering there under and, in spite of that knowledge, designed its EICQ product to be compatible with Complainant's ICQ service and used the ICQ mark without authorization.

B. Respondent

1. Confusing similarity/identity

Respondent contests Complainant's allegation that the disputed domain name is confusingly similar to the ICQ Mark.

First, although the only difference between the disputed domain name and the ICQ mark is the letter "E," Respondent's mark "SPEED EICQ" differs, by more than half of its letters, from Complainant's ICQ Mark. The domain name, which Respondent uses for marketing and sales, is a simplification of the SPEED EICQ mark and name and thus causes no purchaser confusion.

Second, Respondent contends that no incident of actual confusion has arisen as a result of concurrent use of its mark SPEED EICQ when used in conjunction with its translation software and the ICQ Mark for Complainant's Internet chat service. In that regard, a purchaser would buy this software as a package, including a disk and an instruction book, for a specific purpose, namely Chinese-English translation, which has absolutely nothing to do with Internet chat services.

2. Rights and legitimate interests

Respondent claims, contrary to Complainant's allegations, that it has rights and legitimate interests in the disputed domain name.

First, Respondent states that since February 21, 2002, the disputed domain name was merely used as vehicle to forward Internet users to Respondent's website reachable at <lotousa.com>. Respondent registered the name to protect its interests in its translation software marketed under its mark SPEED EICQ.

Second, Respondent states it did not need any authorization from Complainant to use the mark SPEED EICQ as Respondent's product name and mark. Furthermore, Respondent previously offered its software through its website and thus is commonly known by the name SPEED EICQ. Consequently, as Respondent states, "the derivative name eicq.net shall be legitimate."

Third, Respondent is using the disputed domain name in connection with a *bona fide* offering of its translation software, SPEED EICQ, to its customers.

3. Bad faith use and registration

Respondent also contradicts Complainant's allegations that it registered and used the disputed domain name in bad faith.

First, Respondent contends that it registered the name in good faith with regard to just its SPEED EICQ Chinese to English translation software. No evidence exists of record to support Complainant's assertion that Respondent intended, through registering the name, to attract Internet users seeking Complainant's ICQ service to Respondent's website instead. This software, contrary to Complainant's view, does not interact with Complainant's ICQ service nor is it similar to that service.

Second, Complainant induced Respondent into providing a monetary offer to relinquish the disputed domain name, among other assets, to Complainant if for no other purpose than to stop Complainant from continuing its harassment. Moreover, Respondent never offered to sell the disputed domain name through an auction. Respondent claims that the amount of money, \$ 500,000, which it sought through its July 11, 2003 e-mail to Complainant's counsel, in exchange for relinquishing its two domain names <eicq.net> and <eicq.org> and the mark SPEED EICQ to Complainant was intended to compensate

Respondent for expenses it apparently had incurred up to that date in printing, design, advertisement and sales under those domain names and mark.

C. Additional Submissions

The Panel has fully considered both submissions as both were timely made and complied with the requirements of Supplemental Rule 7.

Nevertheless, the Panel finds that, for the most part, both submissions reiterate and amplify various arguments already set forth in the primary filings and, to a lesser extent, raise additional arguments, such as dilution in the Chinese Internet community, that are irrelevant to a determination under the Policy. Hence, for the sake of brevity, the Panel will simply dispense with summarizing either of these additional submissions.

FINDINGS

A copy of the WHOIS registration record for the disputed domain name appears in Exhibit 2 to the Complaint. As indicated, the domain name was registered on February 21, 2002.

A. Complainant's ICQ Marks

Complainant owns a United States trademark registration for the term "ICQ," in block letters and on which this dispute is based. Complainant has provided in Exhibit 5 a copy of its registration certificate for this mark, the pertinent details of which are as follows:

ICQ

United States registration 2,411,657; registered: December 12, 2000
filed: October 29, 1997

This mark is currently registered for use in connection with "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 chat rooms, and electronic yellow pages that may be downloaded from a computer information network" in international class 9; "online directory of businesses and people; and providing employment information via computer networks" in international class 35; "providing financial information via electric means" in international class 36; "telecommunications services, namely, services relating to electronic transmission of data, images and documents via computer terminals, electronic mail services, facsimile transmission, personal communication services, paging services, store and forward messaging services; providing multiple-user access to computer information networks, in and electronic bulletin boards and chat rooms for the transmission of messages among computer users concerning topics of general interest" in international class 38; "providing entertainment, arts, sports and music information via electronic means" in international

class 41; and "providing information in the field of personal advice, romance, general interest news, health, computers and technology via computer networks" in international class 42. The registration certificate states that both first use and first use in commerce of the mark for the goods and services in all the classes commenced as of November 30, 1996.

Complainant also claims ownership of common law rights in various other marks that incorporate the term ICQ, including ICQ MAIL, ICQ.COM, ICQ2GO, ICQ CHAT, and ICQ LABS.

B. Complainant and its Activities

Complainant is one of the world's largest and well-known interactive online service providers, with tens of millions of subscribers and users in the United States and many more millions worldwide. Complainant's network attracts millions of unique visitors each month, which, in turn, exposes consumers to various ones of Complainant's many well-known brands (as reflected in a corporate news article provided on the Complainant's website with a copy of that article appearing in Exhibit 4 to the Complaint). Moreover, during the quarter that ended June 30, 2007, page views for various web-based services on Complainant's network totaled 52 billion, with 1.7 billion instant messages sent each day across Complainant's messaging networks, including its ICQ service.

Since at least as early as November 1996 and continuing to the present, Complainant and its predecessor-in-interest uses the ICQ mark, both in domestic and international commerce, in connection with advertising and sale of Complainant's computer-related goods and Internet-based services. Complainant has invested substantial sums of money in developing and marketing its goods and services under its ICQ mark. Each year, tens of millions of Complainant's customers worldwide obtain goods and services offered under the ICQ mark; millions more are exposed to this mark through Complainant's advertising and promotion. This advertising has been disseminated through television programs, radio broadcasts and print media including newspapers and periodicals.

C. Respondent and its Activities

Respondent uses the disputed domain name to redirect Internet users to its commercial website at <lotousa.com> through which Respondent promotes and provides software and provides various services (a copy of several of the pages, including the home page, of that website appears in Exhibit 7 to the Complaint).

Of particular pertinence here, that site promotes one of Respondent's software products under the mark SPEED EICQ (hard-copy printouts of various relevant pages from that site appear in Exhibits 9 and 10 to the Complaint). This particular product primarily provides automatic translation of Chinese into English; it does not provide Internet chat functionality. Respondent's website characterizes this product as providing "a multilingual chatting platform with instant translation function for global live business

talks and private chatting, and supports online game instant translation for customers from different countries" and useful with "embedded translation of PDA, Pocket PC, Notebook, ICQ, online games and chatting room" (specifically, Exhibit 10). Respondent sells its SPEED EICQ product primarily to Chinese-speaking customers and users in the US and China, with the predominant portion of those users being in China.

Respondent claims that Complainant's interactive online chat service ICQ has diminished to insignificance in the China and, more generally speaking, Asian markets and, as a consequence, Complainant has voluntarily withdraw its ICQ on-line chat service from the Chinese market. In that regard, most of the Chinese Internet users use "QQ", a product of Tencent Holdings, as their primary Internet chat tool.

Respondent has invested a substantial amount of money in promoting its SPEED EICQ software on Chinese television, the Internet and through print and other media.

D. Interactions between the Parties

On April 1, 2003, Complainant's counsel sent a letter (a copy of which appears in Exhibit 11 to the Complaint) to Respondent asking for additional information into the nature of Respondent's services obtainable through its <lotousa.com> website and under the mark SPEED EICQ.

Through a letter dated April 29, 2003, Respondent indicated that it was using the disputed domain name in conjunction with its website also resolvable through <lotousa.com> and had filed a trademark application with the US Patent and Trademark Office to register the mark SPEED EICQ. Respondent claimed that while it used the term in conjunction with its translation software, that software can not be used with Complainant's ICQ chat service.

During April-July, 2003, Complainant's counsel and Respondent corresponded, by e-mail, regarding Respondent's continuing use of the mark EICQ (copies of this correspondence appear in Exhibit 13 to the Complaint). Respondent stated that it has used ICQ in its mark and through its message dated July 11, 2003 expressed its interest in selling the domain names <eicq.net> and <eicq.org>, and the mark SPEED EICQ to the Complainant for \$500,000. Complainant's counsel, through its message of July 29, 2003, rejected Respondent's offer.

Respondent eventually abandoned its federal trademark application for the mark SPEED ICQ and represented to Complainant's counsel that it would cease using the mark EICQ. Copies of correspondence between the parties were provided in Exhibits 14 and 15 to the Complaint.

Despite those representations, Complainant's counsel learned that Respondent had not ceased its use of either the mark EICQ or the two domain names <eicq.net> and <eicq.org>. During February-September, 2006, Complainant's counsel sent further e-mail messages to Respondent concerning this, as reflected in the messages in

Exhibits 16 and 17 to the Complaint, but evidently received no further response from Respondent.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) instructs this Panel to “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.”

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

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

Identical and/or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to Complainant’s ICQ Mark.

The proper analysis under paragraph 4(a)(1) of the Policy simply focuses on comparing the disputed domain name, <eicq.net>, to Complainant’s ICQ Mark to assess the degree of similarity between the two and its likely potential to cause confusion of Internet users. Any dissimilarities between Respondent’s product name or mark, SPEED EICQ, used on its translation product and Complainant’s ICQ Mark, as well as any differences between the functioning of that product and Complainant’s ICQ chat service and any and all incompatibilities there between are all totally irrelevant to this analysis and will thus be ignored. What matters here is the disputed domain name <eicq.net>.

From a simple comparison of the disputed domain name and the mark ICQ, no doubt exists that the name is confusingly similar to that mark. The only differences between the name and that mark are the prepending of the letter "E" and the appending of a gTLD (generic top level domain) “.net” to the mark -- with the latter being totally irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that minor variations, such as adding short letter or number groups or even generic words to a mark, are each insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Prepending the letter "E" such that the term “ICQ” becomes in the domain name “EICQ” is clearly

such a minor variation. *See Tetris Holding, LLC v. Smashing Conceptions*, FA 1030720 (Nat. Arb. Forum Sept. 11, 2007); *see also Associated Bank Corp. v. Tex. Int'l Prop. Assocs.*, D2007-0334 (WIPO June 28, 2007); *see also Gerber Childrenswear Inc. v. David Webb*, D2007-0317 (WIPO Apr. 24, 2007); *see also SPX Corp. v. Hevun Diversified Corp.*, FA 791657 (Nat. Arb. Forum Nov. 13, 2006); *see also Google Inc. v. Burns*, FA 726096 (Nat. Arb. Forum Aug. 16, 2006); *see also Cheesecake Factory Inc. v. Say Cheesecake*, D2005-0766 (WIPO Sept. 12, 2005); *see also Napster, Inc. v. Vinscani*, D2005-0531 (WIPO July 19, 2005); *see also Caesars Entm't Inc. v. Nova Internet Inc.*, D2005-0411 (WIPO June 22, 2005); *see also Lockheed Martin Corp. v. The Skunkworx Custom Cycle*, D2004-0824 (WIPO Jan. 18, 2005); *see also Lockheed Martin Corp. v. Deborah Teramani*, D2004-0836 (WIPO Dec. 1, 2004); *see also Nat'l Collegiate Athletic Assoc. v. Brown*, D2004-0491 (WIPO Aug. 30, 2004); *see also Lane-Labs USA, Inc. v. Powell Prods.*, FA 155896 (Nat. Arb. Forum July 1, 2003).

Therefore, the Panel finds that the disputed domain name <eicq.net> is confusingly similar to Complainant's ICQ Mark as to cause confusion; hence, Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

Rights or Legitimate Interests

Respondent has not provided any basis that, under the circumstances here, would legitimize a claim to the disputed domain name under paragraph 4(c) of the Policy.

No evidence exists of record that Complainant has ever authorized Respondent to utilize Complainant's ICQ Mark or any mark confusingly similar thereto in the United States, nor does Complainant have any relationship or association whatsoever with Respondent. The Panel looks to the pertinent facts of record pertaining to Complainant's rights and Respondent's activities in the United States and also applies United States law, as the United States, not China, is where Respondent is located.

Consequently, any use in the United States to which Respondent were to put the ICQ Mark or one confusingly similar thereto, certainly including EICQ, in connection with identical or similar goods and services to those currently provided by Complainant under its ICQ Mark would violate the exclusive federal trademark rights now residing in Complainant. In that regard, given the high degree of consumer recognition and goodwill which Complainant enjoys in the United States for its ICQ-branded Internet chat service and hence for its ICQ Mark, the Panel believes that Internet users certainly in the United States who seek Respondent's software would reasonably think, by virtue of the goodwill and reputation Complainant has acquired over time in its ICQ Mark and upon seeing the disputed domain name <eicq.net>, that a relationship or affiliation of some sort exists between Complainant and Respondent, when, in actuality, none exists at all. *See Nat'l Football League v. Blucher*, D2007-1064 (WIPO Sept. 24, 2007); *see also Toilets.com, Inc.*, cited *supra*; *see also Associated Bank*, cited *supra*; *see also GoDaddy.com, Inc., v. GoDaddysDomain.com, Clark Signs, Graham Clark*, D2007-0303 (WIPO May 7, 2007); *Citgo Petroleum Corp. v. Antinore*, D2006-1576 (WIPO Mar. 14, 2007); *see also New Destiny Internet Group, LLC v. SouthNetworks*, D2005-0884 (WIPO Oct. 14, 2005); *see*

also *Cheesecake Factory Inc., Napster and Caesars Entm't, Inc.*, all cited *supra*; see also *Pelmorex Commc'ns Inc. v. weathernetwork*, D2004-0898 (WIPO Dec. 28, 2004); see also *Sybase, Inc. v. Analytical Sys.*, D2004-0360 (WIPO June 24, 2004); see also *Caesars World, Inc. and Park Place Entm't Corp. v. Japan Nippon*, D2003-0615 (WIPO Sept. 30, 2003); see also *Leiner Health Servs. Corp. v. ESJ Nutritional Prods.*, FA 173362 (Nat. Arb. Forum Sept. 16, 2003); see also *AT&T Corp. v. Roman Abreu*, cited *supra*; see also *MPL Commc'ns, Ltd. v. IWebAddress.com*, FA 97092 (Nat. Arb. Forum June 4, 2001); see also *Am. Online, Inc. v. Xianfeng Fu*, D2000-1374 (WIPO Dec. 11, 2000). Consequently, the Respondent, being located in the United States not China, could not legally acquire any public association between it and the ICQ Mark or one similar thereto, at least in the United States for the services rendered there by the Complainant or for goods and service that might be similar thereto. Hence, based on the evidence before the Panel, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Further, there is absolutely no evidence of record that the Respondent has ever been commonly known by the disputed domain name. In that regard, while it can be assumed that Respondent may have acquired some degree of consumer recognition in its mark SPEED EICQ, specifically in conjunction with its translation software product -- that mark is not the subject of this dispute; the term EICQ alone is. Respondent has solely used that term, in the context of the disputed domain name, to re-direct Internet users to its website at <lotousa.com>. The Respondent could never have become known by that term in the United States in light the Complainant's continuous use of its ICQ Mark for nearly 6 years prior to the date (February 21, 2002) on which the Respondent registered the name, without infringing on the exclusive trademark rights of the Complainant. See *Treeforms, Inc. v. Cayne Indus. Sales, Corp.*, FA 95856 (Nat. Arb. Forum Dec. 18, 2000).

Moreover, since Respondent's use of the name is clearly commercial in nature, that use does not constitute either a legitimate noncommercial or fair use, and hence does not fall within paragraph 4(c)(iii) of the Policy. Further, since Respondent's use of the name infringes Complainant's trademark rights, that use is not *bona fide* within paragraph 4(c)(i) of the Policy.

Accordingly, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) and 4(c) of the Policy.

Registration and Use in Bad Faith

The Panel believes that Respondent's actions constitute bad faith registration and use of the disputed domain name.

An e-mail message (see Exhibit 14 to the Complaint) dated July 11, 2003 from Respondent to Complainant's counsel, states, in pertinent part:

We are interested in selling the eicq.net and eicq.org domain names, SPEED EICQ name and mark to your client. Our offer is \$ 500,000.

The Panel finds that, under the specific facts of record here, Complainant did not solicit a specific monetary offer from Respondent to purchase the name but that Respondent did make such an offer to sell the name. Specifically, Respondent made a package offer that also encompassed a companion name <eicq.org>, differing only in its gTLD from the disputed domain name, together with the mark SPEED EICQ. Though Respondent set forth a package price of \$500,000 without specifying a particular sum for sale of the disputed domain name itself, it is reasonable for the Panel to infer, from the lack of any evidence to the contrary, that Respondent then sought a sum for that name which was still well in excess of its cost of registration, hence allowing Respondent to commercially benefit from the sale of that name -- a name which infringes Complainant's exclusive federal trademark rights.

The Panel finds that such conduct constitutes bad faith under the general paragraph 4(b) and thus also under paragraph 4(a)(iii) of the Policy.

Accordingly, the Panel concludes that Complainant has provided sufficient proof of its allegations to establish a *prima facie* case under Paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

DECISION

In accordance with Paragraph 4(i) of the Policy and Paragraph 15 of the Rules, the relief sought by Complainant is hereby **GRANTED**.

Accordingly, the Panel orders that the disputed domain name, <eicq.net>, is to be **TRANSFERRED** from Respondent to Complainant.

Peter L. Michaelson, Esq., Panelist
Dated: November 2, 2007