



**NATIONAL**  
**ARBITRATION**  
**FORUM**

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**American Express Company** )  
200 Vesey Street )  
New York, NY 10285 (USA) )  
 )  
**Complainant** )  
 )  
v. )  
 )  
**Amexsux.com** )  
P.O. Box 321 )  
Chandler, AZ 85244-0321 (USA) )  
 )  
**Respondent** )  

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**Domain Names in Dispute:**  
"amexsux.com"

**COMPLAINT IN ACCORDANCE WITH  
THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

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## Complaint Transmittal Cover Sheet

**To:** Amexsux.com, Respondent  
**From:** American Express Company, Complainant  
**Cc:** National Arbitration Forum  
**Date:** 29 October 2004  
**Re:** "amexsux.com"

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The attached Complaint is being filed against you with the National Arbitration Forum (the "Forum") pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy") adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on October 24, 1999 and incorporated in your Registration Agreement with the Registrar of your domain name(s). By submitting this Complaint to the Forum, the Complainant agrees to abide and be bound by the provisions of the Policy, the ICANN Rules, and the Forum's Supplemental Rules.

**Until you are notified by the Forum that a proceeding has commenced, you have no duty to act with regard to this Complaint.**

- The Forum will examine the Complaint to determine whether it conforms to the ICANN Policy, Rules, and the Supplemental Rules.
- If the Complaint conforms to those standards, the Forum will forward an official copy of the Complaint to you.
- *Once the official Complaint is forwarded to you, you will have **twenty (20)** calendar days to submit a Response to both the Forum and the Complainant in accordance with the Policy, Rules, and Supplemental Rules.*
- You may seek legal assistance to represent you in this administrative proceeding.

*The Policy and Rules governing this proceeding can be found at:*

ICANN Policy	<a href="http://www.icann.org/udrp/udrp-policy-24oct99.htm">http://www.icann.org/udrp/udrp-policy-24oct99.htm</a>
ICANN Rules	<a href="http://www.icann.org/udrp/udrp-rules-24oct99.htm">http://www.icann.org/udrp/udrp-rules-24oct99.htm</a>
Forum Supplemental Rules	<a href="http://www.arb-forum.com/domains/domain-rules.html">http://www.arb-forum.com/domains/domain-rules.html</a>

Alternatively, you may contact the Forum to obtain any of the above documents.

Telephone: (800) 474-2371 or (651) 631-3700  
E-mail: [info@arb-forum.com](mailto:info@arb-forum.com)

***Please provide the Forum with the contact information (mailing address, e-mail address, telephone number) where the official Complaint and other communications in the administrative proceeding should be sent.***



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**Domain Names in Dispute:**  
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**COMPLAINT IN ACCORDANCE WITH  
THE UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

[1.] This Complaint is hereby submitted for decision in accordance with the Uniform Domain Name Dispute Resolution Policy, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved by ICANN on October 24, 1999 (ICANN Policy), and the Rules for Uniform Domain Name Dispute Resolution Policy (ICANN Rules), adopted by ICANN on August 26, 1999 and approved by ICANN on October 24, 1999, and the National Arbitration Forum (NAF) Supplemental Rules (Supp. Rules). ICANN Rule 3(b)(i).

[2.] **COMPLAINANT INFORMATION**

[a.] Name: American Express Company  
[b.] Address: 200 Vesey Street  
New York, New York 10285  
[c.] Telephone: 212-640-4588  
[d.] Fax: 212-640-0361  
[e.] E-Mail: gtld@aexp.com

**COMPLAINANT’S AUTHORIZED REPRESENTATIVE**

- [a.] Name: Dianne K Cahill  
American Express Company
- [b.] Address: 200 Vesey Street, 49<sup>th</sup> floor  
New York, New York 10285
- [c.] Telephone: 212-640-4588
- [d.] Fax: 212-640-0361
- [e.] E-Mail: dianne.k.cahill@aexp.com

- The Complainant’s preferred method for communications directed to the Complainant in the administrative proceeding: ICANN Rule 3(b)(iii).

**Electronic-Only Material**

- [a.] Method: E-Mail
- [b.] Address: dianne.k.cahill@aexp.com
- [c.] Contact: Dianne K Cahill

**Material Including Hard Copy**

- [a.] Method: Fax
- [b.] Address/Fax: 212-640-0361
- [c.] Contact: Dianne K Cahill

- The Complainant chooses to have this dispute heard before a single-member administrative panel. ICANN Rule 3(b)(iv).

**[3.] RESPONDENT INFORMATION**

- [a.] Name: Amexsux.com
- [b.] Address: P.O. Box 321  
Chandler, AZ 85244-0321
- [c.] Telephone: 858-860-6401 Ex 9013
- [d.] Fax: Unknown
- [e.] E-Mail: webmaster@amexsux.com

- Complainant is unaware of who is acting as Respondent’s authorized representative in the administrative proceeding. ICANN Rule 3(b)(v).

**[4.] DISPUTED DOMAIN NAME**

- [a.] The following domain names are the subject of this Complaint: ICANN Rule 3(b)(vi): **“amexsux.com”**

**[b.] Registrar Information: ICANN Rule 3(b)(vii).**

- [i.] Registrar's Name: Tucows Inc.
- [ii.] Registrar Address: 96 Mowat Avenue  
Toronto, ON  
Canada M6K 3M1
- [iii.] Telephone Number: 1-416-535-0123
- [iv.] Fax Number: 1-416-531-5584
- [v.] E-Mail Address: compliance@opensrs.org

**[c.] Trademark/Service Mark Information: ICANN Rule 3(b)(viii).**

The Complainant bases this Complaint on over 160 trademark registrations for AMEX in 83 countries around the world. This does not include AMEX design marks or marks presented in languages other than English. (See Trademark Table attached hereto as Exhibit 1.)

**[5.] FACTUAL AND LEGAL GROUNDS**

**[a.] The Domain Name and Trademark Are Identical**

The American Express Company began using its AMEX trademark in 1969 for a wide variety of financial and travel related services. As indicated by the registrations in the Table attached hereto as Exhibit 1, American Express, a multi-national company with offices worldwide, uses the AMEX mark and name in connection with a wide variety of goods and services including charge card, credit card, smart card and stored value card services, travel and travel-related services, rewards programs, and banking services, that are used by millions worldwide. American Express Company currently has over 60 million cardholders worldwide, with cardholders and consumers of its varied services spanning the globe. In 2003, Complainant grossed over \$25.9 billion in revenue and spent over \$1.45 billion in advertising worldwide. American Express extensively advertises its trademark and services through television, radio and print advertising, through statement inserts, through brochures available at merchant sites and on the American Express web site. (See Cahill Affidavit attached hereto as Exhibit 2.)

Indeed AMEX was found to be a well-known mark in *American Express Company v. MustNeed.com*, the National Arbitration Forum found that "Respondent intentionally registered a domain name that contains in its entirety Complainant's well-known mark. . . ." (See *American Express Company v. MustNeed.com*, FA 257901 (NAF June 7, 2004) attached as Exhibit 3.)

The strength of the Complainant's mark is further evidenced through its listing in both the 30<sup>th</sup> edition of *Acronyms, Initialisms & Abbreviations Dictionary* and the Internet search finder acronymfinder.com. This clearly demonstrates that AMEX is a commonly used acronym to refer to Complainant. (See Exhibit 4 attached hereto). Complainant also submits excerpts from news articles from a Westlaw search for a recent 60 day period showing that AMEX is synonymous with American Express. Over 3,000 articles were found where American Express is referred to as "Amex" around the world; however, in the interests of economy, attached are a few samples of articles found in the search (See Exhibit 5 attached hereto), demonstrating that

AMEX is used to refer to Complainant around the world. Accordingly, Complainant submits that Complainant is recognized as AMEX in the United States and in other jurisdictions outside the U.S. and is famous around the world.

Appending the pejorative term “sux” – a phonetic spelling of “sucks” – to Complainant’s AMEX mark does not change the fact that Complainant’s mark remains the prominent feature of the disputed domain name nor does it create a new or different mark. UDRP panels have addressed this issue and found that “sucks” domain names are not immune from scrutiny as to whether or not the domain name is confusingly similar to the trademark to which they are added.

A confusingly similar test should be held to a different standard when used with Internet search engines. The Internet is made useful to a worldwide public through the operation of search engines. When an Internet user enters a word or combination of words into a search engine, the engine identifies websites of potential relevance by canvassing domain names, metatags and other web page codes. By using Complainant’s “AMEX” mark in its domain name, Respondent makes it likely that Internet users entering “amex” into a search engine will find the “amexsux.com” website in addition to American Express sites. Respondent’s domain name is sufficiently similar to Complainant’s mark that Internet search engine results will list Respondent’s domain name and website when searching Complainant’s mark.

ICANN decisions have held that the addition of “sucks” does not change the overall impression of a mark. See *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, WIPO D2000-0477, July 20, 2000, attached hereto as Exhibit 6.) See also *Infospace Inc. v. Sunwave Communications*, NAF 198015, November 10, 2003; *Cabela’s Inc. v. Cupcake Patrol*, NAF 95080, August 29, 2000; *Access Services and Miss Cleo v. David Molle* NAF 97750, August 13, 2001; *Kendall/Hunt Publishing Co. v. headhunterbob*, NAF 102247, January 14, 2002 and *Stop & Shop Supermarket Co. v. Ian Anderson*, NAF 133637, January 8, 2003. (See above referenced Decisions attached hereto as Exhibit 7.)

Similarly, in the present matter, the Respondent’s addition of a phonetic spelling of the pejorative term “sucks” – “sux – to the AMEX mark and name results in a domain name that is confusingly similar to the Complainant’s AMEX mark. When consumers enter the “amexsux.com” domain name and are not connected to the American Express Company web site, they will be confused as to (1) whether Respondent and/or its web site is approved of or affiliated in some way with American Express and/or (2) whether the “amexsux.com” domain name and/or web site is endorsed, authorized or sponsored by American Express Company. None of which is in fact true.

Alternatively, in addition to a likelihood of consumer confusion, it is also possible that Internet users with search engine results listing Respondent’s domain are likely to be puzzled or surprised by the coupling of Complainant’s mark with the pejorative verb “sux”. Such users, including potential customers of Complainant, are not likely to conclude that Complainant is the sponsor of the identified websites. However, it is likely (given the relative ease by which websites can be entered) that such users will choose to visit the site, if only to satisfy their curiosity. Respondent will have accomplished his objective: diverting potential customers of Complainant to his website by the use of domain name that is similar to Complainant’s mark.

A side-by-side comparison of the domain name at issue, “amexsux.com” and Complainant’s AMEX mark shows they are virtually identical except for the addition of “sux”. Registration and use of “amexsux.com” is likely to cause confusion given the obvious connection between the domain name and American Express. As a result, registration and use of the domain name “amexsux.com” by the Respondent will result in consumer confusion as to source and tarnishment of the Complainant’s mark.

**[b.] Respondent Has No Legitimate Rights in the Domain Name and is Operating the Site for Commercial Purposes**

Respondent should be considered as having no legitimate rights in the domain name “amexsux.com.” Although Respondent lists its name as Amexsux.com in the WHOIS domain name registration information, a search of company records in Arizona found no match for “Amexsux.com” as a company name. Respondent has no pending application or registration for the mark AMEX or AMEXSUX. Registration of the domain name “amexsux.com” with no legitimate rights in or connection to the “Amex” name demonstrates Respondent’s bad faith in attempting to capitalize on the goodwill Complainant has established in its mark and in diverting consumers to Respondent’s web site.

Simply having a domain name with “sux” in the name cannot, by itself, establish fair use; one must look to the content of the website to determine if there is an exercise of free speech which allows the Respondent to rely on the fair use exception. To do otherwise would legitimize cybersquatters, who intentionally redirect traffic from a famous mark, simply through the use of a derogatory term. The right to free speech or fair comment or other fair use defenses - does not apply to this case. Respondent has used the name in such a way that the Complainant’s reputation and goodwill will suffer. For these reasons, whilst the Complainant accepts that the Respondent may be free publicly to comment on the Complainant’s services on the Internet, the Complainant does not consider that such freedom confers a right or legitimate interest in the use of a domain name which is identical to the Complainant’s trade-mark

Use of a “sucks” or “sux” domain name may be justified by legitimate noncommercial use considerations for free expression forums. However, this is not the situation here. Rather, Respondent is operating a commercial site, offering “Amexsux Merchandise” for sale on his site. If you click on the “Amexsux Merchandise” icon, you are connected to cafepress.com and the Amexsux Online Store where you can purchase Amexsux t-shirts, boxer shorts, mugs, baseball caps, and bumper stickers. Respondent is using the domain name in connection with offering items for sale. Respondent is not making a legitimate noncommercial or fair use of the domain name. Respondent’s use of amexsux.com in connection with a web site operating for commercial purpose revokes any claim to use of the domain name to express opinions or to seek opinions of others. To do so would allow inappropriate reliance on the fundamentals of free speech in order to operate a web site for commercial gain. As a result of the sale of merchandise through the web site, the site does not constitute genuine non-commercial use.

Based on the famous nature of American Express’ AMEX mark, the Respondent had notice of Complainant’s famous mark and selected “amexsux.com” to intentionally capitalize on the goodwill American Express has established in its AMEX name and trademarks to divert



consumers seeking American Express to Respondent's web site. Due to the virtually identical nature of the domain name to Complainant's famous AMEX mark, Respondent knew that registration and use of the domain name "amexsux.com" would result in a likelihood of confusion with American Express and its trademarks for consumers.

**[c.] The Respondent Acted in Bad Faith**

Respondent has no legitimate rights in the Domain Name and is operating the site for commercial purposes. The Respondent should be considered as registering the domain name "amexsux.com" in bad faith based on the following:

The value of the domain name rests in its appropriation of the AMEX mark. As indicated in sections 4[c] and 5[a] above, Complainant is the owner of over 160 AMEX trademark registrations in the United States and around the world. Complainant has used the mark continuously since 1969, making the mark famous around the world. Accordingly, under the law, Complainant may protect against infringement and tarnishment of its trademarks.

The disputed domain name "amexsux.com" currently resolves to a site clearly offering the sale of commercial merchandise. The result is Respondent's attempts to show that his site is for free speech or criticism, when in fact, the site is being used for commercial purposes – the sale of merchandise. (See Exhibit 8 attached hereto.)

Evidence that Respondent registered the domain name "amexsux.com" in bad faith can be inferred from the fact that Respondent deliberately chose to register a domain name that entirely incorporated Complainant's famous AMEX mark. Registration with actual or constructive knowledge of a trademark holder's rights in a mark is evidence of bad faith registration. *See Digi International Inc. v. DDI Systems*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002) (holding that "there is a legal presumption of bad faith, when Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively"); *see also Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. Feb. 11, 2002) (finding that "[w]here an alleged infringer chooses a mark he knows to be similar to another, one can infer an intent to confuse").

Merely adding a term such as "sucks" – or "sux" – to the end of a domain name does not automatically make it protected speech. Rather consumers searching for a company by its trademark on a search engine will, at least be intrigued by a website such as amexsux.com, leading many consumers to access the site. As a result the Respondent achieved the objective of diverting consumers to its site. In so doing, these consumers may not continue their search for Complainant's site, interfering with the company's ability to conduct business on the internet. Further, the addition of a common or generic term such as "sucks" or "sux" following a trademark does not create a new or different mark in which the Respondent has rights.

The Respondent's use of "amexsux.com" to include the sale of merchandise for financial gain and allowing posting by third parties to advertise for clients through postings, such as Jon E Drucker, Esq., to entice possible Plaintiffs in a class action lawsuit against Complainant and enrich such third parties is evidence that the site is not a free speech site but a site for

commercial gain and enrichment. Respondent should be precluded from hiding behind the First Amendment while reaping the commercial gain generated from operation of the site.

Beyond the Wal-Mart decision, there are other UDRP rulings finding bad faith registration of such URLs, including, *Infospace Inc. v. Sunwave Communications*, *Cabela's Inc. v. Cupcake Patrol*, *Access Services and Miss Cleo v. David Molle*, *Kendall/Hunt Publishing Co. v. headhunterbob* and *Stop & Shop Supermarket Co. v. Ian Anderson*. NAF found in each case that the purpose for registration of the domain name was commercial gain, rather than free speech and ordered transfer of the domain names. (See Exhibit 7 attached hereto.)

Because there is no affiliation between Respondent and Complainant, the Complainant has no control over the nature and quality of the Respondent's web site or services; therefore, the valuable reputation of American Express and its "AMEX" mark is likely to be diminished, diluted and tarnished by association with Respondent's merchandise and their uncontrolled use.

When consumers seeking the Complainant's web site instead access the Respondent's site at "amexsux.com" it is likely that many consumers will not continue searching the Internet for the Complainant's web site, interfering with the Complainant's ability to conduct business on the Internet. Such interference with Complainant's ability to conduct business on the Internet under its trademarks constitutes bad faith registration and use of the "amexsux.com" domain name.

As indicated above, Respondent use of a virtually identical domain name to Complainant's trademark is likely to cause confusion for consumers searching the Internet and to tarnish the goodwill and integrity the Complainant has developed in its trademarks since it first began use of its AMEX mark in 1969.

Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web sites or other on-line locations, by creating a likelihood of confusion with the AMEX mark as to the source, sponsorship, affiliation, or endorsement of its web sites or other on-line locations or of a product or service on its web. If consumers are seeking the American Express web site and mistakenly access the Respondent's sites, it is likely that many consumers will assume that the sites are affiliated with American Express thereby creating confusion for consumers, disrupting American Express' business and damaging American Express' reputation. Respondent's use of the "amexsux.com" domain name will perpetuate consumer fraud. Such interference with the AMEX mark constitutes bad faith use of the "amexsux.com" domain name as defined by Paragraph 4(b) of the Domain Name Dispute Resolution Policy.

Complainant files this Complaint to protect the goodwill it has established in its AMEX trademarks. The Panel should find that Respondent registered and used the domain name that incorporates Complainant's mark in bad faith. In light of Respondent's foregoing bad faith use of "amexsux.com" this Complaint is now filed requesting transfer of the "amexsux.com" domain name to the Complainant, American Express Company.

[6.] **REMEDY SOUGHT**

The Complainant requests that the Panel issue a decision that the domain name registrations be transferred. ICANN Rule 3(b)(x); ICANN Policy ¶ 4(i).

[7.] **OTHER LEGAL PROCEEDINGS**

At this time, there are no other legal proceedings that have been commenced or terminated in connection with or relating to the domain name that is the subject of this Complaint. ICANN Rule 3(b)(xi).

[8.] **COMPLAINT TRANSMISSION**

The Complainant asserts that a copy of this Complaint, together with the complaint transmittal cover sheet as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Respondent in accordance with ICANN Rule 2(b). ICANN Rule 3(b)(xii); NAF Supp. Rule 4(c).

[9.] **MUTUAL JURISDICTION**

The Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the location of the concerned Registrant.

[10.] **CERTIFICATION**

Complainant agrees that its claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the National Arbitration Forum and panelists, except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) the Internet Corporation for Assigned Names and Numbers, as well as their directors, officers, employees, and agents.

Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted,

/Dianne K Cahill/  
Dianne K Cahill  
Senior Manager, Legal Affairs  
American Express Company

Date: October 29, 2004



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**AFFIDAVIT OF DIANNE K. CAHILL**

I, Dianne K. Cahill, being duly sworn, depose and state:

1. I am a senior manager at American Express Travel Related Services Company, a division of the American Express Company, located at 200 Vesey Street, New York, New York 10285. I have held the position since December 1998. I have personal knowledge of the facts stated in this affidavit. To my knowledge, all of the facts stated in this affidavit are true and correct.

2. American Express Company currently has over 60 million cardholders worldwide.

3. In 2003, the American Express Company grossed over \$25.9 billion in revenue.

4. American Express extensively advertises its trademark and services through television, radio and print advertising, through statement inserts, through brochures available at merchant sites and on the American Express web site at “americanexpress.com”.

5. In 2002, the American Express Company spent approximately \$1.45 billion in advertising expenditures worldwide.

I sign this affidavit on October 28, 2004 at New York, New York.

/Dianne K Cahill/  
Dianne K. Cahill  
Senior Manager, Legal Affairs  
American Express Travel Related Services Company, Inc.  
American Express Company

SUBSCRIBED AND SWORN BEFORE ME on October 28, 2004.

\_\_\_\_\_  
Notary Public  
County: \_\_\_\_\_