



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

**American Express Company** )  
200 Vesey Street )  
New York, NY 10285 (USA), )  
 )  
**Complainant,** )  
 )  
v. )  
 )  
**AmeXsuX.com** )  
P.O. Box 7604 )  
Mesa, AZ 85216-7604 (USA), )  
 )  
**Respondent.** )  
 )

**Domain Name in Dispute:**  
"ameXsuX.com"

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

[1.] Respondent received a Notification of Complaint and Commencement of Administrative Proceeding on November 3, 2004. The Notification stated that Complainant had submitted a Complaint 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 4.

[2.] **RESPONDENT INFORMATION**

- a. Name: ameXsuX.com
- b. Address: P.O. Box 7604  
Mesa, AZ 85216-7604
- c. Telephone: 817-549-0546
- d. Fax: 817-549-0546
- e. E-Mail: webmaster@ameXsuX.com

The Respondent's preferred method for communications directed to the Respondent in the administrative proceeding: ICANN Rule 5(b)(iii).

**Electronic-Only Material**

- a. Method: email
- b. Address: webmaster@ameXsuX.com

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

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

**a. STATEMENT OF FACTS**

As the accompanying Affidavit of Respondent shows in greater detail, AmeXsuX.com is a highly interactive web site that encourages people to exercise their First Amendment right to discuss, criticize or defend American Express products and services.

*Forbes Magazine* has featured ameXsuX.com and rated it as **one of the top five complaint sites** on the web. The site has also been featured in *National Geographic's Traveler Magazine*, ABCNews.com, and Investment News. Per Google's link search on other sites that link to ameXsuX.com, the link search resulted in more than 80 links that point to Respondent's web site.

AmeXsuX is popular and provides a genuine public service. It serves clients and prospective clients of American Express, as well as people who have worked there. As of November 2004, the site has received over 290,000 unique visitors; and the message boards have over 1,900 members and contain over 19,000 postings.

A few representative postings (from just the first two pages of postings at the "Financial" Board) at ameXsux.com are as follows:

Allie Stabler, a client with a complaint against American Express, writes, "Thank you. This is the only place I could get a mailing address for American Express."

Eva Christofano, another client, writes, "I found you[r] site very informative and helpful. Thank you!"

Still yet another client, "BeeFree" writes:

My husband and I just signed paperwork for a VUL [variable universal life insurance] a week ago and after asking many questions, I decided on my own that this didn't make sense to me. If we haven't finished the underwriting (haven't had the medical exam yet), but we've cut a check, how do I get my money back? I'm assuming if we cancel now, we should get a full refund.

By the way, thank for this site. It's confirmed many apprehensions I was having about the advice we've been given. We started working with our advisor a month ago and the VUL and DI are the only things that have been pitched so far.

I'm planning on terminating our agreement with the advisor as soon as possible. I simply can't reconcile myself to using someone who makes commission off of important life decisions for our financial future and well being.

Similarly, another new client, Dhowell, writes:

I paid 500 bucks for a financial plan and my advisor gave me and my wife the plan a couple of days ago. The advisor advised us to buy an annuity within our IRA account, purchase a 250,000 universal life insurance policy, disability insurance, and some AXP funds in something he called a wrap account. Before I complete the paperwork, I wanted to get some opinions on the above advice.

Thanks for the input!

Another person, a then-current American Express financial advisor, writes:

So, when I had come on board, I thought I was going to enjoy working with AEFA, but the things I had read about on amexsux.com were starting to come true. I had read everything with "a grain of salt" because it's a "sux" site, but I had to find out for myself. Better to leave now BEFORE I may have hurt my friends and family through a professional endeavor.

And, finally, one new advisor writes,

I am in the transition of becoming a new F[inancial A[dvisor] at A[merican]E[xpress] F[inancial]A[dvisors]. I have read the site and some arguments have raised my decisions [sic] to go through with this career. I [would] like to get more factual opinions on the experiences [that] former FAs in American Express had, [the] Pros and cons. If you are disgruntled, please don't post your reply. I want the good and the bad.

Next, AmeXsuX contains numerous safeguards to ensure that the site never causes any confusion that it might be associated with American Express. These include the following:

- a. The banner at the top of the site's homepage is as follows:

This web site is not a part of American Express. To visit American Express go to <http://www.americanexpress.com>.

ameXsuX.com  
and  
amexsucks.com



The Unofficial Consumer  
Opinion Web Page



Do Leave Home Without It!

Fight Back! | Contact | News | Links | Home

Welcome to ameXsuX.com  
and amexsucks.com!

- b. The title of the web site clearly results in the word “Unofficial” being displayed in any search engines’ search results.
- c. On the left hand side of the main page, there is an image stating, “This site is not affiliated with American Express.”
- c. The word “NOT” (before “affiliated”) is in a different color -- to add emphasis that the site is not affiliated with American Express.
- d. The first text that any visitor to the site reads is:

Welcome to the unofficial American Express sucks consumer opinion web site. If you are visiting this site you are probably unhappy, like myself, with the way American Express® has treated you. I have used American Express® products in the past and I feel they are over-priced for what you receive in return. I believe you can find quality products from other companies at a fraction of the price and with better treatment.

- e. The terms and conditions on the bottom of the page state, “This web site is not affiliated with American Express.”
- f. That clarification appears on *every page of the web site*.

Additionally, American Express has not even registered the domain name “Amex.” Entering the URL [www.amex.com](http://www.amex.com) in one’s browser directs the web surfer to the American Stock Exchange – not to American Express.

A quick web search of previous arbitration decisions involving American Express further reveals that American Express has never asserted that the American Stock Exchange has violated American Express’s alleged trademark in “Amex.”

Finally, ameXsuX began offering the sale of merchandise on July 2, 2004, through CafePress, which handled billing, production, and shipping. ameXsuX terminated the sale of merchandise on November 3, 2004.<sup>1</sup>

**b. LEGAL DISCUSSION**

**(1) Respondent's Domain Name and Complainant's Domain Name Are Not Identical or Confusing**

American Express suggests in its complaint:

[W]hen 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.<sup>2</sup>

It appears that the only one confused is American Express, for in the very next paragraph of its complaint, it concedes the obvious: “[S]uch users, including potential customers of Complainant, are *not* likely to conclude that Complainant is the sponsor of the identified websites.” (*Emphasis added.*) American Express’s concession renders its claim that the domain names are confusing or identical a moot point. By American Express’s own admission, there is no trademark issue of confusion here.

American Express also claims that the mark “Amex” is widely known and identified with American Express’s business services including credit cards, travel services, and financial advice. If the “Amex” brand were so valuable, well-known and defined, however, one would think American Express would have been able to register the domain name www.amex.com. It has not. Upon entering in a browser the URL, www.amex.com, one is directed to the American Stock Exchange – and not to American Express.

Indeed, based on a quick search of previous arbitration decisions, it appears American Express has never asserted its alleged trademark in “Amex” was being violated by the American Stock Exchange.

But now that ameXsuX is also using the term Amex -- with “sux” appended to it, suddenly American Express feels there is trademark infringement. It thus is clear -- this arbitration case is not about protecting a valid trademark of American Express. Rather, it is a bad faith attempt by American Express to stifle constitutionally protected criticism.

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<sup>1</sup> It grossed a mere five dollars in sales commission, although it is unable to collect the five dollars due to CafePress’s policies.

<sup>2</sup> If consumers are entering the “ameXsuX.com” domain name in the address bar of their browser, they are already acquainted with the site and know it is not affiliated with American Express.

Moreover, all the cases American Express cites are inapplicable to the facts here.

In citing one former arbitration decision, American Express misstates: “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 to Complaint.)” American Express conveniently fails to mention, however, that the Respondent, Mustneeds.com, ***never even responded*** to the complaint; therefore, the case was, by default, automatically decided in American Express’s favor.

Likewise, in the cases of *Access Services and Miss Cleo v. David Molle* NAF 97750; *Kendall/Hunt Publishing Co. v. headhunterbob*, NAF 102247, January 14, 2002; and *Stop & Shop Supermarket Co. v. Ian Anderson*, NAF 133637, January 8, 2003; once again, the respondent failed to respond. So, by default, a ruling was rendered in favor of the complainant.

Here, by contrast, Respondent has responded to the Complaint, as well as to American Express’s untimely Additional Submissions and other correspondence.

American Express has also cited a few other arbitration decisions, failing in each instance to establish any nexus between the facts of those cases and the ones here.

In *Infospace Inc. v. Sunwave Communications*, NAF 198015 and *Cabela’s Inc. v. Cupcake Patrol*, NAF 95080, the domain names in dispute were authorizenetsucks.com and cabelassucks.com. American Express fails to mention, however, that those domain names never had actual web sites associated with them -- until *after* the arbitration complaint was filed. They were mere cybersquatters, seeking to extract money from a valid trademark holder.

AmeXsuX.com, by contrast, is a well-established robust website: It has had over 290,000 unique visitors and over 19,000 postings; it is highly interactive; it has been featured in other well known media and praised as a top consumer complaint site by *Forbes Magazine*.

Complainant also cites *Wal-Mart Stores, Inc. v. Walsucks and Walmarket Puerto Rico*, WIPO D2000-0477, July 20, 2000. American Express conveniently omits that the case involved only cybersquatting, *i.e.*, the ruling was in favor of Wal-Mart because the respondent registered the domain names for the sole purpose of extorting money from Wal-Mart. The owner of ameXsuX.com, by contrast, has never approached American Express in the hope of selling the domain name.

All the other cases that Complainant cites actually favor Respondent.

In *Lucent Technologies, Inc. v. LucentSucks.com*, 95 F.Supp.2d 528 (E.D. Va. 2000), the court noted that “the average consumer would not confuse ‘lucentSucks.com’ with a website sponsored by plaintiff [Lucent].” The same is true for ameXsuX.com; only

due to American Express's failure to even own the domain "Amex.com," ameXsuX's right to its domain name is even stronger.

In *Bally Total Fitness v. Faber*, 29 F.Supp.2d 1161 (C.D. Cal. 1998), where the defendant had created a "Bally Sucks" website, the court held that the parties' marks were not similar -- because the defendant's addition of the word "sucks" [to the plaintiff's trademark] was a **major**, rather than a "minor **change**." Likewise, here, Respondent's addition of the term, "suX" is a major change to a domain name -- that American Express does not even own! Again, because complainant does not even own the domain name that is being appended with the term "sux," Respondent's right to the domain is even stronger than that of the Respondent in *Bally*.

Another relevant case is *Lockheed Martin Corporation v. Dan Parisi*, Case No. D2000-1015 (WIPO January 26, 2001) (domain names at issue: "lockheedsucks.com" and "lockheedmartinsucks.com."). There, the panel logically held that "[b]oth common sense and a reading of the plain language of the policy support the view that a domain name combining a trademark with the word 'sucks' or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark."

Similarly, in *Wal-Mart Stores, Inc. v. wallmartcanadasucks.com*, Case No. 2000-1104 (WIPO Nov. 23, 2000) the panel held "a reasonably prudent user would not mistake the wallmartcanadasucks.com site for any of Wal-Mart's official sites." The Wal-Mart panel also expressed well-founded doubt as to whether "a domain name including 'sucks' ever can be confusingly similar to a trademark to which 'sucks' is appended."

*Taubman Company v. Webfeats*, 319 F.3d 770 (6th Cir. 2003) is also highly instructive. There, the federal circuit court held that the use of Taubman's mark in the domain name, "taubmansucks.com," was *purely an exhibition of free speech*, and the Lanham Act was not invoked. And although economic damage might be an intended effect of the domain owner's expression, the First Amendment protects critical commentary when there is no confusion as to source -- even when it involves the criticism of a business. Such use is not subject to scrutiny under the Lanham Act. In fact, the court noted that the "gripe site" owner is:

free to shout 'Taubman Sucks!' from the rooftops. . . . Essentially, this is what he has done in his domain name. The rooftops of our past have evolved into the internet domain names of our present. We find that the domain name is a type of public expression, no different in scope than a billboard or a pulpit, and [Respondent] has a First Amendment right to express his opinion about Taubman, and as long as his speech is not commercially misleading, the Lanham Act cannot be summoned to prevent it.

Similarly here, since Respondent is free to shout "Amex sucks!" from the rooftops or a pulpit, or paint it on a billboard, he is free to publicly express himself through an internet domain with the same name.

Finally, *Savin Corp. v. savinsucks.com*, NAF File No. FA0201000103982 (March 5, 2002) is also instructive. There, the arbitration board held that Respondent has a free speech right to incorporate the term -sucks to the name Savin. The situation here is no different – except for the critical distinction that American Express does not even possess the right to the domain, “Amex.com.”

Complainant also fails to acknowledge several UDRP decisions that concur with *Bally*. See, e.g., *Bloomberg L. P. v. Secaucus Group*, Claim Number: FA0104000097077 (Nat. Arb. Forum June 7, 2001); (The exercise of free speech for criticism and commentary also demonstrates a right or legitimate interest in the domain name.); *Bosley Medical Group and Bosley Medical Institute, Inc. v. Michael Kremer*, Case No. D2000-1647 (WIPO February 28, 2001) (Respondent’s use of domain name “bosleymedical.com” as a consumer commentary site was clearly fair use.); *Wal-Mart Stores, Inc. v. walmartcanadasucks.com*, D2000-1104 (WIPO Nov. 23, 2000) (Respondent has rights and legitimate interests to use the domain name walmartcanadasucks.com as a forum for criticism of the complainant); *Compusa Management Company v. Customized Computer Training*, Claim Number: FA0006000095082 (Nat. Arb. Forum August 17, 2000) (Respondent’s First Amendment right to offer criticism of the goods and services provided by Complainant via the domain names “stopcompusa.com” and “bancompusa.com” are as legitimate as any commercial activity.); *Bridgestone Firestone, Inc. v. Myers*, D2000-0190 (WIPO July 6, 2000) (Respondent has free speech rights and legitimate First Amendment interests in the domain name “bridgestone-firestone.net.”); *Northland Insurance Companies v. Blaylock* 115 F. Supp.2d 1108, Civ. No. 00-308 (DSD/JMM) (D. Minn. September 25, 2000) (Court denies plaintiff’s application for a preliminary injunction, enjoining defendant from operating a web site critical of plaintiff and its business practices at the domain www.northlandinsurance.com).

In *Bosley Medical Group and Bosley Medical Institute, Inc. v. Michael Kremer*, since the WIPO ruled in favor of Kremer, Bosley Medical decided to sue Kremer in federal court. Respondent cites in *Bosley Medical Institute v. Kremer*, 01-1752WQH(JMA) (S.D.Cal. 04/29/2004) the courts held that Kremer’s criticism was protected speech: “[A]lthough Kremer's domain names do not include the word ‘sucks,’ or other pejorative terms, the commentary contained in the websites may rightly be termed ‘cybergripping.’” Accordingly, it was deemed “protected speech.”

**(2) Respondent Has Legitimate Rights in the Domain Name and is Not Operating the Site for Commercial Purposes**

American Express argues that ameXsuX.com receives commercial gain by the selling of T-Shirts, coffee cups, bumper stickers, boxers, and thongs. Such sales were begun on July 2, 2004, and as of November 1, 2004, the total gross profit on the sale of merchandise amounted to \$5.<sup>3</sup> In light of such meager sales, ameXsuX has discontinued

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<sup>3</sup> In reality, Respondent will never even be able to collect the \$5 in profit as a result of Cafepress’s policy:



its sale of merchandise as of November 3, 2004. Accordingly, American Express's claim of "commercial gain" is moot.

Notwithstanding the mootness of its argument, Complainant mischaracterizes *Digi International Inc. v. DDI Systems*, FA 124506 (Nat. Arb. Forum Oct. 24, 2002), failing to mention that the respondent just added a "-dis" to the end of the complainant's actual web site address. Here, by contrast, ameXsuX has added the term -sux,(which has been upheld as a major change by the various court rulings and arbitration proceedings cited above) – to a domain name not even owned by American Express.

American Express also offers *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1148 (9th Cir. Feb. 11, 2002), yet it omits that the court held there that "the only element of EMI's trademark infringement claim in dispute is whether Smith's use of the terms "EntrepreneurPR," "Entrepreneur Illustrated," and "entrepreneurpr.com" were "likely to cause confusion" as to their "origin, sponsorship, or approval." "The test for likelihood of confusion is whether a 'reasonably prudent consumer' in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks." *Id.* Once again, though, unlike the confusing suffixes in *Entrepreneur*, Respondent has added the term "sux" to the purported trademark. "Sucks" has been upheld as a major unambiguous change -- that eliminates the possibility of confusion -- by a variety of court rulings and arbitration proceedings (cited above).

This legal distinction, combined with the facts that ameXsuX has numerous additional safeguards against confusion, that American Express concedes that there is no confusion with American Express, and that ***American Express does not even own the domain Amex.com***, no "reasonable prudent consumer" could conceivably confuse ameXsuX.com with American Express.

### (3) Respondent Has Acted in Good Faith

American Express accuses Respondent of bad faith. The accusation is absurd. AmeXsuX.com contains safeguards to ensure such confusion never happens: First, the title of the web site clearly results in the word "Unofficial" being displayed in any search engines search results. Second, on the left hand side of the main page is an image stating, "This site is not affiliated with American Express." Third, the word "NOT" is in a different color -- to add emphasis that the site is not affiliated with American Express. Fourth, the terms and conditions on the bottom of the page clearly state, "This web site is not affiliated with American Express." Finally, this clarification appears on ***every page of the web site***.

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*All accrued commissions are paid within 45 days of the month they were accrued. Accrued commission must be equal to or greater than \$25.00 in total for a commission check to be generated. If for any given month your stores commissions are below the \$25.00 threshold those commission will roll forward to the following month until a minimum of \$25.00 is accrued. Commission will be accrued for a maximum of six months in which time if the \$25.00 threshold is not met the commissions will be reversed and forfeited by the shopkeeper.*

Even if Respondent were able to collect the \$5, however, the cost to register and maintain the domain far exceeds that amount. AmeXsuX is truly a non-profit labor of love.

As of November 5, 2004, the ameXsuX.com message boards have over 19,000 postings. Not one has ever expressed any confusion about whether ameXsuX is affiliated with American Express.

**[4.] 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 Response. ICANN Rule 3(b)(xi).

**[5.] RESPONSE TRANSMISSION**

The Respondent asserts that a copy of the Response, as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Complainant, in accordance with ICANN Rule 2(b). ICANN Rule 5(b)(vii); NAF Supp. Rule 5.

[6.] The Respondent respectfully requests that the Administrative Panel denies the remedy requested by the Complainant.

**[7.] CERTIFICATION**

Respondent certifies that the information contained in this Response is to the best of Respondent's knowledge complete and accurate, that this Response is not being presented for any improper purpose, such as to harass, and that the assertions in this Response 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,

November 22, 2004

By: \_\_\_\_\_  
ameXsuX.com