



**NATIONAL
ARBITRATION
FORUM**

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)
)

Domain Names in Dispute:
"amexsux.com"

File Number: **FA 356410**
Commencement Date: November 3, 2004

**COMPLAINANT'S SUPPLEMENTAL WRITTEN
STATEMENT IN ACCORDANCE WITH THE
UNIFORM DOMAIN NAME DISPUTE RESOLUTION POLICY**

This additional written statement of Complainant is submitted in accordance with the Uniform Policy for Domain Name Dispute Resolution, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 (ICANN Policy), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on October 24, 1999 (ICANN Rules) and the National Arbitration Forum (NAF) Supplemental Rules, Rule 7 (NAF Supp. Rules).

Complainant incorporates herein its previously filed Complaint. The following remarks address certain assertions of the Respondent in its Response dated November 22, 2004. On November 22, 2004, the National Arbitration Forum served the Response on Complainant. Per Rule 7 of the National Arbitration Forum Supplemental Rules, this supplemental written statement is being filed within five (5) business days of the last date the Response was due to be submitted to Forum.

A. Respondent Failed to Establish a Legitimate Right in the Domain Name.

Respondent argues that: 1) it “allow[s] all people to exercise their First Amendment right to discuss, criticize or defend American Express products and services”; 2) the site is popular and provides a genuine public service; and 3) American Express is trying to “stifle constitutionally protected criticism.” We do not dispute that the Respondent has the right to exercise his First Amendment rights to free speech. We dispute his use of one of Complainant’s trademarks to do so while selling merchandise and gathering information for a class action lawsuit for commercial gain. Respondent also admits that he was using the site to sell “amexsux” hats, T-Shirts and mugs and only suspended those sales once American Express filed its Complaint. Nothing restricts respondent from starting those sales again at any date.

While Amexsux is free to shout Amex Sux from the rooftops, it is not free to use Complainant’s AMEX mark to operate a site that goes beyond free speech and crosses over to commercial use.

Respondent argues that he has “implemented numerous safeguards to ensure that AmeXsuX.com never causes any confusion that it might be associated with American Express.” 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. Respondent’s “safeguards” do not mitigate any “initial interest confusion” that may occur when someone using a search engine finds amexsux.com. UDRP panels have 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.

Use of the American Express Card design and a spin on the DON’T LEAVE HOME WITHOUT IT! mark on the home page further creates a likelihood of confusion. These uses are not needed to make commentary about American Express.

Whether or not American Express registered the domain name amex.com is irrelevant to this proceeding. This is a trademark dispute and as we know, the same mark can be used to identify totally different goods and services, *i.e.*, DELTA for faucets or airlines or dental services. AMEX is a registered trademark of Complainant and Complainant is entitled to protect its trademarks rights, whether or not Complainant has a domain name registration that corresponds to one of its trademarks or not.

B. Registrant is Using the Domain Name in Bad Faith.

Respondent’s use of the amexsux.com domain name to entice additional Plaintiffs to join in a class action lawsuit against Complainant and enrich himself is evidence that the site, although disguised as a free speech site is not a free speech site at all 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 and his own enrichment through gathering information and filing a class action lawsuit against Complainant.

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 clicked on the "Amexsux Merchandise" icon, you were connected to cafepress.com and the Amexsux Online Store where you could 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 but rather collecting information to unjustly enrich him through a class action lawsuit and to sell merchandise for commercial gain, both blatant commercial activities.

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 true 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.

Respondent's assertion that sales and profit was minimal or that he has since discontinued its sale of merchandise does not change the fact that he was offering merchandise for sale and for commercial gain. Whether or not Respondent can collect any monies owed to him are irrelevant to this matter. Whether sales of t-shirts were \$5.00 or \$10,000...the commercial purpose remains. If the site were truly a "non-profit labor of love", the site would not have commercial purpose. Certainly the operators of amexsux sought to make more than \$5.00 on the sale of merchandise.

The copy of the Complaint sent to Respondent by first class mail was returned as "Undeliverable" and "Attempted, Not known." This provides **further evidence of bad faith** as apparently the address provided in the WHOIS information is false.

Using a web site for commercial purpose is cybersquatting. You don't need to register a URL to with the intent to extort money from the trademark holder to be a cybersquatter.

This Complaint was brought to protect against consumer confusion, dilution and tarnishment of Complainant's valid trademark rights. As indicated in its Complaint, Complainant has used the AMEX mark since 1969. Respondent's registration of the amexsux.com domain name that is the subject of this complaint is virtually identical to the Complainant's famous mark infringes and dilutes the Complainant's rights. 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. . . ." (*American Express Company v. MustNeed.com*, FA 257901, NAF June 7, 2004). The fact that a respondent defaulted in a case does not change the fact that an arbitration decision found AMEX to be a well known mark.

Together with its previously filed Complaint, Complainant offers this additional written statement for the Arbitrator's consideration and requests that bad faith use of the amexsux.com domain name by Respondent be found and amexsux.com be transferred to Complainant.

Respectfully Submitted,

/Dianne K Cahill/

Dianne K Cahill

Senior Legal Manager

American Express Company

29 November 2004