



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 Names in Dispute:
"ameXsuX.com"

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

**RESPONDENT'S SUR-REPLY TO
COMPLAINANT'S ADDITIONAL SUBMISSION**

1. This Sur-Reply is hereby submitted in response to Complainant's Additional Submission filed November 30, 2004, and in support of Respondent's Response, filed November 3 2004, in the above-captioned proceeding, 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. RESPONDENT INFORMATION

Respondent's contact information remains the same as identified in the Complaint.

3. **RESPONDENT’S SUR-REPLY TO COMPLAINANT’S ARGUMENT**

A. Complainant’s Submission Of Additional Written Statements And Documents Was Untimely And Should Be Disregarded.

Supplemental Rule 7 of the Forum’s Supplemental Rules permits the optional submission of additional written statements and documents “within five (5) calendar days after the date the Response was submitted or the last date the Response was due to be submitted to the Forum, whichever occurs first.” (Emphasis added.) Supp. Rule 7 also states, “[e]ach submission must be timely received by the Forum.” (Emphasis added.)

Complainant, however, submitted its additional written statements and documents on November 30 -- *eight (8) calendar* days after Respondent filed his Response on November 22. Even taking into account that November 27 (5-days later) fell on a weekend or that November 25 was a recognized holiday, Complainant’s optional response was due no later than Monday, November 29. Having filed it on November 30, Complainant’s optional submission was thus late – and must be disregarded.

Moreover, the Forum’s Instructions For Filing An Additional Submission Under Forum Supplemental Rule 7 states in relevant part:

Additional submissions must be received by the Forum within five (5) calendar days after the Response was submitted or the last day the Response was due, *whichever occurs first*. Additional submissions received after the five (5) day deadline will not be considered timely. (Emphasis in original.); and

A submission will be considered timely only if it is received in its entirety (submission, attachments, and payment) by the Forum prior to midnight on the fifth calendar day. If the submission, attachments, or payment are not all received by midnight of the fifth calendar day, the additional submission will not be considered complete. (Emphasis in original.)

There is no dispute that Complainant filed its optional additional response in an untimely manner. Considering American Express’s status as a Fortune 100 company -- with a veritable army of lawyers at its disposal, it has no excuse. Its optional additional submission must be disregarded.

Assuming, for the sake of argument only, however, that the Panel accepts and considers Complainant’s untimely optional Additional Submissions, Respondent sur-replies as follows:

B. Respondent has Established a Legitimate Right in the Domain Name, AmeXsuX.com.

In its Additional Submissions, Complainant flails for arguments -- misreading, ignoring and mischaracterizing Respondent’s Opposition.

Complainant starts its futile attack by arguing not the facts – but theoretical possibilities: “[N]othing restricts respondent from starting those sales [of merchandise] again at any date.” Respondent replies, “So what?” Complainant has apparently misread the Response or misconstrues the nature of this proceeding. AmexSux does not sell merchandise. It never had any commercial gain from the sale of merchandise. It has no intention of ever again selling merchandise. This proceeding must consider only facts before it; it cannot contemplate future improbabilities. Accordingly, there is no element of commercial activity to even consider here.

Complainant next asserts that, “[U]DRP 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.” But Complainant hasn’t offered one UDRP or court decision to back this empty assertion. In contrast, Respondent has offered numerous UDRP and court decisions that support the contention that AmexSux.com has established a legitimate right to the domain name. Complainant has not even attempted to dispute even one of those legal authorities. That failure comes for an obvious reason. American Express is in no different a position than all the complainants in those cases in which the trademark holder lost: Lucent obviously had its trademark involved when LucentSucks was permitted; Bally had its trademark involved when BallySucks was permitted; Lockheed-Martin had its trademark involved when LockheedMartinSucks was permitted; Taubman had its trademark involved when TaubmanSucks was permitted; and Savin had its trademark involved when SavinSucks was permitted. Indeed, in light of the First Amendment, CompUSA’s trademark was insufficient to even prevent BanCompUSA and StopCompUSA from operating.

Complainant also asserts that the “[U]se 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.” Poppycock. Again, in *Bally Total Fitness v. Faber*, 29 F.Supp.2d 1161 (C.D. Cal. 1998), the court held that a trademark with –Sucks superimposed will never create any confusion: “[S]ucks” has entered the vernacular as a word loaded with criticism. Faber has superimposed this word over Bally’s mark. It is impossible to see Bally’s mark without seeing the word ‘sucks.’ Therefore, the attachment cannot be considered a minor change. . . . This factor cuts against Bally.” Likewise, here, “It is impossible to see [American Express’s alleged] mark without seeing the word ‘sucks.’” This is fair use.¹

C. Registrant is Not Using the Domain Name in Bad Faith.

Complainant also tries to distract attention from the real issues here by calling attention to the fact that the Respondent is one of the lead plaintiffs in a class action suit against American Express Financial Advisors. Complainant thus alleges that Respondent is (somehow) seeking commercial gain. The allegation is a red herring. First, the issue here is AmexSux.com -- and not the Respondent. AmexSux.com is seeking nothing in the class action. Second, in that class action, the Respondent is seeking only rescission of his financial planning contract and

¹ And even if “DO LEAVE HOME WITHOUT IT!” were objectionable, it could easily be removed without jeopardizing the entire web site.

restitution of his \$350 financial planning fee – in order to force Complainant to cleanup its fraudulent business practices. Such a claim for *restitution* is not “commercial gain.”

Finally, Complainant argues that because its mailed copy of the Complaint was returned as “Undeliverable,” it evidences bad faith because it indicates “the address provided in the WHOIS information is false.” Although the information may be incorrect, it certainly does not prove Respondent’s bad faith. It indicates only that the WHOIS information was not updated after a change in address. The only bad faith evident here is American Express’s in trying to cast aspersions on account of this innocent -- and irrelevant -- fact.

CONCLUSION

For all the forgoing reasons, together with its previous -- timely filed -- Response, Respondent requests that the amxsux.com domain name not be transferred to Complainant.

Respectfully Submitted,

ameXsuX.com

December 1, 2004

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing
**RESPONDENT'S SUR-REPLY TO
COMPLAINANT'S ADDITIONAL SUBMISSION**
in UDRP Proceeding Number FA 318783 for amexsux.com has been duly served upon the
authorized representative of Complainant American Express by electronic transmission and by
facsimile on this 1st day of December, 2004.