

CPR Institute for Dispute Resolution

SCHOLASTIC INCORPORATED

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vs.

RARENAME/WEBREG

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File Number: CPR 05-06

Date of Commencement: May 25, 2005

Domain Name(s): 1) goosebumps.org, 2) goosebump.net,
3) interscholastic.com, 4) scholasticexcellence.com,
5) scolastica.org, 6) scolastica.com,
7) scolastica.net, 8) scholastique.com
9) scholastics.net & 10) scolastique.com

Registrar: 123 Registrations Inc. (#9)
Domaindiscover (#1, 2, 3, 6, 7, 8)
Registration Technologies (#4, 5)

Arbitrators: Steven Brower, Esq. (Chair)
Hon. Nelson A. Diaz, Esq.
James P. O'Shaughnessy, Esq.

Before Steven Brower, Hon. Nelson A. Diaz and James P. O'Shaughnessy, Arbitrators:

PROCEDURAL HISTORY

The Complaint was filed with CPR on or about May 25, 2005, which is deemed the Date of Commencement, and, after review for administrative compliance, was served on the Respondent. The Respondent DID file a Response on or before July 5, 2005. We were appointed Arbitrators pursuant to the Uniform Domain Name Dispute Resolution Policy ("UDRP") and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). Upon the written submitted record including the Complaint (including Exhibits A-E) and the Response (including Tables 1-2 and the Affidavit of Rochelle Hastings), we find as follows:

FINDINGS

Respondent's registered domain names, listed above and numbered by the panel for reference, were registered with the specified Registrars as set forth above on the various dates reflected in Exhibit C to the Complaint. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

IDENTITY/CONFUSING SIMILARITY: Complainant alleges that the domain names, as set forth above, are identical or confusingly similar to Complainant's trademark, Scholastic and/or Goosebumps, as more fully set forth in Exhibit "A" to the Complaint, which applies to various published goods and other material as specified in Exhibit "A" to the Complaint.

Respondent does not contest the validity of the trademarks and does not claim any direct right to use such trademarks, except to the extent that Respondent alleges that the trademarks consist, in whole or in part, of common words and/or phrases.

The Arbitrators find, unanimously, that adding and/or deleting a plural "s" can still be confusingly similar. So, for example, the domain name "goosebump" can be confusingly similar to the trademark "goosebumps." And the domain name

"scholastics" can be confusingly similar to the trademark "scholastic." The Arbitrators are aware, in this instance, that the trademarks at issue (goosebumps and scholastic) also have meanings and/or usage other than to describe the goods and/or services of Complainant. However, there is no evidence here that the other usages are being applied to the domain names at issue.

Some of the marks are described as foreign language derivations of the trademark. For example, and without limitation, scolastica and scholastique. The Arbitrators, unanimously, have determined that this is not the appropriate case in which to determine whether foreign language derivations should be considered as confusingly similar to marks which are used exclusively, by the Complainant, in their native language spelling.

The Arbitrators accept the proposition, for the purpose of consideration of these issues, that Complainant's trademarks may qualify as "famous" marks. However, even with that qualification, the Arbitrators find, unanimously, that the terms "interscholastic" and "scholastic excellence" have common meanings which supersede any potential confusion with the Complainant's marks. In other words, Complainant's evidence of secondary meaning respecting the Goosebump(s) and Scholastic(s) marks is insufficient to extend to these expanded terms, which have independent meaning.

We therefore conclude that the following registered domain names ARE identical or confusingly similar to Complainant's protected marks: 1) goosebumps.org, 2) goosebump.net, 9) scholastics.net.

We therefore conclude that the following registered domain names ARE NOT identical or confusingly similar to Complainant's protected marks: 3) interscholastic.com, 4) scolastica.org, 5) scolastica.net, 6) scholasticexcellence.com, 7) scolastique.com, 8) scholastique.com and 10) scolastica.com. As to these marks, no further consideration will be set forth in this Order.

RIGHTS AND LEGITIMATE INTERESTS: Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain name at issue. In support for this allegation, Complainant notes that Respondent has not made use of such marks for any stated purpose other than resale. Respondent, on the other hand, notes that the marks consist of terms which have non-trademark usage.

UDRP Paragraph 4(c) provides that Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (b) Respondent has been commonly known by the domain name; or (c) Respondent is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

The Arbitrators find no evidence that Respondent has any rights or legitimate interest in the marks.

We therefore conclude, unanimously, that Respondent DOES NOT have rights or legitimate interests with respect to the domain names remaining at issue (#1, 2, 9).

BAD FAITH: In support of the contention of Respondent's bad faith registration and use, Complainant notes that Respondent regularly engages in the business of resale of domain names for a profit. Respondent notes that various decisions have held that acquisition of domain names, which consist of generic terms, does not constitute bad faith under the UDRP policy.

Paragraph 4(b) of the UDRP provides that indications of bad faith include, without limitation, (a) registration for the purposes of selling, renting or transferring the domain name to the Complainant for value in excess of Respondent's cost; (b) a pattern of registration in order to prevent Complainant from reflecting the mark in a corresponding domain name; (c) registration for the primary purpose of disrupting the business of a competitor; or (d) an intentional attempt to attract, for commercial gain, Internet users to Respondent's web site by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation or endorsement of Respondent's web site or location, or of a product or service on Respondent's web site or location.

Significantly, while Respondent regularly and prominently states that it did not acquire the marks for the purpose of selling them to the Complainant, it does not dispute that such sales would most likely go to a competitor. Not does Respondent adequately explain the acquisition of certain additional domains, two of which are those which the Arbitrators find are confusingly similar to the trademarks of Complainant, after receiving written notice from Complainant.

We therefore conclude that Respondent DID register and use the referenced domain names in bad faith, as that term is defined in the ICANN Policy.

CONCLUSION

In light of our findings above that (a) the registered domain names: 1) goosebumps.org, 2) goosebump.net, and 9) scholastics.net ARE identical or confusingly similar to Complainant's protected mark; (b) Respondent DOES NOT have rights or legitimate interests with respect to those domain names; and (c) Respondent DID register and use those domain names in bad faith, as that term is defined in the ICANN Policy, we find in favor of the COMPLAINANT as to those domain names, and in favor of the Respondent as to 3) interscholastic.com, 4) scolastica.org, 5) scolastica.net, 6) scholasticexcellence.com, 7) scolastique.com, 8) scholastique.com and 10) scolastica.com.

REMEDY

Complainant's request to transfer the domain names: 3) interscholastic.com, 4) scolastica.org, 5) scolastica.net, 6) scholasticexcellence.com, 7) scolastique.com, 8) scholastique.com and 10) scolastica.com is hereby DENIED.

Complainant's request to transfer the domain names: 1) goosebumps.org, 2) goosebump.net, and 9) scholastics.net is hereby GRANTED. These domain names shall be transferred to Complainant, Scholastic Incorporated.


Steven Brower, Esq.

7/27/05
Date


Hon./Nelson A. Diaz, Esq.

July 27, 2015
Date


James P. O'Shaughnessy, Esq.

July 27, 2015
Date