



# CPR Institute for Dispute Resolution

File Number: CPR 013  
Date of Commencement: October 14, 2000  
Domain Name: SCHOLASTICTOYS.COM  
Registrar: Network Solutions, Inc.

## COMPLAINANT

Name: Scholastic Inc.  
Address: 555 Broadway, New York, NY 10012-3999  
Telephone: (212) 343-6560  
Fax: (212) 343-6538  
E-Mail: tm&c@scholastic.com

vs.

## RESPONDENT

Name: Dan Waters  
Address: 520 North 900 East, Provo, UT 84606  
Telephone: (801) 235-9431  
Fax: (801) 235-0828  
E-Mail: dwaters@itsnet.com

Before Louise E. Dembeck, Esq., Jerome T. Wolf, Esq. and Thomas M. Pitegoff, Esq., Panelists

## PROCEDURAL HISTORY

The Complaint was filed with CPR on October 11, 2000 and, after review for administrative compliance, served on the respondent on October 14, 2000. The Respondent did not file a Response. In accordance with Complainant's request to have a three-member panel of arbitrators determine this matter, we were appointed Panelists 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 and its attachments, we find as follows:

## FINDINGS

Respondent's registered domain name, SCHOLASTICTOYS.COM, was registered with Network Solutions on December 9, 1999. 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 Complaint to prevail:

- i. Respondent's domain name must be 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 since at least as early as 1922, Complainant has been using the trademark "SCHOLASTIC" and trademarks featuring "SCHOLASTIC", often together with another word or words, in connection with a wide variety of goods and services, including children's books, classroom and professional magazines, software and other educational materials.

Complainant is the owner of more than 65 trademarks registered with the United States Patent and Trademark Office that include the word "Scholastic", in classes including International Class 9 (computer software and related merchandise), Class 16 (periodicals and printed materials), Class 28 (computer games) and others.

Complainant further alleges that it markets and sells many toys under the SCHOLASTIC trademarks, including puzzles and games, arts and crafts supplies, stuffed animals, dolls and other toys, and has recently entered into an agreement with Toys R Us, a national chain of toy stores, to sell Scholastic branded products in Toys R Us stores.

In 1993, Complainant registered the domain name Scholastic.com with Network Solutions, Inc. Complainant provides visitors to its www.scholastic.com site with immediate on-line access to its many and varied educational resources and merchandise, including toys.

Complainant has expended millions of dollars to promote its SCHOLASTIC trademarks and the goods and services that bear those trademarks. As a result of these expenditures and Complainant's efforts, the public has come to associate the word "Scholastic," at least in the children's market, with the goods and services provided by Complainant.

The domain name SCHOLASTICTOYS.COM simply combines the word "scholastic" with the word "toys".

It is our conclusion that the subject domain name is confusingly similar to the Complainant's protected mark.

## **RIGHTS AND LEGITIMATE INTERESTS**

Complainant alleges that Respondent has no rights or legitimate interest with respect to the domain name at issue. In support of this allegation, Complainant notes that Respondent is not currently using, has not used and has made no preparations to use the domain name SCHOLASTICTOYS.COM in connection with the provision of any goods or services, a fact that Respondent has confirmed in correspondence between the parties. In fact, the domain name SCHOLASTICTOYS.COM does not resolve to an active web site.

UDRP Paragraph 4(c) provides that Respondent's rights or legitimate interests in a domain name may be demonstrated, for example, by any of the following circumstances: (a) before notice to Respondent of the dispute, Respondent is using or has 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.

Respondent has not shown that it is using the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services nor that it has made any demonstrable preparations to do so. Respondent has not been commonly known by the domain name, nor is Respondent making legitimate noncommercial or fair use of the domain name.

We therefore conclude that Respondent does not have any rights or legitimate interest with respect to the domain name at issue.

## **BAD FAITH**

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.

Evidence produced by Complainant, including a letter it received from Respondent dated February 1, 2000, demonstrates Respondent's willingness, if not clear intention, either to sell, rent or transfer the domain name to Complainant for a value in excess of Respondent's cost or to attract, for commercial gain, Internet users to Respondent's web site for commercial gain by creating a likelihood of confusion with Complainant's marks.

Respondent having failed to refute both the allegations and the implications of its correspondence, we conclude that Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy.

### **CONCLUSION**

In light of our findings above that (a) the registered domain name is identical or confusingly similar to Complainant's protected mark; (b) Respondent does not have rights or legitimate interest with respect to the domain name at issue; and (c) Respondent did register and use the domain name in bad faith, as that term is defined in the ICANN Policy, we find in favor of Complainant.

### **REMEDY**

Complainant's request to transfer the domain name SCHOLASTICTOYS.COM is hereby GRANTED. The domain name shall be transferred to Complainant, Scholastic Inc.

---

Louise E. Dembeck, Esq.

---

Date

---

Jerome T. Wolf, Esq.

---

Date

---

Thomas M. Pitegoff, Esq.

---

Date