



NATIONAL ARBITRATION FORUM

DECISION

The College Network, Inc. v. Internet Source Communications Inc c/o Domain Administrator
Claim Number: FA0811001234692

PARTIES

Complainant is **The College Network, Inc.** (“Complainant”), represented by **Jonathan G. Polak**, of **Taft Stettinius & Hollister LLP**, Indiana, USA. Respondent is **Internet Source Communications Inc c/o Domain Administrator** (“Respondent”), represented by **Michael A. Freeman**, of **Greenberg Freeman LLP**, New York, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<collegenetwork.com>**, registered with **Fabulous.com Pty Ltd.**

PANEL

The undersigned certify that they have acted independently and impartially and to the best of their knowledge have no known conflict in serving as Panelists in this proceeding.

Hon. Carolyn M. Johnson, (Ret.), Terry F. Peppard, Esq., and James A. Carmody, Esq. (Chair), as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on November 19, 2008; the National Arbitration Forum received a hard copy of the Complaint on November 21, 2008.

On November 23, 2008, Fabulous.com Pty Ltd. confirmed by e-mail to the National Arbitration Forum that the **<collegenetwork.com>** domain name is registered with Fabulous.com Pty Ltd. and that the Respondent is the current registrant of the name. Fabulous.com Pty Ltd. has verified that Respondent is bound by the Fabulous.com Pty Ltd. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On December 1, 2008, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of December 22, 2008 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@collegenetwork.com by e-mail.

A timely Response was received and determined to be complete on December 22, 2008.

Both parties timely filed Additional Submissions which were considered by the Panel.

On December 31, 2008, pursuant to Respondent’s request to have the dispute decided by a three-

member Panel, the National Arbitration Forum appointed Hon. Carolyn M. Johnson, (Ret.), Terry F. Peppard, Esq., and James A. Carmody, Esq. (Chair), as Panelists.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

1. Respondent' **<collegenetwork.com>** domain name, the domain name at issue, is confusingly similar to Complainant's THE COLLEGE NETWORK mark.
2. Respondent does not have any rights or legitimate interests in the domain name at issue.
3. Respondent registered and used the domain name at issue in bad faith.

B. Respondent makes the following assertions:

1. Respondent denies that the domain name is identical or confusingly similar to a mark in which Complainant has exclusive rights and asserts that the domain name at issue is composed of generic terms.
2. Respondent claims rights and legitimate interests in the domain name at issue.
3. Respondent denies that it has registered or used the domain name at issue in bad faith.
4. Respondent asks the Panel to find that Complainant is guilty of reverse domain name hijacking.

C. Additional Submissions:

Both parties filed additional submissions which were taken into consideration by the Panel.

FINDINGS

Complainant claims common law trademark rights in THE COLLEGE NETWORK mark which it began using in commerce in 1995, in order to publish study guides labeled as "comprehensive learning modules" that help adult learners complete college course requirements through the use of college-equivalency exams. Complainant has not been granted registration of THE COLLEGE NETWORK by the USPTO on the principal register, although such application has been made with a recitation of a first use in 1995. On May 2, 1996, the **<collegenetwork.com>** domain name at issue was registered by one of Respondent's predecessors-in-interest. Since 1995, Complainant alleges that it has enjoyed approximately \$647 million in net sales of its study guides identified with the mark and has spent millions of dollars on advertising using its mark. Complainant asserts that **<collegenetwork.com>** is identical or confusingly similar to THE COLLEGE NETWORK mark. Further, Complainant says that Respondent is not currently using the domain name at issue, is not commonly known by that name and that Complainant has not licensed or otherwise authorized Respondent to use THE COLLEGE NETWORK mark or anything similar to it. Finally, Complainant alleges that Respondent registered and has used the domain name at issue in bad faith.

Respondent denies that Complainant has exclusive rights in THE COLLEGE NETWORK and points out that the USPTO has, in an office action, denied registration of the mark on the grounds that it is merely descriptive of Complainant's goods and services. Further, Respondent points out that there has been no showing whatsoever of common law trademark rights because Complainant has not offered evidence sufficient to establish that THE COLLEGE NETWORK has a

“secondary meaning” in the mind of the public such that these words are exclusively associated with Complainant’s goods and services. Because Complainant has failed to prove its own exclusive rights in THE COLLEGE NETWORK, Respondent argues, it has failed to make out a *prima facie* case that Respondent has no rights or legitimate interests in the domain name at issue. Respondent says that it and its predecessors-in-interest have as much right to register a generic domain name as anyone else. Presently, Respondent asserts that it is generating legitimate advertising revenue from pay-per-click activity on the website associated with the domain name at issue. Finally, Respondent says that it could not have registered or used the <collegenetwork.com> domain in bad faith if Complainant has no common law or registered trademark rights in THE COLLEGE NETWORK.

In the Additional Submissions, the parties repeat some of the same arguments, but Complainant provides more exemplars of its advertising and other activities using THE COLLEGE NETWORK to show a common law trademark. Complainant also argues for the first time in its Additional Submission that, even though <collegenetwork.com> was first registered in 1996 by one not a party to this proceeding, Respondent re-registered it in March of 2008. Surely by then, Complainant suggests, it must have obtained its common law trademark rights and, accordingly, Respondent must have registered the domain name at issue in bad faith. Respondent notes, in its own Additional Submission, that Complainant has still failed to show secondary meaning to establish a common law trademark and offers evidence that its registration in 2008 was merely reflective of a transfer of the domain name at issue between two related corporations, the transferor having rights in the domain prior to the 2008 registration with which the Complainant takes issue.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”) instructs this Panel to “decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.”

Paragraph 4(a) of the Policy requires that the Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Registration and Use in Bad Faith

It is not necessary for the Panel to make findings on the first two elements of the Policy since Complaint has clearly failed to show registration or use in bad faith on the part of the Respondent. *See America Online, Inc. v. GSD Internet*, D2001-0629 (WIPO Jun. 25, 2001). At no point in time over the thirteen years since Complainant claims to have been using THE COLLEGE NETWORK has the Panel been shown that Complainant holds registered or common law trademark rights in the mark in question.

Accordingly, Complainant has failed to meet the burden of proof of bad faith registration and use under Policy ¶ 4(a)(iii). *See Starwood Hotels & Resorts Worldwide, Inc. v. Samjo CellTech.Ltd.*, FA 406512 (Nat. Arb. Forum Mar. 9, 2005) (finding that the complainant failed to establish that the respondent registered and used the disputed domain name in bad faith

because mere assertions of bad faith are insufficient for a complainant to establish Policy ¶ 4(a)(iii); *see also Graman USA Inc. v. Shenzhen Graman Indus. Co.*, FA 133676 (Nat. Arb. Forum Jan. 16, 2003) (finding that general allegations of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which the panel may conclude that the respondent acted in bad faith).

The disputed domain name is comprised entirely of common terms that have many meanings apart from use in Complainant's mark. No evidence has been provided to this Panel that the claimed mark serves to uniquely identify Complainant's goods and services. A respondent is free to register a domain name consisting of common terms, and **<collegenetwork.com>** contains commonly-used terms found to be merely descriptive by Complainant's USPTO examiner. Respondent did not register or use the disputed domain name in bad faith under Policy ¶ 4(a)(iii). *See Zero Int'l Holding v. Beyonet Servs.*, D2000-0161 (WIPO May 12, 2000) ("Common words and descriptive terms are legitimately subject to registration as domain names on a 'first-come, first-served' basis."); *see also Target Brands, Inc. v. Eastwind Group*, FA 267475 (Nat. Arb. Forum July 9, 2004) (holding that the respondent's registration and use of the **<target.org>** domain name was not in bad faith because the complainant's TARGET mark is a generic term); *see also Miller Brewing Co. v. Hong*, FA 192732 (Nat. Arb. Forum Dec. 8, 2003) (finding that because the respondent was using the **<highlife.com>** domain name, a generic phrase, in connection with a search engine, the respondent did not register and was not using the disputed domain name in bad faith).

While a strong case might be made that Complainant has failed to hurdle even the first element of the Policy, the Panel unanimously finds that there has been no showing of bad faith registration or use of **<collegenetwork.com>** by Respondent.

Reverse Domain Name Hijacking

The Panel declines to make a finding of reverse domain name hijacking on the part of the Complainant.

DECISION

The Complainant having failed to establish all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

James A. Carmody, Esq. (Chair)
Hon. Carolyn M. Johnson, (Ret.)
Terry F. Peppard, Esq.

Dated: January 24, 2009

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