



NATIONAL ARBITRATION FORUM

DECISION

Chandler Horsley v. Fundacion Private Whois / Domain Administrator

Claim Number: FA1305001497825

PARTIES

Complainant is **Chandler Horsley** ("Complainant"), represented by **Jared M. Richards**, Draper, Utah, USA. Respondent is **Fundacion Private Whois / Domain Administrator** ("Respondent"), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Toronto, Ontario, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<degreesearch.com>**, registered with **Internet.bs Corp.**

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.

Fernando Triana, Esq. as Chair of the Panel

The Honorable Neil Anthony Brown, QC. as Co-Panelist

Honorable Judge James A. Carmody. as Co-Panelist

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on May 2, 2013; the National Arbitration Forum received payment on May 2, 2013.

On May 8, 2013, Internet.bs Corp confirmed by e-mail to the National Arbitration Forum that the <degreesearch.com> domain name is registered with Internet.bs Corp and that Respondent is the current registrant of the name. Internet.bs Corp has verified that Respondent is bound by the Internet.bs Corp registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On May 8, 2013, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of May 28, 2013 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@degreesearch.com. Also on May 8, 2013, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on May 22, 2013.

Complainant submitted an Additional Submission, which was received and determined to be compliant on May 28, 2013.

Respondent submitted an Additional Submission, which was received and determined to be compliant on May 28, 2013.

On May 31, 2013, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Fernando Triana, Esq. as Chair of the Panel, The Honorable Neil Anthony Brown, QC. and Honorable Judge James A. Carmody, as Panelists.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

1. Complainant has used the DEGREESEARCH.ORG trademark since 2006 in connection with its school matching, school directory, and school selection services for prospective college or university students. Complainant has used the <degreesearch.org> domain name to host this business since its inception.
2. Respondent's disputed domain name <degreesearch.com> is identical to Complainant's DEGREESEARCH.ORG trademark. The generic top-level domains ("gTLDs") ".org" and ".com" are irrelevant to the analysis under the Policy.
3. The disputed domain name is identical to Complainant's trademark and it is used to promote identical or similar services as the ones offered by Complainant.

4. Complainant sent a Cease and Desist letter to Respondent arguing that the disputed domain name infringed Complainant's trademark rights. Respondent never responded to the Complainant's letter.
5. Respondent has not used or made demonstrable preparations to use, the disputed domain name in furtherance of a *bona fide* offering of goods or services. Respondent's domain name contains a related-searches list that redirects Internet users to an array of related and competing services. Respondent is profiting from this monetized parking page.
6. Respondent is not commonly known by the disputed domain name.
7. Respondent has recently listed the domain name for sale. Respondent has specifically informed Complainant that the domain name is valued at \$36,000 (Exhibit 5 to the Complaint). Respondent's willingness to surrender this domain name for an out-of-pocket cost illustrates that Respondent has no legitimate interest in the domain name.
8. Respondent's willingness to sell this domain name to Complainant for \$36,000 evidences Respondent's bad faith. Respondent is in the business of buying domain names and owns over 1,852,000 domain names.
9. Respondent seeks to intentionally attract Internet users to this domain name by confusing them into believing the goods and services advertised therein have been officially endorsed by Complainant and its DEGREESEARCH.ORG business. Respondent is presumably provided money in exchange for allowing advertisements to be hosted on the disputed domain name **<degreesearch.com>**.
10. Respondent purchased this domain name on December 29, 2011 and likely had knowledge of Complainant's rights in the DEGREESEARCH.ORG trademark.

B. Respondent

1. Respondent asserts that it did receive Complainant's Cease and Desist letter, and then responded to this letter on March 7, 2013 (Exhibit A to the Response).
2. Complainant misrepresents material facts in this proceeding, as the Complaint explicitly claims to this Panel that Respondent did not respond to the Cease and Desist letter.
3. Respondent is "Investments.org, Inc.", as per the underlying registrant information. "Investments.org, Inc.", was incorporated pursuant to the laws of the Province of Ontario, Canada, and domiciled in Toronto, Ontario, Canada, whose commercial activity is to acquire, develop and sale generic ".com" and ".ca" domain names.
4. Complainant has failed to illustrate rights in the alleged DEGREESEARCH.ORG trademark. Complainant's single-sentence rationale as to why this Panel should find rights is insufficient.
5. Complainant's DEGREESEARCH.ORG sign has not been registered as a trademark before the USPTO (Exhibit F to the Response).
6. A third-party had previously attempted to register the "USDEGREESEARCH" trademark, but the USPTO declined to give a registration to such a generic trademark (Exhibit G to the Response).
7. The expression "degree search" is descriptive of the services provided by Complainant.
8. Complainant has provided no evidence as to revenues, advertising expenses, sales volumes, media reports, or anything else to substantiate its bold claim to rights in this trademark dating back to 2006.
9. Numerous colleges have made more substantial uses of the term "degree" and "search" than Complainant, yet Complainant cannot provide any reason as to why it has some distinct rights into the

usage of these terms. Complainant simply cannot establish rights in two descriptive terms such as “degree” and “search,” but even if it could it would be vastly limited in its ability to police the usage of these terms.

10. Complainant failed to prove any common law rights or secondary meaning of the expression DEGREESEARCH.ORG.
11. The disputed domain name was registered on April 25, 2003. Respondent came to acquire the domain name on or about May 28, 2010. Respondent is in the business of acquiring and selling domain names based on their generic and marketable value. In instances where a domain name consisting of only generic or descriptive terms is registered, the party who prevails is the party that registered first. Respondent’s holding of the domain name for resale is *bona fide* as the domain name is not distinct or stylistic in such a way that it inherently has some superior value to any given party.
12. Respondent’s use of the disputed domain name for advertisement is in itself a legitimate and *bona fide* offering because the advertisements are related to the terms “degree” and “search” and thus provide Internet users with material relevant to the subject-matter of the domain name. A domain name can host pay-per-click advertisement, which is a business model permitted under the Policy.
13. Respondent did not engage in a bad faith course of conduct in soliciting this disputed domain name, as it was entirely descriptive and Respondent is itself in the business of selling domain names.
14. Respondent is willing to sell its domain names for profit to any member of the general public, and it does not tailor its offers to extort any specific trademark holder. Complainant first bid the low figure of \$2,000.00. This merely started a bargaining process in which Respondent replied with its highest offer.

15. Complainant falsely represents that Respondent owns over 1 million domain names. This figure is actually the number of domain names using the privacy service that Respondent is enrolled in.
16. Respondent could not have acquired this domain name with knowledge of Complainant's trademark, as there was no trademark to begin with. Respondent could not have the requisite bad faith at the time of registration to allow Complainant to prevail. Even if Respondent did know of Complainant, there is no evidence to suggest that Complainant has a trade monopoly on all usage of the terms "degree" or "search."
17. Pursuant Rule 15 (e) of the Rules, Complainant's request should be qualified as Reserve Domain Name Hijacking.
18. Complainant knew, or should have known, that it would be incapable of proving its trademark rights under the UDRP. Complainant has instead misled the Panel as to both the existence of a trademark, as well as having misrepresented various facts to this Panel.
19. Complainant's failure to provide any evidence to support its finding, along with its misrepresentations to this Panel amount to bad faith (or at least recklessness) on behalf of Complainant that warrants a finding of reverse domain name hijacking.

C. Additional Submissions

A. Complainant's Contentions

1. Respondent's response to the cease and desist letter went into Complainant's "SPAM" folder, and thus was not viewed until Complainant was notified of the Response.
2. The relevant consumers know that Complainant is a lead provider to for-profit universities.

3. The disputed domain name <degreesearch.com>, since 2012 has been a pay-per-click website.
4. DEGREESEARCH.ORG has acquired secondary meaning due to the extensive and continuous use.
5. Complainant's have spent approximately \$11,000,000 in online marketing efforts and has provided its for-profit college clients approximately 435,000 leads.
6. Complainant actually uses its services to provide for-profit colleges with lists of potential students that they can in turn solicit for enrollment into their programs. Thus the mark is not merely descriptive, as Complainant is not providing tools to allow students to search for college degree programs. The use is distinct in providing the personal information of individuals to for-profit colleges for marketing purposes.
7. Complainant's DEGREESEARCH.ORG trademark has acquired a secondary meaning within the niche market of for-profit colleges and thus is protected.
8. Respondent has by its own admission shown that it is "Investments.org, Inc." and is not commonly known by the disputed domain name.
5. It is hard to believe that a sophisticated domain name reseller such as Respondent would pay \$8,500.00 for a domain name without having completed a simple Internet search to see if that domain name conflicts with an existing trademark.
6. Respondent cannot legitimately argue that it has a *bona fide* purpose in maintaining the disputed domain name, exclusively for hyperlinks, for a period of years. Respondent likely knows of the value of the disputed domain name to Complainant and wishes to capitalize on this.

7. Respondent seeks to sell the domain name in excess of 66 times the estimated value of the domain name.
8. Respondent is using the disputed domain name for the exact same purpose as Complainant's business on its own domain name: solicitation of hyperlinks to "lead" Internet users to the respective for-profit university of their choice. Unlike Complainant's business however, Respondent is not providing the ability to search by degree, and instead only provides generic hyperlinks to for-profit university homepages.
9. Complainant's mark is suggestive and not descriptive in nature, and thus Complainant had good reason to expect that it would prevail in this proceeding. A finding of reverse domain name hijacking is only appropriate when it is clear that a Complainant knew that it did not have rights in a trademark.

B. Respondent's Contentions

1. Complainant's Additional Submission does not comply with the Rules, and thus should not be considered in the Panel's findings. Complainant's Additional Submission is nothing more than an exploit of the Rules, as this Additional Submission is in itself in excess of 90 print pages.
2. Respondent cannot reasonably be expected to address the plethora of new documents and legal arguments that Complainant presents in 91 pages given the fact that Respondent only had a condensed five day window allowed for this Additional Submission.
3. Complainant nowhere in the Complaint mentions "secondary meaning" or "acquired distinctiveness," and it cannot use the Additional Submission as merely another tactic to amend its Complaint.

4. Complainant's original Complaint mentions only that it used the trademark for "school matching" services, "online directory of schools," and "tools, information, and resources for assisting with the school selection process." Complainant cannot now attempt to completely rewrite its own narrative to appear more appealing to this Panel.
5. The Additional Submission should not be admitted.

FINDINGS

1. Complainant argues to have used the expression DEGREESEARCH.ORG as a trademark since 2006; however, neither in the Complaint nor in the Additional Submission does Complainant provide any evidence of such use. After reviewing the Exhibits to the Complaint and the Complainant's Additional Submission, the Panel only found the current screenshot of the website <degreesearch.org> (Annex 1 to the Complaint) and an employee declaration regarding the use of the trademark (Annex 2 to the Additional Submission). The aforementioned documents, and all the other documents filed by Complainant, do not prove the existence of a trademark, its use or its secondary meaning. Consequently, there is neither evidence of secondary meaning nor evidence of use of the expression DEGREESEARCH.ORG as a trademark. Thus, Complainant has not proven any rights regarding the trademark DEGREESEARCH.ORG.
2. Respondent uses a domain name which is the combination of descriptive words.
3. Complainant should have known of the existence of the disputed domain name, since a commercial site such as Complainant's would

have used “.com” as a generic top-level domain, instead of “.org” reserve for organizations.

DISCUSSION

Paragraph 15(a) of 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 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 Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) 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.

Identical and/or Confusingly Similar

Complainant argues to have rights over the trademark DEGREESEARCH.ORG since 2006.

a) Existence of a trademark or service mark in which Complainant has rights

Firstly, it is important to point out that Paragraph 4(a) of the Policy requires the existence of a trademark or a service mark. The industrial property rights are only acquired by registration before the competent office in a number of jurisdictions throughout the world.

The worldwide-accepted definition of a trademark involves the concept of distinctive force as the most relevant element. Said force gives the sign the capability to identify the products or services of its owner and differentiate them from the product and services of other participants in the market.

When a sign is registered as a trademark, it is surrounded by a presumption of sufficient distinctive force, and the owner is granted with an exclusive right over the mark, which entitles him to prevent any third party from using the registered sign or any other sign confusingly similar to it in connection with goods and services of the type with respect to which the trademark is registered.

However, the UDRP does not discriminate between registered and unregistered trademarks¹ and thus, it is well established that a Complainant does not need to own a registered trademark to invoke the Policy. It is sufficient in certain common law jurisdictions, such as the United States of America, that Complainant has rights over an unregistered trademark in order to deserve legal protection, based solely on its use in commerce.

In this case, Complainant argues to have had rights over the expression DEGREESEARCH.ORG since 2006. Since, no trademark registration was provided; Complainant's alleged rights should be common law rights.

Common law rights are obtained with use of the trademark to identify certain goods or services in commerce and to distinguish them from those of competitors.² The common law rights may be established by extensive or

¹ See *MatchNet PLC. v. MAC Trading*, D2000-0205 (WIPO May 11, 2000); see also *British Broad. Corp. v. Renteria*, D2000-0050 (WIPO Mar. 23, 2000).

² See *Lilian Vachovsky, COO, Aplus.Net Internet Servs. v. A+ Hosting Inc.*, D2006-0703 (WIPO Oct. 26, 2006) ("Common law rights in a trademark derive from the use of the mark in commerce so as to distinguish the trademark owner's goods or services from those of its competitors. See

continuous use sufficient to identify particular goods or services as those of the trademark owner.

Hence, to prove common law rights, it is necessary to file evidence regarding the extensive and continuous use, enough to be considered sufficient by the Panel as to identify the goods or services specified by the trademark owner.³

The evidence filed must show that the trademark has acquired secondary meaning, i.e., that the public associates the trademark with Complainant's services. The Panel considers relevant evidence of secondary meaning include the income produced by the trademark (sales), the advertisement and media recognition.⁴

However, there is no evidence of use or secondary meaning of the expression DEGREESEARCH.ORG. After reviewing the Annex 1 to the Complaint where, according to Complainant, there would be evidence of use regarding school matching services, online directory of schools and tools, information and resources for assisting with the school selection process, the Panel only found the current screenshot of the website <degreesearch.org>, which by no means could be understood as use of a trademark.

Complainant also alleged that the expression DEGREESEARCH.ORG had acquired secondary meaning within the niche market of for-profit colleges.

T.A.B. Sys. v. Pactel Teletrac, 77 F.3d 1372 (Fed.Cir. 1996). Under United States trademark law, common law rights in a trademark or service mark may be established by extensive or continuous use sufficient to identify particular goods or services as those of the trademark owner. *See United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918”).

³ *See Tuxedos By Rose v. Nunez*, FA 95248 (Nat. Arb. Forum August 17, 2000).

⁴ *See Lilian Vachovsky, COO, Aplus.Net Internet Services v. A+ Hosting Inc.*, D2006-0703 (WIPO October 26, 2006).

Notwithstanding, no evidence produced by such colleges is filed. The evidence in Annex 2 to the Additional Complaint was produced by an employee of Complainant; thus, it is not possible to conclude that the expression DEGREESEARCH.ORG has acquired secondary meaning within the niche market since the evidence did not come from the market.

Consequently, Complainant has not proven the secondary meaning or use of the expression DEGREESEARCH.ORG. Hence, Complainant has not established common law rights regarding the trademark DEGREESEARCH.ORG.

This Panel, emphasizes on the contradictions found between the Complaint and the Additional Submission to the Complaint, where Complainant adapts Complainant's services identified with the alleged trademark DEGREESEARCH.ORG, from "*school matching services, online directory of schools and tools, information and resources for assisting with the school selection process*" to "*lead generation service*" as to fit the new arguments set forth in the Additional Submission to counter arguments in the Response. This conduct shows lack of seriousness from Complainant and is not sponsored by the Panel.

The Panel considers that "common law rights" should not be taken as a "last resource" when a Complainant does not have a trademark registration, as it appears to be the case of the Complainant's Additional Submission where the argument changes from a trademark right as described in the Complaint, to a common law right and secondary meaning of the expression DEGREESEARCH.ORG, as set forth in the Complainant's Additional Submission. Common law rights must be proven by strong and serious evidence of constant use and recognition from the objective customers of the goods or services. A simple argument based on a screenshot and an employee

declaration, is not enough to comply with the requirements of trademark recognition under the URDP.

As trademark registrations, common law right must be seriously demonstrated, since under the Policy both trademark recognition systems are enforceable as equals. Awarding common law rights to any expression to ultimately granting the same status of either a trademark or service mark without proper evidence, would be improper behavior of this Panel and also very unjust with the systems where, unless a registration is obtained, no trademark rights can be awarded even if the expression allegedly from which trademark rights are derived has been used for many years in a certain jurisdiction.

Moreover, the disputed domain name is integrated by two expressions that together make a description of a service. As per the Merriam Webster online dictionary, the word “degree” means: “a step or stage in a process, course, or order of classification <advanced by degrees>”.⁵ On the other hand, “search” means: “to look into or over carefully or thoroughly in an effort to find or discover something.”⁶ Therefore, the expression “degree search” means: to look for a course or order of classification, i.e., to look for a program which grants a degree. As a result, the expression is indeed descriptive of school matching services, online directory of schools and tools, information and resources for assisting with the school selection process, which are the services provided by Complainant as per the Complaint.

Furthermore, since Complainant is a commercial entity, Complainant should have tried to register a “.com” website, or at least should have done an

⁵ Merriam-Webster Online, degree, (last visited June 12, 2013), <http://www.merriam-webster.com/dictionary/degree?show=0&t=1370981457>

⁶ Merriam-Webster Online, search, (last visited June 12, 2013), <http://www.merriam-webster.com/dictionary/search>

availability search of the “.com” generic top-level domain. However, Complainant registered an “.org” domain name, years after the registration of the disputed domain name. Thus, Complainant should have known of the existence of the disputed domain name, since a commercial site such as Complainant’s would have used “.com” as a generic top-level domain, instead of “.org” reserved for organizations.

Finally, on the descriptiveness of the expression “degree search”, the USPTO has established: “*The term DEGREE SEARCH describes the services, because applicant’s specimen shows that the applicant is providing searches on school and ‘degree programs.’*”⁷

For the aforementioned reasons, the Panel concludes that Complainant has not demonstrated rights in the trademark DEGREESEARCH.ORG for purposes of Paragraph 4(a)(i) of the Policy, and that the expression DEGREESEARCH is merely descriptive for the services provided by Complainant.

Consequently, the element of the Policy paragraph 4(a)(i) has not been established in the present case.

Regarding the reverse domain name hijacking Respondent’s allegation, although the Panel found several suggestions as to the possibility of its existence, the Panel did not find incontestable evidence of bad faith on the filing of the Complaint,⁸ since failing to prove one element of the Policy cannot be considered as bad faith.⁹

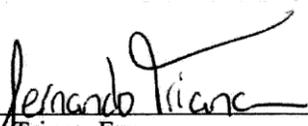
⁷ See *Office Action dated June 6, 2011*. Application Serial No. 85252782. Applicant: Transcend Media LLC.

⁸ See *All About Blinds, LLC v. Blinds Acquisition, LLC c/o Jay Steinfeld*, FA 1029947 (Nat. Arb. Forum Aug. 23, 2007) (“The Panel finds that Complainant has not engaged in reverse domain name hijacking through the filing of the present Complaint as Respondent failed to prove any bad

DECISION

Having not established the element required under the ICANN Policy paragraph 4(a)(i); it will not be necessary to make an in depth study of the remaining elements of paragraph 4(a) of the Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is ordered that the **<degreesearch.com>** disputed domain name **REMAINS WITH** Respondent.



Fernando Triana, Esq.
Arbitrator

Fernando Triana, Esq.
Chair of the Panel

The Honorable
Neil Anthony Brown, QC.
Co-Panelist

June 12, 2013

Honorable Judge
James A. Carmody
Co-Panelist

faith of Complainant in filling this Complaint.”) see also *Brahma Kumaris World Spiritual Organization v. John Allan*, FA 1075486 (Nat. Arb. Forum Nov. 19, 2007) (“Although the Panel concludes that Complainant is not entitled to the relief sought, it finds insufficient evidence of bad faith to justify a determination of reverse domain name hijacking.”)

⁹ See *ECG European City Guide v. Woodell*, FA 183897 (Nat. Arb. Forum Oct. 14, 2003) (“Although the Panel has found that Complainant failed to satisfy its burden under the Policy, the Panel cannot conclude on that basis alone, that Complainant acted in bad faith”).