



NATIONAL ARBITRATION FORUM

DECISION

Joseph L. Carpenter v. DOMAIN ADMINISTRATOR / ORIGINAL WEB VENTURES
INC.

Claim Number: FA1409001578228

PARTIES

Complainant is **Joseph L. Carpenter** ("Complainant"), represented by **Jonathan M.A. Salls**, Nevada, USA. Respondent is **DOMAIN ADMINISTRATOR / ORIGINAL WEB VENTURES INC.** ("Respondent"), represented by **Zak Muscovitch** of **The Muscovitch Law Firm**, Canada.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<myschool.com>**, registered with **Uniregistrar 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.

Honorable **Karl V. Fink (Ret.)**, **Douglas M. Isenberg, Esq.**, and **James A. Carmody, Esq.**, (Chair), as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on September 4, 2014; the National Arbitration Forum received payment on September 4, 2014.

On September 4, 2014, Uniregistrar Corp confirmed by e-mail to the National Arbitration Forum that the <myschool.com> domain name is registered with Uniregistrar Corp and that Respondent is the current registrant of the name. Uniregistrar Corp has verified that Respondent is bound by the Uniregistrar 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 September 9, 2014, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of September 29, 2014 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@myschool.com. Also on September 9, 2014, 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 September 19, 2014.

On September 24, 2014, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Honorable Karl V. Fink (Ret.), Douglas M. Isenberg, Esq., and James A. Carmody, Esq., (Chair), 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 domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

- A. **Complainant's Assertions.** Complainant has rights in the MYSCHOOL mark through a United States Patent and Trademark Office ("USPTO") registration (Reg. No. 3,568,160 registered Jan. 27, 2009, filed March 22, 2007). Complainant uses the MYSCHOOL mark in connection with advertising and communications services, and promotes the service online through the <myschool411.com> website. The <myschool.com> domain name is identical to the MYSCHOOL mark.

Respondent has no rights or legitimate interests in the <myschool.com> domain name. Complainant has not authorized Respondent's use of the mark, and there is no indication that Respondent has been commonly known by the name.

Respondent is not making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the domain name. The domain name resolves to promote pay-per-click advertisements and links. In addition, Respondent's offer to sell the disputed domain name is further evidence that Respondent lacks rights and legitimate interests in the disputed domain name.

Respondent is using the domain name to redirect Internet users and to extort money from Complainant to purchase the domain name. Respondent's willingness to sell the <myschool.com> domain name indicates bad faith. Respondent is using the disputed domain name to mislead Internet users into

believing Complainant has some association with the disputed domain name and resolving content, which enables Respondent to generate click-through revenue. Respondent acquired the disputed domain name after Complainant registered the MYSCHOOL mark with the USPTO, and therefore Respondent had at least constructive notice of Complainant's rights.

- B. **Respondent's Assertions.** The Complaint is a misleading attempt to obtain the disputed domain name. In fact, this is Respondent's second bite at the UDRP. Respondent cites the previous UDRP case *Joseph L. Carpenter v. Foresight.com and Andy Booth*, FA 1319483 (Nat. Arb. Forum June 2, 2010), in which Complainant sought the transfer of this <myschool.com> domain name to no avail. The <myschool.com> domain was initially registered April 4, 1996 (almost four years before the UDRP), and purchased by Respondent in March 2013.

The <myschool.com> domain name is composed of common, generic terms. A Google search for "my school" shows at least 112 million results, none of which is associated with Complainant.

Respondent obtained the disputed domain name on or about March 1, 2013, following a public auction where Respondent was the successful bidder in the amount of \$42,000.00. Respondent was attracted to the domain name purely as a result of its value as a generic or descriptive common term. Respondent has bid on and purchased numerous other generic and descriptive domain names. Selling domain names comprised of generic terms is a recognized and legitimate practice.

Respondent has legitimately used the domain name for advertising related to the descriptive nature of the domain name itself. Respondent's use of the domain name for advertising related to schools is an obvious and natural use to follow

from the <myschool.com> domain name. Such use evinces legitimate interest in the domain name.

As to bad faith, actual knowledge is required, not simply constructive knowledge. Because there is no significant value or reputation in the MYSCHOOL mark as purportedly used by Complainant, the accusation that Respondent acquired the domain name to target Complainant's business does not hold water.

Complaint is trying to hijack the domain name to which he was never entitled. Complainant attempted to mislead the Panel as to the scope of Complainant's business. Further, Complainant tried to gloss over the fact that he had filed a UDRP claim previously, which proved unsuccessful.

FINDINGS

Complainant has rights in the MYSCHOOL mark through a United States Patent and Trademark Office ("USPTO") registration (Reg. No. 3,568,160, registered Jan. 27, 2009, filed March 22, 2007). Complainant uses the MYSCHOOL mark in connection with advertising and communications services, and promotes the services online through the <myschool411.com> website. The <myschool.com> domain name is identical to the MYSCHOOL mark.

Respondent has legitimately used the domain name for advertising related to the descriptive nature of the domain name itself. Respondent's use of the domain name for advertising related to schools is an obvious and natural use to follow from the <myschool.com> domain name. Such use evinces legitimate interest in the domain name.

There is no persuasive evidence that Respondent registered and has used the domain name at issue in bad faith.

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 has rights in the MYSCHOOL mark through a United States Patent and Trademark Office ("USPTO") registration (Reg. No. 3,568,160, registered Jan. 27, 2009). Complainant uses the MYSCHOOL mark in connection with advertising and communications services, and promotes the services online through a website using the <myschool411.com> domain name. Complainant's USPTO registration is a sufficient showing of rights pursuant to Policy ¶ 4(a)(i). *See Metro. Life Ins. Co. v. Bonds*, FA 873143 (Nat. Arb. Forum Feb. 16, 2007) (finding that a USPTO trademark registration adequately demonstrates a complainant's rights in a mark under Policy ¶ 4(a)(i)).

The <myschool.com> domain name is identical to the MYSCHOOL mark. The domain name differs from the mark only by the addition of the generic top-level domain ("gTLD") ".com." Prior panels have consistently held that the addition of a

gTLD is irrelevant to the Policy ¶ 4(a)(i) confusing similarity analysis. *See Abt Elecs., Inc. v. Ricks*, FA 904239 (Nat. Arb. Forum Mar. 27, 2007) (“The Panel also finds that Respondent’s <abt.com> domain name is identical to Complainant’s ABT mark since addition of a generic top-level domain (“gTLD”) is irrelevant when conducting a Policy ¶ 4(a)(i) analysis.”).

The Panel finds that Policy ¶ 4(a)(i) has been established.

Rights or Legitimate Interests

Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name under Policy ¶ 4(a)(ii), and then the burden shifts to Respondent to show it does have rights or legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm’t Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

The Panel finds that Complainant has not established a *prima facie* case in support of its arguments that Respondent lacks rights and legitimate interests under Policy ¶ 4(a)(ii). *See Terminal Supply, Inc. v. HI-LINE ELECTRIC*, FA 746752 (Nat. Arb. Forum Aug. 24, 2006) (holding that the complainant did not satisfactorily meet its burden and as a result found that the respondent had rights and legitimate interests in the domain name under UDRP ¶ 4(a)(ii)); *see also*

Workshop Way, Inc. v. Harnage, FA 739879 (Nat. Arb. Forum Aug. 9, 2006) (finding that the respondent overcame the complainant's burden by showing it was making a *bona fide* offering of goods or services at the disputed domain name).

Respondent has legitimately used the domain name for advertising related to the descriptive nature of the domain name itself. Specifically, Respondent explains it has used the domain name for advertising related to schools, which is an obvious and natural use to follow from the <myschool.com> domain name. The disputed domain name resolves to feature links such as "Online Courses," "Home Schooling," "Distance Education," and "Teaching Jobs." See Compl., at Attached Ex. 12. In *Canned Foods, Inc. v. Ult. Search Inc.*, FA 96320 (Nat. Arb. Forum Feb. 13, 2001), the panel stated, "Respondent is using the domain <groceryoutlet.com> for a website that links to online resources for groceries and similar goods. The domain is therefore being used to describe the content of the site." As a result, the panel in *Canned Foods* found that the respondent was making a *bona fide* offering of goods or services with the disputed domain name. Similarly here, this Panel finds that Respondent is using the <myschool.com> domain name to describe the content of the site, namely for a website that links to online resources for schooling and related educational services. Therefore, the Panel holds that Respondent has made a *bona fide* offering of goods or services at the website using the domain name pursuant to Policy ¶ 4(c)(i).

Respondent counters the claim that its willingness to sell the domain name is suggestive of no rights or legitimate interests. Respondent urges that it obtained the disputed domain name following a public auction where it won the bid at \$42,000.00. Respondent adds that it was attracted to the domain name purely as a result of its value as a generic or descriptive common term, which is a practice Respondent has engaged in as seen by its holding of numerous other generic and descriptive domain names. The selling of domain names comprised of generic

terms is a recognized and legitimate practice. Prior panels have been persuaded in similar circumstances. *See Franklin Mint Fed. Credit Union v. GNO, Inc.*, FA 860527 (Nat. Arb. Forum Mar. 9, 2007) (concluding that the respondent had rights or legitimate interests in the <fmcu.com> domain name because it was a generic domain name reseller who owned numerous four-letter domain names). Accordingly, Respondent's purchase of this <myschool.com> domain name is consistent with the legitimate practice of generic domain resale.

The Panel finds that Policy ¶ 4(a)(ii) has not been established.

Registration and Use in Bad Faith

Where a complainant does not prove one or more of the elements required by the UDRP, the panel is compelled to issue a decision denying the complaint, regardless of the complainant's ability to prove the other element(s) required by the Policy. Accordingly, under such circumstances, any discussion by the panel with respect to such other element(s) would be unnecessary in reaching a decision to deny the complaint. *See, e.g., Admerex Limited v. Metyor Inc.*, WIPO Case No. D2005-1246 (“[s]ince the Complainant must prove all three elements of the Policy, and since the Complainant fails under the third element,... it is not necessary to make a finding under the second element of the Policy”); *Micro Electronics, Inc. v. MicroCenter*, WIPO Case No. D2005-1289 (where the complainant failed to prove the second element of the Policy, “there is no need for the Panel to address the third element of the Policy”). Therefore, given that the Panel in the instant case finds, as discussed above, that Complainant has failed to prove the second element of the UDRP – that is, paragraph 4(a)(ii) – the Panel makes no conclusive findings with respect to the third element of the Policy.

Reverse Domain Name Hijacking

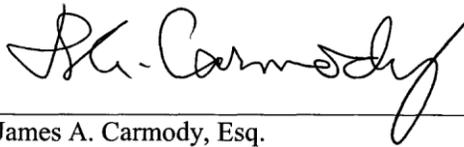
The Panel declines to make a finding of RDNH under the circumstances of this case.

DECISION

The Complainant not having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

Accordingly, it is Ordered that the <myschool.com> domain name **REMAIN WITH** Respondent.

Honorable Karl V. Fink (Ret.), Douglas M. Isenberg, Esq.,
and James A. Carmody, Esq., (Chair), as Panelists.

A handwritten signature in black ink, appearing to read "J.A. Carmody", written over a horizontal line.

James A. Carmody, Esq.
Arbitrator

James A. Carmody, Esq. (for the Panel)

Dated: September 30, 2014