



CPR Institute for Dispute Resolution

COMPLAINANT

Grolier Incorporated
90 Old Sherman Turnpike
Danbury, Connecticut 06816
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E-mail: tm&c@scholastic.com

File Number: CPR0220

Date of Commencement: August 6, 2002

Domain Name: groliers.com

Registrar: Tucows, Inc.

vs.

RESPONDENT

Research Center
1525 Broadway
New York, New York 10010
Tel: not supplied to registrar
Fax: not supplied to registrar
E-mail: americanclinic@yahoo.com

Before Peter L. Michaelson, Esq., Louise E. Dembeck, Esq. and Sandra A. Sellers, Esq., Arbitrators

PROCEDURAL HISTORY

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (“the Policy”), which was adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved on October 24, 1999 and in accordance with the ICANN Rules for Uniform Domain Name Dispute Resolution Policy (“the Rules”) as approved on October 24, 1999 and under the CPR Institute for Dispute Resolution Supplemental Rules for Uniform Domain Name Dispute Resolution Policy then in effect (“the Supplemental Rules”).

The Complaint was filed with CPR on August 5, 2002 and, after review for administrative compliance, on August 6, 2002, CPR sent written notice to Respondent of the commencement of this proceeding together with a copy of the Complaint in accordance with Paragraph 2(a) of the Rules.

Though a response was due on August 26, 2002, the Respondent did not file any Response. On September 13, 2002, we were appointed Arbitrators pursuant to the Policy and the Rules.

Upon the written submitted record including the Complaint and its attached Exhibits A-H, we find as follows.

FINDINGS

The contested domain name, GROLIERS.COM, now owned by the Respondent, was originally registered, with Tucows, Inc., to Golden Media Consulting, on February 24, 2000. It was later transferred to American Medical, and subsequently transferred to the Respondent. One of which being The original registrant, through its registration agreement, agreed to submit to this forum in order to resolve any dispute concerning the domain name pursuant to the Policy, and, in accepting transfer of the name from

its predecessor owners, the Respondent is now so bound.

Paragraph 4(a) of the Policy provides 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.

IDENTICALITY/CONFUSING SIMILARITY:

The Complainant alleges that the contested domain name, GROLIERS.COM, is identical or confusingly similar to Complainant's trademark, GROLIER, which applies, *inter alia*, to encyclopedias featuring articles on various subjects of educational, business, health and entertainment interest, atlases; biographies; and information cards.

In particular, the Complainant relies on its ownership of at least twelve United States registrations for or including the term "GROLIER" (collectively the GROLIER Marks) on which this dispute is based. The Complainant has provided, in Exhibit A to the Complaint, a list of the GROLIER Marks, illustratively including:

- a) GROLIER (block letters)
US registration 2,141,672; registered March 10, 1998
This mark was registered for use in connection with a "full line of pre-recorded CD ROMs and optical discs feature interactive multimedia works on various subjects of educational and business interest" in international class 9.
- b) GROLIER (block letters)
US registration 2,110,255; registered November 4, 1997
This mark was registered for use in connection with a "full line of books and publications on a variety of topics, namely, encyclopaedias featuring articles on various subjects of educational, business, health and entertainment interest, children's books, reference books on various subjects of educational, business and entertainment interest; educational and factual information materials, namely, atlases, biographies, informational cards, books on how to conduct research, learn reading, writing and math skills, learn languages, make arts and crafts and play sports; cookbooks; trading cards; instructional books and manuals for CD-ROM and optical discs products; series of fiction books" in international class 16.
- c) GROLIER MULTIMEDIA ENCYCLOPEDIA (block letters)
US registration 1,975,416; registered May 21, 1996
This mark was registered for use in connection with a "computer programs and instructional manuals sold as a unit in the nature of reference works and educational materials for adults and children" in international class 9.

The Complainant, a global publishing and media company which produces and distributes children's books, reference and encyclopedia volumes and multimedia products, asserts that it is among the leading direct-to-home distributors of children's books and other educational materials and sells these and other products through its popular Internet web site accessible at www.grolier.com.

The Complainant states that it has been using its mark GROLIER and other marks featuring the term GROLIER preceded or followed by other word(s) (the GROLIER Marks) since at least as early as 1895, in connection with a wide variety of goods and services and has continuously, exclusively and extensively used the GROLIER Marks in connection with the promotion and sale of products and services throughout the United States and other countries.

The Complainant further relies on its registration of the domain name GROLIER.COM with Network Solutions, Inc. in April, 1995 and its use, continually since then of the GROLIER Marks in connection with its Internet web sites, including www.grolier.com.

The Complainant alleges it has expended millions of dollars to promote its GROLIER Marks and the goods and services which bear those marks as a result of which the public has come to strongly associate the goods and services provided by the Complainant with those marks.

The Complainant contends that the contested domain name is confusingly similar to the GROLIER Marks, and the Complainant's domain name, GROLIER.COM, because the contested name copies the Claimant's mark "GROLIER" (in its entirety) and merely adds the letter "s" at the end. The Complainant contends that the existence of the letter "s" at the end of the contested domain name does not make it any less confusing to consumers because consumers commonly use "Grolier" and "Groliers" interchangeably when referring to the Complainant's products and services.

Merely appending the letter "s" to the mark "GROLIER" to yield the contested domain name, GROLIERS.COM, is a change that is so *de minimus* that it utterly fails to dispel user confusion and is, for all intents and purposes, equivalent to the Complainant's mark "GROLIER."

Therefore, the Panel finds that the contested domain name groliers.com sufficiently resembles the Complainant's mark "GROLIER" as to cause confusion; hence, the Complainant has shown sufficient similarity between that mark and the contested domain name under paragraph 4(a)(i) of the Policy.

RIGHTS AND LEGITIMATE INTERESTS:

The Complainant alleges that the Respondent has no rights or legitimate interests with respect to the domain name at issue.

Paragraph 4(c) of the Policy provides that the Respondent's rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that: (i) before notice to the Respondent of the dispute, the 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 (ii) the Respondent has been commonly known by the domain name; or (iii) the 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.

Specifically, in support of this allegation, Complainant contends that the Respondent has not been commonly known as GROLIERS.COM or GROLIERS as an individual, business or other organization. Moreover, Complainant states that the Respondent has not been authorized by the Complainant to use the GROLIER Marks and is not affiliated with the Complainant in any way.

By not submitting a response, the Respondent has not contested the allegations of the Complaint and has failed to invoke any circumstances that could demonstrate, pursuant to Paragraph 4.c. of the UDRP, any rights or legitimate interests in the Domain Name.

Thus, the Panel finds that the Respondent has no rights or legitimate interests in the contested domain name within paragraph 4(a)(ii) of the Policy.

BAD FAITH:

The Complainant contends that the Respondent's actions amount to bad faith registration and use under the Policy.

Paragraph 4(b) of the Policy provides various examples of a respondent's conduct that signify bad faith including, without limitation: (i) registration for the purposes of selling, renting or transferring the domain name to the complainant for value in excess of the respondent's cost; (ii) a pattern of registration in order to prevent the complainant from reflecting the mark in a corresponding domain name; (iii) registration for the primary purpose of disrupting the business of a competitor; or (iv) an intentional attempt to attract, for commercial gain, Internet users to the respondent's web site by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation or endorsement of the respondent's web site or location, or of a product or service on the respondent's web site or location.

From the record, the Respondent appears to have acquired the contested domain name from American Medical, which acquired the contested domain name from its original registrant, Global Media Consulting.

The Complainant states that it first became aware of Global Media Consulting's registration and use of the contested domain name, GROLIERS.COM, in October of 2000, at which time the Complainant informed Global Media Consulting by various letters (copies of which appear in Exhibit C to the Complaint) that the use of that domain name infringed upon the Complainant's rights. Global Media Consulting never responded to any of those letters.

The Complainant then states that when it subsequently learned that the contested domain name had been transferred to American Medical, the Complainant immediately sent a letter to inform American Medical that use of the contested domain name infringed upon the Complainant's rights. In that regard, the Complainant sent American Medical a series of letters, the first two of which are attached to the Complaint and included copies of the Complainant's prior correspondence with Global Media Consulting.

The Complainant states that thereafter, upon learning that the contested domain name had been assigned to Respondent, it immediately wrote to Respondent and sent the Respondent copies of the Complainant's previous correspondence with both Global Media Consulting and American Medical. The letter to Respondent was sent to the address it supplied to the registrar (as specified in the WhoIs entry for the

contested domain name, indicated in Exhibit B to the Complaint) but the letter to the Respondent was returned as undeliverable. The Complainant contends that the Respondent's failure to provide accurate and complete name and contact information to its registrar is, in and of itself, evidence of Respondent's bad faith in acquiring the contested registered domain name.

The Complainant contends, on information and belief, that the contested domain name was registered and acquired by the Respondent primarily for the purpose of luring the Complainant's customers to the Respondent's Internet portal site, which has, at times, included prominently displayed links to sites that offer online gambling. For example, at one time a user who accessed a web site through GROLIERS.COM, perhaps mistakenly while trying to access the Complainant's Grolier's web site GROLIER.COM, was directed to an Internet portal site provided through Engine54.com. This portal site, among other things, offered numerous links to online gambling sites. A copy of a hard-copy printout of that portal site, as it appeared on December 19, 2001, has been provided in Exhibit G to the Complaint.

The Complainant states that, as of the date it filed the Complaint, the contested domain name resolves to a web site called "Groliers Travel Company", which is currently under construction (a copy of the home page of that site as it then appeared is contained in Exhibit H to the Complaint.). The Complainant contends that this is further evidence that the Respondent is not using the contested domain name for a legitimate business purpose, but rather to create web sites that take advantage of the Complainant's renown and substantial goodwill and/or for the purpose of selling, renting, or otherwise transferring those sites to the Complainant for valuable consideration.

Furthermore, the Complainant contends that the Respondent's unauthorized use of the contested domain name and particularly in connection with online gambling further evidences bad faith in that it disparages, dilutes, and tarnishes Complainant's GROLIER Marks which are uniquely associated with children and children's education material.

Finally, the Complainant contends that the Respondent's bad faith is also shown by the fact that the Respondent uses the word "encyclopedia" as part of a link to its web site Groliers.com and gives the following as an example: A user who enters "Groliers" into the Google search engine, for example, perhaps while trying to access Grolier's online encyclopedia, is presented with an entry "Groliers Construction Company" with a link entitled www.groliers.com/encyclopedia/hope. If the user clicks on the link, the user is taken to Respondent's web site at Groliers.com.

Based upon the Complainant's evidence, and in the absence of any response by Respondent or its predecessor in interest either to Complainant's letters or to the Complaint, the Panel believes that the Respondents' actions constitute bad faith registration and use of the contested domain name, and this is buttressed by the fact that the Respondent failed to update the registrar with correct contact information once it obtained the contested domain name.

We therefore conclude that Respondent registered and used the domain name in bad faith, under paragraph 4(a)(iii) of the Policy.

CONCLUSION

In light of our findings above that: (a) the contested domain name is identical or confusingly similar to the Complainant's protected mark; (b) the Respondent does not have any rights or legitimate interests in

the contested domain name; and (c) the Respondent registered and used the contested domain name in bad faith, as that term is defined in the ICANN Policy, we find in favor of the Complainant.

REMEDY

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel now grants the relief sought by the Complainant.

The contested domain name, specifically <GROLIERS.COM>, is ordered transferred to the Complainant.

Peter L. Michaelson, Esq

September 30, 2002

Louise E. Dembeck, Esq

September 30, 2002

Sandra A. Sellers, Esq

September 30, 2002