



NATIONAL ARBITRATION FORUM

DECISION

Educational Broadcasting Corporation v. DomainWorks Inc. c/o Eric Woodward
Claim Number: FA0701000882172

PARTIES

Complainant is **Educational Broadcasting Corporation** (“Complainant”), represented by **Ellen A. Hochberg**, of **Debevoise & Plimpton LLP**, 919 Third Avenue, New York, NY 10022. Respondent is **DomainWorks Inc. c/o Eric Woodward** (“Respondent”), represented by **Ari Goldberger**, of **ESQwire.com Law Firm**, 35 Cameo Drive, Cherry Hill, NJ 08003, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

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

PANEL

A three- member Panel was constituted. The undersigned Panelists certify that they have acted impartially and to the best of their knowledge and have no known conflict in serving in this proceeding.

Mr. Debrett G. Lyons was appointed as Chair of the Panel and Mr. Peter L. Michaelson and Mr. David E. Sorkin were appointed as his Co-Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on January 5, 2007; the National Arbitration Forum received a hard copy of the Complaint on January 8, 2007.

On January 7, 2007, Fabulous.com Pty Ltd. confirmed by e-mail to the National Arbitration Forum that the <**thirteen.com**> domain name is registered with Fabulous.com Pty Ltd. and that 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 January 10, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of January 30, 2007 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@thirteen.com by e-mail.

On January 20, 2007, Respondent requested, pursuant to Supplemental Rule 6, an extension of twenty (20) days to respond to the Complaint due to extenuating circumstances. Complainant did not consent. On January 26, 2007, the National Arbitration Forum, without Complainant's consent, granted Respondent an extension of twenty (20) days and set a new deadline of February 14, 2007 for a filing of a Response.

A timely Response was received and determined to be complete on February 14, 2007.

On February 15, 2007, the parties requested a stay of the proceeding for a one-time period of forty-five (45) days until April 1, 2007, pursuant to Supplemental Rule 6(b)(i). The National Arbitration Forum granted the stay on February 15, 2007, requiring either party to submit a request to lift the stay by April 1, 2007 or else the Complaint would be withdrawn.

On March 27, 2007, Complainant filed a request to lift the stay of arbitration. The National Arbitration Forum lifted the stay on March 27, 2007 and let the case proceed.

On March 28, 2007, the National Arbitration Forum received a timely Additional Submission from Complainant and determined it to be in compliance with Supplemental Rule 7.

On April 5, 2007, pursuant to Respondent's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Mr. Debrett G. Lyons (Chair), Mr. Peter L. Michaelson and Mr. David E. Sorkin as Panelists.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Complainant alleges that the disputed domain name is identical to a trademark in which it has rights, that Respondent has no rights or legitimate interests in the domain name, and that Respondent registered and used it in bad faith.

In particular, it alleges a common law reputation in the trademark THIRTEEN in Canada and elsewhere long before the disputed domain name was registered by Respondent. Complainant argues that Respondent is not known by the domain name, nor has it made any noncommercial or fair use of the domain name. Complainant alleges that after it initiated contact with Respondent, Respondent posted a landing page at a website corresponding with the domain name which bore no connection with the ordinary dictionary meaning of the word "thirteen" and Respondent benefited from a pay-per-click royalty scheme arising from hits on that website. Complainant alleges more generally

that Respondent's business consists primarily of registering and selling domain names to legitimate businesses and that Respondent knew of Complainant's mark when it registered the domain name. Complainant submits that these acts show both registration and use of the domain name in bad faith.

B. Respondent

Respondent makes no admission or denial that the disputed domain name is identical or confusingly similar to Respondent's trademark. It strongly denies knowledge of Complainant's mark at the time it registered the domain name and argues that Complainant's registered trademark rights all post-date the domain name registration by many years.

Respondent argues that it has a legitimate business in registering and dealing in generic domain names and that the dictionary word THIRTEEN was perceived as potentially desirable to any number of traders. It was therefore registered and added to Respondent's stable of marks for sale. It submits that since that business does not offend the Policy and has previously been held legitimate, it therefore follows that it has a legitimate right and interest in the disputed domain name.

Respondent therefore denies having registered the domain name in bad faith. It also denies any bad faith use of the domain name and submits that before notice of the dispute, the domain name pointed to <blemish.com>, another name registered to Respondent, which carried links to skincare and beauty products of interest to teenage girls. Respondent states that it has no recollection of having been contacted by Complainant.

Respondent submits that the Complaint is an abuse of the administrative proceedings and petitions Panel to find that Complainant has engaged in so-called "reverse domain name hijacking" since at the time the Complaint was filed, Complainant either knew or should have known that it could not show that the domain name was registered in bad faith.

C. Additional Submissions

Both parties made additional submissions and the admissibility and content of those submissions is considered under "Discussion" below.

FINDINGS

The Panel makes the following factual findings:

1. Complainant is a non-profit corporation registered under the laws of the State of New York which produces educational and entertainment programs for public broadcast.
2. Complainant brands its goods and services with various trademarks, including THIRTEEN.

3. Complainant has many US Federal trademark and service mark registrations for the mark THIRTEEN in classes 9, 16, 18, 38 and 41 ('the US Registrations').
4. Complainant first adopted the internet address <WNET.org> for use in connection with its web-based business which began in 1996.
5. Complainant registered <thirteen.org> in November 1997 and it is now Complainant's principal web address.
6. Respondent was previously known as CES Marketing Group at which time it described its business as specialists "in the development and marketing of valuable internet domain names".
7. Respondent's business is located in Vancouver, Canada.
8. Respondent registered the disputed domain name on March 14, 1998.

DISCUSSION

Preliminary Issue

The Panel has given careful consideration to the admissibility and content of the parties' Additional Submissions.

Whilst WIPO's Supplemental Rules are silent as to the treatment of supplemental filings, the National Arbitration Forum's Supplemental Rules treat such filings under Supplemental Rule 7, which specifically allows such filings provided that they are: (a) accompanied by an appropriate filing fee and (b) timely filed. Such is the case here with the Additional Submissions from both parties.

This Panel has in the interests of justice and fairness, accepted the Additional Submissions from both parties and has fully considered those filings.

See generally, Reichert, Inc. v. Leonard, FA 672010 (Nat. Arb. Forum May 24, 2006); *Deep Foods, Inc. v. Jamruke, LLC*, FA 648190 (Nat. Arb. Forum Apr. 10, 2006); *Pierret v. Sierra Technology Group, LLC*, FA 472135 (Nat. Arb. Forum July 1, 2005); *America Online, Inc. v. Miles*, FA 105890 (Nat. Arb. Forum May 31, 2002).

Substantive Issues

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 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;

- (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

(i) Generally

The Panel is unanimously of the view that if the only question before it was whether the disputed domain name is identical to the trademark of the US Registrations, then the answer would be clearly in the affirmative. Moreover, Respondent has not denied the claim.

The Panel must however also determine whether Complainant has rights in the trademark and, ultimately, whether those rights go towards establishing bad faith on the part of Respondent.

(ii) Registered rights

In the first place, it is well established by former panels that US federally registered trademarks carry a presumption of validity and are of themselves adequate proof of rights in a trademark. In this case, Complainant is the owner of, for example, US Trademark Registration No. 2,495,086 in class 9 for “pre-recorded video cassettes and DVDs in the fields of education, news, the sciences, the humanities and the arts,” and Registration No. 2,652,265 in class 38 for “public television and cable broadcasting television services,” both filed on October 4, 1999.

Taking account of the first use in commerce dates indicated for those two registrations leads to a finding that rights in No. 2,495,086 date from October 24, 1999, whilst rights in No. 2,652,265 commence with its filing date, October 4, 1999. Accordingly, the Panel holds that Complainant has rights in the trademark THIRTEEN arising through federal registration from October 4, 1999.

(iii) Common law rights

Complainant's registered trademark rights dating to 1999 are sufficient as a basis for proceeding under the first prong of Paragraph 4(a) of the Policy, but the Panel also considers Complainant's common-law rights here because of their potential relevance to the other two prongs, particularly bad faith. In particular, since the domain name was registered in March 1998, it falls to the Panel to examine what rights Complainant enjoyed prior to that date. Complainant predicates its case on having acquired common law trademark rights through use of the mark in commerce and specifically in connection with educational and entertainment services.

It is useful to set out at length what was said in the case of *WHM L.L.C. v. Northpoint, Inc.*, D2005-1134 (WIPO Jan. 27, 2006):

Regarding any distinction in coverage between registered and unregistered marks, paragraph 4(a) of the Policy simply recites: “You are required to submit to a mandatory administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure, that ... (i) your domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights” [emphasis added]. Nowhere does the Policy contain a restriction that specifically limits its reach to only registered marks. Therefore, given the apparent inclusive nature of the Policy, whether the Complainant has rights to an unregistered mark and hence a protectable interest under the Policy, lies with national trademark law that governs the Respondent’s actions that are the subject of the Complaint. Under American law, rights accrue in unregistered, so-called “common law”, marks as a result of usage, though limited by geographic and product/service markets in which the mark is used. As evidence of this, one need turn no further than to §43 of the Lanham Act (15 U.S.C. §1125(a)) which states, in pertinent part: “Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof ... (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person ... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.” [emphasis added]

Consequently, numerous panels, when faced with unregistered marks, have upheld their protectable status in the United States under the Policy. In that regard, when faced with this issue, the panel in *Brooklyn Institute of Arts and Sciences v. Fantastic Sites, Inc.*, FA 95560 (Nat. Arb. Forum, November 2, 2000) held: “ICANN dispute resolution policy is broad in scope in that the reference to a trademark or service mark in which the complainant has rights means that ownership of a registered mark is not required, unregistered or common law trademark or service mark rights will suffice to support a domain name complaint under the policy”. See, e.g., *True Blue Productions, Inc. v. Chris Hoffman*, WIPO Case No. D2004-0930 (December 22, 2004); *AT&T Corp. v. Roman Abreu d/b/a Smartalk Wireless*, WIPO Case No. D2002-0605 (September 11, 2002); *Peter Frampton v. Frampton Enterprises, Inc.*, WIPO Case No. D2002-0141 (April 17, 2002); *America Online, Inc. v. John Deep d/b/a Buddy USA Inc.*, FA 96795 (Nat. Arb. Forum, May 14, 2001); *Missing Children Minnesota v. Run Yell Tell, Ltd.*, FA 95825 (Nat. Arb. Forum, November 20, 2000); *Mike Warner 2001 v. Mike Larson*, FA 95746 (Nat. Arb. Forum, November 15, 2000); *CMG Worldwide Inc. v. Naughtya Page*, FA 95641 (Nat. Arb. Forum,

November 8, 2000); *Home Properties v. SMSOnline*, FA 95639 (Nat. Arb. Forum, November 2, 2000); and *Bridal Rings Company v. Yemenian*, FA 95608 (Nat. Arb. Forum, October 26, 2000). Furthermore, the panel in *United States Postal Service v. Consumer Info. Org.*, FA 95757 (Nat. Arb. Forum, November 27, 2000) held: “The UDRP does not discriminate between registered and unregistered marks.” In *Exario Network Inc. v. THE DOMAIN NAME YOU HAVE ENTERED IS FOR SALE*, AF-0536, (eResolution, December 11, 2000), the panel recognized: “It is well established that a complainant need not own a registered trademark to invoke the policy. It is sufficient that a complainant have rights in an unregistered trademark.” In that regard, also see *Sand Hill Wholesale of Ohio v. Hatton*, FA 95970 (Nat. Arb. Forum, December 18, 2000), and *David Taylor Cadillac/Buick Co. v. Spider Works, Ltd.*, FA 95832 (Nat. Arb. Forum, November 30, 2000). Similarly, see *American Home Products Corporation v. Healthy Futures*, WIPO Case No. D2000-0454 (August 3, 2000); *Cho Yong Pil v. ImageLand, Inc.*, WIPO Case No. D2000-0229 (May 10, 2000); *SeekAmerica Networks, Inc. v. Tariq Masood and Solo Signs*, WIPO Case No. D2000-0131 (April 13, 2000); and *Bennett Coleman & Co. Ltd. v. Steven S Lalwani and Bennett Coleman & Co. Ltd. v. Long Distance Telephone Company*, WIPO Case No. D2000-0014 and D2000-0015 (March 11, 2000).

Therefore, given that common law trademark rights suffice under the Policy, then as a threshold matter, a question arises as to whether and if so, when, common law trademark rights in THIRTEEN arose.

(iv) Proof of use

Complainant asserts that “for over forty years, Thirteen has been synonymous with educational television programming” (Complaint #5). It goes on to state that it has continuously and extensively used the THIRTEEN mark in connection with an educational television network in the States of New York, New Jersey, and Connecticut since 1977. Complainant asserts it is the flagship public broadcaster in these areas and that it broadcasts to millions of viewers every week. Complainant also claims that some of its television productions under the THIRTEEN mark are carried nationwide by the Public Broadcasting Service (“PBS”), including *Great Performances*, *American Masters*, *Frontier House*, *Nature*, *NOW with Bill Moyers*, and *Cyberchase*.

At the annual television Emmy Awards, Complainant claims that it wins numerous awards for its television programming marketed under the THIRTEEN mark. Complainant also alleges that it spends over \$3.2 million advertising the THIRTEEN mark each year.

In Canada, Complainant alleges that it licenses its programming to local networks. It claims, at various points in the Complaint and the Additional Submissions, that as a result of this long-term, widespread use, the THIRTEEN mark acquired secondary meaning long before Respondent registered the disputed domain name.

For the greater part, these are bald assertions unsupported by evidence. The evidence that is put forward for the Panel's consideration is unconvincing of any significant public exposure of the trademark prior to March 1998. There is simply no support for the claim that the trademark has been used for 40 years. There is no evidence that the mark was first used in 1977. The proof of use which is provided comes largely from a 2004-5 Annual Company Report which records, as would be expected, current rather than historical activities.

Complainant alleges maintenance of an active web presence since 1996 and in support evidences a screenshot of the <wnet.org> homepage from that time. The Panel observes from that screenshot the existence of a dominant mark, "NETSTATION" at the top of the homepage attaching to which is the symbol "SM" (service mark) and in much less obvious lettering below, "Thirteen-wnet," where the word "thirteen" is presented as a logo. Such use -- particularly from Complainant's own actions in designating the mark "NETSTATION" as its service mark -- does not reflect trademark use of the term "thirteen," standing by itself. All that can be inferred from this page is that Complainant is claiming common law trademark rights in the term "NETSTATION" and possibly in the composite term "thirteen-wnet." This page does not suffice to show any trademark use of the term "thirteen," let alone whether any of these three terms has acquired any sufficient distinctiveness in the relevant market to actually qualify as being a common law mark. The evidence adduced here is just deficient for this purpose.

The replacement web address, <thirteen.org>, would logically have only come into existence after the corresponding domain <thirteen.org> was registered in November 1997. We have no evidence as to the form or extent of Complainant's web presence on March 14, 1998 when the disputed domain name was registered, four months later.

In short, the Panel finds that the evidence achieves nothing whatsoever by way of establishing common law rights in the trademark in Canada and does nothing to show common law rights in the mark in the United States at March 14, 1998. Indeed, the single physical piece of evidence showing use prior to that date shows use of a different trademark which the Panel would not regard to be identical to the domain name.

In light of the paucity of the evidence put forth by Complainant, the Panel is left simply with Complainant's bald assertions of reputation of the trademark in Canada prior to the filing date of the domain name registration. Those assertions are not directly rebutted in the Response however in evidence there is supplied a sworn statement of Christopher Wall, principal shareholder of Respondent, who states that he had no knowledge of Complainant's trademark when the domain name was registered. Given the utter lack of

evidence leading to a contrary finding, the Panel accepts Mr. Wall's statement for its own worth and, from it, infers, that no such reputation existed in Canada.

The Panel therefore holds that Complainant has rights in a trademark which is identical to the domain name registered by Respondent however those rights owe their existence solely to the US Registrations and date from no earlier than October 4, 1999.

Rights or Legitimate Interests

Under Policy ¶ 4(a)(ii), it is necessary only for Complainant to make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name. Once it does that, 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) ; *AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006).

Complainant argues that Respondent is not commonly known by the domain name, because the WHOIS information lists "DomainWorks Inc." as the registrant, and nothing else in the record suggests that Respondent is commonly known by the domain name in dispute. The Panel finds nothing in the submissions or the evidence to counter that argument and agrees that Respondent is not commonly known by the domain name.

Complainant claims that Respondent is using the domain name as a commercial website displaying links and advertisements for entertainment services, movies, publications, and DVDs that are in direct competition with the products and services of Complainant. Complainant argues that Respondent is profiting from click-through fees for each consumer it diverts to these competing websites. The Panel finds that Respondent's use of the disputed domain name for these purposes does not represent a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii). See *Trip Network Inc. v. Alviera*, FA 914943 (Nat. Arb. Forum Mar. 27, 2007) ; *Tesco Pers. Fin. Ltd. v. Domain Mgmt. Servs.*, FA 877982 (Nat. Arb. Forum Feb. 13, 2007).

The Panel is not on balance persuaded that the generic character of the domain name is of itself sufficient to prove a legitimate interest when in fact the use to which the name is put bears no connection with the dictionary meaning claimed.

The Panel accordingly finds that Complainant has also established this second limb of the Policy.

Registration and Use in Bad Faith

It is now a commonplace observation that in order to prevail, Complainant must show both bad faith use and bad faith registration of the disputed domain name.

On the evidence presented to it, this Panel is not willing to infer that Respondent had actual knowledge of Complainant's common-law marks in 1998. Additionally, this Panel is not convinced that Respondent picked the word "thirteen" because Complainant was already using it as a trademark, or for any other reason relating to Complainant.

Absent proof or compelling reasons to infer that Respondent registered the domain name with Complainant's business in mind, there is no bad faith. The Panel finds on the evidence that the more likely scenario given Respondent's business is that it hoped to later sell the domain name at a profit without, at least at that time, any contemplation of Complainant or a competitor of Complainant. Again, to do so is not bad faith under the Policy.

Respondent's act in registering the domain name preceded the earliest claim to use of Complainant's trademark in commerce by more than 18 months. It may have been broadly contemporaneous with the material first being posted to the <thirteen.org> website but the Panel has no evidence of that material and instead it is faced with Complainant's use of an altogether different mark "NETSTATION," itself prominently claiming service mark status, from broadly the same period. There is no evidence at all of use of the trademark in Canada and the principal shareholder of Respondent has deposed to no knowledge of the trademark at the time the domain name was registered. The Panel finds no convincing evidence of bad faith registration and so for that reason is not required to consider Respondent's later use of the domain name.

Complainant therefore has failed to establish the third element under the Policy.

Accordingly, the Complaint must fail.

REVERSE DOMAIN NAME HIJACKING

The Panel cites with approval the case of *Koninklijke KPN N.V. v. Telepathy Inc.*, D2001-0217 (WIPO May 7, 2001) where it was said that to prevail on a claim of reverse domain name hijacking, the respondent must show that the complainant brought the claim in bad faith despite the knowledge that the respondent has an unassailable right or legitimate interest in the disputed domain name, or that the respondent lacks the requisite bad faith registration and use of the disputed domain name.

See Mirama Enters. Inc. v. NJDomains, Abuse Contact: abuse@mail.com, FA 588486 (Nat Arb. Forum Jan. 16, 2006) (finding that complainant has engaged in reverse domain name hijacking where the complainant commenced the proceeding despite possessing knowledge of the respondent's rights in the disputed domain name); *Microsoft Corp. v. Domain Registration Phil.*, FA 877979 (Nat. Arb. Forum Feb. 20, 2007) (considering the respondent's allegations of reverse domain name hijacking to be unfounded where the complainant had proven all elements of the Policy); *Watson Pharm., Inc. v. WhoisGuard*, FA 588321 (Nat. Arb. Forum Dec. 19, 2005) (rejecting the respondent's assertion of

reverse domain name hijacking argument because there was no evidence that the complainant was using the Policy other than to declare its rights.)

In this case, Complainant alleges that it only brought this proceeding after its efforts to contact Respondent regarding the contested domain name failed. Having regard to the authorities the Panel finds that this is not an instance of reverse domain name hijacking because Complainant brought this action in the good faith belief that it has rights to the THIRTEEN mark. The Panel has already decided that Respondent did not prove itself to have legitimate interests in the domain name, although it had not registered the name in bad faith. Again, this points away from a successful claim of reverse domain name hijacking and the Panel finds against Respondent on this aspect of the case.

DECISION

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

Debrett G. Lyons, Presiding Panelist
David E. Sorkin, Panelist
Peter L. Michaelson, Panelist
Dated: April 18, 2007

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