



CPR Institute for Dispute Resolution

COMPLAINANT: Scholastic Inc.

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E-Mail: afradin2@scholastic.com

File Number: CPR005

Date of Commencement: August 1, 2000

Domain Names: scholasticaustralia.com

Registrar: Network Solutions, Inc.

Vs.

RESPONDENT: Tracy Dunbar

Address: 39 Clifton Crescent, Mount Lawley, W.A. Australia

Telephone: n/a

Fax: n/a

E-Mail: dunbargs@excite.com

Before Edward C. Chiasson Q.C., Peter L. Michaelson, Esq. and Thomas M. Pitegoff, Esq., Panelists

PROCEDURAL HISTORY

The Complaint was filed with CPR on July 26, 2000 and, after review for administrative compliance, served on the respondent on August 4, 2000. The Respondent did not file a Response on or before August 23, 2000. We were appointed Panelists pursuant to the Uniform Domain Name Dispute Resolution Policy (UDRP[®]) and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN).

On August 28, 2000, the Respondent requested "...an extension of time to provide a more detailed response..." By direction of the panelists this was granted and the time for delivering this decision was extended to September 28, 2000 pursuant to Rule 10(c).

Upon the written submitted record including the Complaint and its attachments, we reached our findings.

FINDINGS

Respondent's registered domain name, scholasticaustralia.com, was registered with Network Solutions, Inc. in 1999. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

- i. Respondent's domain name must be 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.

IDENTITY/CONFUSING SIMILARITY

Complainant alleges that scholasticaustralia.com is confusingly similar to Complainant's trademark, "SCHOLASTIC", which applies *inter alia* to children's books, classroom and professional magazines, software and other educational materials.

Since at least as early as 1922, the Complainant has been using the trademark "SCHOLASTIC" and trademarks featuring "SCHOLASTIC" followed by another word or words in connection with a wide variety of goods and services. It also has a popular Internet website called www.Scholastic.com.

The Complainant is the owner of more than 65 trademarks registered with the United States Patent and Trademark Office for the SCHOLASTIC Trademarks in classes including International Class 9 (computer software and related merchandise), Class 16 (periodicals and printed materials), Class 28 (computer games) and numerous other classes.

Since about 1993, the Complainant has used the SCHOLASTIC Trademarks on and in connection with information and services offered through online services. Specifically, in 1992 it registered the domain name Scholastic.com with Network Solutions, Inc. Beginning in about 1993, the Complainant maintained an area on America Online accessible by using the keyword "Scholastic," and since 1996, it has used the SCHOLASTIC Trademarks in connection with its Internet websites outside of America Online. In April of 1997, it launched its Scholastic Australia website, www.Scholastic.com.au, which is accessible to visitors worldwide.

Among other things, the Complainant uses its websites to promote its goods and services. Visitors to its Scholastic site at www.Scholastic.com and its Scholastic Australia site at www.Scholastic.com.au are provided with immediate on-line access to its many and varied educational resources.

In 1968, a wholly-owned subsidiary of Complainant was formed in Australia, called Scholastic Australia Pty. Ltd. (“Scholastic Australia”). Scholastic Australia is responsible for all of Complainant’s activities in Australia.

In a letter dated November 8, 1999, sent to the Complainant, the Respondent noted registered trademarks, not owned by the Complainant as follows: Scholastic Plastic; Applied Scholastic; Scholastic Software. It also stated that “. . .no commercial activity has been transacted to date in respect of the ScholasticAustralia.com URL”.

The Complainant replied stating that none of the three marks had advanced beyond the status of applications for registration, that legal action was pending with respect to two of these applications and that the third had been abandoned.

The United States Patent and Trade Mark Office may or may not conclude that one or both of the pending marks identified by the Respondent is sufficiently descriptive to be confused with the Complainant’s mark.

It is our conclusion that the subject domain name is confusingly similar to the Complainant’s protected mark.

RIGHTS AND LEGITIMATE INTERESTS

The Complainant alleges that the Respondent has no rights or legitimate interest with respect to the domain name at issue. In support of this allegation, the Complainant says that the Respondent has not attempted to undertake any business using the domain name and has asked for money significantly in excess of the Respondent’s out-of-pocket costs directly related to the domain name.

UDRP Paragraph 4(c) provides that a respondent’s rights or legitimate interest in a domain name may be demonstrated by (a) before notice to the respondent of the dispute, respondent’s use of, or 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 (b) the fact that the respondent has been known commonly by the domain name; or (c) the fact that 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.

The Respondent’s did not assert any basis for its legitimate use of the domain name. It questioned the Complainant’s rights and suggested that the Complainant buy the name for US\$15,000.

We conclude that the Respondent does not have rights or legitimate interest with respect to the domain name at issue.

BAD FAITH

Paragraph 4(b) provides for the implication of evidence of bad faith if, *inter alia*, there are circumstances indicating registration of a domain name for the purpose of selling it to the Complainant for valuable consideration in excess of its documented out-of-pocket costs related directly to the domain name.

In this case no legitimate business interest has been demonstrated by the Respondent and it sought to sell the domain to the Complainant for a sum well in excess of the likely costs related directly to the domain name.

We conclude that the Respondent registered and used the domain name in bad faith, as that term is defined in the ICANN Policy.

CONCLUSION

In light of our findings that (a) the registered domain name is confusingly similar to Complainant's protected mark; (b) the Respondent does not have rights or legitimate interest with respect to the domain name at issue; and (c) the Respondent registered and used the domain name in bad faith, as that term is defined in the ICANN Policy, we are satisfied the Complainant has proved the elements of its complaint as required by paragraph 4(a) of the Policy.

REMEDY

Complainant's asks for an order to transfer the domain name scholasticaustralia.com to it and we hereby so order.

Edward C Chiasson Q.C.

September 28, 2000

Peter L. Michaelson, Esq.

September 28, 2000

Thomas M. Pitegoff, Esq.

September 28, 2000

