



NATIONAL ARBITRATION FORUM

DECISION

Russell Frey d/b/a edHelper v. International Services Company SA c/o Administration Dom
Claim Number: FA0910001288396

PARTIES

Complainant is **Russell Frey** d/b/a **edHelper** (“Complainant”), represented by **Clifford D Hyra**, Virginia, USA. Respondent is **International Services Company SA c/o Dom Administration** (“Respondent”), represented by **Paul Raynor Keating**, of **Renova, Ltd.**, Spain.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**eduhelper.com**>, registered with **Eurodns S.A.**

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.

Debrett G. Lyons, Diane Cabell and Houston Putnam Lowry, Esq. as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on October 8, 2009; the National Arbitration Forum received a hard copy of the Complaint on October 8, 2009.

On October 14, 2009, Eurodns S.A. confirmed by e-mail to the National Arbitration Forum that the <**eduhelper.com**> domain name is registered with Eurodns S.A. and that the Respondent is the current registrant of the name. Eurodns S.A. has verified that Respondent is bound by the Eurodns S.A. 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 October 14, 2009, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of November 3, 2009 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@eduhelper.com by e-mail.

A timely Response was received and determined to be complete on November 3, 2009.

An Additional Submission in compliance with Rule 7 was received from Complainant on November 6, 2009. An Additional Submission in compliance with Rule 7 was received from Respondent on November 12, 2009.

On November 12, 2009, pursuant to Complainant's request to have the dispute decided by a three-member Panel, the National Arbitration Forum appointed Debrett G. Lyons, Diane Cabell and Houston Putnam Lowry, Esq. as Panelists.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Complainant asserts rights and alleges that the disputed domain name is confusingly similar to its trademark.

Complainant alleges that Respondent has no rights or legitimate interests in the disputed domain name.

Complainant alleges that Respondent registered and used the disputed domain name in bad faith.

B. Respondent

Respondent broadly denies those allegations. It does not refute Complainant's contention that it is a domainer but submits that the disputed domain name was registered in good faith. It says that the domain name is overtly descriptive of educational services¹.

The claim that the domain name is composed of descriptive, non-distinctive terms is Respondent's retort to all of Complainant's arguments. The Response states, for example, that:

"Taken together, the words "EDU" and "HELPER" merely refer to a person who assists in education. A Google search for "edu" + "Helper" and excluding "edhelper.com", shows over 3.8 MILLION results. A Google search for "eduhelper" as a single term shows 8,320 results. Excluding Complainant from this search shows 8,140 results."

[...]

¹ Proved, Complainant says, if nothing else by the existence of the ".edu" domain name extension.

“There are over 122, 225 domains that have been registered that start with the term “EDU”. Over 220 domains contain the terms “EDU” + “Helper”. Strikingly, there are over 803 domains registered that start with “ED” and contain the word “HELP”. The domain name EDHELP is registered in virtually every extension.”

[...]

“ ‘Eduhelper’ is a descriptive phrase in the context of education and different forms of learning. Since acquisition, the Domain Name has been used as a PPC search portal, to provide advertising and other content related to education in the broad sense. The content is generated by Google and reflects Google’s commercial judgment, of what links are the most contextually relevant at any given time. In this case the evidence shows that the links are in fact contextually related to the words comprising the Domain Name.”

C. Additional Submissions

The Additional Submissions of both parties were fully taken into account by the Panel and are referred to where required in the Discussion which follows.

FINDINGS

1. Complainant provides web based educational services under the trademarks EDHELPER and EDHELPER.COM.
2. Complainant is the owner of U.S. Federal trademark Regn. No. 2,955,044 for EDHELPER, filed April 11, 2004 and registered May 24, 2005, and No. 3,065,117 for EDHELPER.COM and Design, filed May 4, 2004 and registered March 7, 2006.
3. Complainant registered the domain name <edhelper.com> on July 25, 2000.
4. The disputed domain name was registered on September 8, 1999.
5. Respondent acquired the disputed domain name on April 7, 2002.
6. There is no relationship between the parties.

DISCUSSION

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.”

Policy ¶ 4(a) 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

Policy ¶ 4(a)(i) requires a two-fold enquiry. First, a threshold investigation of whether a complainant has rights in a trademark, followed by an assessment of whether the trade mark and the domain name are identical or confusingly similar.

Complainant has rights in the trademark EDHELPER by virtue of its U.S. Federal trademark registrations². For the purposes of Policy ¶ 4(a)(i) it is inconsequential that those registrations postdated the registration date of the disputed domain name³.

The remaining enquiry is whether the domain name <eduhelper.com> is confusingly similar to the trademark EDHELPER. In making that assessment it is accepted that the gTLD, “.com”, can be disregarded⁴. Complainant contends that the terms are confusingly similar because, once the gTLD is subtracted, the domain name differs only by the addition of the letter “u” to its trademark⁵.

Respondent argues that the trademark is composed of generic terms in which Complainant has no monopoly. Its states that:

² The Policy does not distinguish between registered and unregistered trademark rights (see *McCarthy on Trademarks and Unfair Competition*, § 25:74.2 (4th ed. 2002)), however a trademark registered with a national authority is *prima facie* evidence of trademark rights for the purposes of the Policy. See *State Farm Mut. Auto. Ins. Co. v. Malain*, FA 705262 (Nat. Arb. Forum June 19, 2006); see also *Mothers Against Drunk Driving v. phix*, FA 174052 (Nat. Arb. Forum Sept. 25, 2003).

³ See *AB Svenska Spel v. Zacharov*, D2003-0527 (WIPO Oct. 2, 2003) holding that the UDRP does not require a complainant to have registered its trademark prior to the respondent’s registration of the domain name under Policy ¶ 4(a)(i) but may prevent a finding of bad faith under Policy ¶ 4(a)(iii); see also *Clear!Blue Holdings, L.L.C. v. NaviSite, Inc.*, FA 888071 (Nat. Arb. Forum Mar. 5, 2007) holding that “[A]lthough the domain name in dispute was first registered in 1996, four years before Complainant’s alleged first use of the mark, the Panel finds that Complainant can still establish rights in the CLEAR BLUE marks under Policy ¶ 4(a)(i).” Nonetheless, see bad faith discussion which follows later.

⁴ See *Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) finding that the top level of the domain name such as “.net” or “.com” does not affect the domain name for the purpose of determining whether it is identical or confusingly similar.

⁵ See *Google, Inc. v. DktBot.org*, FA 286993 (Nat. Arb. Forum Aug. 4, 2004) finding that “[T]he mere addition of a single letter to the complainant’s mark does not remove the respondent’s domain names from the realm of confusing similarity in relation to the complainant’s mark pursuant to Policy ¶ 4(a)(i).”; see also *Microsoft Corporation v. Charlie Brown*, WIPO Case No. D2001-0362 finding <microosoft.com> confusingly similar to complainant’s MICROSOFT mark.

“While Complainant may have a US registered trademark, the mark is extremely weak and the mere fact that it has been registered in the US cannot act to preclude use of the descriptive term by Respondent, a European company.”

Whilst that argument might have merit considered in the context of a question about trademark infringement, it is not a relevant consideration under Policy ¶ 4(a)(i). Nor has it been considered relevant to Policy ¶ 4(a)(i) for a respondent to assert, as in this case, that confusion is unlikely because the domain name is composed of generic terms. A respondent’s registration and use of a generic domain name is generally regarded by former panels as a factor to be considered under Policy ¶ 4(a)(ii) and/or 4(a)(iii).

By a plurality, the Panel finds that the disputed domain name is confusingly similar to Complainant’s trademark. Houston Putnam Lowry does not believe confusion was adequately shown in light of the difference in the third character of the marks.

Complainant has satisfied the first limb of the Policy.

Rights or Legitimate Interests

For the reasons which follow, no findings are required⁶.

Registration and Use in Bad Faith

Policy ¶ 4(b) sets out the circumstances which shall be evidence of the registration and use of a domain name in bad faith. They are:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out of pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

⁶ See *Creative Curb v. Edgetec Int’l Pty. Ltd.*, FA 116765 (Nat. Arb. Forum Sept. 20, 2002), finding that because the complainant must prove all three elements under the Policy, the complainant’s failure to prove one of the elements makes further inquiry into the remaining element unnecessary; *see also Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, FA 836538 (Nat. Arb. Forum Dec. 28, 2006), deciding not to inquire into the respondent’s rights or legitimate interests or its registration and use in bad faith where the complainant could not satisfy the requirements of Policy ¶ 4(a)(i).

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

What is noteworthy about Policy ¶ 4(b)(i)-(iv) is that they are all cases of both registration *and* use in bad faith. It is logical, therefore, to first consider their possible application to the facts of the Complaint.

There is no cogent evidence before the Panel that Respondent registered the disputed domain name for any of the reasons elaborated in Policy ¶ 4(b)(i)-(iii). Respondent has not attempted to sell the domain name to Complainant or to any third party. Complainant has a domain name, <edhelper.com>, which fully reflects its trademark and which it asserts that it has used since July 2000 in relation to a corresponding and commercially successful website. There is no evidence that Respondent registered the domain name primarily for the purpose of disrupting Complainant's business.

It is only Policy ¶ 4(b)(iv) that merits serious attention and in relation to which Complainant argues:

“Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site. Respondent attracts Complainant's customers to its website by using a mis-spelling/typo of Complainant's trademark as its domain name, confusing them as to the nature of the website. Once the users have been directed to Respondent's website they click through its sponsored links and generate income for Respondent.”

In answer, Respondent submits that:

“As reflected in the language of the Policy, this element is intended to reach the subjective intentions of the Respondent in registering and actually using the Domain Name. ... Without actual knowledge of the Complainant, there can be no bad faith intent.

[...]

The Respondent is located in Luxembourg. Until receipt of the Complaint, Respondent had never heard of the Complainant. There is no evidence that the Complainant should be well-known or have established a reputation in Europe, or that Respondent for some other reason should have been aware thereof.”

Policy ¶ 4(b)(iv) requires proof that Respondent

- (a) for commercial gain;
- (b) intentionally used the disputed domain name to attract web users;
- (c) to an on-line location;

(d) by creating a likelihood of confusion with Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of that on-line location, or of a product or service at that location.

Respondent does not deny that its use of the domain name is driving PPC revenue. Respondent does not deny that it is a "domainer". On the evidence, its actions are for commercial gain. The key issue is whether Respondent can be said to have used the domain name in a way which *intentionally* created a likelihood of confusion with Complainant's trademark.

The requisite intention for the purposes of Policy ¶ 4(b)(iv) has been the subject of contrary decisions⁷, however this Panel takes the view that what is required is evidence that Respondent has targeted Complainant.

Complainant argues that Respondent either had actual, or constructive, knowledge of Complainant and its EDHELPER trademark.

By a plurality, the Panel considers that the prevailing consensus of opinion under the Policy is that proof of actual knowledge of a complainant's trademark rights is necessary. There are instances, most notably involving well known trademarks, where panelists have seemingly deemed a respondent with knowledge of the trademark. The better understanding of those cases is that they have in fact applied a test of actual knowledge, which when based on the balance of probability, so overwhelmingly favoured the complainant that it might seem that the decision rests on imputed knowledge of the complainant's rights.

By a plurality, the Panel is not prepared to fetter Respondent with constructive knowledge of Complainant's trademark rights. It looks, instead, to evidence of whether it is more likely than not that Respondent had actual knowledge of Complainant's rights. In that regard, the Panel reiterates that Complainant must establish all three elements under the Policy and so it can not be assumed that just because Complainant has successfully proved trademark rights, it follows that Respondent has acted in bad faith because it was aware of those rights. Knowledge of Complainant's rights is an essential part of the bad faith analysis. For that reason a complainant must be astute to prove its reputation in, and the public awareness of, its trademark even when it has abundantly clear registered trademark rights. That is especially so when the trademark consists of descriptive elements.

Complaint states that:

⁷ See, for example, *Paule Ka v. Paula Korenek*, WIPO Case No. D2003-0453 where the panel held that the reference to the registrant's intention in paragraph 4(b)(iv) of the Policy should be regarded as importing an objective, rather than a subjective, test.

“Complainant's website was advertised extensively for years prior to April 7, 2002. There were approximately 500,000 page views in January of 2002. Complainant's marks were prominently displayed on the website since at least August 17, 2000, as shown in the attached Annex from the Internet Archive. At the time the “eduhelper.com” domain was registered, the edhelper.com site featured at least 10,960 lesson plans, 5,000 free worksheet generators, 1,600 word and critical thinking problems, and much more.”⁸

In its Additional Submissions, Complainant states further that:

“Complainant has advertised worldwide via the Internet and Complainant's site is highly ranked in countries around the world, including the UK. Considering the volume of traffic and revenue eduhelper.com generates from confusion with edHelper, it strains credulity to believe that Respondent was unaware of Complainant at the time of registration less than one year ago.”

Respondent spends much time in its critique of the quality of the physical evidence said to support Complainant's claim to notoriety. It is critical too of the broad reach of many of Complainant's assertions based on that alleged notoriety.

There are merits and shortcomings in both sets of submissions. Complainant's use of its trademark is far from being insignificant. Respondent's claims that Complainant's evidence is flawed and that its arguments are laced with conclusory statements are not unjustified. For the purposes of Policy ¶ 4(a)(iii), it is unnecessary for this Panel to decide whether or not Complainant has done enough to show the level of use which would be necessary to establish common law trademark rights under Policy ¶ 4(a)(i)⁹. Rather, the Panel must balance the evidence of reputation against all of the circumstances and decide whether it is more likely than not that Respondent targeted Complainant by using the domain name to intentionally attract web users through a likelihood of confusion with Complainant's trademark.

Taking account of the inherently descriptive character of both the trademark and the disputed domain name, the degree to which either very similar domain names or identical domain names with different extensions have been registered/used by others, the lack of

⁸ Complainant submits internet archives from August 17, 2000 and March 28, 2002. In its Additional Submissions, Complainant submits statistics on its <edhelper.com> domain name showing the web traffic, page visits, and percentage of Internet users that landed on Complainant's domain name while searching for educational information between 2004 and 2008. Complainant alleges that its <edhelper.com> domain name had approximately 500,000 page views in January 2002 alone.

⁹ See, for example, “*Overview of WIPO Panel Views on Selected UDRP Questions*” where the Q&A at #1.7 of relevance to the discussion here: **1.7 What needs to be shown for the complainant to successfully assert common-law or unregistered trademark rights?** *Consensus view:* The complainant must show that the name has become a distinctive identifier associated with the complainant or its goods and services. Relevant evidence of such “secondary meaning” includes length and amount of sales under the mark, the nature and extent of advertising, consumer surveys and media recognition.

evidence that Respondent has habitually abused third party trademark rights, and all of the circumstances, the Panel finds that Policy ¶ 4(b)(iv) is not made out.

With that conclusion, it remains for the Panel to decide whether, taking the evidence as a whole and drawing on its own reasoning, there is evidence independent from the scenarios laid out in Policy ¶ 4(b), that the disputed domain name was registered in bad faith and used in bad faith.

Complainant states that:

“Respondent registered the disputed domain name within the last year, presumably purchasing it for its PPC revenue stream. This revenue stream exists in large part because of its use of keywords related to the Complainant, of which Respondent must have been aware, in combination with its confusing similarity to the edhelper mark.”

Respondent alleges that:

“it is using the <eduhelper.com> domain name to host a website featuring advertisements for educational products and services. Respondent contends that it is the owner of a portfolio of other domain names incorporating common words, generic terms, and useful phrases that are employed in conjunction with Google AdWords to display advertisements.”

The Panel first notes the timing issue. In particular, the registration of the domain name on September 8, 1999 predates both the filing dates and registration dates of Complainant’s Federally registered trademarks and the first use in commerce dates of those registrations.

Panels have generally found that the registration of a domain name prior to the establishment of trademark rights will negate a claim of bad faith registration. Exceptions to that general position have been made in very limited circumstances, namely, where a respondent had knowledge of a complainant’s impending trademark rights;¹⁰ where a respondent sought to take advantage of a complainant by acquiring a pre-existing and conflicting domain name;¹¹ and under a very narrow interpretation of Policy ¶ 4(b)(iv).¹²

Respondent acquired the domain name on April 7, 2002. Whether it did so by re-registration of the name after it had lapsed from third party ownership, or whether it did so by transfer of the September 1999 registration, is not clear from the evidence. If

¹⁰ See *Dreamgirls, Inc. v. Dreamgirls Entertainment*, Case No. D2006-0609; *Opera Software ASA v. Mike Morgan*, Case No. D2006-0752.

¹¹ See *Dixons Group Plc v. Abdullaah*, Case No. D2000-1406

¹² See *Yell Limited v. Ultimate Search*, Case No. D2005-0091; see also *Admiral Insurance Services Limited v. Dicker*, WIPO Case No. D2005-0241; *FabJob Inc. v. Compana LLC*, WIPO Case No. D2006-0610.

Respondent obtained the domain name through transfer, then the second of those exceptions outlined above might have occupied more of this Panel's attention¹³.

The fact that it has not is because, for the most part, Respondent assumes that the relevant date for assessment of Complainant's reputation (and so any likely public awareness of its rights) is April 7, 2002 and not some earlier point in time.

For many of the reasons already set out, the Panel does not find bad faith registration. The three exceptions set out in the discussion above are further evidence of the proposition that, for a domain name to have been registered in bad faith, a respondent must have had the complainant in mind at time of registration (or acquisition) of the domain name. This Panel has already found on a balance of the evidence that was not the case.

That brings to an end the formal analysis. Since the registration was not in bad faith the Complainant has not established the third element under the Policy.

DECISION

Having failed to establish at least one of the elements required under the ICANN Policy, the Panel concludes that relief shall be **DENIED**.

REVERSE DOMAIN NAME HIJACKING

Respondent petitions the Panel to find that the Complaint was brought in bad faith and constitutes an attempt of Reverse Domain Name Hijacking.

The Rules define Reverse Domain Name Hijacking as use of the Policy in bad faith to attempt to deprive a domain name holder of its domain name. In *Smart Design LLC v. Carolyn Hughes*, WIPO Case No.D2000-0993 the panel stated that:

“Clearly, the launching of an unjustifiable Complaint with malice aforethought qualifies, as would the pursuit of a Complaint after the Complainant knew it to be insupportable.”

There is nothing in the evidence to indicate anything as high as malice on the part of the Complainant. Accordingly, the evidence must demonstrate that the Complainant brought

¹³ In *Dixons Group Plc v Mr. Abu Abdullaah*, [note 11 above] the panel explained that “[I]n the present proceeding, the Respondent did not himself register the disputed domain name, and is only the transferee. However, there is some basis for saying that the term "registration" extends beyond the original act of registration and covers subsequent acquisitions of the domain name. Thus, para 4(b)(i) specifically refers to circumstances in which the Respondent has registered or has acquired a domain name, and there are several prior Panel decisions in which it has been held more generally that "registration" extends to subsequent acts of acquisition: see *BWR Resources Ltd v Waitomo Adventures Ltd*, Case No D2000-0861 and *Motorola Inc v NewGate Internet, Inc.*, Case No D2000-0079. The question, then, is whether the acquisition of the disputed domain name by the Respondent in the present case can be said to have done in bad faith.”

these Administrative Proceedings in the knowledge that the Respondent has an unassailable right or legitimate interest in the disputed domain name, or that Respondent lacks the requisite bad faith registration and use of the disputed domain name¹⁴.

The Panel decides that there is nothing in the evidence to support a finding against Complainant of Reverse Domain Name Hijacking.

Debrett G. Lyons

Diane Cabell

Houston Putnam Lowry, Esq.

Panelists

Dated: December 4, 2009

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¹⁴ See, *Koninklijke KPN N.V. v. Telepathy Inc.*, D2001-0217 (WIPO May 7, 2001); *Aspen Grove, Inc. v. Aspen Grove*, D2001-0798 (WIPO Oct. 5, 2001). Further, the facts must point to harassment or similar conduct by Complainant in the face of that knowledge - see, *Goldline International, Inc. v. Gold Line*, D2000-1151 (WIPO, January 4, 2001); *Sydney Opera House Trust v. Trilynx Pty. Limited*, D2000-1224 (WIPO, October 31, 2000); *Plan Express Inc. v. Plan Express*, D2000-0565 (WIPO, July 17, 2000).