

ADMINISTRATIVE PANEL DECISION

CollegeNet, Inc v. Qompas B.V.

Case No. DNL2022-0017

1. The Parties

The Complainant is CollegeNet, Inc, United States of America (“USA”), represented by Linden & De Roeck sprl, Belgium.

The Respondent is Qompas B.V., Netherlands, represented by Wille Donker advocaten, Netherlands.

2. The Domain Name and Registrar

The disputed domain name <collegenet.nl> (the “Domain Name”) is registered with SIDN through Softtech Systeembeheer B.V.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 21, 2022. On March 21, 2022, the Center transmitted by email to SIDN a request for registrar verification in connection with the Domain Name. On March 22, 2022, SIDN transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Complainant filed a technically amended Complaint on March 22, 2022. The Center verified that the Complaint as amended satisfied the formal requirements of the Dispute Resolution Regulations for .nl Domain Names (the “Regulations”).

In accordance with the Regulations, articles 5.1 and 16.4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 24, 2022. In accordance with the Regulations, article 7.1, the due date for Response was April 13, 2022. On the Respondent’s request, in the circumstances of this case, the due date for Response was extended to April 23, 2022. The Response was filed with the Center on April 22, 2022, and on April 28, 2022, the Center received additional email communications from the Respondent.

On April 29, 2022, SIDN commenced the mediation process. On May 20, 2022, SIDN confirmed to the Parties and the Center that the dispute had not been solved in the mediation process.

The Center appointed Wolter Wefers Bettink as the Panelist in this matter on June 2, 2022. The Panel finds that it was properly constituted. The Panelist has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required to ensure compliance with the Regulations, article 9.2.

On June 14 and 15, 2022, the Complainant submitted further submissions to the Center, and on June 15 and 16, 2022, the Respondent submitted further submissions to the Center.

4. Factual Background

The Complainant is a company based in Portland, Oregon, USA, providing web-based on-demand technologies to colleges, universities, and non-profit organisations. Its products and services include integrated systems for optimized academic scheduling and event management, space use analysis and planning, video interviewing for admissions, hiring and career services; international student services; and complete online admissions services, from recruitment through matriculation.

The Complainant has rights in the following trade marks (the "Trade Marks"):

- United States ("US") word mark COLLEGENET registered on March 18, 1997, under Number 2045384
- European Union ("EU") word mark COLLEGENET registered on September 26, 2005, under Number 002338804
- EU word/device mark COLLEGENET registered on August 30, 2011, under Number 009787367.

The Respondent acquired the Domain Name in 2018 from a Dutch company called EDG Media which in turn had acquired it from Malmberg, a text book publisher in the Netherlands, which had used the Domain Name for a website containing information aimed at pupils of secondary school education. The Domain Name was first registered on July 5, 1999. The Domain Name now redirects to a website under the Respondent's domain name <tkmst.nl> which provides a search engine for all higher educational institutions in the Netherlands and their courses and open days.

In July and August 2018, the Parties corresponded about the Respondent's use of the Domain Name, which correspondence has not been submitted in this case. On June 5, 2019, the Complainant sent a cease-and-desist letter to the Respondent, alleging infringement of its rights in the Trade Marks and demanding transfer of the Domain Name, to which the Respondent reacted by letter of June 18, 2019, in which it challenged the infringement allegation and refused to meet the Complainant's demands. After further correspondence, the Respondent's attorney in an email proposed transfer of the Domain Name against payment of EUR 20,000 and the transaction costs, which offer was valid for a period of fourteen (14) days. The Complainant did not accept this offer.

5. Parties' Contentions

A. Complainant

The Complainant submits that the Domain Name is confusingly similar to the Trade Marks, since it incorporates the COLLEGENET word mark in its entirety, while the country code Top-Level Domain ("ccTLD") ".nl" may be disregarded in assessing confusing similarity.

According to the Complainant, the Respondent does not have a right or legitimate interest, since the Domain Name is used as a redirect to a website under the domain name <tkmst.nl> that provides identical and similar services to those of the Complainant, including assistance to students in all aspects of their higher education. The Complainant submits that the Respondent is using the Domain Name to divert those seeking the Complainant's website and online services to the Respondent's website which is intended to trick, deceive, and confuse those Internet users. The Complainant contends that by using a domain name incorporating the COLLEGENET word mark in connection with a website which offers identical and similar services to the Complainant's goods and services, the Respondent is trading off the Complainant's goodwill. In addition, the Complainant states that the Respondent does not own rights in a trade mark, company name or trade name COLLEGENET as it is not or has not been using the sign COLLEGENET as such. The Complainant points out that the use of the Domain Name to redirect to a website under another domain

name, which does not use the sign COLLEGENET, does not grant trade name protection as a redirect does not constitute significant use of the name in the course of trade. The Complainant submits that use of the Domain Name for redirecting to a website under a different domain name, establishes that the Respondent has not used the Domain Name in connection with a *bona fide* offering of goods or services, nor has the Respondent thereby made a legitimate noncommercial or fair use of the Domain Name, without intent to obtain commercial gain.

With respect to bad faith registration and use of the Domain Name the Complainant states that the Respondent, for commercial gain, has sought to confuse consumers so that those consumers searching for the Complainant's products will mistakenly access the website under the Domain Name, whereby the Respondent commercially benefits from the goodwill of the Trade Marks. The Complainant contends that bad faith registration and use are further indicated by the fact that the Respondent in its letter of September 22, 2020 offered the Domain Name for sale asking EUR 20,000 which indicates that the Respondent registered the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name's registration to the Complainant as the owner of the Trade Marks for valuable consideration in excess of documented out-of-pocket costs directly related to the Domain Name. According to the Complainant, the Respondent's bad faith is increased with its renewal of the Domain Name after having received the Complainant's demand letter informing the Respondent of the Complainant's prior rights.

B. Respondent

The Respondent submits that the COLLEGENET word mark lacks distinctiveness, as it is a general description of the service offered by the Complainant and may therefore be subject to an annulment claim. In addition, the Respondent contends that the EU Trade Marks have not been used in the EU within five years of the registration thereof, which constitutes a ground for revocation of the Trade Marks. Furthermore, according to the Respondent there is no risk of confusion between the Domain Name and the Trade Marks since the Complainant focuses on students at American universities and colleges who have already chosen a program, while the Respondent uses the Domain Name in connection with a website for Dutch students in secondary education, offering information about and a search tool for choosing a study program.

The Respondent states that its predecessor in title has been using the "Collegenet(.nl)" name since 1997 and registered the Domain Name in 1999. According to the Respondent, this prior use implies that the Respondent has acquired (existing) trade name rights in the Domain Name which predate the Complainant's (the Panel understands: EU) Trade Marks.

The Respondent denies that it registered or used the Domain Name in bad faith, pointing out that it has offered its services to Dutch students in secondary education through the Domain Name. According to the Respondent, this means that the Respondent has not registered the Domain Name to disrupt the activities of the Complainant or to prevent the Complainant from using the Domain Name. The Respondent also contends that it and the Complainant offer different services to different customers so that it cannot be plausibly demonstrated that the Respondent uses the Domain Name to confuse Internet users for commercial gain. Furthermore, the Respondent asserts that such confusion cannot occur, considering the reputation of the Domain Name, and the lack of reputation of the younger EU Trade Marks which the Complainant has not or hardly used in the EU. Therefore, the Respondent submits, Internet users looking for the website of the Complainant who arrive at the website of the Respondent will not use the services offered by the Respondent as these are very different from the services they were looking for. With respect to its offer to sell the Domain Name, the Respondent states that it made this proposal to serve its interests, as is clear when the entire correspondence between the Parties would be taken into account.

C. Further submissions

After the mediation process was concluded and the Panel had been appointed, the Complainant by email alleged it had not received the Response and requested an additional period to file a reaction to the Response. The Respondent objected to the request and, subsequently, the Complainant filed a further submission without being so invited by the Panel in accordance with article 11.1 Regulations.

Article 11.2 of the Regulations provides that the Panel in its sole discretion shall determine the admissibility of further submissions. The basic premise of the Regulations is that both parties may file only one submission – the Complaint and the Response respectively. This implies that it may not always be possible for a complainant to anticipate all defenses in the Response. Even so, it is standard precedent under the Regulations that further submissions must be motivated by exceptional circumstances. The Complainant has not invoked any such exceptional circumstance.

In this connection, the Panel notes the following:

- on April 22, 2022, the Response was sent to and received by the Center by email from the Respondent, copying the Complainant's representative;
- on April 22, 2022, the Center sent an acknowledgment of receipt of Response by email to the Respondent, copying the Complainant's representative;
- on April 28, 2022, the Center sent a second acknowledgment of receipt of Response to the Parties, referring to the Response received by the Center on April 22, 2022, and to the Center's acknowledgment of receipt of Response of April 22, 2022; and
- on April 29, 2022, SIDN commenced the mediation process, stating *inter alia* in its email: "As provided for in the associated Regulations, a complaint has been made to the WIPO Arbitration and Mediation Center. The party that the complaint is against has sent in a formal written response. WIPO has forwarded both the complaint and the response to the mediator, and the documents will form the basis of the mediation."

The Panel concludes that from the communications of the Center and SIDN, referred to above, the Complainant was or should have been aware already on April 22, 2022 that a Response had been filed. The Panel takes note that the Complainant nevertheless did not enquire about the Response.

In view of all of the above, the Panel finds that the alleged late receipt by the Complainant of the Response does not present an exceptional circumstance warranting a further submission. Consequently, it will not take into account the Complainant's submission.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Respondent has challenged in this .NL procedure the Complainant's rights in the EU Trade Marks, submitting that such rights are subject to cancellation due to a lack of distinctiveness and due to non-use in the EU for a period of five years or more after registration. As a rule, if a complainant owns a registered trade mark it *prima facie* satisfies the threshold requirement under the Regulations of having trade mark rights (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.1).¹ In the absence of a decision of a court or trade mark authority canceling or invalidating the Trade Marks, the Panel accepts the evidence of the registration of the Trade Marks in the name of the Complainant as sufficient evidence of the Complainant's trade mark rights for the case at hand. For completeness' sake, the Panel notes that the degree of strength of the Trade Marks may in circumstances be considered relevant as part of the evaluation of the second and third elements (see [WIPO Overview 3.0](#), section 1.7).

The Panel notes that the Domain Name incorporates the dominant element COLLEGENET of the Trade Marks in its entirety (see [WIPO Overview 3.0](#), section 1.7), while the ccTLD ".nl" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11).

¹ In view of the fact that the Regulations are substantially similar to the Uniform Domain Name Dispute Resolution Policy ("UDRP"), it is well established that both cases decided under the Regulations and cases decided under the UDRP, and therefore [WIPO Overview 3.0](#), may be relevant to the determination of this proceeding (see, e.g., *Aktiebolaget Electrolux v. Beuk Horeca B.V.*, WIPO Case No. [DNL2008-0050](#)).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under article 3.1 of the Regulations, the Complainant has to make out a *prima facie* case that the Respondent does not have rights to or legitimate interests in the Domain Name, upon which the burden of production on this element shifts to the Respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the Domain Name ([WIPO Overview 3.0](#), section 2.1).

Article 3.1 of the Regulations provides that the Respondent “may demonstrate such rights or legitimate interests on its part *inter alia* through the following circumstances:

- a. before having any notice of the dispute, the registrant 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;
- b. the registrant as an individual, business or other organization is commonly known by the domain name;
- c. the registrant is making a legitimate noncommercial use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish or otherwise damage the relevant trademark, trade name, personal name, name of a Dutch public legal entity or name of an association or foundation located in the Netherlands.”

Generally speaking, panels have found that, when a domain name consists of the trade mark in its entirety – as is the case here –, it carries a high risk of implied affiliation ([WIPO Overview 3.0](#), section 2.5.1). In this case the registration of the Domain Name occurred six years before that of the oldest EU Trade Mark, and two years after the registration of the US Trade Mark, while there is no evidence in the file that the Complainant has objected to the use of the Domain Name before July 2018 – therefore during a period of nineteen years after its registration. There is no indication in the case file that during those nineteen years the Complainant perceived a risk of implied affiliation. In fact, it appears that the transfer of the Domain Name in 2018 to the Respondent prompted the Complainant to object to its use thereof, while the present case was not initiated until more than three years later. Although the mere delay between the registration of a domain name and the filing of a complaint neither bars a complainant from filing such case, nor from potentially prevailing on the merits ([WIPO Overview 3.0](#), section 4.17), the Panel here finds that, given the apparent inactivity of the Complainant with respect to the previous use of the Domain Name in the period 1999-2018 and its delay in bringing this case after its initial objections in 2018, the Complainant would need to advance further circumstances beyond the Domain Name consisting of the dominant element of the Trade Marks.

The Complainant submits that the Respondent is using the Domain Name to divert those seeking the Complainant’s website and online services to the Respondent’s website and that such use is intended to “trick, deceive, and confuse” Internet users seeking the Complainant’s goods and services. The Panel notes that the Complainant has not submitted any evidence of such Respondent intent, nor of any actual confusion of Internet users as a consequence of the Domain Name and the Trade Marks both having the term COLLEGENET as their dominant element. As pointed out by the Respondent, the services offered and the target audience of the relevant websites are different. Since 2018, when the Respondent acquired the Domain Name, it has been used to redirect Internet users to a website under the domain name <tkmst.nl>. This website offers primarily information on and a search engine for higher education institutions and courses available in the Netherlands, aimed at Dutch secondary school (college bound) students. The Complainant, on the other hand, offers administrative software solutions for colleges, universities, and non-profit educational institutions in the USA.

In view of the differences in services, potential customers and geographical markets, the Panel finds that the parties are not competitors and that it is unlikely that colleges and universities based in the USA would

access information on the Complainant or its goods and services under a domain name in the ccTLD “.nl”, and that if they nevertheless would, this would not cause harm to the Complainant. In all of these circumstances, including absence of evidence of malicious Respondent intent and of actual confusion, the Panel finds that the Complainant has not made credible an intent on the part of the Respondent to deceive or confuse Internet users who are looking for the Complainant’s services.

The Complainant submits that the Respondent by using the Domain Name is trading off the goodwill of the Complainant or the Trade Marks. The Panel notes that, since the activities of the Complainant are concentrated in the USA and aimed at universities, colleges and nonprofit institutions in the USA, such goodwill would be primarily, if not solely, present in the USA. Given the different services, target audience and geographical focus of the Respondent’s activities, the Complainant has not explained in what way the Respondent by using the Domain Name is trading off that goodwill. Furthermore, from the case file it transpires that there is no similarity between the parties’ websites (they use very different logos and the websites have a different lay-out and general appearance), while there is no evidence that the Respondent has tried to impersonate or suggest any affiliation to the Complainant or the Trade Marks. On the basis of all of the above mentioned circumstances, the Panel reaches the conclusion that the Complainant has not or has insufficiently, substantiated its submission that the Respondent is trading off the goodwill of the Complainant or the Trade Marks.

The Respondent has asserted trade name rights in the Domain Name which it claims it obtained when it acquired the Domain Name from the Domain Name’s preceding registrants and which would predate the Complainant’s EU Trade Marks. However, the Parties have not focused their submissions and evidence on this assertion, which in any event the Panel does not consider appropriate for examination in this proceeding; the Regulations are designed to address circumstances of abusive cybersquatting, leaving less obvious scenarios to be considered by the courts (see *e.g. Summit Industries, Inc. v. Jardine Performance Exhaust Inc.*, WIPO Case No. [D2001-1001](#) and *K & K Promotions Inc. v. Route 44 Leathers*, WIPO Case No. [D2011-0088](#)).

While the Respondent’s use of the Domain Name as a redirector may raise certain questions, the Panel finds such use permissible in the mentioned specific circumstances of this case, including the Domain Name’s composition and the history of its registration and use. The Panel views no basis in the record before it to conclude that the Respondent’s offering of goods and services under the Domain Name is not *bona fide*.

On the basis of all of the above, the Panel concludes that the Complainant has not succeeded to show that the Respondent lacks rights to or a legitimate interest in the Domain Name.

C. Registered or Used in Bad Faith

As the Complainant has not succeeded on the above second element under the Regulations, the Panel need not discuss the third element, registration or use in bad faith.

7. Decision

For all the foregoing reasons, the Complaint is denied.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Panelist

Date: June 27, 2022