

## **ADMINISTRATIVE PANEL DECISION**

CollegeNET, Inc. v. Mark Roxberry, Drive Technology, LLC  
Case No. D2023-1538

### **1. The Parties**

Complainant is CollegeNET, Inc., United States of America (“United States”), internally represented.

The Respondent is Mark Roxberry, Drive Technology, LLC, United States.

### **2. The Domain Name and Registrar**

The disputed domain name <standout.pro> (the “Domain Name”) is registered with Tucows Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2023. On April 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On April 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email to Complainant on April 13, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on April 18, 2023.

The Center verified that the Complaint, together with the amended Complaint, satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on April 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 14, 2023. The Response was filed with the Center on May 6, 2023.

Complainant submitted to the Center an unsolicited “Reply” on May 11, 2023. In its discretion, the Panel has considered this submission in its deliberations.

The Center appointed Robert A. Badgley as the sole panelist in this matter on June 7, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of

Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

#### **4. Factual Background**

According to the Complaint:

“Among other things, Complainant CollegeNET provides college information and services designed to help students succeed in jumpstarting their career. To further this goal, Complainant owns and operates <standout.com>, a website that helps students master their interviewing skills. <Standout.com> offers interview-preparation packages to individuals and also provides platform services to universities who wish to build a library of content for their student body. <Standout.com> also provides services to employers, aiding them in identifying top candidates and sort through applicants.”

Complainant owns two registrations for the mark STANDOUT with the United States Patent and Trademark Office, including Reg. No. 2,195,782, registered on October 13, 1998. According to Complainant: “Through over 25 years of extensive, continuous use, CollegeNET’s STANDOUT® trademark has become widely recognized by the consuming public in the United States and abroad.” Notwithstanding this allegation, the record is devoid of any evidence of the actual renown of Complainant’s STANDOUT trademark.

The Domain Name was registered on August 23, 2016. The Domain Name resolves to a parking page and does not appear to have ever resolved to an active website.

Respondent asserts that he registered the Domain Name in order to establish “a professional online platform to showcase and provide certified consulting services for cloud platforms and cloud security”. Annexed to the Response are documents showing that Respondent has been a “Certified Information Systems Security Professional” since 2005 and a “Certified Ethical Hacker” since 2006.

Respondent states that he chose the Domain Name because “standout” is a common firm used to “highlight excellence, expertise, and differentiation,” and he chose the .pro generic Top-Level Domain (“gTLD”) to emphasize that his services would be designed for professionals.

Respondent provides no real explanation why he has not developed a viable website despite owning the Domain Name for nearly seven years.

On February 9, 2023 and February 15, 2023, a domain broker sent emails to Respondent, asking on behalf of a client (Complainant) whether Respondent would be interested in selling the Domain Name. Respondent did not reply to these missives.

On March 28, 2023, Complainant sent a message to Respondent, through the Registrar, with the subject header “your domain name is infringing on our trademark”. The body of this missive states:

“I have attempted to contact you to purchase [the Domain Name]; but received no reply. I am in the process of filing a UDRP case in order to prevent your continued trademark infringement. If you would like to avoid the process please contact us at the above email address.”

Respondent did not reply to this missive, either.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Domain Name.

## **B. Respondent**

Respondent's essential position is reflected in the "Factual Background" section above. Respondent also asserts that Complainant is engaged in Reverse Domain Name Hijacking.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the 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) the Domain Name has been registered and is being used in bad faith.

### **A. Identical or Confusingly Similar**

The Panel concludes that Complainant has rights in the trademark STANDOUT through registration demonstrated in the record. The Panel also concludes that the Domain Name is identical to that mark.

Complainant has established Policy paragraph 4(a)(i).

### **B. Rights or Legitimate Interests**

Pursuant to paragraph 4(c) of the Policy, Respondent may establish its rights or legitimate interests in the Domain Name, among other circumstances, by showing any of the following elements:

- (i) before any notice to you [Respondent] of the dispute, your 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
- (ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Domain Name, even if you have acquired no trademark or service mark rights; or
- (iii) you [Respondent] are making a 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 Panel need not address this element, given its conclusion below regarding the "bad faith" element.

### **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy provides that the following circumstances, "in particular but without limitation" are evidence of the registration and use of the Domain Name in "bad faith":

- (i) circumstances indicating that Respondent has registered or has acquired the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name registration to Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of its documented out of pocket costs directly related to the Domain Name; or

- (ii) that Respondent has 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 Respondent has engaged in a pattern of such conduct; or
- (iii) that Respondent has registered the Domain Name primarily for the purpose of disrupting the business of a competitor; or
- (iv) that by using the Domain Name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website or location or of a product or service on Respondent's website or location.

The Panel concludes, on this record and on a balance of probabilities, that Complainant has failed to carry its burden of proving that Respondent registered and has used the Domain Name in bad faith.

As noted above, although Complainant holds a registered trademark for STANDOUT, there is no evidence that Complainant's mark enjoys widespread renown such that Respondent more likely than not would have been aware of it when he registered the Domain Name. The effect of this lack of evidence is aggravated by the fact that "standout" is, as Respondent asserts, a common word.

In the Panel's view, Respondent's failure to develop a website for nearly seven years does not bolster his alleged *bona fides*, but it is not a critical factor here. As the panel in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) stated "the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith". In the case at hand there is no evidence showing that Respondent registered the Domain Name in bad faith targeting Complainant, it being plausible that the Domain Name was registered due to its dictionary meaning. On balance, Respondent's non-use of the Domain Name does not advance Complainant's allegation of Respondent bad faith.

The Panel also notes that Complainant reached out to Respondent – not the other way around – to discuss a possible sale of the Domain Name. Respondent simply ignored these missives and did not reply with an exorbitant demand.

In sum, the record lacks sufficient evidence for the Panel to conclude that Respondent more likely than not was aware of the STANDOUT mark when registering the Domain Name. As such, the Complaint must fail.

Complainant has not established Policy paragraph 4(a)(iii).

#### **D. Reverse Domain Name Hijacking ("RDNH")**

The Panel declines to make a finding that Complainant launched this UDRP Complaint in bad faith. Complainant holds a registered trademark that is identical to the Domain Name (ignoring the gTLD). It was not apparent from Respondent's website or any pre-Complaint communications that Respondent was engaged in any legitimate activity.

The Complaint was misguided, but not brought in bad faith. It appears that Complainant misunderstands certain aspects of trademark law (merely holding a domain name identical to someone's trademark is not trademark infringement, nor bad faith per se under the Policy, notwithstanding the March 28, 2023 missive from Complainant to Respondent). It also appears that Complainant misunderstands the "bad faith" element of the UDRP. A finding that a domain name registration was done in bad faith requires a subsidiary finding that the respondent more likely than not was aware of the complainant's trademark. Here, Complainant made no showing whatever that its mark – even though registered – was sufficiently well known to support such a finding. Complainant's reference to "constructive notice" in the Complaint underscore this misunderstanding.

In sum, the Panel perceives no basis on which to conclude that Complainant brought this case in bad faith.

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Robert A. Badgley/*

**Robert A. Badgley**

Sole Panelist

Date: June 21, 2023