



## **WIPO Arbitration and Mediation Center**

### **ADMINISTRATIVE PANEL DECISION**

**Advanced Reading Solutions LLC d/b/a Urok Learning Institute v. Vrvv Inc.**

**Case No. D2009-1418**

#### **1. The Parties**

The Complainant is Advanced Reading Solutions LLC d/b/a Urok Learning Institute of San Diego, California, United States of America, represented by Higgs, Fletcher & Mack LLP, United States.

The Respondent is Vrvv Inc. of Houston, Texas, United States, represented by Strasburger & Price, LLP, United States.

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

The disputed domain names, <urok.com> and <urokapparel.com>, are registered with Tucows Inc (the "Registrar").

#### **3. Procedural History**

The Complaint was brought pursuant to the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), which was adopted by the Internet Corporation for Assigned Names and Numbers ("ICANN") on August 26, 1999, and approved on October 24, 1999, and also in accordance with the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") as approved on October 24, 1999, and the World Intellectual Property Organization ("WIPO") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy in effect as of December 1, 1999 (the "Supplemental Rules").

The Complaint, with accompanying Annexes 1-9, was filed with the WIPO Arbitration and Mediation Center (the "Center") by email on October 22, 2009 and subsequently by hardcopy on October 23, 2009.

Pursuant to paragraph 4(d) of the Policy, the Complainant selected the Center as the ICANN approved administrative dispute resolution service provider to administer this proceeding. Through the Complaint, the Complainant requested a single-member

panel.

After receiving the original Complaint, the Center, in accordance with paragraph 5 of the Supplemental Rules, verified that the Complaint complied with the formal requirements of the Rules and the Supplemental Rules. In that regard, on October 22, 2009, the Center requested confirmation from the Registrar as to: whether the Registrar received a copy of the Complaint from the Complainant, contact and registrant information set forth in the Complaint relative to each of the disputed domain names, and whether each domain name is indeed registered with the Registrar. The Center also requested the Registrar to specify for each of the disputed domain names: (a) the dates on which the current registrant registered or acquired the registration for that name and on which that registration will expire, (b) whether the Policy applies to that name, (c) the language of the registration agreement, and (d) whether the domain name will remain “locked” during the proceeding.

Subsequently, on October 22, 2009, the Registrar provided its response to the Center through which it specified name and contact information pertinent to the disputed domain names to the extent, as it then existed, in its WhoIs database. Further, the Registrar stated that: it had not received a copy of the Complaint, the Respondent was listed as the registrant for each of the domain names and the domain names are registered with Tucows Inc. The Registrar’s response further indicated that: (a) the registration for <urok.com> and <urokapparel.com> will expire on October 4, 2010 and August 4, 2010, respectively, (b) the Policy applies to each of the domain names, (c) the registration agreements are both in English, and (d) both domain names will remain locked during the proceeding.

The Center verified that the Complaint satisfied the formal requirements of the Policy, the Rules and the Supplemental Rules.

On October 29, 2009, the Center formally notified the Respondent of the filing of the Complaint, including an indication that the Center was forwarding a complete copy of the Complaint to the Respondent, together with all its annexes, by post or courier, facsimile and email. The Complaint and its accompanying documents, and all subsequent communications associated therewith, were provided in the preferred manners and to the addresses as mandated by paragraphs 2(a), 2(b) and 4(a) of the Rules.

Hence, the notification to the Respondent having occurred on October 29, 2009, under paragraph 4(c) of the Rules, this administrative proceeding is deemed to have commenced on that date.

Having reviewed the Complaint and all the correspondence, including that between the Center and the Registrar, the Panel agrees with the determination of the Center that the Complaint and its handling met the requirements of the Rules and the Supplemental Rules.

The Respondent was then provided with a 20 calendar day period, expiring on November 18, 2009, to file its Response with the Center and the Complainant. Upon a joint stipulation of the parties, the Center, through an email message dated November 18, 2009, subsequently extended the due date of the response to November 23, 2009.

On November 23, 2009, the Center timely received, from the Respondent, a Response to the Complaint, including Annexes 1-23.

Thereafter, on November 25 and as Supplemental Filings, the Complainant filed, by e-mail with the Center, a Reply to the Complaint, followed the same day by the Respondent having filed, also by email with the Center, a Sur-reply.

Accordingly, pursuant to the Rules and Supplemental Rules, by email letter dated November 30, 2009, the Center contacted the undersigned, Mr. Peter L. Michaelson, Esq., requesting his service as sole Panel for this dispute. Subsequently, on the same date, Mr. Michaelson accepted and returned, by email attachment to the Center, a fully executed Statement of Acceptance and Declaration of Impartiality and Independence. The Center, through an email letter dated December 1, 2009, notified the Parties of the appointment of Mr. Michaelson as sole Panelist.

Based on the deadline set forth in paragraph 15 of the Rules, a decision is to be issued by the Panel to the Center on or before December 15, 2009. Owing to unexpected time conflicts experienced by the Panel all of which constituted unforeseen circumstances, the Center, at the request of the Panel, extended this due date to January 5, 2010.

This dispute concerns two domain names, specifically <urok.com> and <urokapparel.com>.

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

As indicated in the WhoIs registration records provided in Annex 3 to the Complaint, the disputed domain names <urok.com> and <urokapparel.com> were registered by a third party on October 4, 2001 and by the Respondent on August 4, 2004, respectively. The Respondent acquired the former domain name, through purchase, on September 8, 2004.

##### **A. Extent of Factual Summary by the Panel**

Both parties have set forth considerable facts, particularly with respect to the Respondent's activities in securing United States registration of its stylized version of the mark UROK (filed February 14, 2004 as serial number 78/368,186; subsequently registered on September 20, 2005 as US registration 2997252) and Complainant's subsequent cancellation of that registration (cancellation number 92045854; instituted April 17, 2006), all with extensive supporting exhibits including copies of salient portions of the prosecution history of the underlying application and of the cancellation proceeding, the latter copies including the Respondent's interrogatory responses and an opinion and ruling by the United States Trademark Trial and Appeal Board granting the petition.

As will become quite evident from the ensuing discussion, all activities of the Respondent in securing its United States registration and the Complainant's subsequent cancellation of that registration are irrelevant to the present proceeding. Accordingly, for the sake of brevity, the Panel will summarize only those facts which it views as pertinent to its resolution of this dispute and only then to the extent minimally necessary, thus substantially simplifying this matter.

##### **B. Complainant's UROK Mark**

Presently, the Complainant owns a single United States registration for the mark UROK in a stylized pattern. The Complainant has provided, in Annex 5 to the Complaint, a printout of the registration certificate for this mark. Pertinent details of that registration

are as follows:

UROK (stylized)  
United States registration 3,068,862; registered: March 14, 2006  
Filed: August 28, 2001

This mark is registered for use in connection with “clothing, namely shirts, sweaters, and hats” in international class 25, and “educational services, namely conducting reading programs, clinics, and/or workshops for students, and conducting professional development clinics, workshops and/or seminars for schools and teachers” in international class 41. The registration certificate indicates that both first use and first use in commerce of this mark, when used in conjunction with the goods in class 25, commenced as of October 15, 2001; and first use and first use in commerce of this mark, when used in conjunction with the services in class 41, commenced as of October 15, 2001 and April 1, 2002, respectively.

### **C. The Complainant**

The Complainant is an educational product and service provider which offers students, teachers and schools a variety of clinics, workshops and services to enhance and enrich the learning process, particularly for those individuals who have low esteem or lack sufficient self-confidence. It principally operates in Southern California and Oregon but is currently expanding its operations into New York, Illinois, Florida, Michigan and Texas.

The Complainant and consumers of its services pronounce “Urok” as “You Rock” or “You are Okay”.

The Complainant’s tutorial package for its Literacy Links Training Program carries a price of USD 599 per person. With 10 people participating, as the Complainant suggests, the total cost of the literacy program materials is USD 5,990.

The Complainant advertises, markets and promotes its UROK-branded educational goods and services through a variety of ways. One such way involves physically distributing its UROK-branded clothing, including shirts and hats. Over the past several years, it has spent over USD 10,000 on its branded apparel. It continues to receive numerous requests for its branded clothing and will likely expand its channels of distribution to include doing so through its website. It also promotes its services through advertisements in various media outlets in Southern California, as well as through trade shows and, since November 2001, its website. Currently, the Complainant spends approximately USD 25,000 - 30,000 per year on advertising and promotion of its UROK-branded services.

The Complainant evidently became aware of the Respondent and its registration of the mark UROK shortly before the former initiated its cancellation action on April 17, 2006.

### **D. The Respondent**

Currently, the Respondent sells worldwide, through its websites accessible through both of the disputed domain names, rock and roll T-shirts, hoodies, and bell-bottomed jeans which bears its UROK mark. Most of its T-Shirts sell for USD 25,00. Since 2004, various celebrities, such as football players, actors, musicians and models, have worn the Respondent’s UROK-branded apparel. Since 2004, the Respondent has

sponsored T-shirt and modeling contests and other events as one way of advertising its products to a target market of college-aged young adults and has hosted booths at various events to promote sales of its branded clothing.

The Respondent has used its marks UROK and UROK APPAREL in January 2004 and in commerce since February 2004 when it sold its first article of branded clothing, and since August/September 2004 when it registered the disputed domain names. It has sold its products on its websites, resolvable through the disputed domain names, continuously since 2004 and starting on or very shortly after the dates on which it acquired/registered both of the disputed domain names.

In preparation for filing a federal application to register its mark UROK on February 14, 2004, the Respondent performed a search of the US PTO publicly accessible trademark databases and, as a result, became aware of the Complainant's pending application for its UROK mark.

The Respondent first received notice of the present dispute when it received a copy of the Complaint.

The parties do not compete with each other, nor do their respective goods travel through the same channels of distribution or are intended for the same customers.

## **5. Parties' Contentions**

### **A. Complainant**

#### **(i). Identical or Confusingly Similar**

The Complainant contends that the disputed domain name is confusingly similar to the Complainant's UROK mark.

Implicitly, the Complainant takes the position that the domain name <urok.com> is identical to the Complainant's mark and, inclusion of the term "apparel" after the Complainant's mark to form the other disputed domain name <uorkapparel.com> fails to adequately distinguish the latter name from the mark to avoid causing user confusion, thus rendering the latter name confusingly similar to the mark.

Furthermore, the Complainant states that it filed its first trademark application on August 26, 2001-some three years prior to the dates on which the Respondent acquired or registered the disputed domain names and the Respondent was aware of the Complainant's UROK mark. As a result of the trademark search performed by the Respondent shortly before the Respondent registered/acquired the disputed domain names and which uncovered the Complainant's pending application, the Respondent was or should have been aware at that time of the Complainant's exclusive rights in the mark UROK.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

#### **(ii). Rights or Legitimate Interests**

The Complainant contends that, for any of several reasons, the Respondent has no rights or legitimate interests in either of the disputed domain names pursuant to

paragraph 4(a)(ii) of the Policy.

First, the Respondent is neither a licensee nor an affiliate of the Complainant and is not authorized by the Complainant to use the UROK mark.

Second, the Respondent was or should have been aware of the Complainant's prior rights in the UROK mark when the Respondent acquired or purchased the domain names and also applied to federally register its own UROK mark.

Third, the Respondent was not commonly known as either "Urok" or "Urok Apparel" when it registered or acquired both domain names in 2004 and began using those domain names later the same year in connection with its websites.

Lastly, the Respondent has never made any noncommercial use of either of the domain names.

**(iii). Registered and Used in Bad Faith**

As to bad faith, the Complainant contends that the Respondent registered and is now using each of the disputed domain names in bad faith under paragraph 4(a)(iii) of the Policy.

Specifically, the Respondent registered the domain names to sell apparel products branded with the Complainant's mark in spite of having prior knowledge of the Complainant's trademark rights. As such, the Respondent intentionally registered (whether directly or through acquisition of an existing registration) both domain names in order to cause user confusion as to source, sponsorship, affiliation or endorsement with the Complainant's UROK mark and, since that time, has been and is using those domain names to that end.

**B. Respondent**

**(i). Identical or Confusingly Similar**

The Respondent contends that the disputed domain names are not confusingly similar to the UROK mark.

In essence, the Respondent states that the Complainant's UROK mark significantly differs from either of the domain names due to inclusion by the former of a vertical line between each pair of adjacent letters with the overall impression of the mark thus being an acronym. The acronym suggests the audible sound "U. R. OK." or "You are OK"- which the Complainant concedes is how its mark is known. The Respondent's version of the UROK mark contains no such lines but with the letter "O" having an umlaut about it. The "O umlaut" conveys an image of rock and roll music, which the Complainant's mark does not.

Furthermore, the Respondent argues that the channels of trade of the goods of both parties are different, their goods are unrelated and there is no evidence of any actual confusion.

**(ii). Rights or Legitimate Interests**

The Respondent contends that, for either of two reasons, it has rights or legitimate interests in both of the disputed domain names.

First, the Respondent has used and continues to use both of the domain names in connection with a *bona fide* online offering of its clothing for sale since 2004 - which started well before it received notice of the present dispute upon receipt of the Complaint in late 2009.

Second, the Respondent is commonly known by both of the domain names. Though it registered or acquired the domain names during August-September 2004, it had started using its mark UROK in connection with its clothing in January-February 2004. That knowledge is shown by its Internet marketing and widespread endorsement, over the years, of the Respondent's clothing by various celebrities.

### **(iii). Registered and Used in Bad Faith**

The Respondent also contends, for various reasons, that it did not register or use either of the disputed domain names in bad faith.

First, the Respondent did not register or acquire either of the domain names as an intentional attempt to attract for commercial gain, Internet users to the Respondent's website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. Instead, the domain names were acquired for the Respondent's legitimate business interest of selling its clothing through its online store and not to fool, misdirect, or confuse Internet users as to the source, sponsorship, affiliation, or endorsement of the Complainant's product.

Second, the Respondent did not register the domain names primarily for the purpose of selling, renting, or otherwise transferring the domain name registrations to the Complainant, or to prevent the Complainant from reflecting the mark in a corresponding domain name and, in connection therewith, the Respondent has not engaged in a pattern of such conduct.

Third, inasmuch as the Complainant and the Respondent are not competitors, the Respondent did not acquire or register the domain names primarily to disrupt the Complainant's business.

Fourth, the Respondent did not register the names in an intentional attempt to attract for commercial gain Internet users to the Respondent's website or other online location by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location. The Complainant admits that it does not sell products on its website and only gives away its clothing as promotional items.

### **C. Supplemental Filings**

Both of the parties have submitted a supplemental filing. Though the Panel, in its sole discretion, has considered both of these filings, neither of these filings adds anything material to the Panel's consideration of this dispute. Hence, the Panel will dispense with summarizing either of these filings.

## 6. Discussion and Findings

### A. Identical or Confusingly Similar

The Panel finds that each of the disputed domain names is identical or confusingly similar to the Complainant's UROK mark.

From a simple comparison of each of the disputed domain names to the Complainant's mark UROK, even in a stylized pattern, no doubt exists that each of the domain names is identical or confusingly similar to that mark.

The primary differences between the mark and both of the disputed domain names is first the inclusion of a vertical bar between each pair of adjacent letters in the UROK mark which does not and to this Panel's knowledge cannot appear in a textual domain name and here does not appear in the term "urok", and second the further inclusion of the word "apparel" after the mark to form the term "urokapparel" - apart from the appending of the gTLD (generic top level domain) ".com" to each such term to form a corresponding one of the disputed domain names. The addition of the gTLD is irrelevant in assessing confusing similarity or identity under paragraph 4(a) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation, such as adding short letter or number groups or even generic or highly descriptive words, or country names to a mark, is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that domain name to avoid user confusion. Similar minor variations, such as punctuation marks or other such symbols, letters or numbers, in the mark which do not appear in the domain name that do not sufficiently differentiate the domain name from the mark to avoid user confusion are treated in the same fashion.

Here, the inclusion of vertical bars in the mark which do not appear in the term "urok" in either of the two disputed domain names and the appending of the word "apparel" to that term to form one of the domain names are clearly no more than minor variations of no practical significance. See, e.g., *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286 (November 18, 2009); *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703 (August 11, 2009); *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099 (April 20, 2009); *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008 (March 25, 2009); *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072 (September 4, 2008); *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505 (May 28, 2008); *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265 (May 5, 2008); *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878 (March 12, 2008); *Blackrock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627 (January 4, 2008); *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359 (November 14, 2007); *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064 (September 24, 2007); *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952 (August 27, 2007); *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334 (June 28, 2007); *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317 (April 24, 2007); *SPX Corporation v. Hevun Diversified Corporation*, NAF Claim No. FA 791657 (November 13, 2006); *Google Inc. v. Jennifer Burns*, NAF Claim No. FA 726096

(August 16, 2006); *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766 (September 12, 2005); *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531 (July 19, 2005); *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411 (June 22, 2005); *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824 (January 18, 2005); *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836 (December 1, 2004); *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491 (August 30, 2004); *Lane-Labs USA, Inc. v. Powell Productions*, NAF Claim No. FA 155896 (July 1, 2003); and particularly *Cable News Network LP, LLP v. Elie Khouri d/b/a Channel News Network et al.*, NAF Claim No. FA 117876 (December 16, 2002).

Therefore, the Panel finds that, with respect to the Complainant's UROK mark, the disputed domain name <urok.com> is identical to that mark, and the other disputed domain name <urokapparel.com> is confusingly similar to the mark so as to cause confusion in each instance. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

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

The Panel, despite the Complainant's rather emphatic assertions to the contrary, finds that the Respondent has for the purpose of the present proceedings established rights and legitimate interests in both of the disputed domain names under paragraph 4(c)(i) of the Policy.

It is undisputed in the record before this Panel that since the August-September 2004 timeframe when the Respondent obtained the domain names, either through direct registration (for <urokapparel.com>) or acquisition of an existing registration (for <urok.com>), it has used and continues to use both of those domain names as addresses to resolve to its corresponding websites through which it has offered and continues to offer its various UROK-branded clothing products for sale. It is also undisputed in the record before this Panel that the Respondent had no prior knowledge of this dispute until it received a copy of the Complaint -some five years after it obtained both domain names and started using them for its websites. There is no evidence of record here that persuades such offerings were anything other than *bona fide* commercial offerings of goods for sale.

As such, the Panel finds it-self persuaded on the present record that the Respondent has met its burden under paragraph 4(c)(ii) of the Policy, and thus has succeeded in the present proceeding in establishing rights and legitimate interests in both of the disputed domain names.

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

In light of the Panel's findings immediately above regarding paragraph 4(a)(ii), any issues concerning whether the Respondent registered and used either or both of the disputed domain names in bad faith are now moot. Hence, the Panel sees no need, to opine on or record a finding on such issues here. See, e.g., *322 West 57th Owner LLC v. Administrator, Domain*, WIPO Case No. D2008-0736 (August 6, 2008); *Marvel Mfg. Co, Inc., supra*; *Groovr, Inc. v. Active Interactive, Inc.*, NAF Claim No. FA 1103425 (December 18, 2007); *CPFilms, Inc. v. Solar Lunar Performance Film*, NAF Claim No. FA 861127 (February 6, 2007); *Hugo Daniel Barbaca Bejinha v. Whois Guard Protected*, NAF Claim No. FA 836538 (December 28, 2006); and *Pom*

*Wonderful LLC v. Redavid*, NAF Claim. No. FA 846577 (January 8, 2006).

Inasmuch as Complainant has failed to meet its burden under paragraph 4(a)(ii) of the Policy with respect to both of the disputed domain names, it has failed to establish a case for relief under paragraph 4(a).

Furthermore, while the Complainant raised various issues (which, being irrelevant to the present dispute, the Panel has not summarized), in its Complaint, pertinent to whether the Respondent's activities involving use of its own mark UROK constitute infringement of the Complainant's UROK mark, it is not the function of this Panel to comment on any such issue. Consideration of such issues extends beyond the limited purview of an ICANN panel pursuant to the very narrow jurisdiction conveyed to it under the Policy. Hence, this Panel declines the Complainant's invitations to render an opinion on any such issue and, by so doing, properly relegates all such issues to an appropriate judicial venue for suitable consideration and resolution.

**7. Decision**

Accordingly, under paragraph 15 of the Rules, the relief sought by the Complainant is hereby denied.

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Peter L. Michaelson  
Sole Panelist

Date: January 4, 2010