

ESTTA Tracking number: **ESTTA565177**

Filing date: **10/15/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Strong College Student Moving, Inc.		
Entity	Partnership	Citizenship	Florida
Composed Of:	Shaun Robinson		
Address	1717 E. Busch Blvd. #200 Tampa, FL 33612 UNITED STATES		

Correspondence information	Steven Rinehart 136 E. South Temple, Suite 2400 Salt Lake City, UT 84111 UNITED STATES steve@uspatentlaw.us Phone:801-347-5173
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Registration Subject to Cancellation

Registration No	3993081	Registration date	07/12/2011
Registrant	Freidman and Soliman Enterprises, LLC 7th Floor 4800 Hampden Lane Bethesda, MD 20814 UNITED STATES		

Goods/Services Subject to Cancellation

Class 039. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are cancelled, namely: Transportation of household goods by motor vehicle

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
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Related Proceedings	Strong Students Moving, Inc. vs. College Hunks Hauling Junk Franchising, LLC; US District Court of Arizona, Case No. 2:12-CV-01156
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Attachments	PetitiontoCancel.pdf(124612 bytes) AnnexMaster.pdf(261762 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/steven rinehart/
Name	Steven Rinehart
Date	10/15/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD (TTAB)**

In the matter of Trademark Registration: 3993081
Mark: COLLEGE HUNKS MOVING
Registration Date: April 26, 2011

<p>STRONG COLLEGE STUDENT MOVING, INC., a Florida corporation;</p>	
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Petitioner,

vs.

<p>CHHJ FRANCHISING, LLC D/B/A COLLEGE HUNKS HAULING JUNK, a Delaware limited liability company;</p>	
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Registrant.

Petitioner Strong College Student Moving, Inc., with an address of 1717 E. Busch Blvd. #200, Tampa, FL 33612, hereby petitions the Trademark Trial and Appeal Board (TTAB) of the United States Patent and Trademark Office (USPTO) , in accordance with 37 C.F.R. § 2.111, to cancel Trademark Registration 3993081 (the “Mark”). Petitioner is, and was at all times relevant, a corporation organized under the laws of the State of Florida.

As grounds for the cancellation, Petitioner alleges the following:

ALLEGATION AND CLAIM(S)

1. Registrant's Mark was obtained through fraud, and Registrant did not make use of the Mark in commerce until after 2009. Fraud was committed by the registrant under applicable provisions of the Trademark Act § 14(3), 15 U.S.C. § 1064(3).
2. In 2005, Petitioner began doing business after registering with the Florida Secretary of State as Strong College Students, Inc. In 2009, Petitioner reincorporated as Strong Students Moving, Inc. as Petitioner's business expanded. Strong Students Moving, Inc. is a competitor of Registrant in the same Florida and other US markets, and has been for some time.
8. From 2005 to 2009, Petitioner maintained a mutually beneficial relationship with Registrant and Registrant's principals Omar Soliman and Nick Friedman. Petitioner and Registrant referred work back-and-forth, and were on good terms.
9. In 2009, before Registrant to this action accrued trademark rights, Registrant began negotiating with the Petitioner to acquire and merge the Petitioner's business into the Registrant's business, then forming a joint venture called College Hunks Moving. A term sheet crafted by the Registrant (the "Term Sheet") and forwarded by the Registrant to the Petitioner, is annexed hereto as Annex A. This Term Sheet was emailed on November 11, 2009 to the Petitioner by the Registrant's principal, Nick Friedman, in an email attached hereto as Annex B. Omar Soliman, who signed the Registrant's supporting declaration in this action, was carbon copied as a recipient of this email.
10. The Term Sheet was drafted and sent after a lengthy series of telephonic discussions over a period of time between Petitioner, Friedman and Soliman.
11. Pursuant to the terms of this Term Sheet, Petitioner was to change its name to COLLEGE HUNKS MOVING TRUCK, then merge its company with the Registrant's parent

company. This new, subsequently formed entity would then be called COLLEGE HUNKS MOVING. [Term Sheet, ¶¶ 1 – 2.]

12. According the terms of the Term Sheet at page 2, ¶ 5 (emphasis added):

Sean [sic] Petitioner shall be granted creative control of College Hunks Moving Franchising LLC in addition to his role as the director of operations of the local Tampa Franchise. **All new moving service guidelines, operational manuals, software upgrades, training of new franchisees and call center employees will be derived under the direct supervision of the new D of O [Shaun Petitioner]**, of College Hunks Moving, but must adhere to the strict brand standards of CHHJ Franchising LLC.

13. The Term Sheet lists the “website” as a cost Petitioner must share on page 3, and twice specifies that the Petitioner shall be a “33% Owner” in College Hunks Moving (a term identical to that incorporated by the domain to this proceeding). [Term Sheet, ¶¶ 3 and 7.]

14. According to the Term Sheet, Petitioner was to be in charge of training and marketing for the business. With all of these terms in mind, planning on forming a partnership as proposed by the Registrant, the Petitioner registered the domain name <collegehunksmoving.com> (the “Disputed Domain”), with permission of the Registrant, on September 17, 2009, during the negotiations with the Registrant evidenced by the Term Sheet. It was the Petitioner’s company that was to form College Hunks Moving under the Registrant’s proposal.

15. The Petitioner helped conceptualize and create the College Hunks Moving legal entity, made capital contributions and sweat equity investments in it, only to have the Registrant form and proceed with the brand while locking the Petitioner out of the venture.

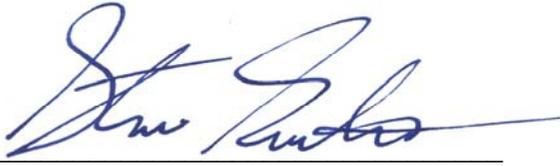
16. The Term Sheet establishes that the Registrant deceived the USPTO with its trademark filing. Registrant had not yet begun using the Mark on the first use in commerce date listed in the trademark application, which date predates the Term Sheet.
17. In fact, Registrant procured registration of the Mark only for the purpose of later using the fraudulently-obtained first use in commerce date to win a UDRP proceeding before the National Arbitration Forum (NAF), which decision is annexed hereto as **Annex C**.
18. Registrant knew the first use in commerce date in its application for the Mark was fraudulent, and submitted it intentionally for fraudulent purposes, later again committing fraud in its UDRP Complaint in which Registrant testified, “Registrant has no relationship whatsoever with Petitioner and has never authorized Petitioner to the Use the Domain Name.”
28. The Registrant procured the registration of the Mark with false allegations of material facts made to the U.S. Trademark Office during the prosecution of its application, which allegations the Registrant made intentionally and knew, or should have known, were false. Accordingly, Registrant obtained the registration through means of fraud.
29. Petitioner is likely to be damaged by the Mark, as the Mark is being used to strip intellectual property from Petitioner, including the Disputed Domain.

WHEREFORE, Petitioner believes that it will be damaged by the registration of the Mark as alleged, and respectfully requests that this Petition to Cancel be granted.

A filing fee has been submitted electronically.

DATED AND SIGNED this 16 day of October, 2013.

Respectfully submitted,

/s/ 

Steven L. Rinehart
Attorney for Petitioner

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing PETITION TO CANCEL was served on October 16, 2013 by mail courier to Applicant's counsel at the following address of record:

Thomas A. Zeigler
MacArthur Place, Suite 200
Santa Ana, CA 92707

CERTIFICATE OF FILING

I certify that a true and accurate copy of the foregoing PETITION TO CANCEL was filed electronically on October 16, 2013 via the ESTTA filing system.

DATED AND SIGNED this 16 day of October, 2013.

/s/



Steven L. Rinehart
Attorney for Petitioner

A N N E X A

PHASE I: Micro Level: Timeline: January 1, 2010 to June 30, 2010.

Local MERGER of College Hunks Hauling Junk franchise and Strong Students Moving (soon to be College Hunks Moving Truck)

CHHJ Tampa acquire/ purchase Tampa based Strong College Students for a fictional dollar amount (for the purpose of local PR). The acquisition will be for the sole purpose of rolling out a new moving product as a division of the "College Hunks" Brand. The name of this brand is yet to be determined but should be put to a panel discussion- "College Hunks Moving" or "College Hunks Moving Truck."

The local CHHJ Franchise will transfer ownership to a newly created LLC (with Soliman 34% owner, Friedman 33% owner, Robinson as 33% owner. The LLC will add Moving Services to its service offering and will execute the franchise agreement with CHHJ Franchising LLC along with the addendum outlining the moving services requirement).

SCS Movers will have 90 days to rebrand, which will include: RE-wrapping all vehicles/trailers, Polo moving shirt for the staff members, re-producing all collateral materials to match CHHJ fonts and marketing materials. This expense will be split 50/50 by the franchise owners. The name of this brand is yet to be determined but should be put to a panel discussion- "College Hunks Moving" or "College Hunks Moving Truck."

CHHJ Tampa and SCS Movers will Merge and rebrand there moving operations under the College Hunks Moving and Hauling. Operations of CHHJ Tampa and CHM will be under supervision and managing control of Sean Robinson and his management team which will include Kevin Burns, as Operation Manager.

An operating agreement must be produced (cost split by both parties) to ensure that the minority partners' shares do not get drowned out by operators' negligence. All expenses must be capped based on a pro-forma that is recommended to all college Hunk Moving Franchisees.

All rebranding will be an expense that will be covered by Shareholders of CHM Tampa

Omar Soliman: 34% Owner

Nick Friedman: 33% Owner

Shaun Robinson: 33% Owner

Must execute Current Franchise Agreement and pay royalties accordingly

1 single account will be used. Reporting in Junkware and moving software will distinguish between Moving Services and Junk Removal. (Systems must be put in place to manage as a dual-package franchise)

Royalty Structure:

On Junk Removal Services 7% Royalty, 6% Call Center Fee, 1% Ad Fund

On Moving Services 7% Royalty, 2% Call Center Fee, 1% Ad Fund.

**** Once Monthly Sales hit \$60k, Phase II "Operation Moving Franchise" will initiate**

PHASE II: Macro Level: (upon satisfactory delivery/execution of Micro-level development and performance): \$60k of Monthly Sales Target Hit) Projected Timeline: July 1, 2010-Sep 30, 2010 Development. Oct 1, 2010 Launch.

Friedman and Soliman Enterprises will be a 80% owner of College Hunks Moving Franchises LLC
Shaun Robinson will be a 20% owner in the Moving LLC and Director of Operations.
Shaun Robinson will take an active role in Call center training and logistics.

Franchise Sales:

- Franchise Fees and royalties collected on the moving services branch of the business will go into a separately monitored account.

EBITDA for Moving Services (royalty and franchise fees only) will be split 80-20 after 25% set aside for re-investment into the company.

The shareholders will be Friedman and Soliman Enterprises, Sean Robinson. Friedman and Soliman will have the controlling interest with 80% of the shares, Mr. Sean Robinson shall have 20%.

Sean Robinson, shall be granted creative control of College Hunks Moving Franchising LLC in addition to his role as the director of operations of the local Tampa Franchise. All new moving service guidelines, operational manuals, software upgrades, training of new franchisees and call center employees will be derived under the direct supervision of the new D of O, of College Hunks Moving, but must adhere to the strict brand standards of CHHJ Franchising LLC.

The expense of franchising CHM will be an expense that is estimated to be 48k; That expense will be paid out of the local Tampa Franchise Op. All branding off CHM including the colors/ logos/ marketing material shall be made with CHHJ in mind and must be produced in similar fashion with identical color schemes. Moving Training will be conducted at CHHJ corporate and will be led by Shaun Robinson

FASE will contribute all franchising sales know how, information, manuals, operational guidelines, sales methods, sale leads over to CHM for the sole purpose of CHM replicating these methods in order to gain a competitive advantage in selling its newly franchised moving product.

All existing franchisees of CHHJ Franchising LLC will be given a time frame which they will be able to open a CHM Location. Opening a CHM location will require the lease of 26 ft wrapped box truck, a commercial location, and an infusion of 50k in working capital, if an existing franchisee doesn't wish to open a CHM location to add an additional revenue stream to its services, that territory will be placed on the open market as a separate franchise offering. All existing franchisees will have the first right of refusal on their existing territories. Future franchisees will have the option to buy 1 or both franchise concepts.

An operating agreement will be produced to ensure that each party involved shall contribute what has been asked of them and what is needed to operate a successful National Moving Franchise System

As first franchisee of CHM, the Orlando Franchisee will not have to pay a 6% royalty, instead he will only pay 6% call center fee and 1% national marketing.

Franchising Costs:

Website: 2-4k

Truck branding: 3-5k per truck (2 trucks?)

Call Center Training/software updates: 5k

Legal Fees/Operational Agreement/FDD Ammendments: 20k

New Logo: \$500

Marketing Material and uniform: 3k

Grand Opening Marketing: 5k

Total cost: 48k

Costs: Paid for by Tampa Operating Entity

A N N E X B

From: collegehunksfriedman@gmail.com [<mailto:collegehunksfriedman@gmail.com>] **On Behalf Of** Nick Friedman

Sent: Wednesday, November 11, 2009 6:21 PM

To: srobinson@strongcollegestudents.com

Cc: Omar Soliman

Subject: Phase I and Phase II

For your review.

--

Nick Friedman | President | COLLEGE HUNKS HAULING JUNK

Making Green Look Good!

To book an appointment call 1-800-586-5872 or on-line at www.1800JunkUSA.com

Follow me on Twitter: <http://www.twitter.com/NickFriedman1>

Join us on Facebook: <http://www.Facebook.com/CollegeHunks>

Let Tomorrow's Leaders Haul Your Junk Today!

Franchise Opportunities Now Available!

ANNEX C



NATIONAL ARBITRATION FORUM

DECISION

CHHJ Franchising LLC d/b/a College Hunks Hauling Junk v. Shaun Robinson

Claim Number: FA1204001437943

PARTIES

Complainant is **CHHJ Franchising LLC d/b/a College Hunks Hauling Junk** ("Complainant"), represented by **Geoffrey C. Brethen of Musick, Peeler & Garrett, LLP**, California, USA. Respondent is **Shaun Robinson** ("Respondent"), represented by **Steven L. Rinehart**, Utah USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<collegehunksmoving.com>**, registered with **GoDaddy.com, LLC**.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Hector A. Manoff, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on April 3, 2012; the National Arbitration Forum received payment on April 5, 2012.

On April 4, 2012, GoDaddy.com, LLC confirmed by e-mail to the National Arbitration Forum that the <collegehunksmoving.com> domain name is registered with GoDaddy.com, LLC and that Respondent is the current registrant of the name. GoDaddy.com, LLC has verified that Respondent is bound by the GoDaddy.com, LLC registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On April 12, 2012, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of May 2, 2012 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@collegehunksmoving.com. Also on April 12, 2012, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on May 2, 2012.

On May 4, 2012, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Hector A. Manoff as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

1. Complainant asserts that it owns U.S. Trademark Registrations for the marks COLLEGE HUNKS HAULING JUNK (wordmark), registered on December 5, 2006, albeit with an alleged first use on June 1, 2003; COLLEGE HUNKS HAULING JUNK (stylized mark), registered on February 20, 2007, but with alleged first use on June 1, 2003; and COLLEGE HUNKS MOVING (stylized mark), registered on July 12, 2011 and with alleged first used on January 1, 2007.
2. Complainant alleges that it has invested large sums of money in advertising and marketing campaigns nationwide, which led them to gain significant publicity.
3. The <collegehunksmoving.com> domain name is identical to the COLLEGE HUNKS MOVING mark.
4. Respondent lacks rights and legitimate interests in the disputed domain name.
5. Respondent has not made an active use of the disputed domain name, despite having registered it more than two and one half years ago.
6. Respondent registered the <collegehunksmoving.com> domain name with the intent to sell, rent, or transfer the disputed domain name to Complainant, the owner of the COLLEGE HUNKS MOVING mark, so as to profit from the eventual transfer.
7. Respondent had actual knowledge of Complainant's rights in the COLLEGE HUNKS MOVING mark prior to its registration of the <collegehunksmoving.com> domain name. Thus, it registered the domain name in bad faith.

B. Respondent

1. The disputed domain name was registered in good faith in 2009 when Complainant was negotiating a partnership agreement with Respondent, long before Complainant accrued trademark rights.
2. Respondent has been in the moving business since 2005, doing business as Strong College Students, Inc. In 2009, he incorporated as Strong Students Moving, Inc.
3. Also in 2009, before Complainant accrued trademark rights, Complainant began negotiating with Respondent to acquire and merge the Respondent's business into Complainant's, then forming a joint venture called COLLEGE HUNKS MOVING. After some time of oral negotiations, Complainant forwarded a "term sheet" to Respondent, which outlined the terms of the business proposal.
4. Pursuant to the terms of the "term sheet", the Respondent was to change its name to COLLEGE HUNKS MOVING TRUCK, then merge its company with the Complainant's parent company. This new, subsequently formed entity, would then be called COLLEGE HUNKS MOVING.
5. Respondent, among other obligations, had to afford the registration of the domain name. Thus, he was authorized by Complainant to register the domain name as part of their business relationship.
6. Respondent claims that he had made investments and had contributed to the project while Complainant has not honored its obligations.
7. Respondent affirms he has made demonstrable preparations to use the disputed domain name for the *bona fide* purpose of forming a partnership with Complainant.
8. Respondent affirms that Complainant committed fraud by declaring in the USPTO a date of first use of the COLLEGE HUNKS MOVING mark in 2007 since, according to the "term sheet", Complainant acknowledged in the term sheet it had not been using the mark prior to November 2009.
9. Respondent contends that, since Complainant did not have any trademark rights identical to the disputed domain when it was registered, the only marks the

Panel can consider are the two COLLEGE HUNKS HAULING JUNK marks, which are not confusingly similar to the disputed domain.

10. Respondent contends that letters and words added to the disputed domain are evidence of confusing similarity only if the similarity of a part suggests the whole, but not confusingly similar where the whole contains its own meaning. In this case, the addition of MOVING to COLLEGE HUNKS in the Applicant's Mark obviates confusingly similarity between the Complainant' mark and the disputed domain and differentiates the disputed domain visually, connotatively, phonetically, and conceptually from the Complainant's mark.

11. Respondent affirms that the registration of the Disputed Domain involves a business dispute between the parties. Therefore, it falls outside the scope of the UDRP.

12. Respondent claims that Complainant initiated this dispute as part of a scheme of reverse domain name hijacking.

FINDINGS

Complainant is a nationally known company that has been doing business from 2003 and provides two type of services: 1) sorts, moves, recycles, and disposes personal items for a fee, and 2) transports household goods by motor vehicle. Complainant owns U.S. Trademark Registrations for the marks COLLEGE HUNKS HAULING JUNK (wordmark), registered on December 5, 2006, albeit with an alleged first use on June 1, 2003; COLLEGE HUNKS HAULING JUNK (stylized mark), registered on February 20, 2007, but with alleged first use on June 1, 2003; and COLLEGE HUNKS MOVING (stylized mark), registered on July 12, 2011 and with alleged first used on January 1, 2007.

Respondent is a competitor of Complainant and has been doing business since 2005. Respondent registered the <collegehunksmoving.com> domain name on September 17, 2009 and had never used it so far. Respondent claims that he

had authorization from Complainant to register the disputed domain name as a part of a business agreement with Complainant.

DISCUSSION

Paragraph 15(a) of 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."

Paragraph 4(a) of the Policy 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; and
- (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.

Preliminary Issue: Business/Contractual Dispute Outside the Scope of the UDRP

Respondent contends that the registration of the disputed domain name involves a business dispute between the parties and, thus, that it falls outside the scope of the UDRP. In support of this assertion, Respondent submitted a document that Complainant would have forwarded to Respondent by e-mail, which outlined the terms of the proposed agreement, as explained in more detail above in the Respondent's contentions paragraph.

The document (referred to as "term sheet" in the Response brief) submitted by Respondent to prove the business relationship with Complainant is not addressed to any person, neither signed. Moreover, the attached e-mail from Mr. Friedman to Mr. Robinson does not include the terms of the alleged business

proposal in the body of the e-mail, nor it shows the attached file, thus preventing this Panel from concluding that such e-mail had attached the above mentioned “term sheet”. Even the subject of the e-mail that mentions Phases 1 and 2, which are also mentioned in the term sheet, is insufficient to prove that the “term sheet” of Annex B was attached to the e-mail of Annex C.

Therefore, the above-mentioned documents cannot be considered as conclusive evidence of a business/contractual dispute that would have this case fall outside the scope of the UDRP.

Under the UDRP, the Panel has discretion to determine whether or not it has jurisdiction over this dispute. Since Complainant and Respondent have provided sufficient evidence for the Panel to properly decide the dispute under the UDRP, the Panel may proceed with the case and consider the contentions of Complainant and Respondent. *See Weber-Stephen Prod. Co. v. Armitage Hardware*, D2000-0187 (WIPO May 11, 2000) (“Like any other tribunal, however, this Panel can determine whether it has jurisdiction only from the facts and arguments presented to it. In this case, Complainant did allege bad-faith use and registration of the domain name at issue. Had Complainant proved those allegations, there would be no proper question as to this Panel’s jurisdiction.”); *see also Draw-Tite, Inc. v. Plattsburgh Spring Inc.*, D2000-0017 (WIPO Mar. 14, 2000) (“This Panel well recognizes that its jurisdiction is limited to providing a remedy in cases of ‘the abusive registration of domain names,’ or ‘Cybersquatting’ ... Like any other tribunal, however, this Panel can determine whether it has jurisdiction only from the facts and arguments presented to it. In this case, Complainant did allege bad-faith use and registration of the domain name at issue. Had Complainant proved those allegations, there would be no proper question as to this Panel’s jurisdiction.”).

In this case, Complainant made assertions following the criteria set out in the Policy, thus the present Panel considers having jurisdiction to render a decision in respect of the disputed domain name.

Therefore, the Panel will proceed to analyze the case under the UDRP rules.

Identical and/or Confusingly Similar

This Panel finds that trademark registrations in the name of Complainant are sufficient to establish rights in the mark under Policy ¶ 4(a)(i). *See Metro. Life Ins. Co. v. Bonds*, FA 873143 (Nat. Arb. Forum Feb. 16, 2007) (finding that a trademark registration adequately demonstrates a complainant's rights in a mark under Policy ¶ 4(a)(i)); *see also Thermo Electron Corp. v. Xu*, FA 713851 (Nat. Arb. Forum July 12, 2006) (finding that the complainants had established rights in marks where the marks were registered with a trademark authority).

Complainant argues that Respondent's domain name is identical to its COLLEGE HUNKS MOVING mark and also confusingly similar to its COLLEGE HUNKS HAULING JUNK marks, which were widely used from 2003, and registered from 2006/2007, prior to the disputed domain name registration date.

Respondent argues that Complainant's COLLEGE HUNKS MOVING mark was filed and registered after he registered the disputed domain name. Moreover, Respondent alleges that, from the submitted evidence, it turns out that Complainant had not used the COLLEGE HUNKS MOVING mark before November 2009. Therefore, he argues that the disputed domain name should be compared, for confusing similarity purposes, to Complainant's COLLEGE HUNKS HAULING JUNK marks only. He adds that the disputed domain name is not confusingly similar to the latter marks, and that the shared words "COLLEGE

HUNKS” is a descriptive expression which is not exclusively associated with Complainant’s business. The Panel disagrees.

Actually, this Panel finds that the shared “COLLEGE HUNKS” expression is a distinctive part of Complainant’s marks, which was already included in Complainant’s trademark registrations dating back to 2006/2007. And this similarity is not changed by the addition of the generic term “moving”. *See Arthur Guinness Son & Co. (Dublin) Ltd. v. Healy/BOSTH*, D2001-0026 (WIPO Mar. 23, 2001) (finding confusing similarity where the domain name in dispute contains the identical mark of the complainant combined with a generic word or term); *see also Warner Bros. Entm’t Inc. v. Rana*, FA 304696 (Nat. Arb. Forum Sept. 21, 2004) (finding that the addition of the generic term “collection” to Complainant’s HARRY POTTER mark failed to distinguish the domain name from the mark). In light of the preceding facts and case precedent, the Panel determines that the disputed domain name is confusingly similar to Complainant’s marks for the purposes of Policy ¶ 4(a)(i).

Lastly, as regards Respondent’s assertion that Complainant had committed fraud by declaring a false date of first use of the COLLEGE HUNKS MOVING mark in the USPTO trademark application procedure, this Panel determines that such issue falls outside the scope of review under the UDRP and should be decided by the Courts.

Therefore, the Panel finds that Policy ¶ 4(a)(i) has been satisfied.

Rights or Legitimate Interests

Under Policy ¶ 4(a)(ii), Complainant must first make a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name and then the burden shifts to Respondent to show it does have rights or

legitimate interests. *See Hanna-Barbera Prods., Inc. v. Entm't Commentaries*, FA 741828 (Nat. Arb. Forum Aug. 18, 2006) (holding that the complainant must first make a *prima facie* case that the respondent lacks rights and legitimate interests in the disputed domain name under UDRP ¶ 4(a)(ii) before the burden shifts to the Respondent to show that it does have rights or legitimate interests in a domain name); *see also AOL LLC v. Gerberg*, FA 780200 (Nat. Arb. Forum Sept. 25, 2006) (“Complainant must first make a *prima facie* showing that Respondent does not have rights or legitimate interest in the subject domain names, which burden is light. If Complainant satisfies its burden, then the burden shifts to Respondent to show that it does have rights or legitimate interests in the subject domain names.”).

The Panel finds that Complainant has made a *prima facie* case that Respondent lacks rights and legitimate interests in the disputed domain name. Complainant claims that no authorization was given to Respondent to use its COLLEGE HUNKS MOVING mark in the disputed domain name and Respondent refers to negotiations to form a partnership with Complainant but provided no credible evidence of having received an authorization from Complainant to register the disputed domain name. Respondent is not commonly known by the <collegehunksmoving.com> domain name. The WHOIS information identifies the registrant of the disputed domain name as “Shaun Robinson” which the Panel determines to be dissimilar to the disputed domain name. In *Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) and *Braun Corp. v. Loney*, FA 699652 (Nat. Arb. Forum July 7, 2006), the panels concluded that the respondents were not commonly known by the disputed domain names as the respective complainants had not authorized the respondents to use the marks, and the WHOIS information was not similar to the disputed domain names. Similar to *Tercent Incorporated* and *Braun Corporation*, the Panel holds that Respondent is not commonly known by the disputed domain name under Policy ¶ 4(c)(ii).

The Panel further notes that Respondent does not have a functional website, which does not constitute either a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii). See *Hewlett-Packard Co. & Hewlett-Packard Dev. Co., L.P. v. Shemesh*, FA 434145 (Nat. Arb. Forum Apr. 20, 2005) (“The Panel finds that the [inactive use] of a domain name that is identical to Complainant’s mark is not a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i) and it is not a legitimate noncommercial or fair use of the domain name pursuant to Policy ¶ 4(c)(iii).”); see also *Bloomberg L.P. v. SC Media Servs. & Info. SRL*, FA 296583 (Nat. Arb. Forum Sept. 2, 2004) (“Respondent is wholly appropriating Complainant’s mark and is not using the <bloomberg.ro> domain name in connection with an active website. The Panel finds that the [inactive use] of a domain name that is identical to Complainant’s mark is not a bona fide offering of goods or services pursuant to Policy ¶ 4(c)(i) and it is not a legitimate noncommercial or fair use of the domain name pursuant to Policy ¶ 4(c)(iii).”).

Based on the foregoing, the Panel concludes that Respondent’s registration and lack of use of the disputed domain name does not constitute a *bona fide* offering of goods or services under Policy ¶ 4(a)(i) or a legitimate noncommercial or fair use of the disputed domain name under Policy ¶ 4(a)(iii).

Registration and Use in Bad Faith

Complainant argues that Respondent’s registration and non-use of the disputed domain name are a product of bad faith. Complainant claims that Respondent attempted to form a partnership with one of Complainant’s franchises, but was unsuccessful. Complainant claims that this meeting occurred in August of 2009, just prior to Respondent’s acquisition of the disputed domain name. Complainant contends that Respondent bought the disputed domain name as a direct result of this failed meeting so as to profit from an eventual transfer of the disputed

domain name to Complainant. Under these circumstances, the Panel believes that, even though Respondent has not attempted to sell the domain name to Complainant, the registration and subsequent lack of use of the same creates the impression that it was registered to improve Respondent's negotiation power in the alleged business dispute between the parties. *See Cruzeiro Licenciamentos Ltda. v. Sallen*, D2000-0715 (WIPO Sept. 6, 2000) (finding that mere failure to make an active use of a domain name can qualify as bad faith if the domain name owner's conduct creates the impression that the name is for sale); *see also CBS Broad. Inc. v. Worldwide Webs, Inc.*, D2000-0834 (WIPO Sept. 4, 2000) ("There is nothing inherently wrongful in the offer or sale of domain names, without more, such as to justify a finding of bad faith under the Policy. However, the fact that domain name registrants may legitimately and in good faith sell domain names does not imply a right in such registrants to sell domain names that are identical or confusingly similar to trademarks or service marks of others without their consent").

Complainant argues that Respondent's non-use of the disputed domain name is evidence of bad faith. Complainant asserts that the <collegehunksmoving.com> domain name resolves to an inactive website. Previously, panels have found that the inactive holding of a disputed domain name could be evidence of bad faith. According to this case's factual circumstances, this Panel agrees. *See Telstra Corp. v. Nuclear Marshmallows*, D2000-0003 (WIPO Feb. 18, 2000) ("[I]t is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith."); *see also Disney Enters. Inc. v. Meyers*, FA 697818 (Nat. Arb. Forum June 26, 2006) (holding that the non-use of a disputed domain name for several years constitutes bad faith registration and use under Policy ¶ 4(a)(iii)).

Complainant also contends that Respondent could not have registered the disputed domain name without actual or constructive knowledge of Complainant

and its rights in the COLLEGE HUNKS MOVING mark. Respondent acknowledged that he is in the same business as Complainant, with principal place of business in the same state, that they know each other and had attempted to do business together. Even though Respondent contends that the COLLEGE HUNKS MOVING mark was a result of a merger negotiation with Complainant, he could not be unaware that COLLEGE HUNKS was a distinctive part of the COLLEGE HUNKS HAULING JUNK mark belonging to Complainant. This Panel thus finds that Respondent registered the disputed domain name in bad faith under Policy ¶ 4(a)(iii) since he had actual notice of Complainant's trademark rights. *See Deep Foods, Inc. v. Jamruke, LLC*, FA 648190 (Nat. Arb. Forum Apr. 10, 2006) (stating that while mere constructive knowledge is insufficient to support a finding of bad faith, where the circumstances indicate that the respondent had actual knowledge of the complainant's mark when it registered the domain name, panels can find bad faith); *see also Yahoo! Inc. v. Butler*, FA 744444 (Nat. Arb. Forum Aug. 17, 2006) (finding bad faith where the respondent was "well-aware" of the complainant's YAHOO! mark at the time of registration).

The Panel finds Policy Paragraph 4(a)(iii) has been satisfied.

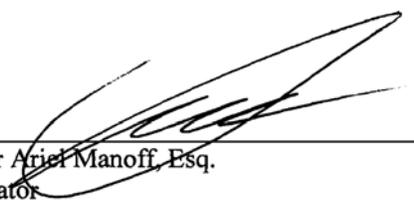
Reverse Domain Name Hijacking

Since the Panel finds that Complainant has satisfied all of the elements of Policy ¶ 4(a), the Panel finds that Complainant has not engaged in reverse domain name hijacking. *See World Wrestling Fed'n Entm't, Inc. v. Ringside Collectibles*, D2000-1306 (WIPO Jan. 24, 2001) ("Because Complainant has satisfied [all of] the elements of the Policy, Respondent's allegation of reverse domain name hijacking must fail"); *see also Gallup, Inc. v. PC+s.p.r.l.*, FA 190461 (Nat. Arb. Forum Dec. 2, 2003) (finding no reverse domain name hijacking where complainant prevailed on the "identical/confusingly similar" prong of the Policy).

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <collegehunsmoving.com> domain name be **TRANSFERRED** from Respondent to Complainant.



Hector Ariel Manoff, Esq.
Arbitrator

Hector A. Manoff, Panelist

Dated: May 17, 2012