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Decisión del Panel Administrativo nº D2000-1188 de WIPO Arbitration and Mediation Center, 21 de noviembre de 2000 (Scottish Provident Institution v. Scottish Provident Ministry)

Year: 2000

Case Number: D2000-1188

Decision Date: 21 November 2000

Plaintiff: Scottish Provident Institution

Respondent: Scottish Provident Ministry

Type of Document: Generic Domain

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Scottish Provident Institution v. Scottish Provident Ministry

Case No. D2000-1188

This is a mandatory administrative proceeding submitted for decision in accordance with the Uniform Policy for Domain Name Dispute Resolution, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 (the "Policy"), the Rules for Uniform Domain Name Dispute Resolution Policy, approved by ICANN on October 24, 1999 (the "Rules") and the World Intellectual Property Organization ("WIPO") Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules"), Paragraph 3(b).

The Administrative Panel consisting of a single member was appointed on November 2, 2000 by WIPO.

2. The Parties

The Complainant in this administrative proceeding is Scottish Provident Institution, a mutual life office incorporated by Act of Parliament registered in Scotland.

The Respondent in this Administrative Proceeding is Scottish Provident Ministry, whose address is listed as P.O. Box 28, San Pedro Town, **Ambergris Caye**, Belize.

3. The Domain Names and Registrar

scottishprovident.com

Network Solutions, Inc ("NSI")

The Complainant did not provide the address of the Registrar, but it is known to have an address as follows:

505 Huntmar Park Drive
Herndon, VA., 20170
United States of America

4. Jurisdiction and Related Matters

By registering the subject domain name with the Registrar, the Respondent agreed to the resolution of disputes pursuant to the Policy and Rules.

5. Procedural History

Complainant filed its Complaint with the World Intellectual Property Organization Arbitration and Mediation Center (the "Center") on September 8, 2000, in hard copy and on September 28, 2000 by email. An Acknowledgement of Receipt dated September 14, 2000, was sent by e-mail by the WIPO Center to the Complainant. The WIPO Center dispatched to the Registrar a Request for a Registrar Verification by email on September 14, 2000. On September 18, 2000 the Center requested an Amendment to the Complaint. On September 28, 2000 the Amendment was received by email and on October 3, 2000 by hard copy. On October 4, 2000, having verified that the Complaint satisfied the formal requirements of the Uniform Policy and the Uniform Rules, the Center formally commenced this proceeding and notified the Respondent that its Response would be due by October 25, 2000. The Respondent did not file a response by the due date.

An examination of this material confirms that all technical requirements for the prosecution of this proceeding were met.

Neither party requested an opportunity to make further submissions and the Administrative Panel is content to proceed on the basis of the existing record.

6. Factual Background

The Complainant's principal place of business is the United Kingdom. It has been trading in the U.K. under the name Scottish Provident since 1837. The Complainant has acquired considerable good will and reputation in the name SCOTTISH PROVIDENT and is well known throughout the U.K. and Europe for its services.

Furthermore, by reason of the fact that the Complainant is a major provider of pension, investment, insurance and trustee services and as an integral part of its business invests world-wide, it has acquired a considerable reputation in the financial world at large.

The Complainant is the registered proprietor of the following trade marks:

a) United Kingdom trade mark registration number 1536362 SCOTTISH PROVIDENT (Series of 3) in Class 16 registered in respect of printed matter and publications, all relating to pension, investment, assurance and trustee services; all included in Class 16, dated May 21, 1993;

b) United Kingdom trade mark registration number 2137252 SCOTTISH PROVIDENT (words) registered in respect of printed matter, publications and brochures, all relating to sports and sporting events and to pension, investment, assurance and trustee services; advertising materials, banners, bunting, calendars, cards, diaries, flags, folders, guides relating to financial affairs and to sports and sporting events, inlay cards for video cassettes, notepads, patches, pens, postcards and programmes in International Class 16 and clothing, footwear and headgear in Class 25, dated June 27, 1997;

c) United Kingdom trade mark registration number 1510599 SCOTTISH PROVIDENT (Series of 3) registered in respect of pension, investment and assurance services; trustee services; all included in Class 36 as of the August 13, 1992;

d) United Kingdom trade mark registration number 2124426B SCOTTISH PROVIDENT SECURE 100 MAXIMISER FUND (Series of 2) registered in respect of insurance services; life assurance services; investment services; fund management; pension services; unit trusts in Class 36 as of February 20, 1997;

e) United Kingdom trade mark registration number 2130064 SCOTTISH PROVIDENT FIRST PROTECT (Series of 4) registered in respect of pensions, investment and assurance services; life assurance services; fund management services; unit trusts in Class 36 as of April 19, 1997;

f) Community trade mark registration number 000122606 SCOTTISH PROVIDENT (words) registered in respect of printed matter and publications in Class 16 and financial services; financial management; pension, investment and assurance services; trustee services; unit trust services in Class 36 as of April 1, 1996;

g) Community trade mark registration number 656058 SCOTTISH PROVIDENT FIRST PROTECT registered in respect of pensions, investments and assurance services; life assurance services; fund management services, unit trusts in Class 36 as of October 17, 1997.

The Respondent, which has registered, but not used the subject domain name, is not connected to the Complainant.

7. Parties Contentions

A. Complainant

The Complainant says that because the Respondent has never used the subject domain name: "It would therefore appear that the Respondent is maintaining a domain name to prevent the Complainant as owner of the trade mark from using their trade mark in the corresponding domain name."

The Complainant expresses a concern that " as it develops its e-commerce business, more and more potential clients and customers will attempt to contact the Complainant by searching for [it] under the domain name "scottishprovident.com" and, by reason of the Respondents registration of this domain name, either the Complainant will not obtain the business or else the Respondent will attempt to provide some form of service to potential customers and will convert consumers or tarnish the trade mark of the Complainant by failing to provide the service the consumers would expect of what they would think to be the Complainant."

The Complainant notes that the Respondent has registered a domain name of a similar financial services company based in Scotland operating in the same business environment as the Complainant, namely scottishequitable.com and the fact that " the Respondent s registration details appear to have changed from the Bahamas to Belize in the past few months.

B. Respondent

Neither party adduced any evidence on the position of the Respondent.

8. Discussion and Findings

Paragraph 4(a) of the Policy requires the Complainant to prove that:

i) a domain name is identical or confusingly similar to a service mark to which the Complainant has rights;

ii) the Respondent has no legitimate interest in respect of the domain name;

iii) the domain name has been registered or is being used in bad faith.

Paragraph 4(b) provides for the implication of evidence of bad faith in a number of circumstances:

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

(ii) registration of 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 the Respondent has engaged in a pattern of such conduct;

(iii) registration of the domain name primarily for the purpose of disrupting the business of a competitor;

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

These are illustrative and do not represent the only circumstances from which may arise evidence of bad faith.

The resolution of this dispute takes place in the context of a consideration of the requirements of paragraph 4(a) of the Policy.

A. Identical or Confusingly Similar

Although the evidence is not clear as to when the Complainant first learned that the Respondent had registered the subject domain name or when the Respondent registered it - it may be that it was December 30, 1997 - but the evidence is clear that the Complainant has used its name from 1837.

The subject domain name is virtually identical to the Complainant's name and marks and the Complainant has long made use of them. The Administrative Panel is satisfied that the Complainant has rights which are violated by the Respondent's registration of the subject domain names and that the requirements of paragraph 4(a)(i) are met.

B. Respondent's Legitimate Interest

The Respondent has made no use of the subject domain name. In the absence of evidence to the contrary it is a fair inference that it has no legitimate interest in it. The Administrative Panel is satisfied that the Complainant has established the requirement of paragraph 4(a)(ii).

C. Bad Faith

While elements are touched on, the Complainant makes no submission which is identified as specifically addressing the ingredients of bad faith. Its case is at best speculative. It says that it "would appear ." and that it is concerned that injury may result as it becomes more active in e-commerce.

The conclusion that a domain name is identical and that the registrant has no legitimate interest in it usually does not lead automatically to a finding of bad faith. It is a separate ingredient of the case a Complainant must establish.

A search of the Internet conducted by the Administrative Panel on November 10, 2000 led to the Complainant's web page when the words "scottish" and "provident" were searched. An attempt to send an e-mail to the domain name resulted in a notification that no such address could be found.

Absent a credible explanation for a Respondent's apparent incursion into a Complainant's rights, it often is appropriate for an Administrative Panel to draw the inference that a registration was made in bad faith. It usually is not necessary for a Complainant to wait until a Respondent reveals its true intention for the registration or takes some overt act that causes harm to the Complainant, but in this case there is no evidence that the Complainant asked the Respondent to relinquish the subject domain name or that the Complainant carries on business in the Bahamas or Belize. The evidence of potential harm is speculative and depends on initiatives that the Complainant may or may not take in the future.

While it appears to be true that the Respondent has registered a name that relates to another company and which also appears to be identical to the name of that organization, evidence of a single registration usually is not sufficient to show a pattern of conduct.

On the evidence presented in this case, the Complainant has not satisfied the Administrative Panel that the Respondent registered or is using the subject domain name in bad faith.

9. Decision

Based on the evidence and the findings stated herein, the Administrative Panel decides that the Complainant has failed to establish its claim. If it were to discover new facts that were evidence of bad faith, it could consider requesting another Administrative Panel to consider the matter. Whether that Administrative Panel could or would do so is an issue to be resolved at that time.

The Complaint is dismissed.

Edward C. Chiasson, Q.C.
Panelist

Dated: November 15, 2000.