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Decisión del Panel Administrativo nº D2002-1059 de WIPO Arbitration and Mediation Center, 09 de enero de 2003 (Scottish Provident Limited v. Scottish Provident Ministry)

Year: 2002

Case Number: D2002-1059

Decision Date: 09 January 2003

Plaintiff: Scottish Provident Limited

Respondent: Scottish Provident Ministry

Type of Document: Generic Domain

WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Scottish Provident Limited v. Scottish Provident Ministry

Case No. D2002-1059

1. The Parties

The Complainant is Scottish Provident Limited, Abbey National Plc, Group Legal Services, Milton Keynes, United Kingdom. It is represented by Alison Greene.

The Respondent is Scottish Provident Ministry, **Ambergris Caye**, Belize. The Respondent is not represented and has not filed a Response.

2. The Domain Name and Registrar

The disputed domain name <scottishprovident.com> is registered with Network Solutions Inc. ("Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the Center") on November 19, 2002. On November 20, 2002, the Center transmitted by email to the Registrar a request for registrar verification of the domain name at issue. On November 21, 2002, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 26, 2002. In accordance with the Rules, paragraph 5(a), the due date for Response was December 16, 2002. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 18, 2002.

The Center appointed the Honorable Sir Ian Barker QC as the sole panelist in this matter on December 30, 2002. 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

The present Complaint is a refiling by the Complainant of an administrative proceeding between the same parties filed with the Center on September 8, 2000. By decision dated November 15, 2000, in WIPO Case No. D2000-1188, a single Panelist declined to order the transfer to the Complainant by the Respondent of the disputed domain name. The Panel was not satisfied that the Respondent had registered or was using the disputed domain in bad faith. This finding was made even though the Respondent had not defended the administrative proceeding and the Panel had been satisfied that the other two criteria of Paragraph 4(a) of the Policy had been proved.

The Panel concluded the decision with the words, *"If it (the Complainant) 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 the time"*.

The Complainant submits that its Complaint against the Respondent should be reconsidered on the basis of fresh evidence which could not reasonably have been known at the time of the original complaint: namely, evidence of a clear pattern of behaviour constituting bad faith conduct involving the speculative registration of the trademarks of well-known corporate entities by the Respondent or persons closely associated with it.

The Complainant's principal place of business is the United Kingdom. It has been trading in the U.K. under the name Scottish Provident Institution since 1837. The Scottish Provident Institution was a mutual life office incorporated in the UK by an Act of Parliament in 1837, and traded under the name Scottish Provident until July 13, 2001, when all assets were transferred under Court approval to the Complainant which has continued trading under the name Scottish Provident from that date.

Accordingly, the Complainant acquired considerable goodwill and reputation in the name SCOTTISH PROVIDENT for the services and goods of interest. It is well known throughout the UK and Europe for these services. The Complainant is a major provider of pension, investment, insurance and trustee services, and as an integral part of its business invests worldwide. The Complainant has acquired a considerable reputation in the financial world at large. The name SCOTTISH PROVIDENT is known internationally.

The Complainant is now the registered proprietor of several UK and Community trademarks for the words "Scottish Provident" in various classifications. These marks were registered by the Scottish Provident Institution, the predecessor of the Complainant.

The Complainant has a considerable Internet presence, and operates e-commerce sites relating to the provision of financial services under the corresponding domain names <scottishprovident.co.uk>, <scottishprovident.org>, <scottishprovident.net>, <scotprov.co.uk>, <scotprov.com>, <scotprov.net> and <scotprov.org>.

The Respondent has not used the disputed domain at all since the date of the decision in WIPO Case No. D2000-1188. The Complainant has given no rights over the disputed domain name to the Respondent.

There were some 5 administrative proceedings filed with WIPO Center later in date to the filing of WIPO Case No. D2000-1188 in which the Respondent or persons associated with it were involved. They were preceded by WIPO Case No. D2000-0396 which is also relevant. Details are as follows:

(i) **Laurent Perrier SA & Anor v Mr. L Perrier & Others, WIPO Case No. D2000-0396 <laurentperrier.com> and <laurent-perrier.com>**

The domain names at issue were <laurentperrier.com> and <laurent-perrier.com>. Peter Colman, was the original registrant of two LAURENT PERRIER domain names. In June 1998, following legal proceedings in the French Courts, Mr. Colman was ordered to transfer the names to the well-known Champagne House.

Prior to that Judgment being enforced, Mr. Colman transferred the two names to a "Laurent Jacques Perrier" and "M L Perrier", both having the same address in Nassau, Bahamas. This was the address of Fernhead Property Holdings, and the same as that initially given for correspondence to the "Scottish Provident Ministry" in WIPO Case No. D2000-1188 (and subsequently in WIPO Case No. D2000-1228 <clericalmedical.com>) (supra).

Whilst Mr. Colman was not the Respondent to the Complaint subsequently brought in 2000, by Laurent Perrier, he nevertheless submitted a Response on behalf of the new registrants and Belize Domain Services (at the address provided for "Scottish Provident Ministry" in WIPO Case No. D2000-1188 and later for Belize Domain Services in D2001-0335 <fulhamfc.com> and WIPO Case No. D2002-0728 <jacobs creek.com>) (supra)).

The Panel ordered transfer of both domain names to the Complainant. With regard to rights or legitimate interests in the names, the Panel expressed more than scepticism about the existence of M L Perrier and Laurent Jacques Perrier and concluded that they were Mr. Colman's inventions, created with a view to avoiding the French proceedings and the Order which was likely to follow.

In its decision the Panel noted:

(a) *"It is evident that the Respondents and their representatives sought anonymity and deployed great efforts to confuse the other parties and make it as difficult as possible to contact them"*

(b) *"Peter Colman has admitted in para 21 that he "has registered and does register domain names both on his own behalf and on behalf of other individuals and organizations." Belize Domain Services now appears as the Registrant of several names of potential commercial importance, in particular, "thepru.com". It is evident that Respondents, or those affiliated with the Respondents, have been "involved" in the "transfer" of the names and that a pattern exists where these names have been transferred from Mr. Colman to services with addresses in the Bahamas and Belize."*

In ordering the transfer, the Panel concluded that there existed a pattern of conduct preventing trademark and service mark owners from reflecting their mark in a corresponding domain name, and;

"that Mr. Colman, and Mr. Alan Jones (Fernhead Property Holdings and Belize Domain Services) play an important role in this pattern of activities."

(ii) Skipton Building Society v Mr. Peter Colman, WIPO Case No. D2000 1217 <skipton.com>

Mr. Colman claimed to have registered the name for the purpose of setting up a local portal site for the town of Skipton (with interest from a Mr. Skipton in the US), although the site had remained dormant for the three years between registration and complaint. The panel concluded that the name had been registered in bad faith, and Mr. Colman had no rights or legitimate interest in the domain. On ordering the transfer to the trademark owner, the Panel noted:

"by his own admission, Mr. Colman took advantage of the first-come, first-served policy of the domain name registrars to obtain a wide range of registrations, including a number of well-known English football clubs, and other substantial entities, including W H Smith and Thames Water. The latter two registrations are particularly telling, as there can be no legitimate geographical or other justification for the registrations."

The Panel found that Mr. Colman's pattern of conduct was compelling, and his explanation for why he had registered football clubs and other business fanciful. Concluding:

"it is hard to see that the registrations which Mr. Colman undertook in 1997, including the domain name at issue, can have been made otherwise than in bad faith, and for the purpose of getting in first ahead of legitimate businesses."

(iii) Clerical Medical Investment Group Limited v Clericalmedical.com (Clerical & Medical Services Agency), WIPO Case No: D2000-1228 <clericalmedical.com>

The domain name at issue was <clericalmedical.com> registered by Clericalmedical.com (Clerical & Medical Services Agency). The address given by the respondent in this case was the same address in the Bahamas also given in the earlier proceedings for <scottishprovident.com> and <laurent-perrier.com> for Fernhead Property Holdings and Alan Jones. No information had been provided concerning any legitimate business being transacted under the name "Clerical & Medical Services Agency", and no use had been made of the domain name for over two years. The respondent has also failed to respond to any communications.

It was held that the respondent had no rights or legitimate interests in respect of the domain, and that the name had been registered in bad faith. Accordingly, the Panel ordered the transfer to the trademark owner.

(iv) Fulham Football club (1987) Limited v fulhamfc.com/Belize Domain Services, WIPO Case No: D2001-0335 <fulhamfc.com>

The domain name at issue was <fulhamfc.com> registered by Belize Domain Services at the same Belize address provided in <scottishprovident.com>, <laurent-perrier.com>, and in WIPO Case No. D2002-0728 <jacobs creek.com> (supra). Following a cease and desist letter from the Fulham Football Club, Belize Domain Services responded stating that it had registered the domain on behalf of its client, and that it was its client's intention, when funded, to operate a "fun club" using the <fulhamfc.com> domain name.

After registration, no use had been made of the domain name, and no information had been provided concerning any legitimate business being transacted under the name "Fulham Fun Club". The Panel concluded it was clear that the respondent had no rights or legitimate interests in respect of the domain name, which had been registered fancifully and in bad faith (along with domain names of other popular football clubs) to prevent Fulham FC from reflecting its trademark in the corresponding domain name.

In ordering the transfer of the domain name, the Panel noted in reference to the issue of non-use that a complainant

"need not wait for direct harm before seeking redress in an ICANN proceeding"

(v) Espirito Santo Financial Group S.A. v Peter Colman, WIPO Case No: D2001-1214 <espiritosanto.com>

The domain name at issue was <espiritosanto.com>. Registered by Mr. Colman (at the same London address provided in <laurent-perrier.com>) for the apparent purpose of setting up a local portal site for the area of Espirito Santo. The site had remained dormant for 4 years, within which time Mr. Colman had contacted the registrant offering to sell the domain for \$10,000. The respondent had no legitimate interest in the domain, which the Panel concluded was part of a wider course of conduct involving the speculative registration of well-known trademarks of commercial entities by Mr. Colman. In ordering the transfer of the domain name, the Panel noted that whilst a mere lack of use may not establish bad faith:

"a combination of lack of solid evidence of the reason for non-use, combined with a history of other similar situations involving the same respondent, making the same type of weak arguments, is enough to find bad faith here".

(vi) Orlando Wyndham Group Pty. Limited v Jacob Creek, WIPO Case No: D2002-0728 <jacobscreek.com>

The domain name at issue was <jacobscreek.com>. The address given by the respondent in this case was the same address in Belize provided for Belize Domain Services in proceedings <scottishprovident.com>, <laurent-perrier.com>, and <fulhamfc.com>. The complainant, a well-known winemaker and distributor, was unable to obtain any evidence that indicated the existence of a person called "JACOB CREEK" a business operated under the name "JACOB S CREEK" or any other organization conducted by the respondent using the name JACOBS s CREEK in **Ambergris Caye**, Belize or elsewhere. The complainant drew on the findings in Laurent-Perrier to demonstrate that the registration was part of a pattern of bad faith conduct by the same registrant. The Panel noting:

"The Laurent Perrier case suggests a pattern of conduct by persons associated with Belize Domain Services (the Administrative Contact in this case) to utilize domain names representing famous wines without any right to do so"

The respondent had not responded to any communication nor operated an active website. In transferring the website to the complainant, the Panel also pointed to the lack of a street address and the elusiveness of the administrative contact in concluding that the registrant had no rights or legitimate interests in respect of the domain name, and that the name had been registered in bad faith.

5. Parties Contentions

Complainant:

The disputed domain name is identical to the Complainant s marks. The Respondent has no legitimate rights or interest in the disputed domain name. There is ample evidence demonstrating the bad faith of the Respondent, acting through Mr. Colman.

The Complainant refers to the Panel s conclusion in <laurentperrier.com> that "Mr. Colman and Mr. Alan Jones (Fernhead Property Holdings and Belize Domain Services)" played an important role in co-ordinating a pattern of conduct of preventing trademark and service mark owners from reflecting their mark in a corresponding domain name. The Complainant relies on the cases noted earlier (where Belize Domain Services, Fernhead Property Holdings, Peter Colman and Alan Jones are noted jointly and individually) to demonstrate that the registration of <scottishprovident.com> was part of a similar course of conduct engaged in by the Respondents behind the veil of Belize Domain Services and the fictional "Scottish Provident Ministry".

Further to the domains already mentioned, there is ample evidence of a pattern of conduct of targeting multiple domain names in a diversity of business areas through registrations (all in late 1997) of other major well-known trademarks of commercial entities, namely: <rimmel.com>, <thameswater.com>, <eaglestar.com>, <thepu.com>, <britishair.com>, <jamesons.com>, and the prolific registration of football related domain names including <arsenalfc.com> and <glasgowrangars.com> (all of which, including the disputed domain name, have been renewed). Peter Colman admitted (in <laurentperrier.com>) to having registered those names above, and having been involved in taking advantage of the "first come first served" policy of domain registrars. As in the WIPO cases already listed, none of these names have active websites. In each case, it is difficult to conceive of any actual or contemplated use of the names that would not be illegitimate.

The Complainant relies on the Respondent s conduct in subsequent and earlier domain name litigation, transferring the domain names in issue to fictitious parties, or providing fanciful justification for registration. The Respondent s strategy of taking active steps to conceal the true identity of the registrant (e.g. Laurent Jacques Perrier, Mr. John Skipton in the USA, Jacob Creek, Fulham Fun Club, and the Clerical Medical Services Agency), is powerful evidence of bad faith dealing, as is the pattern of conduct of transferring domain names in the face of litigation.

"Scottish Provident Ministry" is an illusory institution, the use of which name demonstrates further strong evidence of an intention to deceive. Notably, it is a characteristic of previous disputes that the Respondents hide their true identity behind several different trading names, and use a post office box address instead of an actual address. The failure to provide correct contact information, and a phone and fax number is in violation of their registry agreement, and typical of other registrations where the respondents and their representatives have sought anonymity in their dealings.

The Respondent was clearly aware of the registration of the SCOTTISH PROVIDENT mark when registering the disputed domain name in 1997. The UK registrations date from the late 1980 s, and the Community Trade Mark application, which covers all 15 European Union Member States, was filed April 1, 1996. Its existence could have been ascertained from the OHIM website. The Community trademark was widely publicized in 1996 when the CTM came into operation, and the CTM website was an obvious and readily available place to check for the existence of potential prior trademarks.

Since the decision of the panel in WIPO Case No. D2000-1188, there has been no evidence of any use of the domain name, and the "Scottish Provident Ministry" has shown no sign of being an active business (This has been the status quo since the registration of the domain name in 1997). Whilst this lack of use may not in itself be sufficient to establish bad-faith under the policy, along with a lack of solid evidence for a reason for non-use, operating under a name which is not a business name, and a history of similar situations involving the same Respondent and equally fanciful registrations, such passive holding is sufficient to demonstrate bad faith conduct.

Whilst no direct offer of sale has occurred in this case, an e-mail was received by the Complainant from one, Alan Jones, noting that "serious offers" would be considered by his "client". It is evident that previous domains may have been acquired for the purposes of selling and this has been indicated by attempts to solicit consideration in excess of the respondents out-of-pocket costs, directly associated to the domain name, in <espitosanto.com>. Whilst the Complainant has not been approached by Belize Domain Services for sale of the disputed domain name, it is clear from the conduct of the Respondent in this case that this may have been in mind when the domain was registered (amongst many others) in the first instance.

The Scottish Provident Ministry is not a registered organization in Belize. It is in no way connected with the Complainant, and has no legitimate rights or interests in respect of the disputed domain name or any related trademarks. The fact that the Respondent is operating under a name which evidently is not a business name indicates a direct intention to deceive.

Since it is not possible to conceive of any actual or contemplated use of the domain name that would not be illegitimate, it is apparent that the Respondent's true motive is either speculatively to register the domain name with a view to selling it for a profit, or to prevent the Complainant from reflecting its trademark in a corresponding domain name.

Respondent:

The Respondent has made no submissions.

6. Discussion and Findings

Refiling of Complaint

It now appears generally accepted in WIPO decisions that the principles relating to permitting the refiling of complaints have been established by the decisions in WIPO Case Nos. D2000-0703 and D2000-1490. A helpful summary of relevant later decisions is to be found in *Koninklijke Philips Electronics N.V. v Relson Ltd*, WIPO case no. DWS2002-0001 at pp 5-6.

It further seems accepted that the presentation of fresh material evidence, not reasonably available at the time of filing the original Complaint, is justification for considering a fresh complaint between the same parties in respect of the same domain name. In the present case, the original Complaint failed because of lack of proof of bad faith registration and use. The present Panelist has to say that he would probably not have come to the same view about the absence of proof of bad faith as did the Panelist in WIPO Case No. D2000-1188. An inference to this effect is quite possible given the old established name of the Complainant, indicating a provident/assurance fund in a named country and the absence of any bona fide use of this name in a distant Central American country.

In the present case, the Complainant was invited by the Panelist in WIPO Case No. D2000-1188 to resubmit the Complaint if further evidence of bad faith were found. Whilst such an indication provides further justification to the Complainant in seeking to refile, it should always be emphasized that further evidence must be such as is not only relevant but also not reasonably available at the time of filing the original complaint. If such stringency is not observed, then complainants could be encouraged not to present their best case diligently and respondents could be forced to relitigate without proper justification.

The new evidence demonstrates a pattern of behavior of those connected with the Respondent that offers overwhelming proof of bad faith. Since all but one of the Complaints, brought successfully against the Respondent or its associates, were made after the first Complaint had been rejected, the Panel finds that the fresh evidence could not reasonably have been available to the Complainant at the time of filing its original Complaint WIPO Case No. D2000-1188. The Panel therefore proceeds to consider the Complaint on its merits.

Merits

Paragraph 15(a) of the Rules instructs the 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".

The burden for the Complainant, under paragraph 4(a) of the Policy, is to show:

- That the domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- That the Respondent has no legitimate rights or interests in respect of the domain name; and
- The domain name has been registered and is being used in bad faith.

The disputed domain name is identical to the Complainant's registered trademarks. The Panel considers the first criterion proved.

As to the second criterion, the Complainant gave the Respondent no legitimate rights or interest in respect of the domain name. That fact, on its own, can be sufficient to prove the second criterion. Paragraph 4(c) of the Policy sets out matters which a Respondent is entitled to raise which, if found by a Panel to be proved based on an evaluation of all evidence presented, should demonstrate a Respondent's rights or legitimate interest to a domain name. None of these have been demonstrated.

As contended by the Complainant, the previous decisions cited above demonstrate clearly a pattern of conduct by persons associated with Belize Domain Services (the Administrative Contact in this case) to utilise domain names representing famous marks without any right to do so. The patterns demonstrated give rise to an inference of bad faith at the time of registration.

The Complainant's mark is distinctive and relates to a financial institution well known in many countries. There is no evidence of bona fide use of the name. The lack of any development of a website since the earlier Complaint is further evidence of the Respondent's continuing bad faith.

The third criterion is therefore proved and the Complainant must succeed.

7. Decision

For the foregoing reasons, the Panel decides:

(a) that the domain name <scottishprovident.com> is identical to the trademark to which the Complainant has rights; and

(b) that the Respondent has no rights or legitimate interests in respect of the domain name; and

(c) that the domain name has been registered and is being used in bad faith.

Accordingly, pursuant to paragraph 4(i) of the Policy, the Panel requires that the registration of the domain name <scottishprovident.com> be transferred to the Complainant.

Hon. Sir Ian Barker QC
Sole Panelist

Dated: January 9, 2003