



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Sir Peter Scott v. Dr. Howard Fredrics

Case No. D2009-0276

1. The Parties

The Complainant is Sir Peter Scott, Vice Chancellor, Kingston University of the United Kingdom of Great Britain and Northern Ireland, represented by Charles Russell LLP, United Kingdom.

The Respondent is Dr. Howard Fredrics of the United States of America, represented by Ariane Joachimowicz, Avocat, Belgium.

2. The Domain Name and Registrar

The Disputed Domain Name <sirpeterscott.com> is registered with Spot Domain LLC dba Domainsite.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 2, 2009. On March 2, 2009, the Center transmitted by email to Spot Domain LLC dba Domainsite.com a request for registrar verification in connection with the Disputed Domain Name. On March 4, 2009, Spot Domain LLC dba Domainsite.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on March 6, 2009. In accordance with the Rules, paragraph 5(a), the due date for Response of March 26, 2009 was subsequently extended due to exceptional circumstances to

April 15, 2009. The Response was filed with the Center on April 15, 2009.

The Center appointed Alistair Payne as the sole panelist in this matter on April 22, 2009. 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 Complainant, Sir Peter Scott, is Vice Chancellor of Kingston University, Chairman of the Universities' Association for Lifelong Learning, and President of both the Academic Cooperation Association and the German Academic Exchange Service.

The Complainant has published a number of books in the field of education. The Complainant has also contributed to the works of other academics, made contributions to national newspapers, and given lectures and conferences in the United Kingdom.

The Respondent, Dr. Howard Fredrics, is a former employee of Kingston University. The Respondent operates a website which resolves from the Disputed Domain Name. The Respondent is involved in ongoing Employment Tribunal proceedings against Kingston University.

The Respondent registered the Disputed Domain Name on February 6, 1997, and has subsequently used it to air grievances against the Complainant and Kingston University

5. Parties' Contentions

A. Complainant

The Complainant contends that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant contends that he has built up substantial and extensive goodwill under the name "Sir Peter Scott", which constitutes a common law trade mark right entitled to protection under the UDRP.

The Complainant contends the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. The Complainant has granted the Respondent no license to use its name as part of a domain name.

The Complainant contends that the Respondent has misrepresented to a substantial number of visitors to the website that he is the Complainant. The Complainant points to the fact that the title to the website states "Welcome to the web-site of Sir Peter Scott Vice-Chancellor of Kingston University" and is accompanied by a photograph of the Complainant on the opening page in support of this contention.

The Complainant contends that the Respondent is not making a legitimate non-commercial or fair use of the domain name, but rather that the Respondent has used the Disputed Domain Name with the express purpose of targeting and attacking the Complainant and Kingston University.

Furthermore, the Complainant contends that the website contains insulting and defamatory material.

The Complainant submits that there is no evidence of the Respondent's use of or demonstrable preparation to use the Disputed Domain Name in connection with a *bona fide* offering of goods or services.

The Complainant contends that the Disputed Domain Name was registered and is being used in bad faith. The Complainant supports this contention by reference to content published on the website which includes a photograph of the Complainant which the Respondent does not own and has no permission to use.

The Complainant contends that the Respondent had no other reason for registering the Disputed Domain Name other than for the purposes of tarnishing the Complainant's mark and reputation.

Finally, the Complainant contends that the use of the Disputed Domain Name as a link to defamatory advertisements about Kingston University on Google misleads viewers and is further evidence that the Disputed Domain Name is being used in bad faith.

The Complainant requests in accordance with paragraph 4(i) of the Policy, for the reasons summarized above and more particularly set out in the Complaint, that the Disputed Domain Name be transferred to the Complainant.

B. Respondent

The Respondent denies the allegations put forward by the Complainant.

The Respondent contends that neither the Complainant nor Kingston University own or use the name "Sir Peter Scott" as a trade or service mark. The Respondent supports this contention by referring to the fact that another individual, now deceased, by the name of Sir Peter Scott is more widely recognized for his contributions to society. The Respondent also notes that there are a number of other well-known providers of educational services who go by the name of "Peter Scott".

The Respondent contends that as the first person to register the Disputed Domain Name he is the legitimate owner of the Domain Name.

The Respondent contends that the Complainant has failed to establish a common law trade mark or service mark in his name. The Respondent supports this contention by reference to the fact that there is no evidence that the Complainant used the name "Sir Peter Scott" for commercial purposes or that this name is identified as a source of goods or services.

The Respondent contends the Complainant does not have sufficient rights to ground an action for passing off as the name "Sir Peter Scott" is not the Complainant's real name. The Respondent contends that he has rights and legitimate interests in respect of the Disputed Domain Name which is used as a noncommercial, educational and artistic website containing social commentary on the specific subjects of the Complainant and Kingston University. The Respondent points to the fact he is regularly engaged in the noncommercial professional performance, production and composition of musical works, the subject matter of several of which is Peter Scott.

Respondent contends that the information contained on the web site is true and is in the

genuine public interest. The Respondent supports this contention by reference to the fact the site has received over 300,000 hits since its inception.

The Respondent denies that the Disputed Domain Name is being used in bad faith.

The Respondent contends that he is making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain, to misleadingly divert consumers or to tarnish the alleged mark at issue. In support of this contention the Respondent makes reference to the fact that the web site contains a disclaimer indicating that the web site implies no association with the Complainant.

Respondent contends that the web site's "public interest mission" is consistent with the Respondent's fundamental human right of freedom of expression which supersedes any alleged tarnishment of the Complainant's alleged mark.

6. Admissibility of the Claim

The Panel is willing to accept that the Complaint is brought by Sir Peter Scott personally under his professional address at Kingston University.

7. Discussion and Findings

A. UDRP Elements

If the Complainant is to succeed, he must prove each of the three elements referred to in paragraph 4(a) of the Policy, namely that;

- (i) the Disputed Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

The Panel will proceed to establish whether the Complainant has discharged the burden of proof in respect of the three elements referred to in paragraph 4(a) of the Policy.

B. Identical or Confusingly Similar

If the Complainant is to succeed, he must prove either registered or unregistered trade mark rights in the name "Sir Peter Scott" in order to satisfy paragraph 4(a)(i) of the Policy.

While the Complainant is called Sir Peter Scott, the Panel notes that the Complainant has provided no evidence that he owns a registered trade mark for his name.

A number of previous WIPO UDRP panelists have held that in order for an individual to rely on unregistered trade mark rights he or she must be able to demonstrate use of the mark in trade or commerce. Merely having a famous name (such as a businessman, or religious leader) is not necessarily sufficient to demonstrate unregistered trademark rights.

In *Chimnoy Kumar Ghose v. ICD Soft.com and Maria Sliwa*, WIPO Case No. D2003-0248, and *Julia Fiona Roberts v. Russell Boyd*, WIPO Case No. D2000-0210, it was held that to the Complainant must demonstrate that their name has been used in commerce and has acquired a sufficient secondary association in order to establish that a common law trade mark exists.

In *Ahmanson Land Company v. Save Open Space and Electronic Imaging Systems*, WIPO Case No. D2000-0858, the Panel held that:

“A mark comprising a personal name has acquired secondary meaning if a substantial segment of the public understand the designation, when used in connection with services or business, not as a personal name, but as referring to a particular source or organization.”

In circumstances concerning a published writer, the Panel in *Jeanette Winterson v. Mark Hogarth*, WIPO Case No. D2000-0235 found that common law trademark rights can exist in an author’s name. However, in *Jeanette Winterson* the Complainant was a well-known author, who sold several hundred thousand copies of her books worldwide every year.

The Panel accepts that Sir Peter Scott has established a reputation in his academic field as the author of numerous works. However, there is no other evidence before the Panel of use in commerce before the Panel which points to the development of the requisite goodwill. On the present record, it appears to the Panel that the name “Sir Peter Scott” has not acquired sufficient goodwill or secondary association with the Complainant sufficient to establish a common law trademark.

There is no evidence that the Complainant has commercially exploited his name in trade, for example as an author or broadcaster to a sufficient extent for it to constitute a “brand”. It does not appear that the mark “Sir Peter Scott” would be understood by a substantial segment of the public, when used in connection with services or business, as necessarily referring to the Complainant. This is particularly the case given that a well known academic and broadcaster was also called Sir Peter Scott.

The Panel notes that this approach is consistent with the position stated in the Final Report on the Second WIPO Domain Name Process that the Policy should be limited to personal names that have been commercially exploited.

Even though this case would seem to raise an important issue concerning legitimate criticism and free speech, the Policy simply does not extend to cases in which the Complainant has not established the requisite trade mark rights. The Panel notes that court proceedings are pending concerning the web site at the Disputed Domain Name and that under the circumstances this would appear to be the appropriate forum for the resolution of the matters in issue between the parties.

As the Complainant has failed to adduce sufficient evidence to establish that he has common law trade mark rights in his name, the Complainant has failed to satisfy the requirements of paragraph 4(a)(i) of the Policy.

C. Rights or Legitimate Interests

The Panel does not consider that a decision based on paragraph 4(a)(ii) of the Policy is required as the Complainant fails under paragraph 4(a)(i) of the Policy for reasons provided above.

D. Registered and Used in Bad Faith

The Panel does not consider that a decision based on paragraph 4(a)(iii) of the Policy is required as the Complainant fails under paragraph 4(a)(i) of the Policy for reasons provided above.

8. Decision

For all the foregoing reasons, the Complaint is denied.

Alistair Payne
Sole Panelist

Dated: May 1, 2009