CPR Institute for Dispute Resolution

COMPLAINANT:
SAVANNAH COLLEGE OF ART
AND DESIGN,
516 Abercorn St., Savannah, Georgia 31402
bmurphy@scad.edu
(912) 525-5200  (912) 525-6262

File Number: CPR 0206
Date of Commencement: 2/19/02
Domain Name(s): “scad.info”
Registrar: Register.com
Arbitrator: John J. Upchurch

vs.

RESPONDENT:
PHILIPPE HOUEIX,
220 Forest Avenue, Cincinnati, Ohio 45215
Phoueix@cinci.rr.com
(513) 761-2347  (513) 761-6547

Before John J. Upchurch, Arbitrator

PROCEDURAL HISTORY

The Complaint was filed with CPR on February 19, 2002 and, after review for administrative compliance, served on the Respondent. The Respondent filed a timely Response on March 8, 2002. I was appointed Arbitrator pursuant to the Uniform Domain Name Dispute Resolution Policy (“UDRP”) and Rules promulgated by the Internet Corporation for Domain Names and Numbers (ICANN). Upon the written submitted record including the Complaint, Response, and Supplemental Responses from each party, I find as follows:

FINDINGS

Respondent’s registered domain name, “scad.info”, was registered with Register.com on October 29, 2001. In registering the name, Respondent agreed to submit to this forum to resolve any dispute concerning the domain name, pursuant to the UDRP.

The UDRP provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

i. Respondent’s domain name is identical or confusingly similar to a trademark or service mark in which complainant has rights; and
ii. Respondent has no rights or legitimate interests in respect of the domain name; and

iii. Respondent’s domain name has been registered and is being used in bad faith.

IDENTITY/CONFUSING SIMILARITY: Complainant alleges that “scad.info” is identical or confusingly similar to Complainant’s mark “scad”, which applies to Complainant’s school, The Savannah College of Art and Design.

The SCAD mark is identical to the domain name registered by the Respondent, “scad.info”. This is neither a case in which the domain name is confusingly similar to the Complainant’s mark, nor a case in which the domain name at issue is an international misspelling of the Complainant’s mark. Instead, the Respondent makes direct reference to the Complainant’s mark by registering a domain name that is identical to the SCAD mark, which is the acronym for Savannah College of Art and Design.

I therefore conclude that the registered domain name is identical or confusingly similar to Complainant’s protected mark.

RIGHTS AND LEGITIMATE INTERESTS: Complainant alleges that Respondent has no rights or legitimate interests with respect to the domain name at issue. In support for this allegation, Complainant notes that the Respondent is in no way affiliated with the Complainant, is in no way authorized to act on its behalf, and has no legitimate business interests in the domain name. Complainant further alleges the Respondent is a former employee of Savannah College of Art and Design and is now seeking to divert Internet users and potential students seeking information on the Complainant to a site that is completely unrelated to Savannah College of Art and Design. Respondent, on the other hand asserts that:

- The acronym SCAD in the United States has been registered as a trademark by different companies in the past years.

- The trademark “SCAD” that the Savannah College of Art and Design has registered is still pending. The registration was initiated after this dispute arose.

- The trademark “SCAD” is already registered by another company.
UDRP Paragraph 4(c) provides that Respondent’s rights or legitimate interests in a domain name may be demonstrated, without limitation, by showing that (a) before notice to Respondent of the dispute, Respondent has used, or made demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or (b) Respondent has been commonly known by the domain name; or (c) Respondent is making legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Discussion

After a dispute in connection with Respondent’s employment, Respondent turned to the internet to voice his complaints, in hopes that others would exercise caution in dealing with Complainant. Accordingly, the question is whether Respondent is making legitimate noncommercial or fair use of the domain name.

Complainant is not entitled to curb or diminish Respondent’s legitimate, noncommercial use of the address, because to do so would violate Respondent’s right to free speech. In Bally Total Fitness Holding Corporation v. Faber, 29 F.Supp. 2d 1161 (C.D.Cal. 1998), a critic of Plaintiff’s business was using a website that incorporated Plaintiff’s trademarked name in its address, for the express purpose of criticizing the Plaintiff. The Court noted:

“The mere use of another’s name on the internet, however, not per se commercial use. See 3 McCarthy, §24.97.2, at 24-172.
Here, Faber used Bally’s marks in connection with a site devoted to consumer product review of Bally’s services. In congressional hearings, Senator Orrin Hatch stated that the dilution statute “will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not a part of commercial transactions.” 141 Cong.Rec. S19306-10 (Daily ed. December 29, 1995). Therefore, this exception encompasses both parodies and consumer product reviews. See Panavision Int’l. L.P. v. Toeppen, 945 F.Supp. 1296, 1303 (C.D.Cal. 1996)”

In Bihari v. Gross, 119 F.Supp. 2d 309, the Court held that a metatag redirecting parties from a disputed web site to other websites providing critical commentary on an interior design company could not be enjoined, because to do so would constitute a prior restraint of speech. It was expressly noted that non-commercial criticism of a company or product is not actionable under the various trade infringement statutes, including the Anticybersquatting Consumer Protection Act. Quoting professor McCarthy, the Court
stated: “Whether through the use of statutory interpretation or concern for free speech, traditional protections for commentators and critics on business and commercial affairs must not be jettisoned. It is important to create critical breathing space for legitimate comment and criticism about products and services.” See 4 McCarthy, §27:91 at 27-140, at page 323.

In Northland Insurance Companies v. Blaylock, 115 F.Supp.2d 1108 (D.Minn. 2000), the court held that a web site containing critical commentary about an insurance company could not be silenced by injunction, if it was purely non-commercial.

Complainant might have a basis for its position if Respondent were recruiting students at the site, or otherwise using it for a commercial benefit that would be in direct competition with Complainant. This has not been asserted, and is not the case.

ICANN has been faced with essentially identical complaints in the case of Daniel J. Quirk v. Michael Mancini, Claim Number FA0094964 (NAF 2000). In that matter the Respondent was utilizing the name “quirkchevrolet.com” over the objection of a business proprietor using an unregistered trade name “Quirk Chevrolet”. As in this case, the address was not being used competitively to sell cars, but provided consumer information. The assigned panelist correctly determined that this was a fair noncommercial use of the domain name, and refused to order transfer of the name to Complainant.

There is no basis for distinguishing the Quirk case from this matter. To maintain consistent positions Respondent should be permitted to retain the domain address and continue his exercise of free speech.

I therefore conclude that Respondent does have rights or legitimate interests with respect to the domain name at issue.

**CONCLUSION**

In light of my findings above that Respondent does have rights or legitimate interests with respect to the domain name at issue; I find in favor of the Respondent.

**REMEDY**

Complainant’s request to transfer the domain name “scad.info” is hereby denied.

__________________________________________________________
John J. Upchurch                        Date