



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Full Sail, Inc. v. Ryan Spevack

Case No. D2003-0502

1. The Parties

The Complainant is Full Sail, Inc., Winter Park, Florida, United States of America, represented by Foley & Lardner, United States of America.

The Respondent is Ryan Spevack, represented by Law Offices of Stephen H. Sturgeon & Associates, United States of America.

2. The Domain Name and Registrar

The disputed domain name <fullsailsucks.com> ("the Domain Name") is registered with Go Daddy Software.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 25, 2003. On June 25, 2003, the Center transmitted by email to Go Daddy Software a request for registrar verification in connection with the domain name at issue. On June 26, 2003, Go Daddy Software transmitted by email to the Center its verification response. 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 July 9, 2003. The Response was filed with the Center July 30, 2003.

The Center appointed Mark Partridge, Frederick M. Abbott and G. Gervaise Davis III as Panelists in this matter on August 27, 2003. The Panel finds that it was properly constituted. Each member of 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.

In addition, late submissions were received from both parties and considered by the Panel.

4. Factual Background

Complainant, Full Sail, Inc. is an accredited education institution providing instruction in the fields of film, entertainment and recording. It has been in business since 1979 and has operated a website at "www.fullsail.com" for a number of years.

Complainant owns Federal trademark registrations for the mark FULL SAIL, as well as several other trademark registrations for marks that included the words "Full Sail" with other matter. It appears that these registrations were originally obtained in the name of Complainant's predecessor, Full Sail Recorders, Inc., and that the name was changed to Full Sail, Inc. in 2000.

Respondent registered the Domain Name on May 27, 2003. It appears that the initial registrant was Zero One Entertainment. The registrant subsequently was listed as "Shitty Schools Inc.". In each case the Administrative Contact is listed as Ryan Spevack, the named respondent in this action ("Respondent"). The Domain Name is used for a website that provides reviews and opinions about Complainant's educational services.

The website included the following statement of purpose:

"Welcome to Full Sail Sucks.com. This website was started as an informational resource for students interested in attending Full Sail in Winter Park, Florida. This website hopes to present students with objective and unbiased reviews of the school in a concise manner so future students can make an educated decision before deciding to attend the school."

The website also included the following "special offer":

"\$100 to anyone who takes a self picture of themselves in front of Full Sail with a sign that reads fullsailsucks.com! It will be posted on this site! Try and post flyers around campus to [sic]"

While many of the posted comments provide negative commentary about Complainant, some of the opinions posted are positive. Examples include: "I think Full Sail was the right choice for me and found it to be a very positive experience"; 'In my opinion Full Sail is a great school'; 'I think Full Sail has been worth the money'".

After this proceeding was filed, Complainant filed a civil action in Federal Court in Orlando, Florida, seeking damages and injunctive relief for tortious interference with plaintiff's advantageous business relationships and dilution by tarnishment of its trademarks.

5. Parties' Contentions

A. Complainant

Complainant contends that the Domain Name is virtually identical or confusingly similar to Complainant's FULL SAIL mark, except for the addition of "sucks".

Complainant contends the Respondent lacks any legitimate interest in the Domain Name and is using the Domain Name in bad faith because the Domain Name is used for the purpose of disrupting Complainant's business and diverting business to other educational institutions.

Complainant contends that the Domain Name use is not justified by free speech considerations because the website fails to provide objective comment and is instead used to divert, disparage or tarnish Full Sail's reputation.

B. Respondent

Respondent contends that Complainant has failed to prove trademark rights in the mark FULL SAIL because it does not appear to be the registrant of the trademark registrations relied upon. Respondent also asserts that the Domain Name and alleged trademark are not confusingly similar because "sucks" is recognized as a distinguishing, pejorative term that would not be confused with the trademark owner.

Respondent contends that Complainant has failed to prove that Respondent lacks a legitimate interest in the use of the Domain Name for non-commercial commentary about Complainant.

Finally, Respondent contends that Complainant has failed to prove that the Domain Name was registered and used in bad faith. More specifically, Respondent denies any connection with any competitor of Complainant in regard to the operation of the website.

6. Discussion and Findings

As mentioned above, the parties here are also engaged in federal court litigation involving claims of tortious interference with business relationships and trademark dilution by tarnishment. However, those claims are beyond the scope of this proceeding. The only question before the Panel is whether the registration and use of the Domain Name <fullsailsucks.com> is a violation of the Policy. We reach a determination of that narrow issue based on the record before us. In this case, we have received and considered supplemental filings by both parties.

To establish a violation of the Policy, the Complainant has the burden of establishing each of the following three elements: (1) the Domain Name is identical to or confusingly similar to a trademark in which the Complainant has rights; (2) the Registrant lacks any right or legitimate interest in the Domain Name; and (3) the Domain Name was registered and used in bad faith.

A. Confusing Similarity

Since the year 2000, there have been approximately 30 cases decided under the Policy involving "-sucks.com" websites. Given the number of cases involving analogous disputes, it seems useful to review the conclusions reached by prior Panels, even though those decisions do not formally bind this Panel.

It seems that five different rationales have been expressed for finding that the domain name with the "sucks" suffix were confusingly similar to the complainant's mark. The first of these approaches is simply to find that a domain name is confusingly similar to a trademark "when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name". *Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, [WIPO Case No. D2000-0662](#); see also *Kendall/Hunt Publishing Co. v. headhunterbob*, NAF Case No. FA0111000102247. The Wal-Mart panel stated that its decision was based on its understanding that "the phrase 'identical or confusingly similar' [is] greater than the sum of its parts". The panel also noted that its approach does not look at whether "the domain name causes confusion as to source ... but instead whether the mark and domain name, when directly compared, have confusing similarity". While the panel noted that a "-sucks.com" site could be used as for legitimate protest, it found that such sites would be adequately protected by the legitimate interest and bad faith prongs of the Policy.

A second approach that is used by the panels is to say that the "-sucks.com" domain name will lead to a diversion of customers because it will be pulled up by search engine queries for the trademark. As one panel stated, "Respondent's domain names are sufficiently similar to Complainant's mark ... that Internet search engine results will list Respondent's domain names and websites when searching Complainant's mark". *Wal-Mart Stores, Inc. v. Walsucks and Walmart Puerto Rico*, [WIPO Case No. D2000-0477](#). While the panel noted that Internet users are unlikely to believe that the trademark holder actually sponsors the sites, the panel found it likely that potential customers would visit the sites "if only to satisfy their curiosity". This would allow the Respondent to accomplish "his objective of diverting potential customers of Complainant to his websites by the use of domain names that are similar to Complainant's trademark".

The third commonly cited rationale for a finding of confusing similarity is that the "-sucks.com" sites may be

mistaken for the trademark holder's official complaint site. In support of this rationale, the panels generally pose the following question: "Given the apparent mushrooming of complaint sites identified by reference to the target's name, can it be said that the registration would be recognised as an address plainly dissociated from the Complainant's?" *Direct Line Group Ltd, Direct Line Insurance plc, Direct Line Financial Services Ltd, Direct Line Life Insurance Company Ltd, Direct Line Unit Trusts Ltd, Direct Line Group Services Ltd, v. Purge I.T., Purge I.T. Ltd*, [WIPO Case No. D2000-0583](#). The panels have noted that the most striking element of these domain names is the Complainant's mark, which could lead people to believe that the Complainant sponsors the site.

A fourth rationale used by the panels is that non-English speakers may not be familiar with the pejorative nature of the word "sucks." As this rationale goes, those Internet users that are not familiar with the slang word "sucks" may not be able "to give it any very definite meaning and will be confused about the potential association with the Complainants". *ADT Services AG v. ADTSucks.com*, [WIPO Case No. D2001-0213](#). Thus, such users may "believe that any name using the world-famous mark is associated with the Complainant".

Finally, some panels (although not very many) have noted that in certain situations the word "sucks" may not be used in the pejorative sense. As one panel noted, the word "sucks" can be used "purely descriptively, as in the advertising slogan 'Nothing sucks like Electrolux.'" *Vivendi Universal v. Jay David Sallen and GO247.com, Inc.*, [WIPO Case No. D2001-1121](#). For example, the domain name <electroluxsucks.com> "would be unlikely to be taken as unaffiliated with the company Electrolux". The panel used this example to point out merely that appending the word "sucks" to a mark does not necessarily mean that a trademark holder has nothing to do with the website.

In a minority of decisions, those that find that the domain name should not be transferred, most panels rely on the lack of confusing similarity between the trademark and the domain name in finding that there need not be a transfer. Generally, the panel will simply note that both "common sense and a reading of the plain language of the Policy support the view that a domain name combining the trademark with the word "sucks" or other language clearly indicating that the domain name is not affiliated with the trademark owner cannot be considered confusingly similar to the trademark". *Lockheed Martin Corporation v. Dan Parisi*, [WIPO Case No. D2000-1015](#). These panels see it as basically a *per se* rule that "-sucks.com" websites cannot be confusingly similar to a trademark.

In addition, one panel has noted that the rationale underlying the finding of confusing similarity in many of the cases where the domain name is transferred, namely that non-English speakers do not understand the pejorative nature of the word "sucks", should not necessarily apply in all cases. In *Asda Group Ltd. v. Paul Kilgour*, [WIPO Case No. D2002-0857](#), the panel noted that the Complainant's website was entirely in English, and was "devoted essentially to a UK orientated business". As such, the panel did not put much stock in the possibility of confusion about the meaning of "sucks", since "Internet users unfamiliar with the English language, yet aware of the existence of Asda are unlikely to exist in significant numbers". Thus, the panel felt that for businesses that do not target foreign customers, the non-English speaker rationale is not very persuasive.

In the case before us, it appears that the Complainant has rights in the FULL SAIL trademark. The Domain Name at issue is clearly used in a pejorative sense and is directed to a U.S. audience likely to recognize the pejorative connotation. Nevertheless, Complainant has placed in the record evidence to suggest that the Domain Name may create some confusion due to prominent placement of the Domain Name when using search engines to locate information about Complainant. Because of our findings on the other necessary elements, it is not necessary for us to reach a conclusion as to whether or not this is sufficient to satisfy the first element of Complainant's claim.

B. Legitimate Interests and Bad Faith

While the Policy separates out the issues of legitimate interest and bad faith, and the panels often consider the issues separately, the rationales underlying the decisions on the two prongs are frequently quite similar. Thus, both issues will be considered together here to avoid unnecessary duplication. That being said, there are several common rationales used to find a lack of legitimate interest and bad faith in "-sucks.com" cases, the majority of which deal with the use of the site for the economic benefit of the Respondent.

The most commonly cited rationale is that the Respondent has registered the site primarily for the purpose of selling it to the Complainant (or a third party) at a substantial profit. For example, in *Direct Line Group v. Purge I.T.*, [WIPO Case No. D2000-0583](#), the Respondent claimed to have registered the domain name <directlinesucks.com> so as to protect Direct Line from having the site fall into the hands of critics of the company who might set up a protest site. The Respondent then offered to sell the site to Direct Line for the sum of £5,000.

The panel did not find the claimed altruistic intentions to be credible, and found that the Respondent registered the name primarily for the purpose of selling it to Complainant for an amount in excess of the costs of registering the name, which is one way of showing bad faith under Paragraph 4(b)(i) of the Rules.

In cases where there is no explicit evidence that a domain name is officially for sale, some panels have found that the passive holding of a domain name may give rise to an inference that the Respondent registered the site for the purpose of sale. In *Vivendi Universal v. Jay David Sallen*, [WIPO Case No. D2001-1121](#), the panel stated that "mere passive holding 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." Thus, the fact that the owner of <vivendisucks.com> responded to Complainant's cease and desist letters by saying that he did not have time to deal with their request at the moment because he was too busy trying "to make a living", was taken as evidence that the Respondent was willing to sell the domain name.

In addition to the fact that the Respondent may be either actively or passively offering the domain name for sale, many panels point to the fact that a Respondent has posted embarrassing or offensive material on the site in order to force the Complainant to make the purchase, as evidence of bad faith. For example, in *Stop & Shop Supermarket Co. v. Ian Anderson*, NAF Case No. FA0211000133637, the Respondent, a former employee of Stop & Shop, posted confidential information on his site, "www.stopandshopsucks.com", which advised the public on the best ways to steal from the Complainant's stores. The website also made "false and defamatory statements about the employees of Complainant". The panel found bad faith from the fact that the Respondent designed the website "to be as offensive as possible in an attempt to coerce Complainant into purchasing the domain name".

Another rationale for a finding of bad faith or no legitimate interest is that the Respondent uses the "-sucks.com" site in order to direct traffic to other commercial sites. For example, in *ADT Services AG v. ADTSucks.com*, [WIPO Case No. D2001-0213](#), the Respondent used the "www.adtsucks.com" website, along with several other similar sites, to divert traffic to his own "www.erealestate.com" site, which provided links to several other commercial and pornographic websites. This practice falls within the definition of bad faith in Paragraph 4(b)(iv) of the Rules, and as the panel noted, the mere "fact that Internet users are diverted to the Respondent's sites is evidence of bad faith".

Some panels have found bad faith when the "-sucks.com" domain name was registered by a competitor of the Complainant in order to draw away business. In *BRIO Corp. v. Spruce Caboose*, NAF Case No. FA0205000114419, the Respondent registered <brio-sucks.com> and several other similar domain names, and used them to link to another of Respondent's sites, which was then linked to Respondent's "www.sprucecaboose.com" website, which sold products that directly competed with the complainant. The panel found that this behavior constituted "an opportunistic attempt to trade on the goodwill of the BRIO mark", and therefore was evidence of bad faith registration and use.

A final rationale for finding bad faith is that the Respondent registered the domain name in response to some action taken by the Complainant. In *Diageo v. John Zuccarini*, [WIPO Case No. D2000-0996](#), the Respondent registered several variations of the domain name <guinness-sucks.com> after the Complainant initiated an UDRP proceeding to have the Respondent's domain name <guinness.com> transferred. The panel found that Respondent had no legitimate interest in the domain names and had registered them in bad faith because the domain names were registered "with the intention of harassing the Complainant for its attempts to enforce its trademark rights and to tarnish the Guinness trademark."

In contrast to those cases finding bad faith are decisions finding that the Respondent has a legitimate interest in the Domain Name. In *Bloomberg L.P. v. Secaucus Group*, NAF Case No. FA0104000097077, the panel found that Respondent's website, "www.michaelbloombergsucks.com", was confusingly similar to the Complainant's trademark. However, the panel noted that the Respondent's website directed users to the site "www.sucks.com", which was a legitimate protest site that provided a forum for criticism of a number of U.S. companies. Thus, the panel found that when the Respondent's site is a legitimate criticism site, "the rights of the registrant have been uniformly upheld as a reasonable exercise of free speech rights, as well as a fair use of the person's or company's name".

Federal Court decisions involving similar domain names are also instructive. Recently, In *Taubman v. Webfeats*, 319 F.3d 770 (6th Cir. 2003), the Court held that the inclusion of the suffix "sucks.com" for a protest site was a protected speech, even if there was economic damage, stating:

"We find that Mishkoff's use of Taubman's mark in the domain name <taubmansucks.com> is purely an exhibition of Free Speech, and the Lanham Act is not invoked. And although economic damage might be an intended effect of Mishkoff's expression, the First Amendment protects critical commentary when there is no confusion as to source, even when it involves the criticism of a business. Such use is not subject to scrutiny under the Lanham Act."

"Hence, as per the language of the Lanham Act, any expression embodying the use of a mark not 'in connection with the sale . . . or advertising of any goods or services,' and not likely to cause confusion, is outside the jurisdiction of the Lanham Act and necessarily protected by the First Amendment."

We conclude, based on the evidence before us, that the Complainant has failed to meet its burden of proving bad faith registration and use. The website appears to be a legitimate protest site, used to inform current and potential students about Complainant's school. The website primarily contains negative and positive reviews and opinions about the school, ostensibly from current or former students. The site does not appear to be commercial in nature since it does not offer or propose the sale of any goods or services to visitors of the site. Although Complainant alleges that Respondent is using the website for the express purpose of diverting prospective and current students to a competing enterprise for commercial gain, there is insufficient evidence on the record before the Panel to support such a conclusion.

There is no indication here that the Domain Name was registered and used with the intent to sell the Domain Name for profit. Similarly, there is no indication that the Registrant engages in a pattern of unfair conduct to prevent others registering domain names that correspond to their trademarks.

Complainant argues that the site is commercial in effect because it discourages persons from using Complainant's services. That, however, is not sufficient to constitute bad faith use for the reasons noted in the *Taubman* decision. Such criticism is allowed under U.S. law and therefore is not a basis alone for finding bad faith use.

Complainant contends that the Domain Name should be considered bad faith use because it seems to be connected with a competitive school. While a competitor's use of a Domain Name for a site to disparage a competitor might be viewed as bad faith commercial use, Complainant has failed to prove that the Domain Name is registered and used by a competitor to disrupt Complainant's business. Although Respondent seems evasive on this point and has not fully explained his intent in operating the site, there is insufficient evidence to find for Complainant on this point.

Finally, the fact that Respondent has succeeded in obtaining a prominent position in search engine results does not provide an independent basis for a finding of bad faith.

In summary, the evidence indicates that the Domain Name is used for a non-commercial commentary about Complainant's business, and the allegations of bad faith are not supported by sufficient evidence to support a finding in Complainant's favor on bad faith. In reaching, this conclusion we again note that our inquiry is limited in scope and is based on a limited record.

7. Decision

For all the foregoing reasons, the Complaint is denied.

Mark Partridge
Presiding Panelist

Frederick M. Abbott
Panelist

G. Gervaise Davis III
Panelist

Dated: October 3, 2003