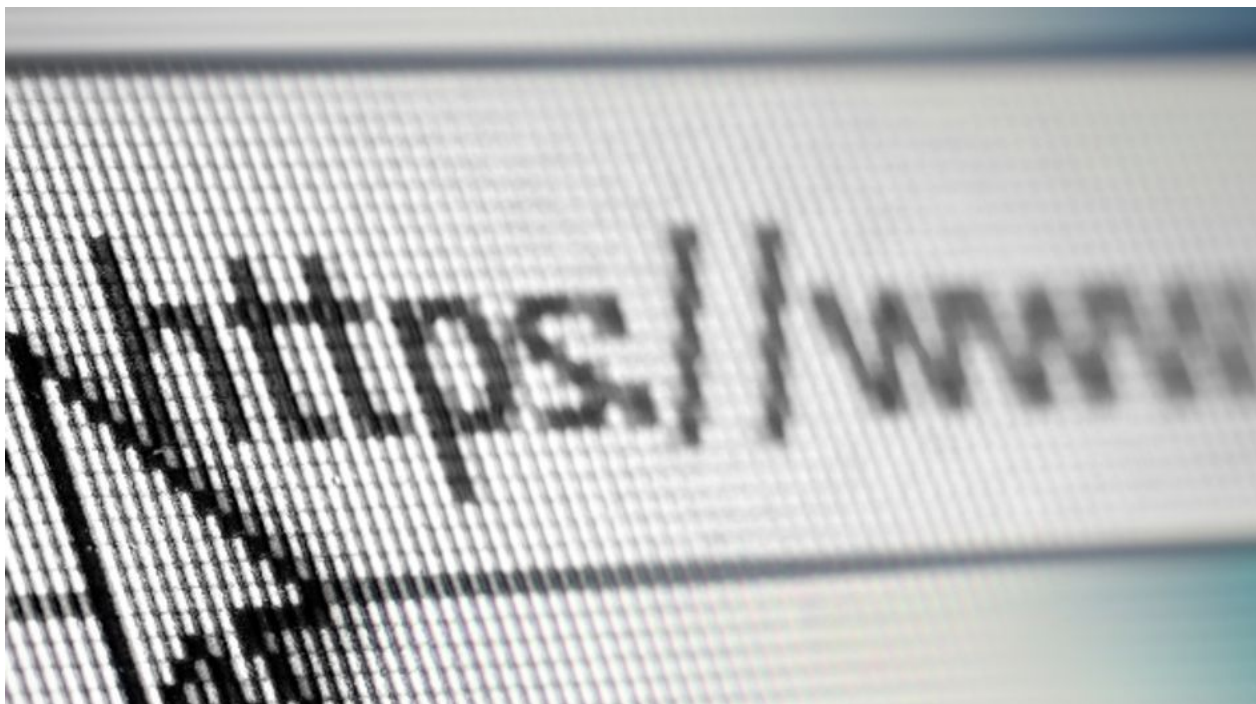


UDRP complainant hampered by lack of rights

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INTERNATIONAL

Legal updates: case law analysis and intelligence

- The Estate of Sheldon Solow sought the transfer of four domain names containing the terms ‘Sheldon Solow’ or ‘Solow Foundation’ under the UDRP
- The complainant claimed that, although the Solow Foundation had no current trademark registrations, the Sheldon Solow name had acquired sufficient secondary association with its activities
- The panel found that the complainant had failed to prove that Mr Solow’s name, or the name of the Solow Foundation, could be considered as distinctive marks

In a recent [decision](#) under the [Uniform Domain Name Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of four domain names, finding that the complainant had failed to prove that the domain names were identical, or confusingly similar, to a trademark or service mark in which it had rights.

Background

The complainant was the Estate of Sheldon Solow, an American real estate developer and art collector. The respondent was an individual activist and community volunteer.

The disputed domain names - ‘sheldonsolow.com’, ‘sheldonsolow.org’, ‘solowfoundation.com’ and ‘solowfoundation.org’ - were registered by the respondent in December 2016. They all resolved to the same parody website containing information about a non-profit art museum in New York City operated by the Solow Foundation, highlighting that it purportedly created tax benefits for the Solow family, but yet remained closed to the public.

To be successful in a complaint under the UDRP, a complainant must satisfy the following three requirements under Paragraph 4(a):

1. the domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
2. the respondent has no rights or legitimate interests in respect of the domain name; and
3. the domain name has been registered and is being used in bad faith.

Decision

First limb

The complainant claimed that, although the Solow Foundation had no current trademark registrations, the Sheldon Solow name was a reputed name under which the foundation conducted its non-profit activities; therefore, due to its distinctiveness, the name had acquired sufficient secondary association with the complainant's activities. The complainant underlined that the foundation intended to register its name as a trademark in Class 41 for museum services. Finally, the complainant added that its popularity could be measured by the fact that there were 171,000 search results obtained by typing the term 'Sheldon Solow' into Google's search engine.

The respondent argued that the complainant had failed to provide any evidence in relation to the distinctiveness of the Solow name and its association with the complainant's goods or services. In addition, the respondent stressed that no trademark application mentioned by the complainant was present in any register, and the name Solow did not appear in the databases containing trademarks already registered, nor those submitted for registration. The respondent underlined that the mere fact that Mr Solow was well known was not sufficient to prove that the complainant had rights to the name under the rules of the UDRP. The respondent further argued that, even if the complainant at one point had acquired common law rights in the Solow name, the complainant had subsequently changed the name to Soloviev and therefore waived its potential rights. Furthermore, the respondent asserted that, even if trademark rights in the Solow name existed, the ownership of such rights would be uncertain given that Mr Solow's activities appear to have been conducted by various business entities and none of these entities were complainants in the present proceedings.

The panel agreed with the respondent and found that the complainant had effectively failed to provide evidence that Mr Solow's name, or the name of the Solow Foundation, could be considered as distinctive marks which consumers would associate with goods or services offered by Mr Solow or the Solow Foundation so as to give rise to common law trademark rights in either name. The ruling was further fortified by evidence that the foundation had changed its name from 'The Solow Art & Architecture Foundation' to 'The Soloviev Foundation'.

Second and third limbs

In light of its findings under the first limb, the panel did not need to comment on the eventual existence of the respondent's rights or legitimate interests or bad faith. However, the panel decided to address these points anyway in order to note its disagreement with the respondent on whether the domain names would qualify under a parody exception had the complainant established any relevant trademark rights.

Under the second and third limbs of the UDRP, the complainant stated that the respondent had not received approval to use Mr Solow's name and the name of his foundation. The complainant also stressed that the respondent was not known by these names. Furthermore, the complainant argued that the registration of the domain names prevented the foundation from establishing an online presence. As such, in the complainant's opinion, the respondent had registered the domain names in order to disrupt the business of complainant and such registration would lead to commercial harm to the complainant.

The respondent rebutted these arguments by stating that the sole purpose of the website at the domain names was to criticise. Furthermore, the respondent argued that he had never in any way profited commercially from his registration and use of the domain names. The respondent also pointed out that the website clearly disclosed the lack of affiliation with the complainant, as it contained a statement that the website was created by "[a]n art enthusiast who would like to visit the collection, but has not received any reply to inquiries by phone, in person and email".

The panel disagreed with the respondent and found that the domain names effectively impersonated Mr Solow and his foundation. According to the panel, registrants remained free to select a domain name as long as the domain name itself made it clear that the registrant was not affiliated with, or authorised by, the trademark holder.

Comment

This decision underlines that merely having a famous name does not automatically equate to unregistered or common law rights for the purpose of standing to file a UDRP complaint. In addition, the decision serves as a reminder that domain names identical to a complainant's rights carry a high risk of implied affiliation. As such, those wishing to set up a criticism or parody website should choose their domain name wisely, ensuring that it differs from the trademark holder's rights, for example by adding a distinguishing term.

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