

DISPUTE RESOLUTION SERVICE

D00008829

Decision of Independent Expert

Sotheby's

and

Matt Skerrett

1. The Parties:

Complainant: Sotheby's
34-35 New Bond Street
London
W1A 2AA
United Kingdom

Respondent: Matt Skerrett
1st Floor 44-50 Old Christchurch Rd
Bournemouth
Dorset
BH1 1LN
United Kingdom

2. The Domain Names:

sothebysinternational.co.uk
sothebyslondon.co.uk
sothebysproperties.co.uk
sothebysproperty.co.uk

3. Procedural History:

14 July 2010 17:39 Dispute received
15 July 2010 14:16 Complaint validated
15 July 2010 14:30 Notification of complaint sent to parties
06 August 2010 09:56 Response received
06 August 2010 09:57 Notification of response sent to parties
10 August 2010 12:05 Reply received
13 August 2010 11:05 Notification of reply sent to parties
13 August 2010 11:06 Mediator appointed
20 August 2010 13:30 Mediation started
18 November 2010 17:08 Mediation failed
24 March 2011 12:09 Close of mediation documents sent
24 March 2011 12:11 Expert decision payment received

4. Factual Background

4.1 The domain names in question are collectively referred to in this Decision as the "Domain Names."

4.2 The Complainant in these proceedings is Sotheby's, an unlimited company incorporated under the laws of England and Wales with a principal place of business located at 34-35 New Bond Street, London, United Kingdom W1A 2AA.

4.3 According to the WHOIS information for the Domain Names, the registrant is Matt Skerrett, trading as IMMAT Ltd, a UK limited company. The Domain Names were registered on March 11, 2010. The registrant is hereinafter referred to as "Respondent."

4.4 The Complainant first learned of the Domain Names in April 2010. On April 30, 2010, Complainant's UK counsel sent Respondent a cease and desist letter demanding that Respondent transfer the Domain Names to Complainant.

4.5 On May 14, 2010, Complainant's UK counsel received a letter from Horsey Lightly Fynn, solicitors acting on behalf of Respondent. In the letter, Respondent's solicitors stated that Respondent "would have no objection to transferring the domain names" to Complainant for a fee. Respondent proposed a "sum of 10,000 pounds per domain name" together with Respondent's "legal costs in connection with this matter."

4.6 On May 28, 2010, Complainant's UK counsel sent another letter to Respondent's solicitors demanding that Respondent transfer the Domain Names to Complainant in consideration of the Complainant reimbursing the Respondent's documented out-of-pocket expenses directly associated with registering the Domain Names.

4.7 On June 3, 2010, Respondent's solicitors sent a letter to Complainant's UK counsel reiterating that Respondent would transfer the Domain Names to

Complainant for 10,000 pounds per domain name, inclusive of costs associated with the “acquisition, registration and maintenance of the Domain Names.” The letter also stated that Respondent “believes that this is a reasonable offer”, but was open to counter-proposals for a slightly lesser figure.”

4.8 As of the date of the Complainant’s complaint the Domain Names were parked with Sedo and resolved to web sites that featured links to third-party sites, including sites which featured real estate and auction services. The lower right hand corner of each web site included a link to the web site located at www.sedo.com along with a notation that the domain name might be for sale.

5. Parties’ Contentions

The Complainant’s Submission

5.1 Complainant sets out its trading history in some detail in its submission. In summary the Complainant contends that:

5.1.1 Complainant and its predecessors, through their affiliated companies and licensees (hereinafter, “Sotheby’s”), have been engaged in the auction business since 1744 and have developed a reputation as a premier auction house for the sale of fine art, jewelry and other collectibles. Sotheby’s is the oldest and most famous international auction house in the world with a continuous history of more than two hundred and sixty (260) years;

5.1.2 Complainant has specialized in auctions of over seventy (70) categories of objects, including, fine art, antiques, decorative art, jewelry and wines. Most objects auctioned by Complainant are unique items, and their value, accordingly, can only be estimated prior to sale. Thus, the principal role of Complainant as an auctioneer is to identify and evaluate works of art and other property through its international staff of approximately 1,300 experts and other staff, to stimulate purchaser interest through professional marketing techniques and to match sellers and buyers through the auction process. Buyers and sellers rely heavily on the expertise and worldwide reputation of Complainant for sales of unique objects of exceptional value;

5.1.3 Since its foundation in London in 1744, Sotheby’s has evolved into a global company with operations in more than thirty (30) countries around the world;

5.1.4 In addition to its core auction business, Sotheby’s, through its affiliates and licensees, has been engaged in the business of selling fine real estate properties in a range of locations, prices and distinctive styles for more than 25 years under the name and mark SOTHEBY’S INTERNATIONAL REALTY.

Complainant's Rights in the SOTHEBY'S Mark

5.2 Complainant has rights in the SOTHEBY'S Mark and marks that incorporate the SOTHEBY'S Mark (collectively, the "SOTHEBY'S Mark") in numerous countries and jurisdictions all over the world, including in the United Kingdom and the European Union. Complainant's United Kingdom registration of the mark SOTHEBY'S issued in 1986. Note: Complainant previously owned the following UK registrations: Registration Nos. 1280414, 1283719, 1283720, 1283721, 1283722, 1283723 and 1283724 in International Classes 16, 35, 36, 37, 39, 41 and 42, respectively. When these registrations came up for renewal in 2007, they were consolidated into a single registration, namely, Registration No. 1283724). Thus, Complainant has rights in the SOTHEBY'S Mark in the United Kingdom.

5.3 In addition to the United Kingdom, Complainant also owns rights in the SOTHEBY'S Mark in the European Union.

5.4 Complainant and its affiliated companies also own service mark registrations and applications of the SOTHEBY'S INTERNATIONAL REALTY Mark in numerous countries and jurisdictions around the world, including the United Kingdom and the European Union. Complainant's rights in the SOTHEBY'S INTERNATIONAL REALTY Mark in the United Kingdom date back to 2002.

5.5 The Complainant contends that Sotheby's and its licensees and affiliates have extensively advertised and promoted the SOTHEBY'S Mark all over the world, including in the United Kingdom. As a result of long and continuous use of the SOTHEBY'S Mark and substantial investment of time, money and effort in advertising and promotion, the SOTHEBY'S Mark has developed substantial public recognition and incalculable goodwill all over the world, including in the United Kingdom. In fact, the SOTHEBY'S Mark has become well-known all over the world, including in the United Kingdom.

5.6 The Complainant further contends that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Names.

Complainant's domain names

5.7 Complainant, through an affiliated company, owns the domain name SOTHEBYS.COM, which was registered in 1994. The SOTHEBY'S Mark appears prominently on the website at that address. Select sales continue to be open for bids and all sales catalogues are available via the website. The SOTHEBYS.COM domain name is well-known to customers, the trade and other segments of the public. The Complainant contends that the website located at www.sothebys.com, operated by Sotheby's and accessible to people all over the world, including in the United Kingdom, has been, and continues to be, an important tool for dissemination of information and news about the auction house and one of the prime sites for reference by the art market.

5.8 In addition to the domain name SOTHEBYS.COM, Complainant owns the domain name SOTHEBYS.CO.UK, which has been registered since 1996 and also resolves to an active web site.

5.9 Also, Complainant, through its affiliate, has operated at internet web sites located at www.sothebysrealty.com and www.sothebysinternationalrealty.com, both of which feature the real estate services offered under the SOTHEBY'S INTERNATIONAL REALTY Mark. The domain names SOTHEBYSREALTY.COM and SOTHEBYSINTERNATIONALREALTY.COM were first registered in 1997 and 1999, respectively. (www.sothebysinternationalrealty.com redirects users to www.sothebysrealty.com).

5.10 Turning to the question of abuse of rights the Complainant contends that the Domain Names are Abusive Registrations under paragraphs 2(a) and (b) of the DRS Policy ('the Policy).

The Respondent's Submissions

5.11 While the Respondent was represented by solicitors referred to above during the exchange of correspondence between the Complainant and Respondent prior to the filing of the Complainant's complaint, the Respondent is not legally represented in this dispute which has come for decision under the rules of the Policy.

5.12 Nonetheless I have taken into account what has been said on behalf of the Respondent by his solicitors in my decision in this matter. For completeness the Respondent makes the following submissions in response to the Complaint.

5.13 The Respondent submits that:

5.13.1 The Domain Names were registered in good faith and not with the intention to sell them;

5.13.2 The Domain Names were parked with Sedo but no money was made from this parking;

5.13.3. That all the Respondent's Domain Names are parked with Sedo;

5.13.4 That the Domain Names have as of the date of the Respondent's response been removed from Sedo and are not in use;

5.13.5 That the Respondent has no intention of breaching the trade mark rights of the Complainant;

5.13.6 That the offer to sell the Domain Names to the Complainant was made by the Respondent in response to an approach from the Complainant and the claim by the Complainant that the Domain Names have value.

Complainant's Response to the Respondent's Response

5.14 Further to receipt of the Respondent's Response the Complainant submitted a Reply

5.15 In summary the Complainant noted the following relevant facts:

5.15.1 That the Respondent did not dispute Complainant's allegation that the Domain Names are similar or identical to Complainant's SOTHEBY'S Mark under paragraph 2(a)(i) of the DRS Policy.

5.15.2 That the Respondent did not provide any support for the contentions made that the Domain Names were not Abusive Registrations under the DRS Policy in particular the Respondent has not explained why the purchase of the Domain Names should be seen as having been done in good faith or why the use that has been made of the Domain Names is not Abusive under the terms of the DRS.

6. Discussion and Findings

6.1 Paragraph 1 of the Policy defines Rights as rights as enforceable by a complainant, whether under English law or otherwise.

6.2 Complainant has rights in respect of the SOTHEBY'S Mark under Paragraph 2(a) of the Policy. Furthermore, the Domain Names are identical or similar to Complainant's SOTHEBY'S Mark.

6.3 As stated above, rights are defined as rights enforceable by a complainant whether under English law or otherwise.

6.4 In this case, Complainant owns a valid and existing registration for the SOTHEBY'S mark in the United Kingdom. In fact, Complainant's registration dates back to 1986. Complainant also owns valid and existing registrations for the SOTHEBY'S Mark in the European Union. All of these registrations predate the Domain Names. Moreover, Complainant has used the SOTHEBY'S Mark extensively all over the world, including in the United Kingdom for numerous years prior to 2010.

6.5 Accordingly Complainant has enforceable rights in the SOTHEBY'S Mark under the Policy.

6.6 In addition the Domain Names are similar to Complainant's SOTHEBY'S Mark under Paragraph 2(a)(i) of the Policy.

6.7 The Domain Names feature Complainant's SOTHEBY'S Mark along with words such as "International", "Properties", "Property" and "London." These additional words along with other differences, namely deletion of the apostrophe and addition of the suffix .CO.UK, are minor and unimportant.

6.8 The dominant element of each domain name registered by Respondent is “Sothebys” (without the apostrophe). Limitations of the naming system on the Internet do not make it possible for a domain name to have apostrophes. Suttons Consumer Products v. Brendan Martin, DRS 4840 (August 28, 2007) (domain name SUTTONSEEDS.CO.UK held identical to SUTTON’S SEEDS. Panel held that apostrophe in mark cannot be reproduced in a domain name). Moreover, terms such as “International”, “Properties”, “Property” and “London” are insignificant especially because these terms have a generic connotation in connection with Complainant and its businesses, namely, that the businesses are international, encompass real estate properties and that Complainant has a deep rooted connection to London.

6.9 Furthermore, I am able to disregard the top level domain suffix .CO.UK. Cath Kidston Limited v. Minoru Suda, DRS 7960 (March 11, 2010) (domain name identical to trademark except for generic suffix .org.uk).

6.10 Accordingly, there is no question that the Domain Names are similar or identical to Complainant’s SOTHEBY’S Mark.

6.11 Accordingly Complainant meets the requirements of paragraph 2(a)(i) of the Policy.

6.12 Turning to the question of Abuse, Paragraph 1 of the Policy defines an Abusive Registration as a domain name which either

(i) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to a complainant’s rights; or

(ii) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to a complainant’s rights.

6.13 Paragraph 3(a) of the Policy sets out a non-exhaustive list of factors which may be evidence that a disputed domain name is an Abusive Registration.

6.14 In this case, the Domain Names in the hands of Respondent are Abusive Registrations for the following reasons:

A. The Domain Names are Abusive Registrations because likelihood of initial interest confusion is high. On seeing the Domain Names as part of a web address an Internet user will likely believe that the Domain Names are registered to, operated or authorized by, or otherwise connected with Complainant because the Domain Names are similar to Complainant’s trade name, the SOTHEBY’S Mark and Domain Name SOTHEBYS.CO.UK. Thus, initial interest confusion between Complainant’s SOTHEBY’S Mark and the Domain Names is highly likely and, consequently, the Domain Name registrations are Abusive Registrations under the Policy. Mamas and Papas Ltd. v. D. Aimee, DRS 07899 (domain name MAMMASANDPAPPAS.CO.UK held to be Abusive Registration because “[g]iven that the domain name is so similar to the

complainant's brand, domain name and trademarks, I am satisfied that initial interest confusion is likely between the domain name and the complainant.”).

B. Furthermore, the Domain Names are Abusive Registrations under Paragraph 3(a)(i)(C) of the Policy because Respondent registered the Domain Names for the purpose of unfairly disrupting the businesses of Complainant and taking undue advantage and causing detriment. Given Complainant's extensive reputation in the United Kingdom, it is inconceivable that Respondent did not know of Complainant, its business and Complainant's SOTHEBY'S Mark. Thus, Respondent could only have registered the Domain Names for the purpose of disrupting Complainant's business or to take undue advantage and cause detriment. It follows that Respondent had the necessary knowledge and intent when he registered the Domain Names. Decision of Appeal Panel in *Verbatim v. Toth*, DRS 04331 (July 31, 2007) (knowledge and intention are pre-requisites for a successful complainant under all heads of §3(a)(i) of the Policy).

C. The Domain Names are also Abusive Registrations under the Policy because under the holding in *Chivas Bros Ltd. v. D.W. Plenderleith*, DRS 00658 it would be reasonable to infer that Respondent selected them for a purpose that was abusive. In *Chivas*, the panelist held that it would “ordinarily be reasonable to infer that the Respondent registered the domain name for a purpose and that that purpose was abusive” if 1) the domain name is identical to a name in respect of which a complainant has rights; (2) that name is exclusively referable to the complainant; (3) there is no obvious justification for the respondent having adopted that name; and (4) respondent has come forward with no explanation for having selected the domain name. Here, the Domain Names are similar to Complainant's SOTHEBY'S Mark that refers exclusively to Complainant, there is no obvious justification for Respondent's adoption of the Domain names and Respondent has not come forward with an explanation for having selected the Domain Names. Accordingly, the panel should conclude that the Domain Name registrations are Abusive Registrations.

D. The Domain Names are also Abusive Registrations under Paragraph 1(ii) of the Policy because they have been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights. As stated above, the Domain Names currently resolve to parked pages on which Respondent provides links to third-party web sites, including auction and real estate sites. Since Respondent has no connection whatsoever to Complainant, there is no doubt that these web sites would lead users into thinking that the web sites are somehow connected to Complainant. *The Electoral Commission v. Domain Administration Limited*, DRS 04389 (March 23, 2007). Furthermore, it is apparent that the Domain Names and the web sites to which they resolve have been established in order to take advantage of Internet users who want to reach Complainant's web sites. Respondent's intention is that when users arrive at the web sites to which the Domain Names resides, they will in turn click on the links to the other web sites featured on Respondent's web sites, including web sites of other auction and real estate businesses, generating income for Respondent or the webhost from click-through advertising payments. Thus, Respondent is taking advantage of the name

and reputation of Complainant. Jupiter Investment Management Group Ltd. v. Domain Administration Ltd., DRS 05264 (January 22, 2008).

E. Moreover, it is well-known that owners of domain names parked with Sedo receive payments based on the number of visitors that click on sponsored links. Thus, Internet users looking for Complainant's web sites on the Internet may be taken to Respondent's pages and due to the similarity between Complainant's Marks and the Domain Names may not realize that they are not on Complainant's site or even if they do they may decide to click on one of the links on the web sites. It is difficult to see why sponsors would pay for links and Sedo could provide the service for free unless visitors were likely to click on the links on the web sites associated with the Domain Names. This also demonstrates that the Domain Names are being used in such a way as to take unfair advantage and cause undue detriment to Complainant. Morgan Stanley v. Sara Manley, DRS 03215 (January 10, 2006).

F. Finally the Domain Names are Abusive Registrations because Respondent offered to sell the Domain Names to Complainant for valuable consideration in excess of Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Names under Paragraph 3(a)(i)(A) of the Policy. Respondent registered the Domain Names on March 11, 2010. Only two months later, on May 14, 2010, made an unsolicited offer to sell the Domain Names to Complainant for 10,000 pounds each, a price that far exceeds the out-of-pocket expense associated with registering a .CO.UK domain name. Moreover, Respondent has in the past offered to sell the Domain Names on the web sites to which the Domain Names resolve. These offers of sale along with other factors discussed above are evidence that the Domain Name registrations are Abusive Registrations within the Policy.

G. On the facts presented by the Complainant it seems clear that both the original registration of the Domain Names and their subsequent use took/take unfair advantage of, and were/are unfairly detrimental, to the Complainant's rights in the SOTHEBY'S Mark and name. In fact, it is difficult to imagine any innocent explanation or legitimate reason as to Respondent's choice of the Domain Names. The fact that the Respondent has removed the Domain Names from Sedo does not alter the finding of Abuse Registrations.

7. Decision

The Domain Names to be transferred to the Complainant.

Signed
MARGARET BRIFFA

Dated
15th April 2011