

DISPUTE RESOLUTION SERVICE

D00021958

Decision of Independent Expert

Sidley Austin LLP

and

Mr Anil Mannick

1. The Parties:

Complainant:
Sidley Austin LLP
One South Dearborn
Chicago
Illinois
60603
United States

Respondent:
Mr Anil Mannick
Surrey
United Kingdom

2. The Domain Name:

sidleylawyers.co.uk

3. Procedural History and Procedural Matters:

3.1 I can confirm that I am independent of each of the Parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the Parties.

3.2 Timeline

The dispute was received by Nominet on 15 October 2019. On 16 October 2019, the Complaint was validated and notification of the

complaint was sent to the Parties. On 4 November 2019, a response reminder was sent to the Respondent and on 7 November 2019 the Response was received by Nominet. On the same day, notification of the Response was sent to the Parties. On 14 November 2019, the Reply was received and notification of the Reply was sent to the Parties. On 14 November 2019, a mediator was appointed and mediation started on 21 November 2019. On 11 December 2019, mediation failed and close of mediation documents was sent to the Parties on the same date.

On 27 December 2019, payment for an Expert decision was received and the Expert, Ravi Mohindra, was appointed on 2 January 2020.

On 6 January 2020, I issued a Further Statement Request (in accordance with section 17.1 of the Policy) in the terms set out below, which Nominet sent to the Parties on the same day:

Expert's Further Statement Request

"In paragraphs 4 and 5 of the Complaint, the Complainant refers to trade marks that the Complainant applied for, and for which it subsequently received corresponding trade mark registrations.

However, the Annexures to its Complaint (nos. 1,2, 3 and 4) show that these trade marks are registered in the name of Sidley Austin Holding LLP, and not the Complainant (Sidley Austin LLP) as the Complainant asserts in paragraphs 4 and 5 of the Complaint.

The Complainant is therefore requested to provide details (and any corresponding evidence) of the relationship between the owner of these trade mark registrations and the Complainant, together with the basis under which the Complainant claims Rights in respect of these marks given the fact that the Complainant is not shown as the registered owner of the marks.

The Complainant has until Friday 10 January 2019 to respond to this Expert's Further Statement Request. Should it choose to respond, the Complainant shall limit its response to the specific issue raised in this Further Statement. The Respondent will then have until Friday 17 January to provide any comment on the Complainant's response to this Expert's Further Statement Request. The Expert will then proceed to decide the complaint on the basis of the Parties' submissions (the Complaint, Response, Reply and any valid responses made to this Expert's Further Statement Request) and the DRS Policy.

For the avoidance of doubt, Nominet shall send (a) this Further Statement Request to both the Complainant and the Respondent, and (b) any response made by either Party in connection with this Further Statement Request to the other Party."

The Complainant filed a Further Statement in response to the Further Statement Request on 10 January 2020. The Respondent did not file any response to, or comment on, the Complainant's Further Statement within the timeframe set out in the Further Statement Request. I have considered the Complainant's Further Statement and, where relevant and appropriate, have taken it into account along with the Complaint, the Response and the Reply in coming to my decision.

4. Factual Background

- 4.1 The Complainant is one of the world's oldest and largest U.S. based law firms. It has provided legal services to clients in connection with complex transactional, regulatory and litigation matters for over 150 years and is consistently ranked in leading publications including Chambers & Partners, U.S. News & World Report and Law360.
- 4.2 Sidley Austin Holding LLP is the owner of European Union and US trade mark registrations for the words SIDLEY and SIDLEY AUSTIN, dating back to 2006.
- 4.3 The Complainant is an affiliated partnership of Sidley Austin Holding LLP, and uses the trade marks set out above under licence from the trade mark owner, Sidley Austin Holding LLP.
- 4.4 The Domain Name was registered by the Respondent on 2 October 2019. For a period commencing on 2 October 2019, and continuing until at least 10 October 2019, the Domain Name resolved to the Complainant's website located at the domain name www.sidley.com. As at the date of this Decision, the Domain Name does not resolve to an active website.

5. Parties' Contentions

- 5.1 A summary of the Complainant's contentions is set out below.

Rights

- 5.2 The Complainant asserts that it operates in London as an affiliated partnership of Sidley Austin Holding LLP. Sidley Austin Holding LLP is the owner of the trade mark registrations as noted in paragraph 4.2 above, and it licenses those marks to its affiliated partnerships, including the Complainant.
- 5.3 The Complainant claims that it is one of the world's oldest and most widely-known law firms, having provided legal services to clients in connection with complex transactional, regulatory and litigation matters for over 150 years. The Complainant further claims that it is consistently ranked as one of the best law firms in the world by leading publications such as Chambers & Partners, U.S. News & World Report and Law360. As a result, the Complainant asserts that its mark

“SIDLEY” has a world-wide reputation.

- 5.4 The Complainant asserts that its group is one of the largest U.S. based law firms with approximately 2000 lawyers and annual revenues of over two billion dollars. It maintains offices in over 20 cities worldwide, including in North America, Europe and Asia Pacific.
- 5.5 The Complainant submits that while the firm’s name has evolved over the last 150 years, the firm was known as Sidley & Austin commencing in 1967, then in 2001 as Sidley Austin Brown & Wood. Since 2006, the firm has been known as “Sidley” or “Sidley Austin”.
- 5.6 The Complainant submits that it first registered the domain name <sidley.com> on 26 April 1995. It claims that it also owns numerous other domain names which consist of or include its SIDLEY mark, including <sidley.co.uk> and <sidley.uk>. All of these, says the Complainant, resolve to the Complainant’s website located at <www.sidley.com>.
- 5.7 The Complainant submits that the Domain Name incorporates its SIDLEY mark in its entirety, and the addition of the word “lawyers” to the end of the Domain Name does not distinguish it from the Complainant’s mark, as the public already associates the “SIDLEY” name and mark with lawyers.

Abusive Registration

- 5.8 The Complainant submits that the Domain Name was both registered and has been used in a manner that has taken unfair advantage of and has been unfairly detrimental to the Complainant’s Rights.
- 5.9 The Complainant contends that the Domain Name is likely to confuse people or businesses into believing that the Domain Name is registered and operated by the Complainant due to it being virtually identical to the “SIDLEY” name and mark in which the Complainant says it has Rights. The inclusion of the descriptive word “lawyers” alongside “Sidley” in the Domain Name makes it more likely, according to the Complainant, that the Domain Name will cause such confusion as the public already associates the Complainant’s “Sidley” name with lawyers.
- 5.10 Further, the fact that the Domain Name previously resolved to the Complainant’s website located at <sidley.com>, with the Respondent having no affiliation with the Complainant, confers false legitimacy or authenticity to the Domain Name, so as to deceive persons as to the true identity of the Respondent.
- 5.11 In addition, the Complainant submits that there is no evidence that the Respondent has reasonable justification for registering the Domain Name and nor could the Respondent make such a showing. Other than

the redirection to the Complainant's website as noted above, there has been no use of the Domain Name by the Respondent.

The Respondent

- 5.12 The Respondent requests that the Complaint be denied.
- 5.13 Prior to the Complaint, the Respondent says that he had no knowledge of the Complainant and their services, nor of the Complainant's website, at the time that he registered the Domain Name. The Respondent contends that the Complainant does not operate in the UK, and the address provided by the Complainant is in Los Angeles, USA.
- 5.14 The Respondent argues that despite the trade mark registrations for the mark SIDLEY in the EU and US, these do not entitle the Complainant to the Domain Name as it contains the word 'Sidley', which the Respondent says is a very popular family name in the USA, Canada, UK and South Africa, and this word is joined by the common dictionary word 'lawyers' to form the Domain Name.
- 5.15 The Respondent asserts that he does not deal in the buying and selling of domain names, but that he merely advises friends and work colleagues on the benefits of doing business on the internet, and assists them in purchasing domain names to establish their online presence.
- 5.16 In this regard, the Respondent says that he has several domain names registered under his name for himself, his friends, his work colleagues and his relatives which he maintains until such time as they decide to have their websites professionally designed and launched. Examples of these include <agilebpm.com>, <mannick.uk> and <westhillcarehomes.co.uk>.
- 5.17 The Respondent denies that the Domain Name is an Abusive Registration. He asserts that he has the right to register the Domain Name for a third party whose surname is 'Sidley', who is nearing completion of his training to become a lawyer and who will be running his own law firm.
- 5.18 The Respondent requests the Expert to issue a finding of Reverse Domain Name Hijacking.

The Reply

- 5.19 The Complainant submits that the Respondent's contention that he had no knowledge of the Complainant or its services is demonstrably false as the Domain Name resolved to the Complainant's website for at least a week commencing on 2 October 2019, the date of registration of the Domain Name, and without explanation from the Respondent as to why

he made this redirection.

- 5.20 Further, the Complainant says that as the Respondent has registered the domain name <mannick.uk> (being the Respondent's surname), it defies logic to suggest that when he registered the Domain Name for an alleged person whose surname is 'Sidley', he bypassed <sidley.com>, <sidley.co.uk> and <sidley.uk> (all of which are owned by the Complainant and resolve to the Complainant's website at <sidley.com>), in favour of the more cumbersome <sidleylawyers.co.uk> domain name.
- 5.21 In any event, submits the Complainant, the Respondent's actual knowledge of the Complainant is irrelevant as due to the Complainant's reputation and its long-standing use of the 'Sidley' name (including in the domain names <sidley.com> and <sidley.co.uk>), he had at least constructive knowledge of the Complainant and its rights in the SIDLEY name and mark.
- 5.22 The Respondent's claim that the Complainant does not operate in the UK is also incorrect. The Complainant asserts that it has been operating in the UK since 1974 and its London office consists of 130 lawyers who offer a wide range of legal services. In any event, there is no geographical or jurisdictional restriction on Rights under the Policy. Further, the Complainant asserts that the Respondent has also registered the domain name <sidleylawyers.com> (in respect of which a dispute in relation to that domain name is pending with the World Intellectual Property Organisation) and hence the Respondent clearly intended to usurp the Complainant's rights worldwide.
- 5.23 The Complainant asserts that immediately after receiving notice of the Complaint, the Respondent offered to sell the Domain Name together with the <sidleylawyers.com> domain name to the Complainant for \$3000. This amount far exceeds the price that the Respondent paid for these registrations.
- 5.24 The Complainant notes that the Respondent's claim that he registered the Domain Name for a third party whose surname is 'Sidley' and who is nearing the completion of his training to be a lawyer and will be running his own law firm is unsupported by evidence. In addition, the mark SIDLEY is registered in the EU and the US as a trade mark, and these trade mark registrations have been subsisting for over a decade.
- 5.25 Finally, the Complainant contends that the Respondent's request for a finding of Reverse Domain Name Hijacking should be summarily rejected on the basis that it is unsupported by any argument or evidence.

6. Discussions and Findings

General

- 6.1 For the Complainant to succeed with its Complaint it is required under section 2.2 of the Policy to prove to me, the Expert, on the balance of probabilities, that:
- I. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
 - II. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant's Rights

- 6.2 Section 1 of the Policy provides that Rights means "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*". Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called 'common law rights'.
- 6.3 Further, it is well accepted that the question of whether the Complainant has Rights falls to be considered at the time that the Complainant makes its Complaint and is a test with a low threshold to overcome.
- 6.4 The Complainant has used, and continues to use, the mark SIDLEY in connection with the provision of legal services. It has provided evidence showing that it is ranked as one of the leading law firms in the world. It has also asserted that it uses certain trade mark registrations for the word mark SIDLEY (which cover legal services) under licence from the registered proprietor, Sidley Austin Holding LLP, which in turn is a member of the Complainant's corporate group. I have no good reason to doubt the veracity of this assertion. Indeed, the Complainant has provided, as part of its Further Statement, a declaration sworn by Rollin A. Ransom, an attorney at law, confirming this basis under which the Complainant uses the SIDLEY and SIDLEY AUSTIN marks.
- 6.5 Further, the Complainant's website located at <sidley.com> (to which the Complainant's domain names <sidley.co.uk> and <sidley.uk> resolve) demonstrates use of the mark SIDLEY in connection with the provision of legal services.
- 6.6 I therefore find that the Complainant has Rights in respect of the name 'SIDLEY'.
- 6.7 The Domain Name incorporates the Complainant's SIDLEY name in its entirety and the only other element contained within it (excluding the generic .co.uk suffix) is the generic word 'lawyers' as a suffix to the distinctive 'SIDLEY' element.

- 6.8 The addition of the word 'lawyers' in the Domain Name does nothing to distinguish the Domain Name from the name in which the Complainant has Rights. The Complainant is a firm of lawyers that is in the business of providing legal services to clients, and it does so under the 'SIDLEY' name.
- 6.9 I therefore find that the Complainant has established that it has Rights in respect of a name which is similar to the Domain Name and accordingly the Complainant has satisfied the first limb of the Policy.

Abusive Registration

- 6.10 Section 1 of the Policy defines "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 the Complainant's Rights; or*
 - ii. has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*
- 6.11 Section 5 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Section 8 of the Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.
- 6.12 The Complainant relies on a number of the factors set out in section 5 of the Policy in order to make out its case on Abusive Registration, including those which relate to the original registration of the Domain Name and those which relate to subsequent use.
- 6.13 Section 5.1.1 of the Policy concerns the Respondent's motives at the time of registration of the Domain Name.
- 6.14 The Respondent in this case is an individual with an address in the UK. The Complainant has established that it has operated, and continues to operate, a well-known law firm in the UK, as well as in other countries around the world, under the 'SIDLEY' name.
- 6.15 The Respondent's case as to why he should be entitled to retain the Domain Name is, in summary, that he registered the Domain Name on behalf of a friend whose surname is 'Sidley', who is nearing the

completion of his training to become a lawyer, and who will be running his own law firm.

- 6.16 None of these assertions made by the Respondent are supported by any evidence. For example, the Respondent could have provided evidence of communication between himself and the friend referred to in the paragraph above showing that this person specifically requested the Respondent to register the Domain Name on his behalf. The Respondent could also have produced documentation showing that his friend's surname is in fact 'Sidley' as the Respondent has claimed.
- 6.17 Further, it is clear that for an unspecified period commencing on the same date as registration of the Domain Name, the Domain Name resolved to the Complainant's own website located at <sidley.com>. In addition, there is evidence to show that on 21 October 2019, a date just under 3 weeks after registration of the Domain Name, when the Respondent was served with a complaint regarding the <sidleylawyers.com> domain name he offered to sell both the Domain Name and the <sidleylawyers.com> domain name to the Complainant for \$3000, which is an amount well in excess of any out of pocket expenses the Respondent would have incurred in registering both of these domain names.
- 6.18 These actions that the Respondent has taken are, in my view, wholly inconsistent with someone who claims (i) that he has registered the Domain Name for the reasons set out above and (ii) that he had no knowledge of the Complainant at the time of registration of the Domain Name. If the Respondent's assertions regarding him registering the Domain Name on behalf of someone who was setting up their own law firm, I find it inconceivable that the Respondent would not have researched the name 'Sidley' in conjunction with lawyers or legal services. Had he done so, then given the renown of the Complainant in this field and the number of years that it has been operating under the name 'Sidley', he would have certainly come across the Complainant and its group.
- 6.19 I therefore find that at the time of registration of the Domain Name the Respondent had actual, or at the very least, constructive, knowledge of the Complainant and its Rights in the name 'SIDLEY' in connection with legal services, at the time that he registered the Domain Name.
- 6.20 The Respondent also states in his Response that he has registered a number of domain names including on behalf of his family, colleagues and friends, including the Domain Name. Section 8.4 of the Policy states that:

"Trading in domain names for profit, and holding a large portfolio of domain names, are of themselves lawful activities. The Expert will review each case on its merits."

- 6.21 However, in the specific circumstances of this case and taking into account the evidence and contentions made by the Complainant in its Complaint and the statements of the Respondent in his Response, I am satisfied that the Domain Name was acquired to benefit from the reputation and goodwill of the Complainant and its Rights in the SIDLEY name, and I find that, on the balance of probabilities, the registration of the Domain Name by the Respondent “*took unfair advantage of or was unfairly detrimental to the Complainant’s Rights*” (per the definition of Abusive Registration as set out in the Procedure), and that each of the circumstances set out in section 5.1.1 of the Policy apply in this case.
- 6.22 In reaching this finding I have taken into account the following factors: (i) the Respondent has put forward no evidence to support its assertions regarding registration of the Domain Name for someone with the surname ‘Sidley’ who will be running their own law firm; (ii) there is evidence before me that the Domain Name has previously resolved to the Complainant’s website, and neither the Respondent, nor anyone associated with the Respondent, has made any legitimate use of the Domain Name in connection with an active website which is not connected or associated with the Complainant; and (iii) the Respondent has offered to sell the Domain Name for an amount which exceeds his out of pocket costs incurred in its registration.
- 6.23 In addition, given the fact that the Domain Name incorporates the name in which the Complainant has Rights (‘SIDLEY’) in its entirety, and is adorned with the generic word ‘lawyers’ (which is wholly connected with the Complainant and the services that it provides under the ‘SIDLEY’ name), there is a significant similarity between the Domain Name and the name in which the Complainant has Rights so I am satisfied that consumers searching online for the Complainant and its services are likely to expect there to be some connection between any website operated under the Domain Name and the Complainant, even before they arrive at that website (regardless of the state of that website). As stated in paragraph 3.3 of the Experts’ Overview:
- “This is what is known as ‘initial interest confusion’ and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived.”*
- 6.24 I am therefore prepared to find that, on the balance of probabilities, section 5.1.2 of the Policy also applies in this case.
- 6.25 Accordingly the Complainant has also made out the requirements of paragraph 2.1.2 of the Policy.

- 6.26 Finally, and for completeness, I have considered the non-exhaustive list of factors set out in section 8 of the Policy which may be evidence that a Domain Name is not an Abusive Registration. These relate to the Respondent's prior knowledge, or lack of the same, of the Complainant's cause for complaint and the possibility of the Respondent making fair use of the Complainant's name. On the evidence before me, the arguments presented by the Complainant and despite the claims made by the Respondent, I take the view that none of the provisions of section 8 of the Policy can assist the Respondent.
- 6.27 In these circumstances I find that the Domain Name (i) was registered in a manner which, at the time when the relevant registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights, and (ii) has been used in a manner which took unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

Reverse Domain Name Hijacking

- 6.28 The Respondent has invited me to issue a finding of Reverse Domain Name Hijacking. Paragraph 18.7 of the Policy provides that "*If, after considering the submissions, the Expert finds that the complaint was Reverse Domain Name Hijacking, the Expert shall state this finding in the Decision*". Reverse Domain Name Hijacking is defined in paragraph 1 of the Policy as "*using the DRS in bad faith in an attempt to deprive a Respondent of a Domain Name.*"
- 6.29 Other than a bare request contained in the Response for the Expert to issue a finding of Reverse Domain Name Hijacking, the Respondent provides no other assertions or evidence as to why this finding should be made.
- 6.30 Having considered all of the submissions made by the Complainant and the Respondent in this case, I do not find that the Complainant has used the DRS in bad faith in an attempt to deprive the Respondent of the Domain Name. The Complainant has provided assertions and evidence to prove that (i) it has Rights in respect of the name 'SIDLEY', which is wholly incorporated in the Domain Name, and (ii) it employs lawyers who operate and provide legal services under the 'SIDLEY' brand name. Thus, it is, in my view, completely reasonable for the Complainant to object to the Domain Name and bring its Complaint.
- 6.31 Further, while the Respondent claims to have potential legitimate interests in the Domain Name (in that he registered the Domain Name on behalf of his friend whose surname is 'Sidley', who is nearing the completion of his training to become a lawyer, and who is setting up his own law firm), he has provided no evidence to support these claims.
- 6.32 I therefore reject the Respondent's request to issue a finding of Reverse Domain Name Hijacking in this case.

7. Decision

- 7.1 I find that the Complainant has proved that it has Rights in a name which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration.
- 7.2 I therefore direct that the Domain Name be transferred to the Complainant.
- 7.3 I further direct that the Respondent's request for a finding of Reverse Domain Name Hijacking be rejected.

Signed Ravi Mohindra

Dated 31 January 2020