

ADMINISTRATIVE PANEL DECISION

The Estate of Sheldon Solow v. ERA ERA / Ethan Arnheim
Case No. D2022-4015

1. The Parties

Complainant is The Estate of Sheldon Solow, United States of America (“U.S.”), represented by Tucker & Latifi, LLP, U.S.

Respondent is ERA, U.S. / Ethan Arnheim, U.S., represented by The GigaLaw Firm, Douglas M. Isenberg, Attorney at Law, LLC, U.S.

2. The Domain Names and Registrars

The disputed domain names <sheldonsolow.com>, <sheldonsolow.org>, <solowfoundation.com>, and <solowfoundation.org> (the “Domain Names”) are registered with Register4Less, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 26, 2022. On October 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Names. On October 27, 2022, the Registrar transmitted by email to the Center its verification response confirming that Respondent is listed as the registrant and providing the contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), 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 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on November 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2022. The Response was filed with the Center on December 3, 2022.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on December 29, 2022. The Panel finds that it was properly constituted. 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.

4. Factual Background

The Solow Foundation was established in 1991 by Sheldon Solow. Mr. Solow is known for his financial success as a real estate developer, and also for developing the Solow Building, located in mid-town New York City, with unobstructed views of Central Park. Mr. Solow is also known for his art collection, which contains works from famous artists across different historic periods and geographic locations. Sheldon Solow and the Solow Foundation have no current trademark registrations.

Respondent is an activist and community volunteer who has worked in various social-minded capacities. In approximately 2016, Respondent became aware of a nonprofit art museum in New York City associated with Sheldon Solow. Forbes magazine estimated Mr. Solow's net worth in 2020 (the year in which he died) at USD 4.4 billion. According to an article in The New York Times about Mr. Solow, written upon his death in 2020, the "astronomical value" of his "distinguished" art collection that included works from Van Gogh, Joan Miró, Jean-Michel Basquiat, Balthus, Picasso, Matisse, Botticelli, Giacometti, Morris Louis, and Mark Rothko "was hard to calculate".

In 2018, Crain's New York Business reported that Mr. Solow's art museum was operated by a nonprofit entity that created tax benefits for Mr. Solow, even though the museum was not (and, to this day, is not) open to the public. The Crain's article noted that the unusual arrangement of nonprofit art museums being closed to the public was the subject of a 2016 inquiry by the U.S. Senate Committee on Finance, and the article highlighted the benefit of Mr. Solow's museum to Mr. Solow's son, Stefan Soloviev:

"Artwork typically is subject to the federal estate tax, which tops out at 40 [per cent], in addition to levies on the state level. Judging from the 2015 value of the charity's collection, that would mean Solow might need to pay about [USD]80 million to bequeath the works to an heir. But if ownership were by the nonprofit, Soloviev could simply assume leadership of the organization without losing a dime of his inheritance."

The Domain Names were registered by Respondent on December 23, 2016. They all point to the same website titled "Solow Art and Architecture Foundation". In a section of the site for "Frequently Asked Questions" ("FAQ"), it states:

"Is the art ever open to the public?"

Right now, it's not open to the public. There is a world class collection of art, but it is totally inaccessible. If you crane your neck, you might get a peek at some of it. The Foundation exists as a 501(c)3, a tax status that Congress created to encourage organizations to work in the public interest."

Another question in the FAQ section of the website is, "Who created this website?" The site provides this answer:

"An art enthusiast who would like to visit the collection, but has not received any reply to inquiries by phone, in person, and email. If you'd like to get in touch or have another question email me or tweet @solowfoundation."

5. Parties' Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant states that although Sheldon Solow and the Solow Foundation have no current trademark registrations, the Sheldon Solow name and the 19-year-old Solow Foundation have established enough of a reputation to make it impossible to associate these names with anyone other than Sheldon Solow himself. Complainant claims that given Sheldon Solow's prolific legacy in arts and society, the name Sheldon Solow

has acquired sufficient secondary association with Complainant. Sheldon Solow has been featured in countless articles, some of which feature his journey to become a self-made billionaire, and others regarding his success as an art collector. He is profiled in Forbes, and a simple Google search of his name yields 171,000 results. News of his passing in late 2020 was headlined in the New York Times.

Complainant submits that Respondent is the owner of the four Domain Names. They incorporate “Sheldon Solow” and “Solow Foundation” in their entirety. All of them are identical to the names under which Sheldon Solow and the Solow Foundation conduct business. Complainant contends that by registering the Domain Names, Respondent has completely shutout the Solow Foundation from establishing an online presence. Additionally, it has become impossible for potential patrons, or anyone curious about the Solow Foundation, to find authentic information. Complainant states that the infringing Domains Names all lead to one website, which presents itself as the official museum’s site, and includes different pages about the museum board and staff, the artwork on display, business hours, and frequently asked questions.

Complainant states that the Solow Foundation intends to trademark its name in International Class 41 for museum services. Complainant has no website or online presence.

(ii) Rights or legitimate interests

Complainant states it has not authorized or approved Respondent to use the Mr. Solow’s personal name, or the name of his foundation, the Solow Foundation. Respondent is not commonly known by the name Sheldon Solow, nor is Respondent known by the Solow Foundation name. Respondent is operating the website to satirically pass criticism of the Solow Foundation, and by extension of Sheldon Solow.

Additionally, Complainant contends that the facts here differentiate this case from certain prior UDRP cases. For example, in one such earlier case, the respondent sufficiently disclaimed his website as satirical, with the website at the disputed domain name stating on its home page that it was not affiliated in any way with the complainant. Here, Complainant asserts Respondent makes no claims that the website is not associated with the Solow Foundation or Sheldon Solow. Furthermore, when parties access any of the four infringing Domains Names they are met with a website that is holding itself out to be the Foundation’s genuine site. There they can access fake “Hours of Operation” and fake “Leadership and Staff” sections, which have published information on private individuals, including the museum’s security guards and curator.

Complainant indicates Respondent has registered the four Infringing Domain Names, including two with “.com” endings, the most common generic top-level domain (“gTLD”). The two other Domain Names include the “.org” gTLD, an equally common ending for museums and similar organizations. Complainant asserts these registrations have eliminated the possibility for Complainant to establish its own online presence. The loss of ability to create and manage an online space for The Solow Foundation will result in commercial harm to Complainant, who now cannot register a website in the Sheldon Solow name. Complainant states Respondent has also registered email addresses in the name of Complainant and social media accounts in the name of Complainant. None of these disclaim that they are satirical, operated in jest, or unaffiliated with the actual Solow Foundation.

(iii) Registered and used in bad faith

Complainant contends that Respondent has registered the infringing Domain Names exclusively to disrupt the business of Complainant and, in turn, to attract Internet users to Respondent’s website by using the Sheldon Solow and Solow Foundation names to further his own agenda against both Sheldon Solow and the Solow Foundation.

Complainant states Respondent registered the four Domain Names, all with extremely common and desirable gTLDs. Respondent has created at least two known emails associated with the website, including “info@solowfoundation.com” and “media@solowfoundation.com”. Respondent states on the website linked to the infringing Domain Names that “media inquiries are welcome at media@solowfoundation.org”. Complainant believes that Respondent’s redirect of media inquiries from Complainant to Respondent also

indicates Respondent's intent to disrupt Complainant's operation of business.

Finally, Complainant points out that Respondent is quoted in the New York Times article discussing the Solow Foundation, titled "What Will Become of a Tycoon's Art Gems", stating that Respondent was excited at the possibility of a museum, and that he would be "happy to turn the website over to them [Complainant] and enable people to go visit the collection". Complainant believes that this quote shows Respondent's desire to disrupt Complainant's business, as well as proves that Respondent is holding the four Domain Names hostage until Respondent's demand that the Solow Foundation become more accessible is met.

B. Respondent

Respondent claims that to highlight the inappropriateness of Mr. Solow receiving tremendous tax benefits through his art foundation without opening its doors to the public, Respondent registered the four Domain Names and created a parody website. Respondent states that his site has been widely described in the mainstream, business, and artworld press as a parody intended to draw attention to an important legal and social issue. For example:

- The New York Post said Respondent "created a parody web site, SolowFoundation.org".
- The New York Times reported that Respondent "launched a website, scrutinizing the foundation and mocking its inaccessibility".
- Crain's New York Business has described Respondent's Website as "a parody website" created by Respondent.
- Artnet News said Respondent's Website "has called attention to the gallery's tax status and lack of visiting hours".
- The Art Newspaper said Respondent's Website is a "spoof site" set up by Respondent.

Respondent claims the "FAQ" page on his website discusses the legal and social issues that enabled Mr. Solow to selfishly benefit from creating an art gallery that is closed to the public. In addition, Respondent indicates that although the building containing Mr. Solow's art collection previously had a sign on the exterior that said "The Solow Art & Architecture Foundation", the sign has since been revised to remove the "Solow" name and has been replaced by a sign that now says, "The Soloviev Foundation". The New York Times has stated that "Soloviev" is "a pre-Ellis Island family name" for "Solow", and Forbes wrote that "Soloviev" is "an older, Russian spelling of the family name".

(i) Identical or confusingly similar

Respondent observes that Complainant admits that "Sheldon Solow, and the Solow Foundation have no current trademark registrations", and instead Complainant states that "[t]he Solow Foundation intends to trademark its name in International Class 41 for museum services". Respondent states he has conducted a search of all trademark applications and registrations at the United States Patent and Trademark Office and has not located any applications on behalf of Complainant that include the name "Solow".

Therefore, Respondent contends that to prevail under paragraph 4(a)(i) of the Policy, Complainant must prove that it has established unregistered or common law trademark rights by "show[ing] that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services". WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.3. However, Respondent submits that Complainant has failed to do so, relying solely on unsupported assertions.

Respondent claims that Complainant's assertions and submissions provide no evidence that the Solow name "has become a distinctive identifier which consumers associate with the complainant's goods and/or services" – instead, Complainant's presentation only shows that Mr. Solow was a wealthy real estate developer and the subject of news articles. In addition, Respondent contends Complainant's statement that "Sheldon Solow has acquired sufficient secondary association with the Complainant" is nonsensical and at best circular given that it simply says Mr. Solow acquired "secondary association" (whatever that may mean)

with his own estate – not that the “Solow” name has become a distinctive identifier which consumers associate with Complainant’s art services. Complainant has submitted only conclusory allegations of unregistered or common law rights, which would not normally suffice to show secondary meaning.

Respondent urges that even if Complainant had at one time established common law rights in the “Solow” name, it is obvious that Complainant has since abandoned these rights in favor of the name “Soloviev”. As noted above, the name on the building housing the art gallery has been changed from “The Solow Art & Architecture Foundation” to “The Soloviev Foundation”, and Mr. Solow’s son and successor, Stefan Soloviev, as well as his grandson, Hayden Soloviev, who contacted Respondent about the Domain Names, use the Soloviev name instead of Solow.

Further, Respondent contends that the fact that Mr. Solow may have been well-known is insufficient to establish trademark rights under the Policy. Respondent states that many famous people (including those more famous than Mr. Solow) have failed to establish rights in their own names under the Policy.

Finally, Respondent urges that if and to the extent that any trademark rights in the “Solow” name might actually exist, it is at best unclear who is the owner of such rights, given that the gallery housing Mr. Solow’s art collection is a nonprofit legal entity separate from Mr. Solow himself (as well as his estate), and that Mr. Solow’s business activities appear to have been conducted by various business – none of which is a complainant in this proceeding.

Accordingly, Respondent concludes that Complainant has failed to establish that the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights.

(ii) Rights or legitimate interests

Respondent contends that he has rights and legitimate interests in the Domain Names because he is making a legitimate noncommercial or fair use of them, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue under paragraph 4(c)(iii) of the Policy.

Here, Respondent states its criticism and parody expressed through Respondent’s website exists solely to highlight the legal and social issues related to the tax benefits obtained by Mr. Solow’s creation of a foundation to receive his artwork without an obligation to publicly disclose the artwork. As set forth above, numerous publications have referred to Respondent’s website as a “parody”, a “spoof”, or one that “mock[s]” the inaccessibility of Mr. Solow’s artwork. Complainant itself admits that “Respondent is operating the website to satirically pass criticism of the Solow Foundation, and by extension Sheldon Solow”. Therefore, Respondent claims the purpose of his site as a criticism or parody site is clear and undeniable.

Further, Respondent states that he has never in any way profited from his registration and use of the Domain Names, because his site is noncommercial. The site does not contain any advertising; it does not offer for sale any goods or services; and the only sites to which it links are those that provide additional factual information about the issues Respondent is criticizing, namely, the questionable tax benefits obtained by Mr. Solow for donating his artwork to his own foundation without a legal obligation to publicly display the artwork.

Finally, Respondent states his site discloses that it is not affiliated with Complainant by including a statement that it 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”. Therefore, Respondent argues it would be impossible for anyone to mistake Respondent’s website as anything other than a criticism site.

Respondent cites to a number of previous UDRP cases to argue that previous panels have found that respondents have established rights or legitimate interests in disputed domain names used in connection with criticism websites similar to Respondent’s website, while also seeking to distinguish a case raised by Complainant.

Accordingly, Respondent concludes that Complainant has failed to establish that Respondent lacks rights or legitimate interests in respect of the Domain Names.

(iii) Registered and used in bad faith

Respondent contends that he has not registered or used the Domain Names in bad faith. Respondent observes that Complainant does not cite which, if any, circumstance set forth in paragraph 4(b) of the Policy is present to establish bad faith, and Complainant does not cite to a single decision under the Policy in support of its opinion that Respondent has registered and used the Domain Names in bad faith.

Respondent contends that Complainant's entire argument for bad faith is that the Domain Names were registered and are being used to disrupt Complainant's business. Respondent responds, however, that it is uncontroverted that the art gallery housing Mr. Solow's collection is not open to the public, and Complainant admits it "has no website or online presence". Therefore, Respondent reasons that given Complainant conducts no business in connection with Mr. Solow's art gallery, and does not provide any public information on the Internet about it, it is impossible for Respondent to cause any disruption because there is nothing for Respondent to disrupt. In addition, all of the information on Respondent's website is factually correct and has not been denied by Complainant.

To the extent that Complainant's argument for bad faith relates to paragraph 4(b)(iv) of the Policy – "creating a likelihood of confusion" – Respondent points out such circumstances require Complainant to show that Respondent's conduct is "for commercial gain". However, Respondent's website is noncommercial as it does not contain any advertising, nor does it offer for sale any goods or services, and the only websites to which it links are those providing factual information about the issues Respondent is criticizing, namely, the tax benefits obtained by Mr. Solow for donating his artwork to his own foundation without a legal obligation to publicly display the artwork.

Finally, Respondent urges that he has acted in good faith because his website is solely for criticism/parody. Respondent urges that numerous prior UDRP panels have recognized that domain names used in connection with criticism/ parody sites are protected by free speech principles, especially where, as here, the case involves two parties in the U.S.

Accordingly, Respondent contends that Complainant has failed to establish that the Domain Names have been registered and are being used in bad faith.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. Those elements are as follows:

- (i) the Domain Names registered by Respondent are identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Names; and
- (iii) Respondent has registered and is using the Domain Names in bad faith.

A. Identical or Confusingly Similar

As noted above, in order to succeed on the first element under paragraph 4(a) of the Policy, Complainant must demonstrate that the Domain Names are identical or confusingly similar to a trademark or service mark in which Complainant has rights.

Here, Complainant has acknowledged that it has no registered trademark rights in the names “Sheldon Solow” or the “Solow Foundation”. It moreover states that “Complainant has no website or online presence.”

While there is no dispute that the Domain Names are identical to these names, the question thus is focused on whether or not Complainant has common law rights in either of them.

In this case, although Complainant has emphasized the notoriety of the late Sheldon Solow as a real estate developer, art collector and philanthropist, Complainant has failed to provide evidence that Mr. Solow's name, or the name of the Solow Foundation, have been used in a trademark manner – that is, as distinctive identifiers which consumers would associate with any good or services offered by Mr. Solow (or the Solow Foundation) – so as to give rise to common law trademark rights in either name. Complainant has not argued, for example, that Mr. Solow acquired trademark rights in his name through its use in the real estate development business or on a building in New York, nor has Complainant suggested that the Solow Foundation has offered any goods or services such that the name would have acquired common law rights. The Panel simply has no evidence on which to make a finding of common law rights in either name.

As stated in section 1.5.2 of [WIPO Overview 3.0](#):

“The UDRP does not explicitly provide standing for personal names which are not registered or otherwise protected as trademarks. In situations however where a personal name is being used as a trademark-like identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant's goods or services.

Merely having a famous name (such as a businessperson or cultural leader who has not demonstrated use of their personal name in a trademark/source-identifying sense), or making broad unsupported assertions regarding the use of such name in trade or commerce, would not likely demonstrate unregistered or common law rights for purposes of standing to file a UDRP complaint.”

See, e.g., *Margaret C. Whitman v. Domains For Sale*, WIPO Case No. [D2008-1534](#) (finding that the former president and CEO of eBay, Inc. – “a publicly traded company valued at approximately USD 46 billion, with over 15,000 employees worldwide and more than 248 million registered users” – did not establish rights in her name because “fame alone is not sufficient to establish common law trademark or service mark rights in a personal name. Rather, the Complainant's personal name must be used such that a relevant segment of the public comes to recognize her name as a symbol that distinguishes her services from those of similarly situated service providers”).

The Panel's ruling that Complainant has failed to provide evidence of common law rights in Mr. Solow's name or the name of the Solow Foundation, is further fortified by the unrebutted evidence that the Foundation has changed its name from the “The Solow Art & Architecture Foundation” to “The Soloviev Foundation”.

Accordingly, the Panel concludes in the circumstances of this case that Complainant has failed on the record to demonstrate common law rights in the Sheldon Solow name and the name of the Solow Foundation. Accordingly, the Panel finds that Complainant has in this case failed to satisfy the requirements of paragraph 4(a)(i) of the Policy.

Because Complainant bears the burden of proving each of the elements under paragraph 4(a) of the Policy, it is unnecessary for the Panel to consider Complainant's arguments under paragraphs 4(a)(ii) and 4(a)(iii) for purposes of this decision.

However, the Panel notes its disagreement, as has also been expressed in a number of prior cases, with Respondent on the point of whether the Domain Names – which are identical to the name of Mr. Solow and the Solow Foundation – would qualify under a parody exception had Complainant established any relevant trademark rights.

[WIPO Overview 3.0](#), section 2.5.1 provides in relevant part: “[g]enerally speaking, UDRP panels have found that domain names identical to a complainant’s trademark carry a high risk of implied affiliation. Even where a domain name consists of a trademark plus an additional term (at the second- or top-level), UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner.”

The Panel finds that in this case, the Domain Names effectively impersonate Mr. Solow and his foundation, although Complainant has failed to establish any relevant trademark rights.

See *Dover Downs Gaming & Entertainment, Inc. v. Domains by Proxy, LLC / Harold Carter Jr, Purlin Pal LLC*, WIPO Case No. [D2019-0633](#) (“Significantly, the [WIPO Overview 3.0](#)’s impersonation test does not bar registrants from using a domain name that contains a trademark plus an additional, distinguishing term. Registrants remain free to select such a domain name so long as the domain name makes clear that the registrant is not affiliated with or authorized by the trademark holder.”); *GitHub, Inc. v. Privacy Service Provided by Withheld for Privacy ehf / Ahmed Kamel*, WIPO Case No. [D2022-3512](#) (panel concludes that respondent has impermissibly taken advantage of complainant’s interests in its GITHUB mark because the domain names effectively impersonate or at least suggest sponsorship or endorsement by the complainant. The panel also disagreed with the view that UDRP cases involving two parties, both of whom are located in the US, should provide the basis for the US single-country exception to the broader consensus view that national law should not be an element in determining “fair use” under the criteria set forth as to rights or legitimate interests under the second element of the Policy). Concerning the question of parody, the Panel agrees with the statement in *A & F Trademark, Inc. and Abercrombie & Fitch Stores, Inc. v. Justin Jorgensen*, WIPO Case No. [D2001-0900](#): “In the context of domain names, the domain name itself, without reference to the content of the web site, must convey both of these separate messages.” See also *Cyveillance, Inc. v. Mr. Kumar Patel*, WIPO Case No. [D2006-0346](#) (“While use of the mark of another in a domain name that parodies the owner of the mark is not inappropriate *per se*, it is usual, or at least desirable, that such domain names connote parody or criticism and do not simply use the mark without qualification.”).

See also *Gun Safety Action Fund, Inc. v. Contact Privacy Inc. Customer 1249561463 / Steve Coffman*, WIPO Case No. [D2022-0473](#) (“Gun Safety”), and *SwissCare Europe v. michael click, Active OutDoors LLC*, WIPO Case No. [D2022-1496](#) “SwissCare”).

Ultimately, the failure of the Complainant to satisfy the first element renders any application of the impersonation test moot.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: February 23, 2023