

## **ADMINISTRATIVE PANEL DECISION**

Sandals Resorts International 2000 Inc. v. Joey Naber  
Case No. D2023-0674

### **1. The Parties**

The Complainant is Sandals Resorts International 2000 Inc., Panama, represented by Dechert LLP, United Kingdom.

The Respondent is Joey Naber, United States of America (“United States”), represented by Dan Cera, Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <sandels.com> is registered with GoDaddy.com, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 14, 2023. On February 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name, which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 15, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on February 20, 2023.

The Center verified that the Complaint together with the amended 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 the Respondent of the Complaint, and the proceedings commenced on February 21, 2023. On March 13, 2023, the Center received the Respondent’s request for an extension of time under paragraph 5(b) of the Rules. In accordance with the Rules, paragraph 5 and the granting of that request, the due date for Response was March 17, 2023. The Response was filed with the Center by email dated March 16, 2023.

The Center appointed Warwick A. Rothnie as the sole panelist in this matter on March 27, 2023. 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 Complainant has been operating a holiday business under the brand “Sandals” since the mid-1980s.

It now has 24 properties in eight countries across the Caribbean, including 17 luxury resorts. It is particularly well-known for its all-inclusive pricing and has been named the World’s Leading All-Inclusive Company for the last 29 years by the World Travel Awards, amongst others. It was also awarded Best All-Inclusive Holiday Company at the British Travel Awards in 2018, and has been named in USA Today’s ‘10 Best Readers’ Choice Awards’ in 2017 and 2020, and has numerous ‘Six Star Diamond Awards’ from the American Academy of Hospitality Sciences.

According to the Complaint, the Complainant has promoted its services under the “Sandals” brand extensively including across the United States, the United Kingdom and the European Union. The Response expressly acknowledges that the Complainant’s brand is famous.

The Complaint includes evidence that the Complainant has numerous registered trademarks for SANDALS. These include (in block capitals) United States Registered Trademarks:

- (a) No. 1,614,295 which was registered on September 18, 1990, in respect of a range of services in International Classes 39 and 42.; and
- (b) No. 2,054,532 which was registered on April 22, 1997, in respect of a range of goods in International Classes 16, 18 and 25.

The block capitals mark is also registered in Canada and Mexico. An italicized or script version is registered in Australia, the European Union, India, Turkey and the United Kingdom.

The disputed domain name was first registered on March 27, 2008. However, the Respondent became the holder of the disputed domain name through a public auction for USD 1614.00 on January 8, 2023.

Prior to January 8, 2023, the disputed domain name resolved at various times to webpages offering pay-per-click (“PPC”.) advertising for services not associated with the Complainant. Since January 8, 2023, the disputed domain name has resolved to a parking page provided by the Registrar:

“sandels.com is parked free, courtesy of GoDaddy.com.”

“Get this domain.”

Then follow three PPC links: “All Inclusive”, “Vacation Deals” and “Vacation Packages”. These apparently link through to hotels and resorts which are not associated with the Complainant.

If one clicks on the “Get this domain” link, one is taken to GoDaddy’s Domain Broker Service which states “sandels.com is taken”. “We might still be able to get it for you.” After promotional material explaining how the broker services works, the page lists numerous other possible “sandels” domains available for registration.

The Respondent in addition to being the registrant of the disputed domain name is a professional actor and also appears to operate as a real estate agent or developer of some sort. He has been credited with roles in

numerous Hollywood films and television shows including “Executive Decision”, “The Siege”, and “Three Kings” and episodes of, amongst others, “Las Vegas,” “ER,” “Charmed” and “JAG”.

In 2005, the Respondent played the role of “Ahmed” in the film “West Bank Story” which was released in 2007, and was awarded the Oscar for Best Live Action Short Film that year. The director of the film was Ari Sandels.

## 5. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest the Respondent of the disputed domain name, the Complainant must demonstrate each of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

### A. Identical or Confusingly Similar

The first element that the Complainant must establish is that the disputed domain name is identical with, or confusingly similar to, the Complainant’s trademark rights.

There are two parts to this inquiry: the Complainant must demonstrate that it has rights in a trademark at the date the Complaint was filed and, if so, the disputed domain name must be shown to be identical or confusingly similar to the trademark.

The Complainant has proven ownership of at least the registered trademarks for SANDALS referred to in section 4 above.

In this case, it is appropriate to disregard the “.com” generic Top Level Domain (gTLD) component as a functional aspect of the domain name system. See *e.g.* WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.11. Accordingly, the disputed domain name consists of the Complainant’s trademark with the letter “e” replacing the second letter “a”. This kind of “misspelling” readily qualifies as confusing similarity under the Policy. See *e.g.* [WIPO Overview 3.0](#), section 1.9.

The Respondent contends, however, that there is no evidence of confusion other than two Google searches for “sandels” which returned an advertisement for the Complainant’s services but did not include any results for the Complainant in the organic results on the first page. The organic results being links to footwear sites.

The Respondent also points out that, unlike other decisions in the Complainant’s favour, the disputed domain name does not include qualifiers that promote confusion such as “hotels” or “resorts”. Further, the Respondent points out that “Sandels” is a surname with a significant number of people with that name listed on LinkedIn (182 results) or in the “411.com” service (100+ records in California alone).

The Respondent’s arguments, however, misunderstand the nature of the test under the first element required by the Policy. This stage of this inquiry simply requires a visual and aural comparison of the disputed domain name to the proven trademarks. This test is narrower than and thus different to the

question of “likelihood of confusion” under trademark law. Therefore, questions such as the scope of the trademark rights, the geographical location of the respective parties and other considerations that may be relevant to an assessment of infringement under trademark law are not relevant at this stage. Such matters, if relevant, may fall for consideration under the other elements of the Policy. See e.g. [WIPO Overview 3.0](#), section 1.7.

Accordingly, the Panel finds that the Complainant has established that the disputed domain name is confusingly similar to the Complainant’s trademark and the requirement under the first limb of the Policy is satisfied.

## **B. Rights or Legitimate Interests**

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant. Panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is usually sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden will shift to the respondent to rebut that *prima facie* case. The ultimate burden of proof, however, remains with the Complainant. See e.g., [WIPO Overview 3.0](#), section 2.1.

The Respondent registered the disputed domain name long after the Complainant began using its trademark and also well after the Complainant had registered its trademark.

The Complainant states that it has not authorised the Respondent to use the disputed domain name. Nor is the Respondent affiliated with it.

The disputed domain name is not derived from the Respondent’s name. Nor is there any suggestion of some other name by which the Respondent is commonly known from which the disputed domain name could be derived. From the available record, the Respondent does not appear to hold any trademarks for the disputed domain name.

The use of the disputed domain name to resolve to a parking page which seeks to generate revenue through PPC links trading on the Complainant’s trademark and reputation does not qualify as a legitimate noncommercial or fair use for the purposes of paragraph 4(c)(iii) of the Policy.

These matters, taken together, are sufficient to establish a *prima facie* case under the Policy that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent admits that he was aware of the Complainant and its brand, if not the fact of its trademark registrations, before he registered the disputed domain name. He says, however, that played no role in his decision to register the disputed domain name.

Instead, the Respondent says he was browsing through GoDaddy one day and came across the pending auction for the disputed domain name. He thought it would make a good gift for his friend, Ari Sandels. The Respondent telephoned Mr Sandels and asked him if he would be interested in owning the disputed domain name. According to the Respondent, Mr Sandels was thrilled at the prospect. So the Respondent committed to the purchase and was successful.

Although he was successful in the auction, the Respondent has not transferred the disputed domain name to Mr Sandels. According to the Respondent, however, GoDaddy prohibits a new registrant from transferring the domain name for 60 days following registration. See paragraph 3 of the page Transfer my domain away from GoDaddy available at “[godaddy.com/help/transfer-my-domain-away-from-godaddy-3560](https://godaddy.com/help/transfer-my-domain-away-from-godaddy-3560)”. When the Complaint was filed leading to the imposition of a Registrar lock, the Respondent had been the registrant for only 35 days. As the Respondent says, therefore, there was not time for him to transfer the disputed domain name.

Moreover, Annex 9 to the Response is an email from Mr Sandels to the Respondent in reply to an email from the Respondent informing Mr Sandels about the Complaint in which Mr Sandels wrote “so I am not going to get my name? Appreciate you trying”. While this exchange is after the filing of the Complaint, it does lend some objective support to the Respondent’s claim.

In these circumstances, the Panel cannot simply reject the Respondent’s explanation for registering the disputed domain name. Given the apparently longstanding relationship between the Respondent and Mr Sandels, it is not inherently implausible.

The only objectively contradictory evidence is the parking page provided by the Registrar. (There is no evidence linking the Respondent with the way the disputed domain name was used before January 8, 2023.) The Respondent does say this was done without his knowledge or agreement. The Respondent also points out that he has not paid GoDaddy to participate in its Cash Parking program. Nor did he set the DNS to the settings required to participate in that program.

Generally, however, a registrant is responsible for the use which a registrar makes of a domain name unless the registrant can point to efforts to suppress targeting a trademark owner. See e.g. [WIPO Overview 3.0](#), section 2.9. That would usually be the case where, as Annex 9 to the Response indicates, the Respondent appears to engage in investing in domain names.

While this is a consideration against acceptance of the Respondent’s position, the Panel considers it is outweighed in this case by the short period of the registration in the Respondent’s name and the restriction on transfer to Mr Sandels as claimed by the Respondent.

In proceedings of this nature, which are proceedings on the papers only, the Panel considers it inappropriate to go behind the Respondent’s explanation in the circumstances of this case.

Mr Sandels plainly qualifies as someone who can claim to be known by the name “Sandels” and so within the terms of paragraph 4(c)(ii) of the Policy. He is not the registrant. The fact that the Respondent appears on the record in this case to have acted as Mr Sandels’ agent as it were, however, does not preclude reliance on this ground. Domain names are often registered for companies and individuals by nominees or persons acting on their behalf.

Accordingly, the Panel finds the Respondent has rebutted the *prima facie* case that he (through Mr Sandels) does not have rights or a legitimate interest in the disputed domain name. Therefore, the Complainant has failed to establish the second requirement under the Policy.

**C. Registered and Used in Bad Faith**

As the Complaint must fail, no good purpose would be served by considering this requirement.

**6. Decision**

For the foregoing reasons, the Complaint is denied.

*/Warwick A. Rothnie/*

**Warwick A. Rothnie**

Sole Panelist

Date: April 10, 2023