

KTAV Publishing House, Inc. v. Moshe Menasheof

IL-DRP Panel Decision

1. The Parties

The Complainant is KTAV Publishing House, Inc. of New Jersey, United States of America, represented by Joseph B. Gelleman, of Israel.

The Respondent is Moshe Menasheof, of Tel Aviv, Israel.

2. The Domain Name and Registrar

The disputed domain name is <ktav.co.il> is registered with LiveDns Ltd.

3. Procedural History

The Complaint was filed with ISOC-IL on October 26th, 2011. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On November 1st, 2011 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on November 1st, 2011, the Panel transmitted to the Respondent by e-mail a copy of the Complaint and attached materials, providing the Respondent 15 days to respond to the Complaint.

The Respondent did not submit a Response to the Complaint.

4. Factual Background

The disputed domain name was registered by the Respondent on August 26, 2007.

The Complainant was founded in 1925 under the name Ktav and was incorporated under the laws of New York in 1956 under the name KTAV Publishing House, Inc.

The Complainant engages in publishing of Jewish Materials. The Complainant publishes each year approximately 2,000 distinct titles.

The Complainant also has a business in the Israeli market. The Complainant maintains a business relationship with several Israeli bookstores, authors and other entities. The Complainant also sells its books to Israeli consumers via its official website.

The Complainant owns United States trademark registration No. 2338272 - KTAV, with the registration date of April 4, 2000.

The Complainant had also registered Israeli trademark registration No. 40352 with the registration date of October 21, 1979. However, the Complainant's Israeli trademark registration was cancelled on August 11, 1996 due to non-payment of renewal fees.

The Complainant operates its official website under the domain name <ktav.com>.

On September 18, 2011, the Complainant's attorney sent the Respondent a cease and desist letter, requesting that the Respondent to transfers the disputed domain name to the Complainant. The Respondent did not reply to the Complainant's letter.

The disputed domain name currently resolves to the website of the Israeli publishing company – Ktav web publishing Ltd. (hereinafter: "**the Company**")

According to the website under the disputed domain name "*Ktav Publishing House is a unique enterprise seeking to combine the advantages of creative writing sites and online publishing with those of conventional publishing.*"

5. Parties' Contentions

A. Complainant

The Complainant further argues that the disputed domain name is identical to the Complainant's trademark.

The Complainant argues that it did not license, sold, transferred or in any way authorize the Respondent to use the Ktav trademark.

The Complainant argues that it and its KTAV trademark are recognized globally and the Ktav trademark is uniquely identified with the Complainant. The Complainant further contends that it had established common law rights in its Ktav trademark.

The Complainant further argues that the disputed domain name causes consumer confusion.

The Complainant further argues that the Respondent has no rights in the name "Ktav" as the registered trademark Complainant's and company name trademark predates the allocation of the disputed domain name and registration of the Company with the Israeli Company Registrar.

The Complainant further argues that the Respondent was aware of the Complainant when registering the disputed domain name, and has done so in order to rely on the Complainant's vast goodwill in the Ktav mark.

The Complainant further argues that the fact that the Respondent is referring to the Company by the Complainant's name – Ktav publishing house (in Hebrew and in English), instead of the Company's actual name - Ktav web publishing Ltd, demonstrates the Respondent's bad faith.

The Complainant further argues that the Respondent registered the disputed domain name in bad faith, trying to attract for commercial gain Internet users by creating a likelihood of confusion with the Complainant.

For all of the above reasons, the Complainant request the transfer of the disputed domain name.

B. Respondent

The Respondent did not file a formal Response.

6. Discussion and Findings

The IL-DRP is an alternative dispute resolution procedure intended to provide expedited resolution to disputes regarding the allocation of Domain Names under the .IL ccTLD in accordance with the Rules. Respondent submitted to this process and Rules when he applied for and registered the disputed domain name. The LiveDNS Domain Name Registration Agreement provides that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See Section 12.3; see also section 13 - <https://domains.livedns.co.il/Terms.aspx>). Respondent, therefore, by applying for and registering the disputed domain name agreed to the IL-DRP and the Rules.

It is also noted that the Rules now adopted by ISOC-IL follow closely those of the Uniform Dispute Resolution Policy (UDRP) and therefore the WIPO Arbitration and Mediation Center case law (and others interpreting the UDRP) can be used as examples of how previous panels have adopted and interpreted provisions similar to the Rules and UDRP.

The Rules provide that disputes regarding the allocation of a domain name by a Holder may be brought by a Complainant on the following grounds:

- 3.1. the disputed domain name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("**Name**") of the Complainant; and
- 3.2. the Complainant has rights in the Name; and
- 3.3. the holder has no rights in the Name; and
- 3.4. the application for allocation of the disputed domain name was made or the disputed domain name was used in bad faith.

A. Same or Confusingly Similar

It is up to the Complainant to show that the disputed domain name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration of the complainant.

The disputed domain name comprises of the word "Ktav" and the suffix .co.il. The suffix .co.il is ignored for the purpose of determination the similarity between the disputed domain name and the word "Ktav" since it is a common suffix showing that

the domain name is part of the .il domain and associated with commercial activities (.co suffix). The relevant part of the disputed domain name is the word "Ktav".

The Complainant owns United States trademark registration No. 2338272 - KTAV, with the registration date of April 4, 2000.

It is therefore the finding of the Panel that the disputed domain name is identical to a trademark owned by the Complainants.

B. Rights in the Name

Next, it is up to the Complainant to show that the Complainant has rights in the name "Ktav"; and that the Respondent has no rights in the name "Ktav".

As noted above the Complainant showed sufficient evidence showing it has rights in the Ktav trademark. However, it is also up to the Complainant to show that the Respondent has no rights in the Name.

While the Complainant bears the "general burden of proof" under Rule 3.3, this burden shifts to the Respondent once the Complainant makes a prima facie showing that the Respondent lacks rights or legitimate interests. (See: Neusiedler Aktiengesellschaft v. Kulkarni, WIPO Case No. D2000-1769; see also Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited, WIPO Case No. D2000-0704.)

The Complainant provided that it has not approved for the Respondent to use its trademark or Name. The Complainant also sent the Respondent a cease and desist letter, which remained unanswered.

Despite the fact that the Respondent did not submit any formal Response, it is the Complainant who bears the ultimate burden of establishing that the Respondent has no rights or legitimate interests with respect to the domain name. In this case, the Panel is unable to conclude that the Complainant has met its burden under Rule 3.3. This finding is also based on the following, non-disputed facts:

- a. The disputed domain name clearly reflects the company name that is associated with the Respondent. This fact itself can suggest that the Respondent has rights or legitimate interests in the disputed domain name. (See: Ken's Foods Inc. v. Kens.com, WIPO Case No. D2005-0721; Penguin Books Limited v. The Katz Family and Anthony Katz, WIPO Case No. D2000-0204).
- b. The disputed domain name is a generic word. The definition of the word "Ktav" in Hebrew is: handwriting, writing, calligraphic; script or document. This term is generic for a publishing company, and an appropriate name for such a web-site. The use of a generic word for the services offered by the Respondent, which is in fact a publishing house, is not prohibited under the Rules (See: Tightrope Media Systems Corporation v. DomainCollection.com, WIPO Case No. D2006-0446).

Because there is a direct connection between Respondent's name and services and the disputed domain name, and due to the fact that the Complainant has not submitted other evidence showing that Respondent's website is a mere pretext or that the Respondent otherwise exhibited conduct showing that it lacks a legitimate interest in the disputed

domain name, the Complainant has not succeeded in proving that Respondent lacks any rights or legitimate interests in the disputed domain name.

Application and Use in Bad Faith

Having decided that the Respondent has a legitimate interest in the disputed domain name, this must conclude that the Complaint must be refused and it is not necessary to proceed to consider whether the disputed domain name has been registered and is being used in bad faith.

7. Decision

For all the foregoing reasons, the Complaint is denied.



Jonathan Agmon
Sole Panelist

Date: December 7, 2011.