

Wikimedia Foundation Inc. v. Oren Shatz

IL-DRP Panel Decision

1. The Parties

The Complainant is Wikimedia Foundation Inc., of California, USA, represented by Douglas M. Isenberg, USA.

The Respondent is Oren Shatz, of Or Yehuda, Israel.

2. The Domain Name and Registrar

The disputed domain name <Wikipedia.co.il> is registered with InterSpace Ltd.

3. Procedural History

The Complaint was filed with ISOC-IL on November 17, 2010. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On November 24, 2010 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on December 5, 2010, the Panel transmitted by e-mail to the Respondent 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 July 30, 2007.

The Complainant is a nonprofit organization dedicated to the distribution of free multilingual content. Among others, the Complainant operates the renowned Wikipedia website under the domain name <Wikipedia.org>, which is the fourth most visited website in the world ("**Wikipedia website**"). Wikipedia is a web-based collaborative multilingual encyclopedia project, which currently contains over 17 million articles written in various languages, among them, over 110,000 articles in the Hebrew language.

The Complainant was established by Jimmy Wales in 2003, two years after creating the Wikipedia website.

The Complainant has been using the mark WIKIPEDIA since the establishment of the Wikipedia website in 2001.

The Complainant is the owner of numerous trademark registrations for the mark WIKIPEDIA worldwide. For example: International trademark registration No. 839132, with the registration date of September 16, 2004, designated to the European Union and Japan; United States trademark registration No. 3505429 – WIKIPEDIA, with the registration date of September 23, 2008, and United States trademark registration No. 3040722 – WIKIPEDIA logo, with the registration date of January 10, 2006.

The Complainant is also the owner of Israeli trademark registration No. 203988 – WIKIPEDIA, with the Registration date of September 7, 2009, and Israeli trademark registration No. 203992 – WIKIPEDIA, with the registration date of September 7, 2009.

In addition, the Complainant owns a considerable number of domain names bearing the mark WIKIPEDIA. For example: <wikipedia.com> and <wikipedia.net> that were registered by the Complainant on January 12, 2001; <wikipedia.org>, which was registered by the Complainant on January 13, 2001; and many others.

The disputed domain name currently resolves to a website which is similar in appearance to the Hebrew version of the Complainant's Wikipedia website and contains a search engine directing to articles on the Complainant's Wikipedia website.

The website operating under the disputed domain name contains an announcement stating that it is a mirror website that is provided as a public service.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is identical to its registered WIKIPEDIA trademark.

The Complainant further argues that it has gained rights in its WIKIPEDIA trademark due to registration of the WIKIPEDIA trademark worldwide, among them in Israel, and by the Complainant's use of the WIKIPEDIA mark since the year 2001.

The Complainant further argues that WIPO Panels had recognized its right in the WIKIPEDIA trademark.

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

The Complainant further argues that the Respondent did not make any preparation to use the disputed domain name in connection with a *bona fide* offering of goods or services. The Complainant claims that operating a website under the disputed domain name, which is nearly identical to the Complainant's Wikipedia website, cannot constitute a *bona fide* offering of goods or services.

The Complainant further argues that the Respondent is not known by the name "Wikipedia" and did not acquire any rights of any kind in the WIKIPEDIA trademark.

The Complainant further argues that the Respondent acts in bad faith, trying to attract for commercial gain Internet users by creating a likelihood of confusion with the Complainant's WIKIPEDIA trademark as to the source, sponsorship, affiliation or endorsement of its website.

The Complainant further argues that the Respondent makes unauthorized use of the Complainant's logo on the website, operating under the disputed domain name.

The Complainant further argues that in light of the fame of the Complainant's trademark, it is likely that the Respondent registered the disputed domain name with knowledge of the Complainant, in order to gain commercial benefit.

Finally, the Complainant argues that the Respondent's use of a disclaimer on his website does not eliminate bad faith by the Respondent.

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

B. Respondent

The Respondent did not reply to the Complaint.

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. The Respondent submitted to this process and Rules when he applied for and registered the disputed domain name. The InterSpace domain name registration agreement provides that the applicant for the domain name accepts the ISOC-IL registration rules (see section B(1) on http://www.internic.co.il/domain_agreement.htm, which also provides a link to the ISOC-IL registration rules). The ISOC-IL registration rules provide that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See section 24.4). The 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 wikipedia 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 wikipedia 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 wikipedia.

The Complainant is the owner of numerous registered trademarks, covering the mark WIKIPEDIA. For example: International trademark registration No. 839132, with the registration date of September 16, 2004, designated to the European Union and Japan; U.S. trademark registration No. 3505429 – WIKIPEDIA, with the registration date of September 23, 2008; U.S. trademark registration No. 3040722 – WIKIPEDIA logo, with the registration date of January 10, 2006; and many others.

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

B. Rights in the Name

Next, it is up to the Complainant to show that the Complainant has rights in the WIKIPEDIA trademark; and that the Respondent has no rights in the WIKIPEDIA trademark.

As noted above the Complainant showed sufficient evidence showing it has rights in the WIKIPEDIA trademark. Furthermore, the complainant's well established rights in its trademark were asserted by WIPO Panels (See, *inter alia*: Wikimedia Foundation Inc. v. Kevo Ouz a/k/a Online Marketing Realty, WIPO Case No. D2009-0798).

It is also up to the Complainant to show that the Respondent has no rights in the Name. Complainant has provided that it has not approved for the Respondent to use its trademark or Name.

While the Complainant bears the "general burden of proof" under Rule 3.3, this burden shifts to the Respondent once 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.)

In this case the Panel finds that the Complainant has made a prima facie showing that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of Rule 3.3. This finding is based on the following, non-disputed facts brought forward by the Complainant:

- a. The Complainant has no relationship whatsoever with the Respondent and has not authorized the Respondent to use the disputed domain name;
- b. It can be assumed that the Complainant's trademark is well known, as the complainant's Wikipedia website has received vast goodwill throughout the world as a source of free, multilingual content;
- c. The Complainant is the owner of numerous worldwide trademark registrations, including two Israeli trademark registrations. Some of those trademark registrations were registered well before the Respondent allocated the disputed domain name;
- d. The Respondent is using the website operating under the disputed domain name to direct users to the Complainant's Wikipedia website. Such use was decided by WIPO Panels not to constitute a bona fide use (See: eDreams, Inc. v. Choi Polo, WIPO Case No. D2009-1509); and
- e. There is no indication in the file that the Respondent is known under the disputed domain name.

It is therefore the finding of the Panel that the Complainant has rights in the WIKIPEDIA trademark and that the Respondent has no rights in the WIKIPEDIA trademark.

C. Application and Use in Bad Faith

Finally, it is up to the Complainant to show that the Respondent applied for allocation of the disputed domain name or the disputed domain name was used in bad faith.

WIPO panels, relying on Rule 4.1 of the UDRP Rules, ruled that the bad faith clause provides a non-exclusive list of circumstances which can be helpful in showing that the Respondent acted in bad faith when he or she applied for or used the disputed domain name:

"For the purposes of [Paragraph 3.4 above], the following circumstances, in particular but without limitation, if found to be present, shall be evidence of the allocation or use of a domain name in bad faith:

- a. the Holder continues to hold the domain name during or after termination of employment or work for hire contract where the domain name allegedly should have been allocated to the employing/contracting party; or
- b. the Holder has requested allocation of the domain name primarily for the purpose of disrupting the business of a competitor; or circumstances indicating that the Holder has requested allocation or holds the Domain Name primarily for the purpose of selling, renting, or otherwise transferring the Domain Name allocation to the complainant who is the owner of the trademark or service mark or to a competitor

of that Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or

- c. the Holder has requested allocation of the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that there is evidence of having engaged in a pattern of such conduct; or
- d. by using the domain name, the Holder has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's Name as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location".

Rule 4.1(b) provides that this Panel can find that the Respondent acted in bad faith if there are circumstances showing that the Respondent requested allocation of the disputed domain name primarily for the purpose of disrupting the business of a competitor; or circumstances indicating that the Respondent requested allocation or holds the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name allocation to the Complainant, who is the owner of the trademark or the service mark, or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name.

The disputed domain name is identical to the Complainant's trademark. Previous WIPO panels ruled that "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site" (see Edmunds.com, Inc v. Triple E Holdings Limited, WIPO Case No. D2006-1095). To this end, prior WIPO Panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark is evidence of bad faith under paragraph 4(b)(iv) of the UDRP (see Humana Inc., op. cit. supra; Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319).

Rule 4.1(d) provides that this Panel can find that the Respondent acted in bad faith if there are circumstances showing that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's Name as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

It is suggestive of the Respondent's bad faith when the trademark of the Complainant was registered before the allocation of the disputed domain name (See: Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). The Complainant's WIKIPEDIA trademark is registered since 2004 and has become well-known worldwide since the launch of the Wikipedia website in 2001. The Respondent registered the disputed domain name after the Complainant registered its WIKIPEDIA trademark.

The Respondent is using the website operating under the disputed domain name to direct consumers to articles located on the Complainant's Wikipedia website. The website operating under the disputed domain name displays the Complainant's trademark and logo, and appears to be visually similar to the Complainant's Wikipedia website. The Respondent is also using the website to present commercial ads directing users to commercial web sites which are not related or affiliated with the Complainant.

The Panel finds it nearly impossible to believe that the Respondent was not aware of the trademark WIKIPEDIA at the time he allocated the disputed Domain Name in July 30, 2007. The Complainant has been using the mark WIKIPEDIA since 2001. The Panel therefore finds that the Respondent requested the allocation of the disputed domain name in order to intentionally attempt to attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with the Complainant's Name as to the source, sponsorship, affiliation, or endorsement of its web site or location or of a product or service on its web site or location.

The fact that the Respondent had acknowledged on the website operating under the disputed domain name that it is a mirror website, is of no relevance in this matter, as such disclaimers do not eliminate the Respondent's bad faith (See: AARC Inc. v. Jayashankar Balaraman, WIPO Case No. D2007-0578).

Given these circumstances the Panel finds that that there are circumstances showing that the Respondent acted in bad faith as provided in Rule 4.1(b) and 4.1(d) thus, it is the finding of the Panel that the Complainant met the burden of showing that the Respondent used the disputed domain name in bad faith in accordance with Rule 3.4.

7. Decision

For all the foregoing reasons, in accordance with the Rules, the Panel orders that the domain name, <wikipedia.co.il> be transferred to the Complainant.



Jonathan Agmon
Sole Panelist

Date: January 9, 2011.