

Colgate-Palmolive Company v. Tal Eisenbaum

IL-DRP Panel Decision

1. The Parties

The Complainant is Colgate-Palmolive Company of New York, the United States of America, represented by Sanford T. Colb & Co., of Tel Aviv, Israel.

The Respondent is Tal Eisenbaum, of Had Nes, Israel.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with ISOC-IL on June 16, 2011. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On June 26, 2011 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on July 1, 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 January 5, 2011.

The Complainant is a publicly listed company. The Complainant was founded in 1806 and its main business is production and marketing of health care and personal products, such as soaps, detergents, and oral hygiene products.

The Complainant markets its products in more than 200 countries, employs more than 36,000 employees and has revenue of more than 15.3 Billion US dollars. The Complainant uses its PALMOLIVE mark to advertise and promote its products.

The Complainant owns numerous trademark registrations for the mark PALMOLIVE worldwide. For example: United States trademark registration No. 0113591 – PALMOLIVE, with the registration date of October 24, 1916; United States trademark registration No. 0205739 – PALMOLIVE (logo), with the registration date of November 17, 1925; Community trademark registration No. 000167122

– PALMOLIVE, with the registration date of October 20, 1998, and many more.

The Complainant also owns multiple Israeli trademark registrations. For example: Israeli trademark registrations No. 685 – PALMOLIVE (logo), with the Registration date of December 21, 1925; Israeli trademark registrations No. 6095 – PALMOLIVE, with the Registration date of August 11, 1944; Israeli trademark registrations No. 138399 – PALMOLIVE SPRING SENSATIONS (in Hebrew characters), with the Registration date of September 5, 2001; Israeli trademark registrations No.220339 – PALMOLIVE (logo - Hebrew characters), with the Registration date of March 6, 2011, and more.

In addition, the Complainant holds a considerable number of domain names bearing the mark PALMOLIVE. For example: <palmolive.com>, <palmolive.co.il>, <palmolive.net>, <palmolive.info>, and many similar others.

On March 28, 2011, the Complainant's attorney sent the Respondent a cease and desist letter, requesting that the Respondent refrain from using the PALMOLIVE mark and transfer the disputed domain name to the Complainant.

On March 29, 2011, the Respondent responded to the Complainant's cease and desist letter. In the response letter, the Respondent claimed that the word "Palmolive" became a generic word that represents blossoming and regeneration, which the Respondent wants to associate with his business.

On June 12, 2011, the Respondent contacted the Complainant's attorney, claiming that despite of the fact that the disputed domain name was registered in good faith, he agrees to transfer the disputed domain name to the Complainant, in exchange for compensation in the sum of 2,400 US Dollars.

The disputed domain name currently resolves to a parking webpage displaying the message "under construction".

5. Parties' Contentions

A. Complainant

The Complainant argues that its PALMOLIVE trademark is a well known trademark, as the term is defined under the Israeli law.

The Complainant further argues that as a result of the Complainant's extensive promotional activities, the public associates the PALMOLIVE trademark, in both English and Hebrew characters, with the Complainant.

The Complainant further argues that the Respondent has no intention of using the disputed domain name in good faith.

The Complainant further argues that the Respondent acted in bad faith when registering the disputed domain name. The Complainant contend that the Respondent registered the disputed domain name to make profit by associating the Complainant's vast goodwill in the PALMOLIVE mark to the Respondent's business, and by misleading the consumers to believe that there is a connection between the Complainant and the disputed domain name.

The Complainant further argues that the Respondent's demand to receive compensation for the release of the disputed domain name is a sign of his bad faith.

The Complainant further argues that the Respondent's allegation that the word "Palmolive" is a generic word is baseless.

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

The Complainant further argues that the Respondent's actions constitute various civil injustices.

The Complainant further argues that the Respondent had known of the Complainant and its use of the PALMOLIVE mark, when registering the disputed domain name.

The Complainant further argues that in his actions, the Respondent is misappropriating, diluting and harming the Complainant's goodwill in its PALMOLIVE trademark.

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 to the Complainant's contentions.

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 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 PALMOLIVE in Hebrew Characters 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 PALMOLIVE (in Hebrew characters) 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 PALMOLIVE (in Hebrew characters).

The Complainant owns trademark registrations for mark PALMOLIVE in Hebrew characters. For example: Israeli trademark registrations No. 138399 – PALMOLIVE SPRING SENSATIONS (in Hebrew characters), with the Registration date of September 5, 2001; Israeli trademark registrations No.220339 – PALMOLIVE (logo - Hebrew characters), with the Registration date of March 6, 2011, and more.

It should be noted that the Complainant also has numerous trademark registrations of the mark PALMOLIVE in English. For example: United States trademark registration No. 0113591 – PALMOLIVE, with the registration date of October 24, 1916; Israeli trademark registrations No. 685 – PALMOLIVE (logo), with the Registration date of December 21, 1925; Community trademark registration No. 000167122 – PALMOLIVE, with the registration date of October 20, 1998, and many more.

Previous WIPO and ISOC Panels have ruled that when the disputed domain name is a phonetic equivalent and a transliteration of the Latin characters of a complainant's well known trademark, it infringes the Complainant's rights in its well known trademark (see Reebok International Ltd. v. Uzi Cnaan, ISOC-IL Case; See also, Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation v. Liu Xindong, Case No. D2003-0408).

The disputed domain name is a phonetic equivalent and a transliteration of the Latin characters of the complainant's well known PALMOLIVE trademark.

It is therefore the finding of the Panel that the disputed domain name is identical to a trademark owned by the Complainant, at least since the year 1916.

B. Rights in the Name

Next, it is up to the Complainant to show that the Complainant has rights in the PALMOLIVE (in Hebrew characters) trademark; and that the Respondent has no rights in the PALMOLIVE (in Hebrew characters) trademark.

As noted above the Complainant showed sufficient evidence, showing it has rights in the PALMOLIVE (in Hebrew characters) trademark, at least since the year 1916.

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

While the Complainant bear 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.)

In this case the Panel finds that the Complainant 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. The Complainant provided sufficient evidence to prove that its trademark is well known. The complainant's PALMOLIVE trademark is used for the Complainant's products in numerous countries around the world, among them, in Israel. It is very difficult indeed to believe that the Respondent was unaware of the vast goodwill of the Complainant's trademark;
- c. The Complainant is the owner of numerous worldwide trademark registrations, including multiple Israeli trademark registrations. These trademark registrations were registered well before the Respondent requested and received the allocation of the disputed domain name;
- d. There is no indication in the file that the Respondent is known under the disputed domain name. Furthermore, the Respondent had recognized the Complainant's rights in the PALMOLIVE mark and agreed to transfer the disputed domain name, in exchange for compensation.

Having met the burden, the Panel finds that the Complainant has shifted the burden of proof to the Respondent. The Respondent failed to bring evidence to support any claim that he may have rights in the Name.

It is therefore the finding of the Panel that the Complainant has rights in the PALMOLIVE (in Hebrew characters) trademark and that the Respondent has no rights in the PALMOLIVE (in Hebrew characters) 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.

Previous 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.

It is undisputed that the Respondent offered to sell the disputed domain name to Complainant for 4,400 US Dollars, which is in excess of Respondent's out-of-pocket costs to register and maintain the disputed domain name. The fact that the Respondent offered to sell the domain name for amounts, which is considered as valuable consideration in excess of the Respondent's out of pocket costs directly related to the domain name indicate bad faith on behalf of the Respondent (see Merck KGaA v. Sunmeet Jolly, Case No. D2004-0195).

The Panel therefore finds that the Respondent registered the disputed domain name primarily for the purpose of selling the disputed domain name to the Complainant who is the owner of the trademark, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name.

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 clear from the Respondent's response to the Complainant's cease and desist letter that the Respondent intended to use the disputed domain name in connection with his own business. To this end, the Panel rejects the Respondent's claim that the word "Palmolive" is a generic word and may be used by the broad public. The Respondent did not support this claim with evidence. Also, the PALMOLIVE mark is a valid registered trademark and is a distinctive word.

Furthermore, the disputed domain name is confusingly similar to the Complainant's Israeli trademark, and is the exact Hebrew transliteration of the Complainant's PALMOLIVE worldwide registered PALMOLIVE 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, previous 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).

Another indication of the Respondent's bad faith arises of the fact that Complainant's trademark was registered well before the allocation of the disputed domain name (See: Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). The Complainant's PALMOLIVE trademark is registered in Israel since the year 1925. As stated above, the Complainant's PALMOLIVE trademark is well-known in Israel and throughout the world.

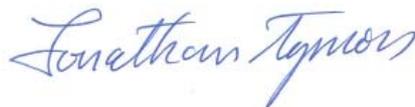
As noted, the Panel finds that it is highly unlikely that the Respondent was not aware of the Complainant's well-known trademarks at the time he allocated the disputed Domain Name.

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 mark as to the source, sponsorship, affiliation, or endorsement of its web site.

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, <פלמוליב.co.il> be transferred to the Complainant.



Jonathan Agmon
Sole Panelist

Date: August 1st, 2011.