

Gap Inc. and Gap (ITM) Inc. v. David Rahamim

IL-DRP Panel Decision

1. The Parties

The Complainants are Gap Inc. and Gap (ITM) Inc., of California, the United States of America, represented by Sanford T. Colb & Co., of Tel Aviv, Israel.

The Respondent is David Rahamim, of Jerusalem, Israel.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with ISOC-IL on February 28, 2011. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On March 6, 2011 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on March 6, 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.

On March 17, 2011, the Respondent submitted a response, in which he stated, among others, that he is willing to cancel the registration of the disputed domain name, under the condition that no further proceedings will be taken against him.

Later on March 17, 2011, the Panel had transmitted the Respondent's communication to the Complainants, for their response.

On March 28, 2011, the Complainants submitted their response to the Respondent's Response, and indicated that they are willing to settle the case under the condition that the disputed domain name be transferred to the Complainants and not cancelled.

4. Factual Background

The disputed domain name was registered by the Respondent on December 28, 2010.

The Complainants are a publicly listed company and its subsidiary. The Complainant 1 was founded in 1969. The Complainant 1 is a specialty retailer, offering clothing, accessories and personal care products for men, women, children and babies.

The Complainants products, bearing the GAP mark, are being sold in large quantities worldwide. The Complainants employ more than 130,000 employees around the world and invest substantial efforts and funds advertising the mark GAP.

The Complainants, themselves and by their subsidiaries, own numerous trademark registrations for the mark GAP worldwide. For example: United States trademark registration No. 1406870 - GAP, with the registration date of August 26, 1986; United States trademark registration No. 1576510 – GAP (logo), with the registration date of January 9, 1990, and Community trademark registration No. 000027201 – Gap (logo), with the registration date of May 22, 1998, and many more.

The Complainants also own of numerous Israeli trademark registrations. For example: Israeli trademark registrations No. 80071, 80072 and 80073 – GAP, with the Registration date of February 4, 1996; Israeli trademark registration No. 187643 – GAP (logo), with the registration date of August 6, 2007, and many more.

In addition, the Complainants hold a considerable number of domain names bearing the mark GAP. For example: <gap.com>, <gap.co.il>, <gapinc.com>, and similar others.

On February 2, 2011, the Complainants attorney sent the Respondent a cease and desist letter, requesting that the Respondent refrain from using the GAP mark and transfer the disputed domain name to the Complainants.

On February 9, 2011 the Respondent replied that he requires more time in order to form his response.

On February 16, 2011, the Complainants attorney sent the Respondent a reminder, stating that if the Respondent does not comply with the Complainants' demands in a few more days, the Complainants will act to enforce their rights. The Respondent did not respond to this reminder.

The disputed domain name currently resolves to a to an error page, which displays an announcement that the webpage is “Under construction”.

5. Parties' Contentions

A. Complainant

The Complainants argue that their GAP trademark is a well known trademark, as the term is defined under Israeli law, and that the Israeli trademark registrar had affirmed this assertion.

The Complainants further argue that the Complainants right in the GAP trademark was also recognized by a WIPO UDRP panel.

The Complainants further argue that the public associates the GAP trademark, in English and with Hebrew characters, with the Complainants and their products.

The Complainants further argue 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 Complainants' GAP trademark as to the source, sponsorship, affiliation or endorsement of its website.

The Complainants further argue that they did not license, sold, transferred or in any way authorize the Respondent to use their GAP trademark.

The Complainants further argue that the Respondents actions constitute various civil injustices.

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

B. Respondent

The Respondent stated in his Response that he is willing to cancel the disputed domain name. Nevertheless, the Respondent claims that he disagrees with the Complainants' assertions in the Complaint, specifically because the Complainants do not own a registered trademark for the word GAP in Hebrew characters.

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.

As stated above, the Respondent had consented to surrender the disputed domain name. Former WIPO and ISOC Panels have ruled that there are circumstances in which such consent by the Respondent gives rise for an immediate transfer of the disputed domain name without consideration of the elements of the respective Rules (see Williams-Sonoma, Inc. v. EZ-Port, WIPO Case No. D2000-0207; Wikimedia Foundation Inc. v. Adam Yohanan, ISOC-IL case).

However, in this case, the Respondent's Consent to cancel the registration the domain name was made while clearly opposing the Complainants claims to have rights in the disputed domain name. Furthermore, the Respondent did not explicitly agree to transfer the disputed domain name to the Complainants.

Under these circumstances, when there is doubt as to the genuineness of the Respondent's consent, the Panel finds it is necessary to proceed and consider whether the evidence provided by the Complainants satisfies the elements of the Rules (see Société Française du Radiotéléphone-SFR v. Karen, WIPO Case No. D2004-0386; Eurobet UK Limited v. Grand Slam Co, WIPO Case No. D2003-0745).

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 Complainants 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 GAP 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 GAP (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 GAP (in Hebrew characters).

The Complainants, themselves and by their subsidiaries, own numerous trademark registrations for the mark GAP worldwide. For example: United States trademark registration No. 1406870 - GAP, with the registration date of August 26, 1986; United States trademark registration No. 1576510 – GAP (logo), with the registration date of January 9, 1990, and Community trademark registration No. 000027201 – Gap (logo), with the registration date of May 22, 1998, and many more.

The Complainant is also the owner of numerous Israeli trademark registrations. For example: Israeli trademark registrations No. 80071, 80072 and 80073 – GAP, with the Registration date of February 4, 1996, Israeli trademark registration No. 187643 – GAP (logo), with the registration date of August 6, 2007, and many more.

Former 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 Complainants provided sufficient evidence that its GAP trademark is a well known trademark in Israel. Furthermore, גאפ is the way of transcribing the GAP mark from its

English characters to Hebrew characters. The two words are also pronounced identically in English and Hebrew.

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 Complainants to show that the Complainants have rights in the GAP (in Hebrew characters) trademark; and that the Respondent has no rights in the GAP (in Hebrew characters) trademark.

As noted above the Complainants showed sufficient evidence showing it has rights in the GAP (in Hebrew characters) trademark. Furthermore, the complainants' well established rights in its trademark were asserted both by a WIPO Panel decision (See, The Gap, Inc. v. YongHoon Lee, SofTech, WIPO Case No. D2007-0386) and by a decision by the Israeli Trademark Registrar (Opposition to the registration of trademark No. 150380 "EYES GAP").

It is also up to the Complainants to show that the Respondent has no rights in the Name. The Complainants have provided that they had not approved for the Respondent to use its trademark or Name.

While the Complainants bear the "general burden of proof" under Rule 3.3, this burden shifts to the Respondent once the Complainants 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 Complainants have 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 Complainants have no relationship whatsoever with the Respondent and has not authorized the Respondent to use the disputed domain name;
- b. The Complainants have provided sufficient evidence that their trademark is well known. Furthermore, the complainants' GAP trademark is displayed on various fashion cloths and accessories that are sold in vast quantities throughout the world in general, and specifically in Israel. It is very difficult indeed to believe that the Respondent was unaware of the vast goodwill of the Complainants trademark;
- c. The Complainants are the owners of numerous worldwide trademark registrations, including many Israeli trademark registrations. Most of those 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.

Having met the burden the Panel finds that the Complainants have shifted the burden of proof to the Respondent. The Respondent failed to bring any evidence to show that he has any rights in the Name. The Respondent's argument that the Complainants do not own a registered trademark for the word GAP in Hebrew characters does not in any way provide any proof or evidence that the Respondent himself has rights to the Name.

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

Application and Use in Bad Faith

Finally, it is up to the Complainants 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 the exact Hebrew transliteration of the Complainants well-known trademark. The public recognizes the Hebrew word for GAP with the Complainants, which in effect is nearly the same as the Complainants' GAP trademark, different only by the use of the different Hebrew characters. 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 Complainants was registered before the allocation of the disputed domain name (See: Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). The Complainants' GAP (in Hebrew characters) trademark is registered in Israel since at least since the year 1997. As stated above, the Complainants GAP trademarks are well-known in Israel and throughout the world. The Respondent registered the disputed domain name after the Complainant registered its GAP (in Hebrew characters) trademark.

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

Name in July 30, 2007. Supporting this deduction is the fact that the Respondent himself did not raise such claims in his Response.

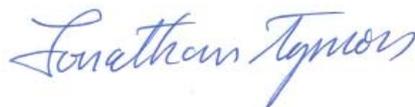
The Panel therefore finds that the Respondent requested the allocation of the disputed domain name in order to intentionally attempt to attract, for commercial gain, Internet users to its web site by creating a likelihood of confusion with the Complainants' Name as to the source, sponsorship, affiliation, or endorsement of its web site.

Furthermore, the Complainants provided as evidence the Cease and Desist letters addressed to the Respondent, which the Respondent failed to properly respond to. Previous Panels stated that "when receiving such notice, good faith requires a response." (Gaggia S.p.A. v. Yokngshen Kliang, WIPO Case No. 02003-0982) This Panel concurs with such reasoning and finds that Respondent's inaction shows lack of legitimate interest in the disputed domain name and lack of good faith in the registration and use thereof (See Carrefour and Carrefour Property v. MIC Domain Management, WIPO Case No. 02009-0489).

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 Complainants 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, <פּאָל.co.il> be transferred to the Complainants.



Jonathan Agmon
Sole Panelist

Date: April 3rd, 2011.