

**Marriott Worldwide Corporation and Marriott International, Inc. v.
Barak Gill**

IL-DRP Panel Decision

1. The Parties

The Complainants are Marriott Worldwide Corporation and Marriott International, Inc., of Maryland, United States of America, represented by Sanford T. Colb & Co., of Tel Aviv, Israel.

The Respondent is Barak Gill, of Tel Aviv, Israel.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with ISOC-IL on February 27, 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. The Respondent did not submit a Response to the Complaint.

4. Factual Background

The disputed domain name was registered by the Respondent on December 30, 2010.

The Complainants are a publicly listed company and its subsidiary. The Complainants were founded in 1927 and began offering services under the MARRIOTT mark since the year 1960. The Complainants are a worldwide operator and franchisor of a broad portfolio of hotels and related lodging facilities.

The Complainants operate hotels under the MARRIOTT mark all around the world. Furthermore, the Complainants offer services to millions of customers worldwide using the MARRIOTT mark. The Complainants employ more than 130,000 employees around the world and invest substantial efforts and funds in order to advertise and promote the MARRIOTT mark.

The Complainants own numerous trademark registrations for the mark MARRIOTT worldwide. For example: United States trademark registration No. 0899900–MARRIOTT, with the registration date of September 29, 1970; United States trademark registration No. 0947709 – MARRIOTT (logo), with the registration date of November 21, 1972; Community trademark registration No. 000144360 – MARRIOTT, with the registration date of October 15, 1998, and many more.

The Complainants also own of multiple Israeli trademark registrations. For example: Israeli trademark registrations No. 109402 – MARRIOTT (in both English and Hebrew characters), with the Registration date of December 24, 1996; Israeli trademark registrations No. 112852– MARRIOTT (in both English and Hebrew characters), with the Registration date of July 6, 1997, and more.

In addition, the Complainants hold a considerable number of domain names bearing the mark MARRIOTT. For example: <marriott.com>, <marriott.co.il>, <marriott.com.au>, <marriotthotels.com>, and many similar others.

On February 6, 2011, the Complainants attorney sent the Respondent a cease and desist letter, requesting that the Respondent refrain from using the MARRIOTT mark and transfer the disputed domain name to the Complainants.

The Respondent did not respond to the Complainants cease and desist letter.

The disputed domain name currently resolves to an error page.

5. Parties' Contentions

A. Complainant

The Complainants argue that their MARRIOTT trademark is a well known trademark, as the term is defined under the Israeli law.

The Complainants further argue that their MARRIOTT trademark became one of most recognized and famous trademark in the world, as a result of the Complainants extensive promotional activities.

The Complainants further argue that the MARRIOTT mark has gained vast goodwill and is associated with the Complainants by the public in Israel, and around the world.

The Complainants further argue that the Complainants right in the MARRIOTT trademark was also recognized by WIPO UDRP panels.

The Complainants further argue that the Respondent acted in bad faith when registering the disputed domain name. The Respondents contend that the Respondent registered the disputed domain name to make profit by attracting internet users to a website that will be built under the disputed domain name, by misleading the consumers to believe that there is a connection between the Complainants and the disputed domain name.

The Complainants further argue that the Respondent had known of the Complainants and their use of the MARRIOTT mark, when registering the disputed domain name.

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

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

The Complainants further argue that in his actions, the Respondent is misappropriating, diluting and harming the Complainants goodwill in their MARRIOTT trademark.

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

B. Respondent

The Respondent did not reply to the Complainants 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 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 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 MARRIOTT 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 MARRIOTT (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 MARRIOTT (in Hebrew characters).

The Complainants own multiple trademark registrations for mark MARRIOTT in Hebrew characters. For example: Israeli trademark registrations No. 109402 – MARRIOTT (in both English and Hebrew characters), with the Registration date of December 24, 1996; Israeli trademark registrations No. 112852– MARRIOTT (in both English and Hebrew characters), with the Registration date of July 6, 1997, and more.

It should be noted that the fact that these Israeli trademark registrations consist also of the MARRIOTT mark in English characters, similar to the Complainants worldwide registered MARRIOTT trademarks, has no significance in this matter. 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 complainants well known MARRIOTT trademark.

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 MARRIOTT (in Hebrew characters) trademark; and that the Respondent has no rights in the MARRIOTT (in Hebrew characters) trademark.

As noted above the Complainants showed sufficient evidence showing it has rights in the MARRIOTT (in Hebrew characters) trademark. Furthermore, the complainants' well established rights in its trademark were asserted by a WIPO Panel decision (See, Marriott International, Inc. v. Thomas, Burstein and Miller, WIPO Case No. D2000-0610).

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 or authorized for the Respondent to use the MARRIOTT 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. The complainants' MARRIOTT trademark is used in numerous countries around the world, among them, in Israel, for the Marriott hotels that Complainants operate. 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 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.

Having met the burden the Panel finds that the Complainants have 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 Complainants have rights in the MARRIOTT (in Hebrew characters) trademark and that the Respondent has no rights in the MARRIOTT (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.

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.

The disputed domain name is identical to the Complainants Israeli trademark, and is the exact Hebrew transliteration of the Complainants worldwide registered MARRIOTT 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).

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 well before the allocation of the disputed domain name (See: Sanofi-

Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). The Complainants' MARRIOTT (in Hebrew characters) trademark is registered in Israel since, at least the year 1996. Furthermore, the Complainants MARRIOTT trademark was registered, at least since the year 1970. As stated above, the Complainants MARRIOTT trademark is well-known in Israel and throughout the world. The Respondent registered the disputed domain name after the Complainant registered its MARRIOTT (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 December 30, 2010.

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

Furthermore, the Complainants provided as evidence a Cease and Desist letter 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 Kiang, 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 or 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, <מריוט.co.il> be transferred to the Complainants.



Jonathan Agmon
Sole Panelist

Date: April 10th, 2011.