

**Dispute Resolution Panel  
For the Internet Society of Israel**

**Ellen B. Shankman, Adv.**

**In the matter between**

**Reebok International Ltd.**

**(The "Petitioner")**

**Represented by Adv. Eitan Shaulsky et al.**

**And**

**Uzi Cnaan**

**(The "Respondent")**

**Regarding the domain name**

**ריבוק.co.il**

**(The "Domain Name")**

**DECISION**

**Procedural Background:**

The panel was established on 9 February 2011, in accordance with the Procedures for Alternative Dispute Resolution under the .IL ccTLD by Dispute Resolution Panels ("IL-DRP Procedures"), ([http://www.isoc.org.il/domains/ildrp\\_rules.html](http://www.isoc.org.il/domains/ildrp_rules.html)) (in English) and [http://www.isoc.org.il/domain\\_heb/ildrp\\_rules.html](http://www.isoc.org.il/domain_heb/ildrp_rules.html) (in Hebrew), in order to address the Petitioner's request to cancel the allocation of the Domain Name (ריבוק.co.il) to Respondent and to reallocate the Domain Name to the Petitioner.

Respondent was notified that a petition had been filed and both parties notified of the appointment of the Panelist. Confirmation of receipt of the notification was made in a telephone call to the Panelist by Respondent. The Panelist specifically

told the Respondent that he must file all concerns, including regarding Hebrew/English language issues, by response to the e-mail list provided by ISOC-IL for this dispute, and that I strongly encouraged him to file a response, since even if no response to this petition is filed, I would make a decision on the information presented *ex parte*. Further, in that same phone call, when Respondent tried to discuss the correspondence and contact that had been made between the parties directly, I explained that I was not the conduit for communications between the parties, who should try to resolve this directly with one another if possible, and that all further communications directed to me or in response to the Petition, be posted to the e-mail list. I reiterated my strong encouragement that a response or any other questions, objections or concerns be filed by the deadline.

Per Section 8.2 of the IL-DRP Procedures, either party may request that the dispute be reviewed by an extended panel within 7 days of the notification. Further, per Section 8.4 of the IL-DRP Procedures, either party may request exclusion of the appointed Panelist on the grounds of any potential conflict of interests. No such requests were made.

Further, per Section H of the IL-DRP Procedures, either party may request Court Review.

**“Section H. Right To Seek Court Review**

20. Petition to the IL-DRP in no way precludes access or petition to an Israel Court of Law.
21. Notwithstanding, should a party, in parallel, institute Court proceedings regarding a Domain Name during the proceedings of the IL-DRP, such petition to the Court shall not affect or stay the IL-DRP proceedings under these Rules, unless a court order regarding such be served on ISOC-IL.”

No such review was made that would affect or stay these IL-DPR proceedings.

The Panelist confirmed that the Petition and all correspondence thereto was posted by ISOC and e-mail sent to the address of the Holder in the records. Accordingly, since I am satisfied that the Respondent had specific notice, I am

taking my decision based on an assessment of the material presented in Petitioner's Petition.

**Petitioner's Arguments:**

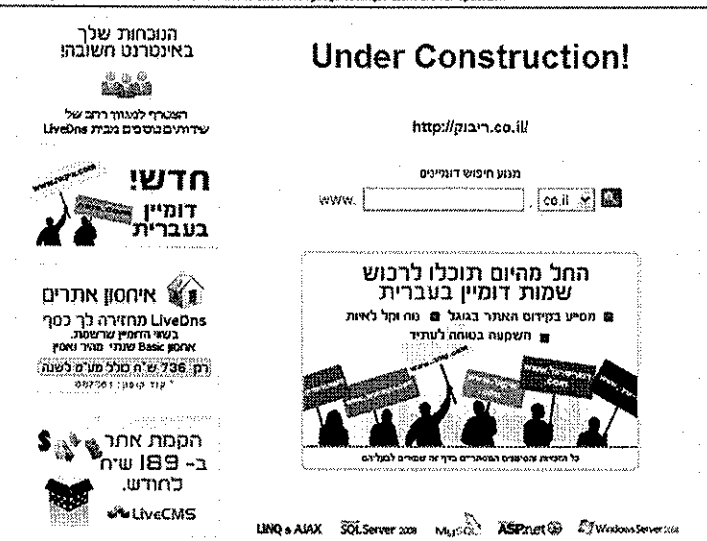
1. Reebok International Ltd. is a well known global sports company.
2. The Petitioner created the REEBOK brand. The Petitioner is the owner of the REEBOK® trademark (hereinafter the "Trademark"), which is registered in Israel as Trademark Nos. 58956, 64910, 68654, 215277, 215278, 215279 and 215280. Registration extracts can be found at <http://www.trademarks.justice.gov.il/TradeMarksWebSiteUI/TradeMarksSearch/TrademarksSearch.aspx>.
3. The Trademark is a well known trademark, as this term is defined in the law. Reebok has extensive, goodwill worldwide in the Trademark. A brief description of the history of Reebok can be found at [http://corporate.reebok.com/en/reebok\\_history/default.asp](http://corporate.reebok.com/en/reebok_history/default.asp).
4. By registering the Domain Name in his name, the Respondent infringed the Petitioner's proprietary rights, committed tortuous actions, prevented Reebok from registering the Domain name in its name and tried to become unjustly enriched at the expense of the Petitioner.
5. The Petitioner has invested extensive resources in advertising and increasing awareness of its products. This includes advertising campaigns in the media, support to famous athletes and more.
6. Reebok has accumulated extensive goodwill in the REEBOK® trademark. The public is familiar with the Trademark and it holds the Trademark in high esteem. The public associates the Trademark (in Hebrew characters as well) with the Petitioner and its products. A simple search in any internet database will lead to hundreds of hits relating to the Petitioner, its products and its activities.
7. The Petitioner owns many domain names which it uses to advertise its products, sell its products and to bring information to the public. The Petitioner operates, *inter alia*, the [www.reebok.com](http://www.reebok.com) website which was registered in the name of Petitioner in 1994. Additional domain names are registered in the

name of Petitioner whose rights were also recognized by WIPO's Arbitration and Mediation Center. – see, for example:

<http://www.wipo.int/amc/en/domains/decisions/html/2008/d2008-0359.html>;

<http://www.wipo.int/amc/en/domains/decisions/word/2008/d2008-1839.doc>.

8. Reebok is a brand for sports fitness and casual footwear, apparel and equipment. The Reebok brand was first created in 1958 and introduced in the United States of America in 1979. From then onwards, The Petitioner started to use and register the Reebok trademark on its products on a worldwide basis. Reebok has since grown into an industry leader for the design, manufacturing and marketing of sports gear and related apparel.
9. The Petitioner is the owner of the Reebok trademark and company name. This trademark has been registered worldwide for various goods and services in almost every country of the world. The Petitioner has used the Reebok trademarks extensively, has been involved as an official licensee, partner, sponsor and/or supplier of many renowned sports series including the National Football League (NFL) and the National Basketball Association (NBA).
10. As a consequence of extensive, long-continued and worldwide use and marketing, the Reebok trademarks enjoy considerable goodwill and fame.
11. On December 31, 2010 the ריבוק.co.il domain name was allocated to the Respondent. The registration details of the Domain Name can be found at <http://www.isoc.org.il/domains/whois.html>.
12. On the filing date of the Petition, the following webpage was found under the domain:



13. The Petitioner contacted the Respondent and demanded that he cease using the REEBOK trademark or any mark similar thereto, and that he immediately assign the Domain Name to Reebok. Respondent replied to Petitioner in a phone call, but has not responded to Petitioner in writing. Petitioner followed up with additional correspondence. Copies of the Petitioners' correspondence were attached as evidence. This IL-DRP action ensued.
  
14. Petitioner claims that in the telephone call received from the Respondent, the Respondent claimed that he registered the domain name in order to establish a sports website; that he had lots of expenditures and that should he transfer the domain name to the Petitioner, he should be reimbursed for these expenditures. The Petitioner claims that he requested that the Respondent put his response in writing and that no written response was received.
  
15. The Respondent acted in a lack of good faith by registering the Domain Name in his name, knowing that the REEBOK® trademark is associated with the Petitioner, in order to promote his business and in order to draw customers who are misled to believe that there is a connection between the Respondent and his website and the Petitioner and or the Petitioner's products.
  
16. Respondent is misleading the public and causing it to believe that there is some connection between the Respondent, the Domain Name and the website which he intends to operate on the Domain Name, and the Petitioner.

17. The Respondent is luring browsers to the [www.ריבוק.co.il](http://www.ריבוק.co.il) website, and in order to obtain a commercial advantage he is creating a high probability of confusion and misleading regarding the origin of the website, and the entities to which it is connected. There is no doubt that the first association which is created when viewing the [www.ריבוק.co.il](http://www.ריבוק.co.il) Domain Name is with the Petitioner's famous REEBOK brand.
18. The Respondent is being unjustly enriched at the expense of the Petitioner and is gaining profit without any legal right. The Respondent cannot refer to any law which permits him to use the Trademark. The Petitioner invested extensive effort and resources in the Trademark and in bringing it to the attention of the public, whereas the Respondent acted in bad faith by registering the Domain Name.
19. The Respondent is misappropriating, diluting and harming the Petitioner's goodwill in the REEBOK® trademark.
20. The Petitioner supported its claims and arguments with legal citations, including:
  - a) Petitioners' right to exclusive use of its Trademark, as set forth in the Trademarks Ordinance [New Version] 1972;
  - b) Section 1 of the Commercial Injustice Law, 1999;
  - c) The test for misleading is whether: "There is an attempt to create an association between the product and the plaintiff", see Ginat, "Passing Off", pages 17-18;
  - d) The tort of unfair intervention pursuant to Section 3 of the Commercial Injustice Law, 1999;
  - e) Civil Case No. 1753/07 Webs Planet Ltd. v. Hezi Hazan, in which the Court noted:

"In order to fulfill the purpose of the prohibition which is set forth in Section 3 above [Section 3 of the Commercial Injustice Law] one must recognize a domain name as 'access' to the trader's business. Accordingly, in the event that one trader unfairly prevents another trader from using a domain name which is associated with his mark, this constitutes a hindrance on the access of customers and suppliers to the business of the other trader".

- f) Civil Case No. 1627/01 M.S. Magnetics Ltd. v. Diskcopy Ltd. et al: "Party No. 1 which registered a domain name which is identical to the trademark of Party No. 2, prevented Party No. 2 from being able to build and operate a website which will bear the trademark which the public associates with Party No. 2. Customers or agents of Party No. 2 may attempt to contact his business via the website and will have difficulty in doing so, since when they access the website which bears the trademark of Party No. 2, they will reach the website of Party No. 1. Such an action constitutes a hindrance by Party No. 1 when customers attempt to locate the business of Party No. 2".

**Respondent's Arguments:**

Apart from the phone call quoted above, Respondent has not filed any further response by the deadline of 24 February 2011, and indeed has not filed any response to date of the drafting of this decision.

**Discussion:**

**Procedural Issue:**

Respondent was specifically directed by the Panelist to the Rules for Allocation of Domain Names, and more specifically to the IL-DRP.

Sections C and F of the Rules for Allocation of Domain Names provide (emphasis in the original and italicized here for quoted emphasis):

***"C. Application & Allocation Process***

***5. The Application***

***5.1. Applicant***

*An application for allocation of a Domain Name may be made by the party who will hold the Domain Name ("Holder") or by a third party, including by way of an ISOC-IL Accredited Registrar ("AR"), on behalf of the Holder (collectively "Applicant").*

...

***5.3. Application Form and Fees***

*The allocation process will be initiated by submission to ISOC-IL of the completed application form according to the procedures set by ISOC-IL ("Application"). The Applicant will pay the initial allocation fee together with filing the Application. All details in the Application should be full and correct.*

#### **5.4. Application Incorporates the Rules**

***These Rules and procedures thereunder (hereinafter "Rules") are binding the Applicant and the Holder upon submission of the Application and prevail over any other representations made by ISOC-IL. {Emphasis added}.***

### **F. Disputes and the IL-DRP**

#### **24. ISOC-IL Not Arbiter of Disputes**

...

*24.3. As a service to the Internet Community, ISOC-IL has established an alternative expedited dispute resolution mechanism, namely, the IL-DRP. The procedures and rules regarding dispute resolution under the IL-DRP are available at [http://www.isoc.org.il/domains/ildrp\\_rules.html](http://www.isoc.org.il/domains/ildrp_rules.html), and are an integral part of these Rules.*

***24.4. Holder agrees to submit to a procedure and a decision made under the IL-DRP. This section does not abrogate any individual's right to go to court or arbitration to resolve disputes regarding a Domain Name. {Emphasis added}.***

*24.5. Section F does not apply to Domain Names allocated under the Rules prior to January 1, 1999, unless the Holder so agrees."*

Accordingly, I find that Respondent, by submission of his application to obtain the Domain Name, agreed to the Rules and the IL-DRP procedures.

Further, by submission of his application Respondent warranted and conditioned his obtaining the Domain Name as follows in Section C of the Rules:



**"5.2. Holder's Representations and Warranties**

*A submission of an Application by an Applicant constitutes the Holder's representation and warranty that the Holder is a legal entity and that the allocation or use of the Domain Name by the Holder does not infringe the legal rights of a third party. Further, it constitutes the Holder's agreement that ISOC-IL will not bear liability for any allocation and use of any Domain Name."*

That the allocation of a Domain Name is not a guarantee of the validity of the use of the Domain Name by the Holder is further emphasized in Section C of the Rules:

**"9. Allocation No Guarantee of Validity of Use**

*The examination of the Application and the allocation of the Domain Name shall not be a guarantee that the Domain Name is valid for use by the Holder under Israel law, and ISOC-IL or its employees shall bear no responsibility whatsoever because the Domain Name was allocated."*

Accordingly, this Panelist has the authority to make a determination regarding the Domain Name, and these proceedings are appropriate for such determination. Further, under the Procedures, the parties retain the right to go to court, should they wish to challenge the decision of this Panelist.

**Grounds for Decision:**

Section F of the IL-DRP Rules provides:

**"17. Ex-Parte Decisions**

*17.1 Where one party fails or refuses to respond to or provide information or additional material to the Panelist/Panel, after being duly notified of the Petition, or where attempts to notify the Holder based on the information provided by the Holder to ISOC-IL do not succeed, the Panelist/Panel may make its determination on the material provided by one party alone or on the material before it."*

Notwithstanding that Respondent has not filed a response, the determination of whether the Petitioner has proven sufficient grounds for re-allocation of the

domain name remains standing. Mere "default" is not determinative. Accordingly, this Panelist will proceed with the evaluation of whether there are sufficient grounds to order re-allocation of the domain name.

The IL-DRP Rules state:

**"B. Grounds for IL-DRP**

*3. Disputes regarding allocation of a Domain Name by a Holder may be brought by a third party ("Petitioner") on the following grounds:*

*3.1. the 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 Domain Name was made or the Domain Name was used in bad faith.*

**4. Evidence of Allocation or Use in Bad Faith**

*4.1. 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*

*c. 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*

- d. *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*
- e. *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."*

Thus, in order to prevail, the Petitioner must establish all four elements: confusing similarity to the Name, rights in the Name, that the Holder has no rights in the Name, and an element of bad faith.

### **Confusingly Similar**

The first question is: Is the Domain Name the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the Petitioner?

I find the answer to this "yes". The Domain Name ריבוק.co.il is confusingly similar to the registered trademark and key element of the company name of the company.

I find the Hebrew "ריבוק" to be the phonetic equivalent and transliteration of the Latin character "Reebok", and confusingly similar, if not identical, with "Reebok" in pronunciation and significance. I find that the Petitioner is widely known in both Hebrew and English in Israel, and thus also has rights to the phonetic equivalent transliteration of the mark in Hebrew characters.

For a similar case concerning transliteration of a well known trademark resolved in a WIPO UDRP proceeding, see **Kabushiki Kaisha Toshiba d/b/a Toshiba Corporation v. Liu Xindong, Case No. D2003-0408**, <http://www.wipo.int/amc/en/domains/decisions/html/2003/d2003-0408.html>.

### **Petitioner's Rights in the Name**

The second question is: Has Petitioner established that it has rights in the name?

I find the answer to this "yes". Petitioner has provided evidence of registration of the trademark "REEBOK" in Israel, as well as ample evidence of use. Moreover, Petitioner has provided support to claim that the term "REEBOK" was coined by Petitioner. In addition, Petitioner holds the Domain Name reebok.com. Further, it appears that a related entity holds the Domain Name reebok.co.il.

It should not be incumbent upon a party to acquire all possible variations of its mark in domain name strings in order not to forfeit any rights or prevent allocation of such domain names to others.

### **Respondent's Rights in the Name**

The third question is: Does the Respondent have rights in the Name?

I find the answer to this "no". Respondent has demonstrated no "rights" in the Name "ריבוק" and that there appears to be no legitimate business reason for Respondent to be holding the Domain Name with the equivalent Hebrew transliteration of the name of a competitor, especially on a "parking" page.

### **Bad Faith**

The fourth question is whether there appears to be any evidence of bad faith in the allocation or use of the Domain Name. I find that there is evidence of bad faith.

In a non-exclusive list of possible evidence of bad faith, Section 4.1. (e) of the IL-DRP Rules states:

- e. *"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."*

The use of a registered trademark in a domain name allows the entity registering the domain name to capture traffic and point or divert it to another website. Courts have recognized that consumers expect to find a company on the Internet at a domain name address comprised of the company's name or trademark. See **Panavision Int'l, L.P. v. Toeppen, 141 F.3d 1316 (9th Cir. 1998)** ("A customer who is unsure about a company's domain name will often guess that the domain name is also the company's name." . . . "[A] domain name mirroring a corporate name may be a valuable corporate asset, as it facilitates communication with a customer base.").

In addition, Respondent's alleged demand for reimbursement for development of a website that appears as a "parking" page "under construction" beyond the reasonable reimbursement of filing fees, evidences that Respondent is holding the Domain Name to obtain benefit from or on the coattails of the Petitioner and/or is not utilizing the Domain Name for any primary purpose other than to re-direct such traffic away from the Petitioner.

Further, in my investigation, I determined that Respondent has registered other Domain Names containing the Hebrew language transliterations or equivalents of other recognized trademarks. This appears to be additional evidence pointing to a practice of registering names containing marks of others to suggest a connection with those companies, and thus supports this interpretation of Respondent's 'bad faith' use and registration of the subject Domain Name.

I find that the Respondent does attempt to draw users to its website either to gain revenue from the "parking" page, or in the creation of a likelihood of source, sponsorship or affiliation with Petitioner, or at minimum with diversion for those typing in the trademark of the Petitioner in direct navigation.

**Discussion:**

Although I find the above sufficient grounds on which to make my determination, since the roll-out of the allocation of Hebrew character IDN third level domains in the .IL ccTLD space is in its nascent stages, I wish to add additional considerations that inform and support my determination, in order to meet the 'spirit' as well as the 'letter' of the Rules.

The purpose of the expansion of the domain name space in Israel to include Hebrew Internationalized Domain Names ("IDNs"), and the expansion of the domain name space world-wide for IDNs in general, is to make the Internet more accessible to more people. In the .IL ccTLD space, the idea is to enable the offering of domain names to users in Hebrew characters rather than only in Latin characters.

"The objective of IDNs is to enable users to easily type domain names in familiar, non-ASCII scripts (while preserving universal uniqueness and resolvability)". ICANN *IDN Committee's Discussion Paper on Non-ASCII TLD Policy Issues*.

As also quoted in ISOC-IL's own FAQs in explaining this expansion:

"The Hebrew Domain Names are an expansion of the Israeli name space. IDNs expand Internet accessibility to new and additional audiences, and provide easier access to the name space:  
"Over half the Internet users around the world don't use a Latin-based script as their native language. IDNs are about making the Internet more global and accessible for everyone." (Rod Beckstrom, ICANN's President and CEO, 16.11.2009, IDN ccTLD Fast Track Process Launch)".

In addition to allowing for the expansion of the name space, an additional goal is to keep it a "unified" space. As quoting from the ISOC-IL FAQs:

**"Is there a connection between the Hebrew Domain Names offered for registration in IL and the Hebrew Top Level Domain for Israel (once selected)?**

When ISOC-IL operates Israel's Hebrew Top Level Domain registry, the Hebrew Top Level Domain and IL will be aliases. This means they will be different names having the same name space ("Unified Name Space").

All the Domain Names registered in IL, Latin and Hebrew alike, will automatically operate under both Top Level Domains without any additional action or cost.

ISOC-IL believes that the Unified Name Space approach will best serve the interests of the local Internet community. In addition, it will save unnecessary expenses for the holders of existing Domain Names, since they will not be required to register these names separately in the Hebrew Top Level Domain.”

Accordingly, it is critical that a balance between these two worthy goals be struck, and the user trust in, as well as the security and stability of, this expanded unified space not be abused. Thus, the expansion of the name space for Hebrew IDNs is to expand and enhance necessary use by holders with Hebrew characters – **not to have the confusingly similar equivalent transliterated names in Hebrew and (English) Latin characters be captured by different entities.** As additional anticipated expansion of the Hebrew IDN of the Top Level Domain (TLD) takes place, identical and/or equivalent transliterated alternatives will need to resolve to the same space.

There must be protection against cybersquatting and other forms of abuse in the Hebrew IDN name space version that do not differ from the protections already afforded – and carefully balanced – in the existing ccTLD space.<sup>1</sup> For example, there is confusion and possibly significant danger for the consumer if different owners can hold different versions of confusingly similar equivalent transliterated domain names in Hebrew and in English. The current IL-DRP Rules can and must apply to equivalent transliterations that meet the four elements referred to above, and I find they do cover this case in point.

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<sup>1</sup> “4.2.1. Dispute Resolution

IDNs create new types of collisions between trademarks and domain names as well as collisions between domain names. These have impact on dispute resolution processes used by registries and otherwise. It is important that deployment of IDNs evolve in parallel with review and updating of ICANN or registry-specific dispute resolution processes.” IETF RFC 4690, Review and Recommendations for Internationalized Domain Names (IDNs).”

[In observation, I also note that the timing of the roll-out of the Hebrew IDN program at the end of the Gregorian calendar and international holiday period should not have been interpreted in the "land-rush" activity as a license for the abuse and registration of others' trademarks.]

**Decision:**

In light of the above, I find that the Domain Name is confusingly similar to the Petitioner's registered (and unregistered) trademarks, that the Petitioner has rights in the trademark, that the Respondent has no legitimate interest in the domain name, and that the allocation or use of the Domain Name by the Respondent is in bad faith. Therefore, I hold that the Domain Name shall be reallocated to the Petitioner within 45 days of the date of this decision.

Further, the Petitioner requests an award of fees. I find this outside the scope of this proceeding, and thus not considered.

Ellen B. Shankman, Adv.

Date: 25 February 2011