



Google, Inc. v. Shlomi Kakon

IL-DRP Panel Decision

1. The Parties

The Complainant is Google Inc. of Mountain View, California, United States of America, represented by Ellen B. Shankman, Israel.

The Respondent is Shlomi Kakon, of Hadid, Israel.

2. The Domain Name and Registrar

The disputed domain name <jgoogle.co.il> is registered with Domain The Net Technologies Ltd

3. Procedural History

The Complaint was filed with ISOC-IL on April 17, 2011. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On May 1, 2011 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on May 4, 2011, 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.

On May 5 2011, the Respondent transmitted by e-mail a motion, requesting that Hebrew be the Language of the proceeding.

On May 8, 2011, the Panel decided that, given the circumstances of this case, to the proceedings will be conducted in the English language, and allowed the Respondent to submit his Response in the Hebrew language.

The Respondent transmitted his Response on May 8, 2011.

On May 11, 2011, the Complainant filed a supplemental communication.

On May 13, 2011, the Respondent filed a supplemental communication, in response to the Complainant's Supplement filing.

On May 24, 2011, the Complainant filed an additional Supplemental communication.

4. Factual Background

The disputed domain name was registered by the Respondent on November 25, 2010.

The Complainant, Google, Inc. is a company based in the United States, founded in 1997 and operates one of the world's largest web search engine in its primary website "google.com". The Complainant also offers wide range of other products and services and in many different languages.

The Complainant's products and services reach more than 150 countries worldwide, its website receives 581 million visitors per month, and it is the number one search engine in Argentina, Australia, Belgium, Brazil, Canada, Denmark, France, Germany, India, Italy, Mexico, Spain, Sweden, Switzerland, the U.K., and the U.S.

The Complainant is the owner of numerous trademark registrations, which consist of the mark GOOGLE, around the world. For example: United States trademark registration No. 2806075 –GOOGLE, with the registration date of January 20, 2004; United Kingdom trademark registration No.2410931 – GOOGLE, with the registration date of January 12, 2006; the People's Republic of china trademark registration No. 5558973 – GOOGLE, with the filing date of December 7, 2009, and many more.

Among the Complainant's worldwide registered trademarks, are numerous Israeli trademark registrations, for example: Israeli trademark registration No. 126748 – GOOGLE, with the registration date of October 5, 2000; Israeli trademark registration No. 181632 – GOOGLE, with the registration date of October 15, 2006; Israeli trademark registration No. 192942 – GOOGLE, with the registration date of March 9, 2008, and many more.

The Complainant also developed its presence on the Internet, and is the owner of numerous domain names, consisting of the mark GOOGLE. For example: <google.com>, <google.net>,<google.fr>, <google.org>, <google.biz> and many more.

The Complainant registered its primary website <google.com> on September 15, 1997, and is using its GOOGLE trademark ever since.

The disputed domain name currently resolves to an offline website, which contains the following message (in the Hebrew language) "Jewish Search, the domain is under construction and does not display results. This website is not related to the Google company, and its marks are registered trademarks."

The disputed domain name used to resolve to a website displaying the Complainant's logo with the letter "J" as a prefix, and a Google custom search bar.

5. Preliminary Issue – The Parties Supplemental Responses

The Complainant and the Respondent submitted Supplemental Responses to this IL-DRP proceeding.

According to the Rules, the IL-DRP proceeding concludes a Response is filed. In addition section 3 of the Rules allows the Panel to request from the parties additional material relevant for its decision.

The Rules do not indicate that the parties have the right to submit supplemental responses on their behalf. The procedure that allows the parties to submit supplementals is by filing a request for permission from the Panel. The Panel may then, at its discretion, allow such a supplemental. The rationale for limiting the number of filings by the parties is to enable the conduct of the proceeding in an efficient and speedy manner.

In the present case, the parties submitted Supplementals without request or leave of the Panel. The Panel decides that the Supplementals are excluded from the case file and will not be regarded in this Panel's decision. Such exclusion is made after the Panel has reviewed the Supplementals and finds that nothing contained therein would have changed the outcome of the present decision.

6. Parties' Contentions

A. Complainant

The Complainant contends the following:

The Complainant argues that the GOOGLE Mark has been widely promoted among the public and exclusively identifies the Complainant.

The Complainant further argues that the disputed domain name is confusingly similar to the Complainant's trademark, as it wholly incorporates, as a dominant element, the Complainant's registered trademark, with the addition of the letter "J" as a prefix.

The Complainant further argues that the Respondent was aware of the Complainant when registering the disputed domain name, and that the disputed domain name was registered to divert Internet traffic from the Complainant's website for commercial gain.

The Complainant further argues that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant contends that by tying his

search to "Jewish Google", the Respondent emphasizes that the rights belong to the Complainant.

The Complainant further argues that the Respondent's increasing demands to receive additional payments demonstrates his bad faith.

The Complainant further argues that the Respondent has registered the disputer domain name in an attempt to attract for commercial gain Internet users to the web site, by intentionally misleading them and creating a likelihood of confusion with the Complainants' trademark as to the source, sponsorship, affiliation, or endorsement of the website.

The Complainant further argues that the fact that the Respondent use of the Complainant's search bar under a logo that incorporates the Complainant's GOOGLE trademark, enhanced the Connection between the website and the Complainant.

The Complainant further argues that it had approached the Respondent demanding it change the contents of its website and cease from using the Complainant trademark. According to the Complainant, after reaching an understanding with the Respondent, to allocate the disputed domain name in return for reimbursement for the registration fees, the Respondent had changed his mind and requested additional fees.

The Complainant further argues that the Respondent is misappropriating, diluting and harming the Complainant's goodwill in the GOOGLE trademark.

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

B. Respondent

The Respondent argues that he registered the disputed domain name, in order to provide the religious and Hasidic communities a search engine that will not display inappropriate materials. The Respondent claims that he learned of this possibility after meeting with the Complainant's representatives.

The Respondent further argues that the Complainant's counsel approached him and demanded that he remove infringing contents from his website. The Respondent contends that he operated accordingly.

The Respondent further argues that the Complainant's counsel had returned and claimed that by operating the disputed domain name he is infringing the Complainant's rights. The Respondent contends that he agreed to allocate the disputed domain name in return for reimbursements for business losses that will occur due to the allocation.

The Respondent further argues that he requested the reimbursement so he will not be damaged, and not for profit.

For all of the above reasons, the Respondent requests the denial of the Complaint.

7. 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 Domain The Net Technologies Ltd. registration agreement provides that the applicant for the domain name accepts the ISOC-IL registration rules (see http://www.domainthenet.com/he/מתחם_שם_רישום_הסכם.aspx). 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 "google" with the prefix "J" 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 "google" 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 Complainant is the owner of numerous registered trademarks, covering the mark GOOGLE. For example: United States trademark registration No. 2806075 – GOOGLE, with the registration date of January 20, 2004; United Kingdom trademark registration No.2410931 – GOOGLE, with the registration date of January 12, 2006; the People's Republic of china trademark registration No. 5558973 – GOOGLE, with the filing date of December 7, 2009, and many more.

Also, the Complainant registered Numerous Israeli trademark registrations, for example: Israeli trademark registration No. 126748 – GOOGLE, with the registration date of October 5, 2000; Israeli trademark registration No. 181632 – GOOGLE, with the registration date of October 15, 2006; Israeli trademark registration No. 192942 – GOOGLE, with the registration date of March 9, 2008, and many more.

The addition of the prefix "J" in the disputed domain name is insufficient to avoid confusing similarity as it is a non-distinctive element, which according to the Respondent is to convey a "Jewish Google". Moreover, the use of the letter "J" to denote a Jewish Google means that the Respondent regards the letter "J" before the disputed domain name as a descriptive term. As such, a descriptive term will not serve to sufficiently distinguish between the disputed domain name and the trademarks of the applicant. In addition, when reviewing the disputed domain name the merely descriptive term (here the letter "J") can be excluded from our examination. The remaining non-descriptive part of the disputed domain name is identical to the trademark of the Complainant.

It is therefore the finding of the Panel that the disputed domain name is confusingly similar 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 GOOGLE trademark, and that the Respondent has no rights in the GOOGLE trademark.

The Complainant showed sufficient evidence showing it has rights in the GOOGLE trademark. There is no doubt that the Complainant's GOOGLE trademark has gained significant goodwill.

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 his Response, the Respondent did not argue to have rights in the disputed domain name, other than the business he intended to do in connection with therewith.

Therefore, the Panel finds that the Complainant showed that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of Rule 3.3.

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 confusingly similar 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 GOOGLE trademark is registered in Israel since the year 2000 and is well-known worldwide since

the launch of the Google website in the year 1997. The Respondent registered the disputed domain name after the Complainant registered its GOOGLE trademark.

The Respondent has used and clearly intends to use the website operating under the disputed domain name to direct consumers to a custom search engine of the Complainant. The website operating under the disputed domain name used to display the Complainant's trademark and logo with the addition of the prefix "J". The Respondent is now using the website to present a hyperlink directing users to a web site that is not related or affiliated with the Complainant. The Respondent himself admitted that he intended to profit of the disputed domain name

The Panel also took notice in the Respondent's Response that he had actual knowledge of the Complainant and its services at the time he requested the allocation of 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 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 noted on the website operating under the disputed domain name that it is not connected to the Complainant is of no relevance in this matter. Such disclaimers do not eliminate the Respondent's bad faith (See: AARC Inc. v. Jayashankar Balaraman, WIPO Case No. D2007-0578).

These facts are sufficient to establish that the Respondent had registered the disputed domain name 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.

8. Decision

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



Jonathan Agmon
Sole Panelist

Date: May 30, 2011