

**IL-DRP PANEL
FOR THE INTERNET SOCIETY OF ISRAEL**

In the matter between

The Open University of Israel
Represented by Adv. Giora Landau
(The "Petitioner")

and

Mr. Reuven Gorodetsky
(The "Respondent")

DECISION

I. Procedure

ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain name "האוניברסיטה הפתוחה.co.il" (herein the "Disputed Domain") be reallocated to the Petitioner.

A Panelist was appointed in accordance with the Procedures for Alternative Dispute Resolution under the .IL ccTLD (IL-DRP Rules), (http://www.isoc.org.il/domains/ildrp_rules.html), in order to address the Petitioner's above request.

Notification of the pending Petition, including copies of all submitted material, and notification of appointment of the Panel under the Rules, was sent on Aug.4, 2011, to the Respondent's address, as recorded with ISOC-IL under contact information for the aforesaid domain.

In accordance with section 9.3 of the Rules, the Respondent was allotted 15 days, concluding on August 19th, 2011, to submit a Statement of Response or any other relevant information to the Panel.

The Respondent failed to submit any comment or Response by designated date.

On August 25th, almost a full week after the last day for submission of a Response, and without receiving prior consent from the Panel or Petitioner, the Respondent submitted an email responding to the Petition.

The Rules of Procedure allow the Respondent 15 days during which he may submit his Response. The same Rules also allow the Panel discretion to allow extension of designated dates. In this case, the Respondent took the liberty to ignore Procedure as set forth in the Rules, and submit a Response at his leisure. According to the Rules, this process is "an alternative dispute resolution procedure intended to provide expedited resolution to disputes regarding the allocation of Domain names". The Parties took upon themselves to abide by these Rules once they registered a Domain Name with ISOC-IL (see section 24.4 of the Rules of Registration- <http://www.isoc.org.il/domains/il-domain-rules.html>).

In light of the above, the Panel will disregard the short Response submitted by the Respondent as described above. Let it be noted, in an aside, that the Panel briefly reviewed the contents of said submission and finds that it has no impact on the decision herein.

II. Factual Background

The Respondent registered the Disputed Domain on December 30, 2010. Let it be noted that commencement of registration of Hebrew Domain names was on Dec. 26th, 2010.

The Petitioner holds many domains pertaining to the Open University

On February 23, 2011, the Petitioner sent the Respondent a letter claiming the Open University's rights in the Disputed Domain and requesting that the Respondent allow IOC-IL to reassign the Disputed Domain to the Petitioner, before additional legal measures will be taken.

The Respondent in return offered to re-assign the Name for a "symbolic sum" of \$1,500. The Respondent also stated that if the Open University will not buy the Domain, he will release it, and then anyone might get hold of it – not necessarily the Petitioner, as it is difficult to get hold of names such as this.

The Petitioner responded that it will not pay excessive amounts for the Domain, but will agree to reimburse the Respondent for actual Registration costs, at a total of no more than 500 NIS.

The Respondent offered several additional proposals, which were also rejected – first for a total of \$500 (June 1st), and then a final proposal of 1,200 NIS (July 4th).

As of date of filing of this Petition, the Disputed Domain does not refer to any active web site.

III. The Parties' Claims

A. The Petitioner

The Petitioner claims as follows:

1. The Open University of Israel was founded in 1974, and recognized as an Institution for Higher Education in 1980. It holds several relevant Domain Names, both in English and in Hebrew including האוניברסיטה-הפתוחה.ac.il
2. The Petitioner has more than 60,000 students nationwide, many branches, and thus is the largest University in Israel.
3. The Disputed Domain is identical to the name of the Petitioner.
4. The Respondent has no rights in the name and has never requested permission of the Petitioner to use it.

5. The Respondent holds the name in Bad Faith, with primary intent of selling Domain to others for excessive consideration, in accordance with the description of Bad Faith under section 4 of the IL-DRP Rules.
6. Since the Petitioner conducts extensive activity over the internet, the Respondent hoped to gain from this on-line traffic by attracting potential users to the Disputed Domain, again constituting Bad Faith according to the Rules.

B. The Respondent

As previously discussed, the Respondent failed to submit a Response within the allotted time frame, as required by the Rules of Procedure. Therefore, any later communication provided by the Respondent is disregarded.

IV. Discussion

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 for Allocation of Domain Names under .IL.

According to section 3 of the IL-DRP Rules, Disputes regarding allocation of a Domain Name by a Holder may be brought by a third party ("Complainant") 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.

Each of the claims above needs to be well established, in order for the Petitioner to prevail.

1. Name is Same or Similar

The Disputed Domain consists of 2 parts: the Hebrew Name, and an attached suffix.

The Hebrew Name in the Domain is האוניברסיטה הפתוחה, directly translated to "The Open University".

The Petitioner was formally recognized under the name of "The Open University" by the **Council for Higher Education**, under the Council for Higher Education Law, 5718-1958.

The Petitioner also holds the Domain האוניברסיטה-הפתוחה.ac.il.

In addition, under said Law, any recognized institute is also a corporation. The Open University is registered corporation, registered in the **Corporate Registry** of Israel (registration no. 510686520), under same Hebrew Name.

The Open University is well recognized by the Public. It has a tremendous amount of students and branches throughout the country. It has been operating for nearly 40 years.

It can therefore be concluded that the Open University is a "**well known trademark**", in accordance with the definition of the Trademark Ordinance - 1972.

Therefore, the Hebrew part of the Domain Name consists of a name which is identical both to the registered company name, and to the legally recognized Institution name under the Council for Higher Education, and is a well known trademark, of the Petitioner.

The disputed Domain consists of the suffix co.il.

It has been well established that the suffix is not relevant in assessing identity of terms.

Internet Domain allocation allows for distinction between commercial entities (concluding with .co.il) and academic ones (concluding with .ac.il). However, the public is not always savvy of this distinction, and will often look up a certain entity according to its recognized Name, with any possible suffix.

In a similar case, WIPO discussed the resemblance between the disputed name "uwindsor.com" and the name "uwindsor.ca", held by the University of Windsor. The panel found that:

"The disputed domain name includes the word term "uwindsor" which is identical to the domain name used by the Complainant and includes the trademark owned by the Complainant. The disputed domain name reflects the name of the Complainant since the letter "u" is used for universities and "uwindsor" is the abbreviated name of the Complainant and its registered trademark.

The addition of the generic top level domain ".com" which is the only part of the disputed domain name that is different from the domain name of the Complainant and of its trademark does not constitute a differentiating element. Top level domains do not constitute distinctive elements and hence do not eliminate the possibility of confusion. "Since it is clear that the "dot.com" element of a domain name is to be ignored for the purpose of assessing similarity..." See *Skipton Building Society v. Peter Colman*, WIPO Case No. D2000-1217." (The University of Windsor v. Modern Empire Internet Limited, WIPO Case No. D2006-1238)

Thus, the Panel finds that the first requirement, that the Domain be confusingly similar to the Trademark or Registered Name of the Petitioner, is fulfilled.

2. Complainant has Rights in Name

- The Petitioner provided a copy of the Certificate of Recognition by the Council for Higher Education, recognizing that The Open University is a recognized Institution, as of 1980.
- The public clearly identifies the term "The Open University" with the Petitioner. The Petitioner has 60,000 students and branches across the country. The Term has become a well known Trademark, according to the Trademark Ordinance – 1972, associated with the Open University of Israel.
- The Petitioner is a registered in the Corporate Registry as "The Open University" – האוניברסיטה הפתוחה
- The Petitioner holds several additional Domain Names, including <האוניברסיטה-הפתוחה.ac.il>.

From all of the above it is evident that the term האוניברסיטה הפתוחה is strongly affiliated with the Petitioner.

3. Holder has no Rights in Name

- Holder is a private citizen. He has established no connection whatsoever to the term Open University.
- Since purchasing the Domain on Dec. 30th, Holder has not used it and to this date there is no active website connected with the Disputed Domain.
- The term "האוניברסיטה הפתוחה" does not refer to universities in general. It includes a definite article, "The", referring to a specific Open University. Even were the Holder to claim providing services regarding universities, it is to be clarified that the Disputed Domain does not refer to open universities in general, but is specific to "The Open University" (האוניברסיטה הפתוחה), which is identified directly with the Petitioner.
- As evident from his response to the petitioner's letter – the Holder has no interest in the Name, and will willingly sell it, provided he receives sufficient consideration
- The Holder has neither requested nor received permission from the Open University of Israel to use the Name.

Therefore, the Holder has no established Rights in the Disputed Domain.

4. Registration in Bad Faith

Section 4 of the Rules sets out various circumstances which, if present, will constitute evidence of the allocation or use of a domain in bad faith.

The following assumptions, pertaining in particular to the Registration or holding of a Domain Name, are applicable to the case hand, as follows:

"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:

...

"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;..."

The respondent registered the Domain on Dec. 30th, 2010, immediately after ISOC-IL opened registration for Hebrew Domain Names (on Dec. 26th, 2010).

When approached by the Petitioner in February 2011, the Respondent did not claim to have any interest in the Domain. He had not put the site to use. His sole response was that he will be willing to relinquish the Domain for a "symbolic" sum of \$1,500. The Respondent also stated in his reply that in the event that the Petitioner has no interest in the name, the Respondent will release it so that it will become available to others, not necessarily the Petitioner.

Such behavior is clearly indicative of the Respondent's intent in Registering the Domain "primarily for the 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", as expressed in sub-section 4(d) of the Rules above. He himself shows no interest whatsoever in maintaining the Domain.

In addition let it be noted that the Respondent also holds the Domain אונברסיטתתל אביב.co.il, registered on the same date as the Disputed Domain. This domain, as well, has not been used and there is no active web site related to it. Such behavior is typical of serial name holders, "cybersquatters", whose sole interest is to take advantage of a window of opportunity - in this case the introduction of Hebrew Domain Registration - and gain hold of various well known names, in order to transfer them later to their rightful owners, at a profitable, and sometimes outrageous fee.

Such behavior was seen often earlier on in the history of Domain registration under ISOC-IL, and has subsided over the years, only to pick up again recently, with the addition of a new format of Domains using Hebrew characters. This cybersquatting wave, as the previous one, is not acceptable, attempts to undermine the Rules of Registration, and encourages unfair use of the Internet - and must therefore be abrogated.

Furthermore, the concept behind allowing use of Hebrew characters in Domain Names, as stated on ISOC-IL's FAQ sheet, is that " The Hebrew Domain Names are an expansion of the Israeli name space. Internationalized Domain Names expand Internet

accessibility to new and additional audiences, and provide easier access to the name space" . Therefore, potential students of the Open University hoping to access the Petitioner's web site by a Hebrew character domain search, might be frustrated when reaching the empty site held by the Respondent under the disputed Domain.

Without conducting a full analysis of the circumstances, it appears that the same logic applies to the Name אוניברסיטתתל אביב.co.il, also held by the Respondent. Such behavior amounts to bad faith as expressed in section 4.1 (d) above, by preventing the rightful owner of a Trademark from using in, thus losing potential traffic to its web site.

Finally, an additional indication of bad faith can be inferred from Respondent's lack of timely response to this Petition. As mentioned in section 4 of the Rules, the indications of bad faith are not limited to the specific listed circumstances. Based on the prior exchange of letters between the Parties, it is evident that the Respondent was aware of the Petitioner's claims. Whereas the Panelist explicitly stated a final date for submission of a Response, the Respondent chose to ignore this date, without insomuch as an excuse or explanation. It has been ruled in the past that no response on behalf of the Respondent can also be considered a sign of bad faith (see for example WIPO Administrative Panel Decision regarding **Mars, Incorporated v. Vanilla, Ltd.**, Case No. D2000-0586).

V. Decision

In light of all of the above, Panel finds that the Domain name האוניברסיטה הפתוחה.co.il is identical with Petitioner's registered corporate name and Well Known Trademark, the Petitioner has rights in the Domain, the Respondent has no rights in the Domain, and the application for the Domain name was made in bad faith.

Therefore, the Panel concludes, in accordance with the Rules, that the Disputed Domain shall be re-assigned to the Petitioner, within 45 days of the date of this decision.

Leehee Feldman, Adv.
Sole Panelist

Date: September 4th 2011