

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

***In the matter of the Domain <barrisol.co.il>***

between

**Barrisol/Normalu Group S.A.S.**

Route du Sipes 68680 Kembs France

Represented by Adv. Jonathan Agmon  
8 Hahoshlim Street P.O.B. 12425,  
Herzliya 4672408

(The "Petitioner")

and

**Mr. Amit Nitzan**

P.O. Box 16,  
Adanim 4592500 Israel  
(The "Respondent" or "Holder")

**DECISION**

**I. Procedure**

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Name "barrisol.co.il" be reallocated to the Petitioner.  
A Panelist was appointed in accordance with the Procedures for Alternative Dispute Resolution under the .ILccTLD IL-DRP Rules, in order to address the Petitioner's above request ([http://www.isoc.org.il/domains/ildrp\\_rules.html](http://www.isoc.org.il/domains/ildrp_rules.html)) (hereinafter – "the Rules").
2. 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 10<sup>th</sup>, 2016, to the Respondent's email address as recorded in the ISOC Domain Name Registry. In accordance with section 9.3 of the Rules, the Respondent was allotted

15 days, concluding on August 25<sup>th</sup>, 2016, to submit a Statement of Response or any other relevant information to the Panel.

3. The Respondent submitted a Letter of Response on Aug. 25<sup>th</sup>, 2016.
4. On Sept.1<sup>st</sup>, the Petitioner submitted an unsolicited Response to the Letter of Response.
5. In addition, on September 20<sup>th</sup>, the Petitioner submitted for the Panel's information a Copy of a WIPO Decision addressing another Disputed Domain between the Parties, pertaining to a parallel dispute.

## ***II. Factual Background***

1. The Complainant is one of the leading international companies for stretch ceilings. The Complainant operates its business under the well-known BARRISOL trademark and operates several websites, including the Official web site under the domain name <barrisol.com>.
2. The Complainant is the owner of several BARRISOL trademarks which are registered since September 1975 at least. The Complainant uses the Trademarks consistently since 1975 and the products under the Trademark have gained a significant reputation and public awareness and have attained the status of fame in the relevant field of stretch ceilings products. The Complainant has extensive goodwill in the Trademark worldwide.
3. The disputed domain name: <barrisol.co.il> was most recently registered by the Respondent on 24.6.2015 under the Respondent's name.
4. As of the writing of this decision, public access to the website at the Domain has been blocked.
5. According to a search on the wayback machine on the non-profit Internet archives site at [www.archives.org](http://www.archives.org), allowing for historic website searches, the Disputed Domain was still active on July 30, but by October 4<sup>th</sup> 2016 was no longer available to the public.

## ***III. The Parties' Claims***

### **The Petitioner**

1. The Petitioner, founded in 1967, is a leading company in developing, producing, manufacturing and marketing stretch ceilings, walls, and related products.
2. The Complainant is the owner of several BARRISOL trademarks, in Israel and in various countries, some of which have been registered as early as September 1975 at least. Trademark application in Israel has been filed as early as 2006.

3. The Complainant has been using its Trademarks consistently since their registration, and the products under the Trademark have gained a significant reputation and public awareness and have attained the status of fame in the relevant field of stretch ceilings products.
4. The Complainant has extensive goodwill in the Trademark worldwide. The Complainant is the owner of many domain names (e.g. <barrisol.fr>, <barrisol.asia>, <barrisol.net>, <barrisol.us>, <barrisol.uk>, etc.), including www.barrisol.com. The Petitioner sells its products all over the world, and Sales cycle in 2014 reached a total of 20,000,000USD.
5. The Petitioner claims that “Barrisol Israel” has been representing the Petitioner since 1999, based on an Exclusive Distribution Agreement (EDA), signed in 2000.
6. Petitioner claims that According to the terms of the EDA, the Respondent was authorized to represent the Petitioner and use its name, as long as the EDA remained valid.
7. The Petitioner claims to have sent the Respondent several letters by which he notified him of Termination of the EDA.
8. Petitioner notes that the Respondent is currently operating his business under the name “Skytec”. Prior to 2015 the Respondent operated his business under the name “Barrisol Israel”.
9. The Petitioner notified the Respondent, on May 20<sup>th</sup>, 2014, that the EDA between the Parties will be terminated due to reasons of non-compliance on behalf of the Respondent. However, the Petitioner would be willing to consider a non-exclusive Distribution Agreement Complainant contingent upon the Respondent’s cessation of use of the Disputed Domain and transferring it to the Complainant.
10. The Petitioner sent the Holder several Cease and Desist letters, on various dates, (February 13, 2015, June 17 2015), stating inter alia that the relationship between the parties was terminated and requesting the Respondent to stop using the BARRISOL Domain, Name and Mark.
11. Despite the above mentioned requests, Petitioner notes that the Respondent did not stop using the disputed domain name <barrisol.co.il> after the EDA was terminated, allegedly by Petitioner’s letter.
12. Petitioner claims that in accordance with the requirements of the Rules, the Complaint contains all the required elements indicating that the Domain should be transferred to the Petitioner, as follows:
  - a. Disputed Domain is identical with Petitioner's well known trade-name and registered company name, Barrisol;
  - b. Petitioner has rights in the name;
  - c. Holder has no rights in the name; and
  - d. Registration and use of the Domain are in bad faith.

## **The Respondent**

The Respondent submitted a Letter of Response with the following contentions:

13. There is no Case to be decided by the Panel at hand, since the Respondent “has no intention to retain or maintain registration or renew or use the domain there nor here for any purpose - despite the commercial legal disputes between the parties (to be determined by the authorized courts in Israel)”.
14. Respondent claims that prior to this response, he addressed the complainant representatives suggesting transfer of the Domain without prejudice to any other commercial rights, and was declined .
15. Respondent insists that in opposition to Petitioner’s claims, Respondent (as defined by complainant) is NOT the Israeli exclusive distributor that the complainant engaged with in 1999, and is NOT a party to the EDA agreement of 15 June 2000 referred to by the complainant.
16. The Respondent has been a Distributor of the Petitioner’s products since 2004, based on an oral Agreement, and not the aforementioned EDA.
17. This oral Agreement creates the Respondents rights to use the name, and this Agreement is still in effect. Hence Respondent has rights in the Name.
18. Respondent claims that the Petitioner also agreed to the Respondents use of the Name for an additional 6 months even after termination of the alleged original agreement.
19. Respondent states that no misleading of consumers has been conducted, and in evidence indicates that the Petitioner has not attempted to create additional business in Israel.
20. Respondent claims to have developed goodwill and reputation of its own over the years based on the Service it provided in connection with the Petitioner’s Products.
21. Respondent claims that the administrative Panel has no authority to discuss the Parties use or bad faith in use of the Domain.

## ***IV. Discussion – Preliminary Rulings***

### **A . Procedure- Unsolicited Filings**

1. The IL-DRP is an alternative dispute resolution procedure intended to provide expedited resolution to disputes regarding the allocation of Domain Names, in accordance with the Rules for Allocation of Domain Names under the .IL country code. By registering a Domain, any Holder agrees to abide by these Rules.
2. Prior to discussion of the merits of the case itself, it is necessary to clear the status of the unsolicited documents set before the Panel and submitted herein, beyond the

Petition on behalf of the Petitioner, and a Letter of Response on behalf of the Holder, as required by the Rules.

3. Section 13 of the Rules allows the Panel full discretion in requesting additional information from the Parties. There is no mention of the Parties' innate right to submit unsolicited information to the Panel. Further, it would be assumed that any party interested in submitting additional information would seek the Panel's permission prior to doing so.
4. In this Case, the Petitioner submitted an unsolicited Response to the Respondent's Letter of Response, and requested that the Panel move to consider said Response at its discretion. (Note – Petitioner also submitted an unsolicited WIPO Decision for review, but this Proceeding was already referred to in Respondent's Response, and therefore not considered new information).
5. Let it be reminded that the II-DRP aims to serve as an expedited form of dispute resolution, and does not provide the necessary evidence-oriented proceedings to properly enable Parties to refute factual claims and statements presented by the other party. As stated by the Panel in the II-DRP Case between **Compubyte Ltd. v. Ruslan Zhulidov re the domain <ucoz.co.il>**: “The procedure that allows the parties to submit supplemental filings is by filing a request to the Panel for permission to request to file a supplemental filing. The Panel may then, at its discretion, allow such a supplemental filing to be made. 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.”
6. Reinforcement for this approach can be found in the Overview of WIPO Panel Views on Selected UDRP Questions, 2<sup>nd</sup> edition, whereby the summary states that “Most panels that have allowed unsolicited filings have also tended to require some showing of “exceptional” circumstances”. Such circumstances were not specified herein.
7. In light of the above – the Panel concludes that the Response by the Petitioner to the Respondent's Letter of Response will not be admissible as part of the information in this proceeding. Let it be noted that the Panel briefly reviewed the Response and finds that it is immaterial to the decision at hand.

## **B. Consent**

1. The Respondent clearly states in his Letter of Response, that “respondent has no intention to retain or maintain registration or renew or use the domain there nor here for any purpose”. This being said in relation to the domain <barrisol-il.com>, which was held by the Respondent and recently ordered by a WIPO Panel to be transferred to the Petitioner.
2. The Respondent also adds that: “The administrative panel can and should conclude its role by allocating and transferring the domain without prejudice to parties' disputes and arguments”, and repeats this statement in conclusion of his Statement as well.

It is not clear whether or not the Respondent is familiar with the II-DRP Proceedings and authority. However, it is clear that the Respondent gives full consent to the transfer of this Domain to the Respondent herein, and that any

contention and disagreement that Respondent may have with the Petitioner, extends beyond the scope of the Domain Registration.

3. Under the Rules, the Panel is not bound by Rules of procedure, and may use its discretion in ruling on a certain matter, as per section 11 of the Rules: “the Panelist/Panel may conduct proceedings in such a manner as it deems appropriate while giving due consideration to the speedy resolution of the Dispute...”.
4. In a similar UDRP case, *Infonxx.Inc v. Lou Kerner*, Case No. D2008-0434, the WIPO Panel ruled that:

“ when the Complainant seeks the transfer of the disputed domain name, and the Respondent consents to transfer, the Panel may proceed immediately to make an order for transfer”.
5. All of the above is sufficient to indicate the Parties’ consent in order to transfer the Domain to the Petitioner.

#### ***IV. Discussion - Decision***

1. However, in order for a case to be brought before an II-DRP Panel, the Petitioner must show prima facie evidence that certain grounds exist, entitling the Petitioner to bring such Complaint before the Panel. Therefore, the Panel will briefly review the claims as presented by the Petitioner.
2. 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 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.

##### **a. Name is Same or Confusingly Similar**

The requirement in the Rules is that "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".

Both Parties agree that the Domain is the same as the Petitioner’s Name and Marks. Precisely for this reason the Respondent has been using it over the years as a Distributor for the Petitioner.

The Panel finds that the first requirement under the rules is fulfilled.

**b. Complainant has Rights in Name**

The Parties agree that the Petitioner is the owner of the rights in the name.

The Respondent's use of the name over the years derives from his being a Distributor of the Petitioner's Products, hence the Complainant maintained rights in the name.

In his consent to transfer the Domain to the Petitioner, the Respondent also acknowledges the Complainant's rights.

From the above it is evident that the Petitioner has established a Prima Facie claim to rights in the Disputed Domain.

**c. Respondent has no Rights in Name**

Section 3.3 of the Rules requires that "the Holder has no rights in the Name".

The Parties are in agreement that in the past, the Petitioner was a Distributor of the Petitioner, by some Agreement, and as such, held certain rights in use of the Petitioner's Name and Mark. Respondent also presents evidence indicating that the Petitioner allowed for extended use of the Domain for a period of 6 months following Termination of Agreement.

Under other circumstances, the Panel would proceed to apply the *OKI Data Test*<sup>1</sup> to identify whether a distributor maintains rights in a name.

However, the Parties are in Agreement that there is no question as to future rights in the name, which should be returned to the petitioner, unless some other contractual arrangement should be reached. The question at hand seems to be one of timing and of the current contractual relationship – whether or not Agreement is still valid, and what exactly are its Terms regarding termination.

It appears that the Respondent's claim applies mostly to alleged commercial rights emanating from the Agreement between the Parties, which are beyond the scope of this Panel. Respondent refers to current use of the name as part of and subject to a contractual agreement between the Parties, which may or may not have been terminated. Respondent does not claim to have independent

---

<sup>1</sup> *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No.D2001-0903 - Panel found that a Reseller may have bona fide rights in a name, if the following conditions are fulfilled:

- (1) "The Respondent must actually be offering the goods or services at issue.
- (2) The site must accurately disclose the registrant's relationship with the trademark owner;
- (3) The Respondent must not try to corner the market in all domain names, thus depriving the trademark owner of reflecting its own mark in a domain name.
- (4) Respondent must use the site to sell only the trademarked goods; otherwise, it could be using the trademark to bait Internet users and then switch them to other goods."

rights in the Name. Respondent's intention is evident from a correspondence between the Parties, of Feb. 26, 2015, in which the Respondent states to Complainant: "We will of course abide by any decision that you make, such that if you insist on your demand to absolutely remove the Barrisol name, we will act to do so subject to that stated above and below". Therefore it seems that the Respondent acknowledges that upon Termination of the Agreement, at some moment unclear to this proceeding, he will no longer have rights in the name, without prejudice to any other claims that arise therefrom.

Let it also be noted that the Petitioner states to be transferring his local business under the name "SkyTec", thus indicating that its rights in the name Barrisol may be coming to an end.

Therefore, in light of all the above, the Panel finds sufficient grounds to establish that the Holder does not claim to have any ongoing independent rights in the name, without prejudice to any other rights he may have.

**d. Registration or Holding in Bad Faith**

Section 3.4 requires that "the application for allocation of the Domain Name was made or the Domain Name was used in bad faith".

The Rule requires that either the registration or the use be in bad faith.

In this case – there is no basis for claim of Registration in bad faith, as the Parties agree that at least at some past time the Respondent used the Domain as a Distributer of the Petitioner's products.

As for use in Bad Faith – section 4.1 (a) of the Rules sets forth that the following may be evidence of Bad Faith:

"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; "

In this Case – it is the facts at the basis of this contention that are in dispute, and not its applicability. Each Party contends that a different Agreement governs their contractual relationship, each having distinct validity, terms and date for termination. Therefore, it appears that it is unclear, without reviewing additional evidence and information, whether or not the Holder "continues to hold the domain after termination".

In reference to the recent WIPO case regarding the Domain <barrisol-il.com>, (Barrisol / Normalu Group S.A.S. v. Amit Nitzan, Case No. D2016-1433), it may be noted that the Panel verified that Prima Facie evidence exists insofar as the Petitioner's Rights in the Name and Similarity thereof, but made no conclusive findings regarding Respondent's Rights or alleged Bad Faith.

Similar circumstances apply to the case at hand. And as stated by the Panel in the aforementioned case:

“Numerous panels have accepted that an order for transfer is appropriate when consented to by a respondent, either immediately or on a showing of a *prima facie* case by the complainant in such circumstances. “

Therefore, the Panel decides that based on sufficient grounds as provided in the previous sections, and based on the Respondent’s consent to transfer the Domain, without prejudice to any other claims, there is no need to present a *prima facie* case of Bad Faith.

## ***V. Decision***

Notwithstanding any Decision given herein, the Parties are hereby referred, for information, to Section 20 of the Rules, by which: “Petition to the IL-DRP in no way precludes access or petition to an Israel Court of Law”, such that any Party so interested may file a case at the relevant court of law.

In light of all of the above, Panel finds that based on the Petitioner’s *Prima Facie* claim to Rights in the Name and similarity to its Marks, and based on the Consent of the Respondent to transfer the Disputed Domain, without prejudice to any claims or rights arising from the relationship between the Parties, **the Disputed Domain shall be re-assigned to the Petitioner.**

*Leehee Feldman, Adv.*  
Sole Panelist

Date: November 15<sup>th</sup>, 2016