

The Open University of Israel v. Oz Moyal

IL-DRP Panel Decision

The Parties

1. The Complainant is The Open University of Israel (hereinafter: "**the Open University**"), of 1 University Road, POB 808, Raanana, Israel 43107, represented by Advocate Giora Landau of 48 Menachem Begin Rd. Tel Aviv 66184.
2. The Respondent is Oz Moyal of Beer Sheba, Israel (hereinafter: "**the Respondent**").

The Domain Name and Registrar

3. The disputed domain name <openu.co.il> is registered with Gorni Interactive Ltd.

Procedural History

4. The Complaint was filed with ISOC-IL on August 3, 2017. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").
5. On August 13, 2017, the IL-DRP appointed Adi Barkan-Lev as the Sole Panelist.
6. In accordance with the Rules, on August 13, 2017, 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.
7. On August 21, 2017, the Respondent submitted his Response to the complaint.
8. The Complainant requested to submit an Answer to the Respondent's Response and was granted the rights to do so by the Panel. The Respondent was also granted with the right to submit a second answer with a limited timeframe in order to conduct the proceeding fairly yet in an efficient and speedy manner.
9. On September 3, 2017, the Complainant submitted its Answer to the Respondent's Response.
10. On September 11, 2017, the Respondent submitted his Answer to the Complainant's Response.

Factual Background

11. The disputed domain name <openu.co.il> was created on March 3, 2004.
12. The Complainant, the Open University, was founded in 1974 by virtue of an agreement between the Government of Israel and the Rothschild foundation and following a decision of the Council for Higher Education dated October 2, 1973.
13. The Complainant was acknowledged as an institute of higher education based on the Council for Higher Education Law, 5718-1958 (hereinafter: "**the Law**") and following a meeting held by Israeli Government on July 6, 1980. Pursuant to article 9 of the Law, the Open University is a corporation that is competent to sue and be sued, to acquire, possess and relinquish property, to enter into contracts and be a party to any legal or other proceedings.
14. The Complainant claim that it provides academic studies via a range of media channel, not necessarily campus based.
15. The Complainant is operating in Israel for more than 40 years, has branches all over Israel and is considered the biggest university in Israel.
16. In 1993 the Open University registered the domain name <openu.ac.il>. Domain names ending with the suffix ac.il can be used only subject to the approval of the Higher Education Council. The Open University claim that it owns several other domain names using the term opunu and that it is well connected and widely recognized with the Open University.
17. The Complainant claim that it has recently found out that the Respondent has been using the disputed domain name openu.co.il.
18. The Complainant claim that the disputed domain name leads to a commercial website – bgu.co.il, intended for students and that currently, there is no active website using this domain and that the disputed domain name is not being used directly by the Respondent.
19. The Complainant claim that on April 4, 2017, its legal representative sent a demand letter to the Respondent requesting him not to use the disputed domain name and to transfer it to the Open university.
20. The Complainant claim that in an e-mail dated April 14, 2017 the Respondent answered and suggested to negotiate the sale of the disputed domain name.

21. The Complainant further claim that several academic institutions such as the Technion own and use the co.il domains.
22. The Respondent is an individual person residing in Israel that developed and operates a website intended for students since 2003.
23. The Respondent claim that the disputed domain name was purchased by him on 2003, more than 13 years ago, and that he is actively using it in reference to his website intended for students. The Respondent claim that until the Complainant's letter dated April 4, 2017, he was never approached by the Complainant
24. The Respondent claim that the disputed domain name's reputation is a result of him using it.
25. The Respondent claim that the disputed domain name was not purchased by him for the purpose of selling it.
26. The Respondent claim that he operates a students' website and that he uses few domains that are easy for students to remember and that his website include a section that is being used by students attending the Open University. The Respondent claim that his main domain name is bgu.co.il and that it is being used for simplicity purposes and due to google guidelines to prevent double indexing of same website.

Parties' Arguments

A. Complainant

27. The Complainant claim that the Respondent has full intention to misrepresent and pretend to have some contact with the Open University under the name "OPENU" which he does not have.
28. The Complainant claim that the disputed domain name is the name by which the Open University is known in the digital world (OPENU) and that the term "OPENU" is being used by all employee's email addresses in the following manner: _____@openu.ac.il.
29. The Complainant refer to WIPO Panel decision handed in the Marriot Worldwide Corporation and Marriot Intl. Inc. v. Barak Gill.
30. The Complainant claim that it is operating under the name האוניברסיטה הפתוחה/Open University and that it is a well-known academic establishment in Israel.

31. The Complainant claim that the Respondent has no right in the name of the Open University and that he never approached the Complainant with a request to use the name OPENU as a domain nor did the Complainant ever gave such permit to the Respondent.
32. The Complainant claim that the Respondent acted in bad faith according to clause 4.1 (c) and (e) of the IL-DRP rules.
33. The Complainant claim that the Respondent, when requested to transfer the disputed domain name to the Complainant, offered to negotiate the sale of the disputed domain name and that this fact indicate bad faith behavior as clause 4(c) sets.
34. The Complainant claim that the mere registration of the disputed domain name with the terms OPENU is an indication that the Respondent intended to attract, for commercial gain, internet users.
35. The Complainant claim that the Respondent aim to use the potential of student and users web traffic to his website since the Complainant intensely use the Web for teaching and transfer of educational materials.
36. The Complainant further claim in their response that by arguing that the Respondent created the reputation of the disputed domain name while admitting that he does not really use the disputed domain directly but rather use is to attract Open University students, the Respondent produces contradicting arguments since it is not possible to build a reputation for an unused domain name.
37. The Complainant claim that using the disputed domain name to attract Open University students is misleading behavior.

B. Respondent

38. The Respondent argued that his website is in no way pretending or misleading its users of being the Open University. The Respondent argue that the Open University is not mentioned anywhere in the website and that it is obvious just by looking at it.
39. The Respondent argue that it is common knowledge that universities use the academic domain name and that to the best of his knowledge none of the universities in Israel use the co.il domain suffix. The Respondent further argue that all universities use the ac.il domain suffix since the co.il is intended to be used for commercial websites.

40. The Respondent argue that the Complainant is trying to achieve an unjust enrichment since the disputed domain name is his property.
41. The Respondent argue that the internet has different domain extensions and that each extension is used for different purpose. Therefore, identical names can be used with different extensions (suffix) by different owners.
42. In his second response, the Respondent further argue and refer to ISOC registration rules according to which: "*co.il - primarily intended for entities operating for profit*". The Respondent argue that the Open University is a non-profit organization, so the Complainant has no priority over other private individuals.
43. The Respondent also refer to IL-DRP Rules cited by the Complainant that states the following: "*circumstances indicating that the Holder has requested allocation or holds the Domain Name primarily for the purpose of selling...*" (section 4.1c). The Respondent argue that he bought the disputed domain name 13 years ago, and renewed it each year, and never tried to sell it. The issue was raised only after the Complainant send him their April 4, 2017 letter. The Respondent argue that this fact indicate that he did not buy the disputed domain name with the primarily intention of selling it.
44. The Respondent also refer to IL-DRP Rules cited by the Complainant that states the following: "*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...*" (section 4.1e). The Respondent argue that his website is a legitimate students' website that has over 5000 daily users, operates for 14 years and been his main income. The Respondent argue that the website has no likelihood to any university website or that he does not try in any way to confuse the users. The Respondent argue that a reasonable user will not think this is the Open University's website and that there is no official academic website operating under the domain suffix .co.il.
45. Finally, The Respondent argue that "OPENU" is not a registered trademark of the Complainant.

Discussion and Findings

46. 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 with Gorni Interactive Ltd. registration agreement provides that the applicant for the domain name accepts the ISOC-IL registration rules (see <https://domains.livedns.co.il/Terms.aspx>).

47. The ISOC-IL registration rules provide that "*the [domain name] holder agrees to the jurisdiction of the IL-DRP.*" (See section 12.3). The Respondent, therefore, by applying for and registering the disputed domain name agreed to the IL-DRP and the Rules.
48. It is also noted that the Rules 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.
49. The Rules (section 3) provide that disputes regarding the allocation of a domain name by a Holder may be brought by a Complainant on the following grounds:
- 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
 - the Complainant has rights in the Name; and
 - the holder has no rights in the Name; and
 - 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

50. 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.
51. The Complainant is the Open University - an institute of higher education that was founded in 1974. According to law, the Open University is a corporation that is competent to sue and be sued, to acquire, possess and relinquish property, to enter into contracts and be a party to any legal or other proceedings. The Open University is operating in Israel for more than 40 years, has branches all over Israel and is considered the biggest university in Israel. The Complainant also provides academic studies via a range of media channel, not necessarily campus based.

52. The Complainant has no trademark registrations in Israel which consist of the mark "OPENU" or "OPEN UNIVERSITY", but a google search under the words "open university" that this Panel performed revealed that all results are related to the Complainant. The Complainant is also the owner of the domain name www.openu.ac.il and uses the term OPENU in the digital world and upon examining its website - for its employee's email addresses, for example: infodesk@openu.ac.il.
53. The disputed domain name <openu.co.il> comprises of the Complainant's first name element – the word "open" with the addition of the shortening word for universities, the letter "u" (see also *University of Windsor v. Modern Empire Internet Limited*, WIPO Case No. D2006-1238 ("**the University of Windsor case**") and the suffix ". co.il".
54. The suffix ". co.il" is ignored for the purpose of determination of the similarity between the disputed domain name since it is a common suffix showing that the domain name is part of the .il domain and associated with commercial activities (.co suffix).
55. Therefore, this Panel finds that the Complainant's rights in the "OPENU" mark have been established in this case by virtue of its long term of use and reputation.
56. As detailed above, the term "OPENU" of the disputed domain name is identical to the name of the Complainant and its ac.il domain name and thus confusingly similar. Therefore, the Panel finds that the disputed Domain name is the same as the Complainant's name. Hence, the first requirement under the Rules, is fulfilled

B. Rights in the Name

57. Next, it is up to the Complainant to show that the Complainant has rights in the OPENU mark, and that the Respondent has no rights in the OPENU mark.
58. The Complainant showed sufficient evidence showing it has rights in the OPENU mark. The evidence shows that the Complainant's OPENU mark has gained significant goodwill, especially in Israel, since its establishment in 1974.
59. This Panel finds it can be determined that the mark "OPENU" should be regarded as a well-known mark associated with the Complainant even though it is not a registered trademark as argued by the Respondent (see also IL-DRP Panel decision dated 4.9.2011 in the matter of the *Open University of Israel v. Mr. Reuven Gorodetsky* ("**the Open University v. Gorodetsky case**") citing the *University of Windsor case*.

60. It is also up to the Complainant to show that the Respondent has no rights in the Name. The Complainant has provided that it has not approved or permitted for the Respondent to use its trademark or name.
61. While the Complainant bears the "general burden of proof" under Rule 3.3, this burden shifts to the Respondent once the Complainant makes a prima facie showing that the Respondent lacks rights or legitimate interests. (See *Neusiedler Aktiengesellschaft v. Kulkarni*, WIPO Case No. D2000-1769; *Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited*, WIPO Case No. D2000-0704.)
62. In the present case, the Complainant alleged that the Respondent has no rights or legitimate interests in respect of the disputed domain name.
63. The Respondent alleged that the disputed domain name was purchased by him on 2003, more than 13 years ago, and that he is actively using it in reference to his website intended for students. The Respondent claim that the disputed domain name's reputation is a result of him using it.
64. The Respondent further argue that though he had registered the disputed domain name 13 years ago, he was approached by the Complainant only on April 2017.
65. Finally, the Respondent argues that the internet has different domain extensions and that each extension is used for different purpose. Therefore, identical names can be used with different extensions (suffix) by different owners. The Respondent also argue that it is common knowledge that universities use the academic domain name and that to the best of his knowledge none of the universities in Israel use the co.il domain suffix that is intended to be used for commercial websites.
66. The Respondent further argue that the Open University is a non-profit organization, so the Complainant has no priority over other private individuals.
67. The Panel notes that academic institutions operate commercial oriented research projects that originates from the academic institute. Therefore, though the co.il suffix is intended for entities operating for profit and the Open University is an academic and primarily a non-profit organization, it may use its equivalent co.il suffix domain name as the Technion does by relating it to its web site located at www.technion.ac.il. As decided in the *Open University v. Gorodetsky* case: "*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 it's recognized Name, with any possibly suffix".

68. The Panel notes the Complainant's evidence, and considers the fact that the Respondent did not provide any evidence to show any rights or legitimate interests in the disputed domain name.
69. The Panel also notes the fact that the Respondent offered to negotiate the selling of the disputed domain name after he was approached by the Complainant which is an indication of lack of legitimate interest in the disputed domain name.
70. Thus, in the present case and given the evidence presented before the Panel, the Panel finds that the Respondent did not rebut the Complainant's prima facie case.
71. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. Application and Use in Bad Faith

72. 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.
73. WIPO and IL-DRP Panels, relying on Rule 4.1 of the Rules, often rule 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:

"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".*
74. The Complainant claim that the Respondent acted in bad faith according to clause 4 (c) and (e) of the IL-DRP rules.
75. The Complainant claim that the Respondent, when requested to transfer the disputed domain name to the Complainant, offered to negotiate the sale of the disputed domain name and that this fact indicate bad faith behavior as clause 4(c) sets.
76. The Respondent claim that the disputed domain name was not purchased by him for the purpose of selling it and that he offered the sale only after the Complainant approached him in April 2017.
77. The concept of a domain name being used in bad faith is not limited to positive action: inaction is within the concept (See *Cho Yong Pil v. Kee Dooseok*, WIPO Case No. D2000-0754 ("**the Choi Yong Pil Case**").
78. Nevertheless, according to Rule 4.1(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*" are considered as "bad faith" behavior.
79. In the present case, the Panel notes that 13 years passed before the Respondent offered the sale of the disputed domain name to the Complainant and only after the Complainant approached him. Though the Respondent's vague negotiation terms to sell the disputed domain name indicate some degree of bad faith on his behalf, it

- cannot be considered as a primarily purpose for purchasing and holding the disputed domain name.
80. The Complainant claim that the mere registration of the disputed domain name with the term OPENU is an indication that the Respondent intended to attract, for commercial gain, internet users as set in Rule 4.1(e) above.
 81. The Respondent claim that he operates a students' website and that he uses few domains that are easy for students to remember and that his website include a section that is being used by students attending the Open University. The Respondent claim that his main domain name is bgu.co.il and that it is being used for simplicity purposes and due to google guidelines to prevent double indexing of same website. Thus, it is clear that the disputed domain name is re-directed to another website associated with the Respondent < bgu.co.il >, that engages in providing services to students.
 82. As detailed above, the evidence provided by the Complainant shows that the OPENU mark has acquired significant good-will and is indicating to the Open University academic institute. The Respondent registered the disputed domain name almost 30 years after the Open University was established in 1974.
 83. The disputed domain name is identical to the Complainant's OPENU well-known mark. By registering and using a domain name incorporating the well-known and well established mark OPENU, the effect is to mislead Internet users and consumers into thinking that the Respondent is, in some way or another, connected to, sponsored by or affiliated with the Complainant or that the Respondent's activities are approved or endorsed by the Complainant. None of which the Panel can find, on the basis of the arguments presented by the parties, is, in fact, the situation (see *Swarovski Aktiengesellschaft v. fan wu*, WIPO Case No. D2012-0065).
 84. Therefore, This Panel finds that the Respondent acted in bad faith since 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 website.
 85. The Panel finds, that the use of the disputed domain name <openu.co.il> to re-direct to another website of the Respondent, while offering services to the Complainant's students, is a clear indication of the Respondent knowledge of the Complainant and its goodwill, and is also an indication, in this specific case, of the Respondent's bad faith use of the disputed domain name.

86. The Panel notes the fact that the disputed domain name was not actively used by the Respondent but rather was re-directing to another website operating under the domain name www.bgu.co.il and that the Respondent has engaged in negotiation to sell the disputed domain name as such indications of bad faith.
87. Further, the Respondent argue that the Open University is not mentioned anywhere in his website and that his website is a legitimate students' website that has no likelihood to any university website and that he does not try in any way to confuse the users. No explanation was provided by the Respondent as to the purpose of using the disputed domain name. If anything, the Respondent use of the disputed domain name to redirect to a web site described as "Ben Gurion University Students Website" shows exactly the opposite.
88. Therefore, in this case, the Panel finds that the facts established above are sufficient to establish that the Respondent had registered or is using the disputed domain name in bad faith, as provided in Rule 4.1(e).
89. Thus, it is the finding of the Panel that the Complainant met the burden of showing that the Respondent registered or used the disputed domain name in bad faith in accordance with Rule 3.4.

Decision

90. For all the foregoing reasons, in accordance with the Rules, the Panel orders that the domain name, <openu.co.il> be TRANSFERRED to the Complainant.

Adi Barkan-Lev

Adi Barkan-Lev, Advocate
Sole Panelist
Date: September 18,
2017.