

IL-DRP PANEL

For the Internet Society of Israel

Before
Yoram Lichtenstein, Adv. (the "Panelist")

In the matter of
the domain name "Strider.co.il" (the "Domain Name")

between

Strider Sports International, Inc.

2221 North Plaza Drive

Rapid City, SD 57702

USA

(the "**Petitioner**")

and

Mr. Gil Yakoby

Harav David Asaf 2,

Haifa 34760

Israel

(the "**Registered Holder**")

DECISION

I. The Parties

The Petitioner is a company incorporated in the USA.

The Registered Holder is a private Israeli citizen.

II. Procedural Background

This panel was established on February 27, 2018 (payment of fees had been delayed), in accordance with the Procedures for Alternative Dispute Resolution under the .IL ccTLD by Dispute Resolution Panel (https://www.isoc.org.il/domain-name-registry/dispute_resolution/ildrp-rules in Hebrew and http://en.isoc.org.il/domains/ildrp_rules.html in English) (the "**Rules**"), in order to address the Petitioner's request to cancel the registration of the Domain Name.

The Registered Holder was notified that a petition had been filed on March 12, 2018 and both parties had been notified of the appointment of this Panelist. Petition and all its annexes were submitted to Registered Holder.

Confirmation of the receipt of notification was made on March 14, 2018 while Registered Holder had requested 90 days extension to submit its response. Decision on this matter was given on March 21, 2018, and Registered Holder was allowed a 30 days extension (45 days altogether) to submit his response. On May 5, 2018 the Panelist had awarded another 1 day extension, yet until the time this Decision was issued – no response had been submitted.

Therefore the following decision is based on the Petition, its attached Annexes and the review of the website located on the Domain Name and the Israeli Trademark Registrar online files.

Prior to this decision, Registered Holder had sent an email response which I include in this Decision.

III. Petitioner's claims

Petitioner holds Israeli registered trademark No. 265402 – textual trademark "STRIDER" (which shall expire on 2024) in Classes 12 and 28 (Tricycles, strollers, scooters, bicycles, structural parts for scooters; vehicles for children and Toy vehicles; toy scooters; toy tricycles; toy pedal cars; ride-on-toys; skateboards; scooters; roller skates).

Petitioner stated that it holds 2 trademarks on said classes yet, in review of the Registrar's searchable trademarks index it had been evident that it only holds that one registered trademark.

Respondent has no rights or legitimate interest in respect of the Domain Name. Parties had been parties to an International Licensing and Distribution Agreement and the past, which was terminated on March 29, 2017. Registered Holder had failed to revert all ownership and control of the Strider intellectual property back to Petitioner, including the Domain Name.

Thus, claims the Petitioner, the Domain Name was registered and is used in bad faith, as Registered Holder is no longer an Authorized Distributor of Petitioner.

Therefore the, it claims, the Domain Name should be cancelled.

IV. Registered Holder's Arguments

Registered Holder's arguments sadly were not filed on time, although a generous extension had been awarded.

As these are proceedings that should be easy, swift and efficient, this Panelist did not find it reasonable to award a 90 days extension, yet awarded 30 days of extension.

On May 16, 2018 I have received a short email response stating that the Domain was registered prior to the Agreement with Strider, so he is willing to transfer the Domain for a sum of 5000 US\$. The amount was calculated based on much resources invested in SEO efforts and support to the Domain, and will be further required for a complimentary domain on his behalf.

V. Discussion and Findings

The IL-DRP is an alternative dispute resolution procedure devised to allow expedited dispute resolution regarding the allocation of online domain names.

Upon registering a domain name with the suffix co.il, the Registered Holder agreed to abide by the Rules, and this procedure is conducted by the Rules.

According to article 3 of the 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."

Those grounds are cumulative and must be established sufficiently by Petitioner.

V.1. Is Name is same or confusingly similar to Trademark?

The Rules require that the Domain Name is the same or confusingly similar to the Trademark.

The dispute Domain Name consists of the name STRIDER and the suffix .co.il.

The registered trademark consists of the term STRIDER.

It has been consistently ruled that the suffix is to be ignored for the review whether the Domain Name and the Trademark are the same or similar (for example see the cases of **L'Oreal v. La Belle Cosmetics Ltd.** over the domain name "essie.co.il" under the IL-DRP, hereby – "**the L'Oreal Decision**" and **Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic**, case No. D2000-1698 over the domain name "guinness.com" under the UDRP).

Hence, my decision is that the Domain Name is the same as the Trademark.

V.2. Does Petitioner have rights in the Name?

Petitioner had shown it holds a registered Israeli trademark on the name STRIDER (No. 265402).

Thus, it has been prove to my satisfaction that Petitioner holds rights in the Name, in Israel.

V.3. Does Registered Holder have no rights in the Name?

Petitioner claims that Registered Holder was an Authorized Distributor of its products in Israel and had also annexed the Distribution Agreement and is Termination Notice.

Article 4 to the Agreement states that either party may immediately cancel this Agreement at any time by written notice to the other party. Upon notice, distributor

may continue to sell the Strider products for 6 months, and following that date it may not make any use of the Strider intellectual property, including the names or trademarks detailed in the Agreement (and "STRIDER" is among them).

Petitioner submitted and email correspondence with Registered Holder, showing the termination notice served in accordance with the Distribution Agreement. Registered Holder further stated that "All strider bike are gone" but he still holds legally purchased parts of said bikes. He further and explained that he does not have any claim to the domain names held by Petitioner (such as Stridersport and Streetstrider) but that he holds the Domain Name itself, and it may be bought from him (along with the website).

As the Distribution Agreement had terminated and considering the above, I decide that Registered Holder may have registered the Domain Name in good faith and with interest as local distributor, yet as of this date **Registered Holder does not have any legal right to keep using the Domain Name or prohibiting the Petitioner from using it and harm its potential business in Israel.**

To remove any doubt, this is not a trademark decision and I say nothing about the right or lack of right of Registered Holder to dully sell legitimate bike-parts purchased by him. This decision applies solely to the right to use the Domain Name.

V.4. Was the application for allocation of the Domain Name made or the Domain Name was used in bad faith?

Article 3.4 requires that "the application for allocation of the Domain Name was made or the Domain Name was used in bad faith". Those conditions are alternative and Petitioner may prove only one of them to meet the requirements set by the Rules.

Article 4.1 of the Rules supplies not exhaustive examples of what should be considered bad faith use of the name, and those are -

- 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.

By Registered Holders representation, the Domain was "purchased" prior to his Agreement with Strider. I review such purchase of a domain name holding a registered Trade Mark as "bad faith" in accordance to the Rules, articles 4.1(c) and 4.1(e).

Furthermore, ignoring that, when the distribution agreement had been terminated and Registered Holder is no longer distributor of the products, he should have stopped any use of the website under the Domain, so article 4.1(a) applies as well. On a side-note, article 4.1(c) may also apply based on Registered Holder offer to sell the website to Petitioner.

As of this date, the website hosted under the Domain Name is discussing the Strider bikes and their benefits and for the casual, non-observant, user may look as if it sells Strider bike. The website's name itself, as of now, is not "strider" yet "Rider".

So I conclude that the use of the Domain Name, currently, is done in a manner that corresponds with the IL-DRP bad-faith terms.

To remove any doubt, this decision is not to blemish the Registered Holder's intent or moral position in any way, yet it corresponds with the procedural definitions of bad faith under the IL-DRP.

VI Decision

Therefore, based on all of the above, the Panel concludes that in accordance with the Rules, the registration of the Domain Name to its current Holder is to be REVOKED ("cancelled"), as requested.

Yoram Lichtenstein, Adv.
Sole Panelist

Date: May 17, 2018