

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

In the matter of the **Domains**
Elite-espresso.co.il and Espresso-elite.co.il

between

Strauss Group Ltd.
Represented by Adv. Saar Plinner
And/or adv. Assaf Naim
(The "Petitioner")

and

Mr. Yuval Masi
(The "Respondent")

DECISION

I. Procedure

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Names "Elite-espresso.co.il" and "Espresso-elite.co.il" (herein the "Disputed Domains") 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) (hereinafter – "the Rules"). Notification of the pending Petition, including copies of all submitted material, and notification of appointment of the Panel under the Rules, was sent on June 19th, 2012, 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 July 4th, 2012, to submit a Statement of Response or any other relevant information to the Panel.

2. The Respondent did not provide any Response to this Petition.

II. Factual Background

1. The Petitioner is an Israeli Conglomerate, specializing in the food and beverage industry in Israel. It is comprised of a merger between two companies: Elite, specializing in the coffee and confectionary industry, and "Strauss", specializing in the dairy industry.
2. The Petitioner is the owner of an extensive list of Registered Trademarks, including approximately 50 Marks bearing the name "Elite", in English and in Hebrew, on its own or jointly with other terms.

3. The Petitioner or the companies of which it consists have been using the term "Elite" for many years, since approximately 1935, when the first Trademark request was filed.
4. The Respondent registered the Disputed Domains on February 15th, 2012. To date, no active web site has been associated with either of the Disputed Domains.
5. During April 2012, the Petitioner attempted to contact the Respondent via email and via Registered mail, according to the Contact Details as they appear in the Registry. A copy of said letter or a description of its contents have not been presented to the Panel. However, the Respondent replied to neither. A return message from the Israeli Post stated that "message has been forwarded to updated address" of Respondent.

III. The Parties' Claims

A. The Petitioner

1. The Petitioner claims to be Israel's second largest food and beverage corporation.
2. Petitioner has been using the term "Elite" since before 1937, first registered as a Trademark by the Petitioner's predecessor and Petitioner owns approximately 50 trademarks referring to the term "Elite", whether alone or in conjunction with other terms.
3. The Petitioner is the owner of the domain: www.elite.co.il, which consists of the Registered Trademark "Elite", and was assigned in 1995.
4. Petitioner states that every single person in Israel has become familiar, at some point, with the petitioner's brand and its strong affiliation with coffee and confectionary products.
5. Among the products branded by the Petitioner is also "Elite Coffee".
6. Petitioner claims the Respondent has no rights in the Domain Names, and has no connection whatsoever to the Petitioner.
7. Petitioner tried to contact Respondent, unsuccessfully, as mentioned above. Reference is made by Petitioner to section 22 of the ISOC-IL Domain Registration Rules, indicating that failure to update Registrant information can lead to cancellation of Domain Registration.
8. Petitioner claims that the Disputed Domains consist of a main element, "Elite", which is identical to the Petitioner's Registered Trademarks.
9. Petitioner states that addition of the descriptive element "espresso" is not sufficient to distinguish between the Registered Mark and the Disputed Domain.
10. Petitioner claims that Respondent acted in bad faith in registering the Disputed Domains: Domains do not have an active website associated with them, the Petitioner has a long lasting reputation regarding coffee products and the brand Elite, Respondent is preventing Petitioner from making legitimate use of the Domains.
11. Petitioner claims that the main element of the Domains, "Elite" is a coined word with no connection to the field of coffee. Such use on behalf of the Respondent indicates his lack of good faith in using the Domain name combination.

B. The Respondent

The Respondent failed to submit any Response to the Petition.

IV. Discussion

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 .IL. By registering a Domain, any Holder agrees to abide by these Rules.
2. In order for a case to be brought before a Il-DRP Panel, the Petitioner must show that certain grounds exist.
3. Let it be noted that without Response on behalf of the Respondent, the Panel will not refute any insufficient claims stated by the Petitioner, but will instead proceed to review whether the information present is in itself sufficient to establish grounds for re-allocation of the Disputed Domains, based on aforementioned Rules.
4. Therefore we will proceed to review existence of the grounds for the request, as follows:

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.
4. Each of the claims above needs to be well established by Petitioner. In the following discussion we will address each claim, based on the Materials of the Petition and any other material available to the Panel. I .

a. Name is Same or Confusingly Similar

The Disputed Domain Names consist of two parts – "Elite" and "Espresso" (it has been previously ruled that the suffix "co.il" is to be disregarded for the purpose of determining similarity of a Domain to a Registered Mark)

The Petitioner holds dozens of Marks including the term "Elite", whether alone or in conjunction with another term.

However, the Petitioner does not hold any Marks including the descriptive term "Espresso" (curious to note that in 1997 the Predecessor of the Petitioner had registered the Mark "Espresso Elite", but this registration was not renewed in 2003).

It is therefore clear that the Disputed Domains are not identical to the Petitioner's Mark, and the question at hand is whether or not the Names are "confusingly similar".

Many IL-DRP cases have addressed this question, as well as WIPO cases which can be used as a reference point.

In the IL-DRP case of "Rakevet.co.il", the Panel stated that:

"The concept of "confusingly similar has its pedigree in both trademark and 'passing-off' law, which we refer to by way of analogy for guidance, without expressing an opinion on the ultimate parameters of the test within the context of ISOC-IL Procedures. Both trademark and passing-off law require that when a name is similar to a trademark or business name, that the similarity creates, in the words of the court in Civil Appeal (CA) 5792/99 Communication and Religious-Jewish Education Mishpaha 1997 Ltd. et al v. SBC Advertising, Marketing and Sales Promotion Ltd. et al, Decisions of the Supreme Court 54 (3), 933, at p. 942, "a reasonable concern about confusing the public to think that the product or service offered by the defendant to the public – is the product or the service of the plaintiff or that they are connected to him." Pp 15- 16.

And in WIPO case in matter of San Giorgio Coffee, Inc. v. Marc DeCaria (Case No. D2010-0567), the Panel stated that:

"The disputed domain name is not identical to Complainant's mark; therefore Complainant must establish that it is confusingly similar to the Complainant's mark, determined with reference to the degree of resemblance between the domain name and mark at issue as to appearance, sound, and meaning. As a general matter, a domain name is likely to be deemed confusingly similar to a mark if it incorporates the mark or a variation of the mark. The Panel finds that the domain name is confusingly similar to the SAN GIORGIO ESPRESSO COFFEE mark. The disputed domain name consists of the first and last portions of the mark, which appear to be the dominant portions of the mark".

And also, as quoted in RapidShare AG, Christian Schmid v. Helena Clouse, (Case No. D2010-1086.)

"In finding confusing similarity, many Panels have found that the mere addition of a descriptive term by way of prefix to a complainant's mark does not adequately distinguish the disputed domain name from the mark".

It is self evident that any Israeli consumer coming across the combination "Elite-espresso" will assume it is in some way, at least, affiliated with the Petitioner.

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.

b. Complainant has Rights in Name

The following are clear indications of the Petitioner's Rights in the Disputed Domains:

- Petitioner has established that "Elite" is a well known trademark around the country and the world: It is associated with brands of coffee and confectionary goods, and has been recognized as such for many years.
- The Petitioner holds numerous Registered Trademarks which are identical to part of the name – for example: Registered TM 47,296 of the Mark Elite, of 1979 , Registered TM 47,321, 47322, 47,325 and many more – all of the Mark Elite, in classes referring to non-alcoholic beverages, coffee products, etc.
- The Petitioner has registered a domain (www.elite.co.il) which is strongly similar to the Disputed Domains.
- The Petitioner has spent significant efforts in advertising this Brand and establishing public recognition. The panel accepts the Petitioner's assumption that any person in Israel is familiar with the Elite brand, its association with coffee and espresso products, and its connection to the Petitioner.

From all of the above it is evident that the Petitioner has established rights in the Disputed Domains.

c. Respondent has no Rights in Name

Respondent is a private citizen, who has no association whatsoever with the Petitioner or its products.

Respondent has neither replied to this Petition nor to previous attempts on behalf of the Petitioner to contact him.

Neither of the Disputed Domains is active nor is there any indication what purpose they were purchased for.

The Panel has no prima facie indication that the Respondent has any intention to use the Disputed Domains or for what purpose.

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

d. Registration or Holding in Bad Faith

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

However – this list is not exhaustive, and does not prevent additional circumstances from constituting bad faith.

In this case, several acts on behalf of the respondent are indicative of bad faith:

- The Respondent holds two Domains which are inactive and don't direct to an active web site.
- Given the extent of the Petitioner's reputation, it is most likely that the Respondent was aware that in registering the Disputed Domains, he will be preventing the Petitioner from operating a site at a Domain which includes its long-time Registered Mark, and any activity would undoubtedly mislead the public to associate the Domain with the Petitioner.
- The term "Elite" is a coined word without particular meaning in relation to coffee or espresso products. Such combination as used by the Respondent is based solely on the meaning created by the Petitioner for the Mark "Elite" as a brand of coffee products.
- The Petitioner failed to reply to this Petition or to any previous attempt to contact him.

The combination of all of the above is a sufficient indication of bad faith. Similar decisions have been reached by ISOC Panels in the past, based on similar circumstances. See for example ISOC II-DRP Decisions regarding the Domain מריוט.co.il or the Domain havaianas.co.il

Therefore the Panel concludes that the Respondent has acted in bad faith.

V. Decision

In light of all of the above, Panel finds that the Disputed Domains are confusingly similar to many well known and Registered Marks of the Petitioner, the Petitioner has established substantial circumstances supporting its rights to the Disputed Domains, the Respondent presented no rights in the Domains, the Respondent has acted in bad faith in registering and holding the Domains.

Therefore, the Panel concludes, in accordance with the Rules, that the Disputed Domain shall be re-assigned to the Petitioner, within 30 days of the date of this decision.

Leehee Feldman, Adv.
Sole Panelist

Date: July 20th, 2012