

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

In the matter of the Domain **קירבי.co.il**

between

The Scott Fetzer Company

Represented by Adv. Eitan Shaulsky
And or adv. Sanford T Colb and/or adv.
David Colb and/or adv. Inbal Navot Eisenthal
(The "Petitioner")

and

Mr. David Kim
(The "Respondent")

DECISION

I. Procedure

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Name "**קירבי.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 .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 May 8th, 2012, to the Respondent's email address. In accordance with section 9.3 of the Rules, the Respondent was allotted 15 days, concluding on May 23rd, 2012, to submit a Statement of Response or any other relevant information to the Panel.
2. The Respondent requested clarification regarding the procedure, and after being directed to the Rules in their Hebrew Version, replied on May 14th that he agrees to transfer the Disputed Domain to Kirby-Israel.
3. In order to ascertain the Panel's authority to review the Petition and to transfer a Domain under the Rules, we will proceed herein to analyze whether the grounds for Petition exist, in accordance with section 3 of the Rules. In addition we will address the Respondent's email response and agreement to transfer the Disputed Domain to the Petitioner.

II. Factual Background

1. The Petitioner is an American Company, who owns the Kirby Company as a subdivision therein. It is the owner of the internationally famous Trademark

"Kirby", as well as the Israeli Registered Trademark "Kirby" (Registered TM # 82,845).

2. The Respondent registered the Disputed Domain on March 1st, 2011. To date, no active web site has been associated with the Disputed Domain.
3. On April 1st, 2012, the Petitioner sent the Respondent a letter requesting that the Respondent cease from any use of the Kirby Trademark which is owned by the Petitioner, and that he transfer the Domain to the Petitioner's name.
4. The Respondent returned an email in which he claims to be an admirer of Kirby, and that he registered the Domain only in order to "protect it from being harmed by others". He also requested the Petitioner's attorney to contact him in order to explain his letter.
5. The Petitioner's attorney did indeed contact the Holder by phone (conversation was recorded and submitted with Petition – hereinafter "the phone conversation"). During this conversation, the Holder claimed that he has no intention of using the Domain, he is willing to release it for a "symbolic" sum of 20,000NIS, and if he doesn't receive this sum, he will continue to hold the Domain, without further use.

III. The Parties' Claims

A. The Petitioner

The Petitioner provides a long list of claims endorsing its rights in the Disputed Domain as its world re-known, well recognized trademark, and indicating that the behavior of Respondent amounts to various torts (misleading the public, cybersquatting, trademark infringement, unjust enrichment, passing off, unjust intervention, misappropriation and more). The petitioner claims that the Respondent holds the Domain in bad faith, never intended to use it and holds it with primary intent of selling it for excessive profit.

B. The Respondent

The Respondent failed to submit a formal Response to the Petition.

The Respondent replied by an email, addressed to the ISOC Panelist and to the Petitioner's attorney, in which he agrees to transfer the Domain to Kirby Israel.

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 II-DRP Panel, the Petitioner must show that certain grounds exist. Even though in this particular case the Holder agrees to transfer the Domain name, the Panel must still establish that it has the authority, and that the grounds exist, for transferring the Domain, and also must ascertain that the Domain be transferred to the specific Petitioner.
3. 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, in order for the Panel to be able to re-assign the Domain, as follows:.

a. Name is Same or Similar

The Disputed Domain Name consists of two parts – the name "קירבי" and the suffix "co.il". It has previously been decided that the suffix "co.il" should be disregarded when examining similarity of a domain name with a trademark (see for example IL-DRP cases regarding crayola.co.il, or האוניברסיטה הפתוחה.co.il), and therefore we need only to examine the similarity between "קירבי" and "Kirby".

The word קירבי, is a direct transliteration of "Kirby". The English name "Kirby" is a registered Israeli Trademark, owned by the Petitioner. The question arising regarding this claim is whether or not a Registered Trademark in English of the mark "Kirby" is sufficient in order to ascertain the similarity between the Hebrew term and the English mark.

Similar issue was discussed in various II-DRP panel decisions, such as regarding גאפ.co.il, or ריבוק.co.il. In both cases, it was decided that "when the disputed domain name is a phonetic equivalent and a transliteration of the Latin characters of a complainant's well known trademark, it infringes the Complainant's rights in its well known trademark".

It can also be noted that pronunciation of both words is identical.

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

Petitioner has established that "Kirby" is a well known trademark around the world: It is associated with the Kirby brand of vacuum cleaners, both in

Hebrew and in English. The Petitioner owns not only the "Kirby.com" domain, but also "Kirby.co.il", as well as many others.

In addition it can be noted that the Holder, in his email response to the Petitioner's first letter requesting transfer of the name, claims that he is an admirer of Kirby, and wants to defend his favorite brand, and save it to give to the Petitioner. As such, even the Holder admits that the Kirby Company, as a division of the Petitioner, has established a world re-known brand.

From all of the above it is evident that the Petitioner has established rights in the name קירבי .

c. Holder has no Rights in Name

Holder is a private citizen, who once worked for the Kirby company, according to his email to the Petitioner. Since purchasing the Domain and to this date there is no active website connected with the Disputed Domain.

As evident from his response to the Petitioner's phone call – the Holder admittedly has no interest in the Name, he is not in the business of selling vacuum cleaners, has no intention of operating a web site in the Domain, and will willingly sell it, provided he receives sufficient consideration.

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

d. Registration or Holding 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. Among these are "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...for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; *(Highlights not in original text-LF)*"

In the phone conversation the Holder stated that he had registered the Domain without intent to use it. Though in passing he claimed at first to possibly want to use it, the Holder admitted that once he realized he can't use it, he will sell it. He clearly states that has no intention of using it, no intention of causing any harm, is not in the business of selling vacuum cleaners and is holding the name only until he finds to whom to sell it.

Though it is at best unclear why the Holder initially bought the Domain, it is very clear that he is currently holding in only for purpose of selling it, at excess profit (20,000nis), thus constituting bad faith.

5. Transfer of Disputed Domain - One additional issue to be addressed is the identity of the assignee to whom the Petitioner agrees to re-assign the Domain.

In his email Response, addressed directly to the Panel (myself) and to the Petitioner's attorney, the Holder agreed to transfer the Domain to "קירבי ישראל".

It is noted that nowhere in any submitted document, is there any reference to a legal entity by the name of "קירבי ישראל".

However, from the context of the interaction, it can be deduced that the Respondent's consent refers to transfer to the Petitioner, based on the following:

- a. The Respondent exchanged emails with the Petitioner's attorney regarding the Domain;
- b. The Respondent acknowledged the II-DRP procedure in discussion of the Domain
- c. The Respondent's letter of agreement to transfer the name to Kirby Israel was addressed to the Panelist and the Petitioner's attorney.

Based on all of the above, the Panel ascertains that the Respondent consented in his email to transfer the Disputed Domain to the Petitioner, as requested in the Petition documents.

6. Let it be noted that in light of the circumstances of the case, and the lack of objection on behalf of the Holder, the panel does find it necessary to address each and every one of the Petitioner's claims.

V. Decision

In light of all of the above, Panel finds that the Petitioner has established substantial circumstances supporting its rights to the Disputed Domain קירבי.co.il, and the Holder has agreed to surrender his rights in the Domain and transfer it to the Petitioner.

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.
Panelist

Date: May 22nd, 2012