

Essilor International v. Duan Zuochum

IL-DRP Panel Decision

1. The Parties

The Complainant is Essilor International (Compagnie d'Optique), represented by Dr. Shlomo Cohen, & Co., of Israel.

The Respondent is Duan Zuochen, of Zhuhai, China.

2. The Domain Name and Registrar

The disputed domain name is <essilor.co.il>.

3. Procedural History

The Complaint was filed with ISOC-IL on April 8, 2013. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On April 14, 2013, the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on April 15, 2013, 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.

The Respondent did not submit a Response to the Complaint.

4. Factual Background

The disputed domain name was registered by the Respondent on January 3, 2013.

The Complainant is the world leader in ophthalmic lenses. The Complainant was created from the merger of two ophthalmic equipment manufactures Essel and Silor in 1972.

The Complainant is the owner of numerous trademark registrations for the mark ESSILOR worldwide, for example: US Trademark registration No. 1756467 – ESSILOR, of March 9, 1993; International Trademark registration No. 388436 - ESSILOR, of June 7, 1972; Israel Trademark registration No. 35583 – ESSILOR, of June 6, 1972.

The Complainant is a registered owner of numerous domain name registrations consisting of the mark ESSILOR, for example: <essilor.com>, <essilor.fr>, <essilor.org>.

On March 27, 2013, the Complainant sent the Respondent a cease and desist letter, requesting the Respondent to transfer the disputed domain name to the Complainant. The Respondent replied and offered to transfer the disputed domain name to the Complainant for \$US3,000.

On March 28, 2013, the Complainant rejected the Respondent's offer and demanded again that the Respondent transfer the disputed domain name to the Complainant and demanded further that the Respondent pay US\$2,000 costs to the Complainant.

On March 29, 2013, the Respondent repeated his offer to transfer the disputed domain name for Euro1,500. On the same day the Respondent contacted the Complainant directly and offered to transfer the disputed domain name for Euro1,000.

The disputed domain name currently resolves to an error page.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name is identical to the Complainant's name and well-known trademark.

The Complainant argues that it did not license, sell, transfer or in any way authorize the Respondent to use the ESSILOR trademark.

The Complainant argues that it and its ESSILOR trademark are well-known worldwide and the ESSILOR trademark is associated with the Complainant.

The Complainant further argues that the Respondent was aware of the Complainant when registering the disputed domain name, and has done so in order to rely on the Complainant's vast goodwill in the mark ESSILOR.

The Complainant further argues that the Respondent registered the disputed domain name in bad faith, trying to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant.

The Complainant further argues that in registering the disputed domain name Respondent attempts to misappropriate, dilute and harm Complainant's goodwill in its trademark ESSILOR.

The Complainant further argues that the Respondent's demands for the transfer of the disputed domain name are a clear indication of the Respondent's bad faith.

For all of the above reasons, the Complainant request the transfer of the disputed domain name.

B. Respondent

The Respondent did not file a formal Response.

6. Discussion and Findings

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. Respondent submitted to this process and Rules when he applied for and registered the disputed domain name. The Respondent registered the disputed domain name with Domain The Net Technologies Ltd. (Domain The Net) The Domain The Net Domain Name Registration Agreement provides that:

*"[y]ou hereby declare and affirm that you are aware that **the registration and management of the domain names is done subject to the registration rules of the Israel Internet Association** (hereinafter: the "Association Rules" and the "Association" respectively). You hereby confirm that you have been given sufficient opportunity to read the registration rules of the Association, that you have actually read these rules and that you agree to them. In this regard, you declare and affirm that you are aware and agree that – (1) the domain names are registered for maintenance periods of one year and – (2) **you are subject to the Association Rules on dispute resolution in relation to the domain names rights.**"*
And, that

*"[b]y submitting a request to register or renew a domain name with one of the generic Top Level Domains (gTLDs), you hereby confirm that **you accept the conditions of ICANN's Uniform Dispute Resolution Policy (UDRP) in force from time to time.** The updated version of this policy can be viewed on ICANN's Internet site at:<http://www.icann.org/udrp/udrp-policy-24oct99.htm>. The dispute resolution policy constitutes an integral part of this Agreement, and you hereby affirm that you have read and understood this document, and that you undertake to comply with its provisions."* [my emphasis, J.A.]

(See http://www.domainthenet.com/en/domain_registration_agreement.aspx).

Respondent, therefore, by applying for and registering the disputed domain name agreed to the IL-DRP and the Rules.

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.

The Rules provide that to succeed in a Complaint, a Complainant must satisfy the four following elements, that:

- 3.1. 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
- 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 disputed domain name was made or the disputed domain name was used in bad faith.

A. Same or Confusingly Similar

First, 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.

In the present case, the disputed domain name comprises of the word "ESSILOR" and the suffix .co.il. The suffix .co.il is ignored for the purpose of determining the similarity between the disputed domain name and the word "ESSILOR" since it is a common suffix showing that the domain name is part of the .il domain and associated with commercial activities (.co suffix). The relevant part of the disputed domain name is the word "ESSILOR".

The Complainant owns various trademark registrations for the mark ESSILOR: Israel Trademark registration No. 35583, of June 6, 1972; US Trademark registration No. 1756467, of March 9, 1993; and International Trademark registration No. 388436, of June 7, 1972. The Complainant ownership of the trademark ESSILOR in Israel and in other countries existed long before the Respondent registered the disputed domain name.

The Panel finds the disputed domain name integrates the Complainant's ESSILOR trademark in its entirety, as the only element.

The addition of the ccTLD ".co.il" to the disputed domain name does not avoid a finding of confusing similarity. (See, Facebook, Inc. V. Gal Erel, IL-DRP Case April 3, 2013). Thus, the ccTLD ".co.il" is without legal significance since the use of a gTLD is technically required to operate a domain name.

It is therefore the finding of the Panel that the disputed domain name is identical to a trademark owned by the Complainant.

B. Rights in the Name

Next, it is up to the Complainant to show that the Complainant has rights in the name "ESSILOR"; and that the Respondent has no rights in the name "ESSILOR".

As noted above the Complainant showed sufficient evidence showing it has rights in the ESSILOR trademark.

It is also up to the Complainant to show that the Respondent has no rights in the Name. The Complainant provided that it has not approved for the Respondent to use its trademark or Name.

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; see also Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited, WIPO Case No. D2000-0704; Skype

Limited. v. Ronen Legativi, IL-DRP Case No. 39, 27 June 2011, Google, Inc. v. Shlomi Kakon, IL-DRP Case No. 38, May 30, 2011)

In this case the Panel finds that the Complainant has made a prima facie showing that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of Rule 3.3. This finding is based on the following, non-disputed facts brought forward by the Complainant:

- a. The Complainant has no relationship whatsoever with the Respondent and did not authorize the Respondent to use the disputed domain name;
- b. The Complainant provided sufficient evidence to prove that it has trademark rights in the ESSILOR trademark. The Complainant's ESSILOR trademark is used for the Complainant's products in 100 countries around the world. It is very difficult to believe that the Respondent was unaware of the goodwill of the Complainant's trademark;
- c. The Complainant owns numerous worldwide trademark registrations, including in Israel. These trademark registrations were registered well before the Respondent requested and received the allocation of the disputed domain name;
- d. There is no indication in the file that the Respondent is known under the disputed domain name.

It is therefore the finding of the Panel that the Complainant has rights in the ESSILOR trademark and that the Respondent has no rights in the ESSILOR trademark.

Application and Use in Bad Faith

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.

WIPO panels, relying on Rule 4.1 of the UDRP Rules, ruled 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:

"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 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
- c. 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
- d. 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".

Rule 4.1(b) provides that this Panel can find that the Respondent acted in bad faith if there are circumstances showing that the "Respondent requested allocation or holds the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name allocation to the Complainant, who is the owner of the trademark or the service mark, or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name."

The Complainant provided clear evidence showing that the Respondent offered to sell the disputed domain name to the Complainant for various sums of money. Circumstances where a Respondent offered to sell the domain name for amounts, which are considered as valuable consideration in excess of the Respondent's out of pocket costs directly related to the domain name, indicate bad faith on behalf of the Respondent. (See The Ritz-Carlton Hotel Company L.L.C. v. Mr. Boaz Bar Lavy, ILDRP Case No. 37, 16 May 2011; see also Merck KGaA v. Sunmeet Jolly, Case No. D2004-0195).

The Panel therefore finds that the Respondent registered the disputed domain name primarily for the purpose of selling the disputed domain name to the Complainant, who owns rights in the name ESSILOR, for valuable consideration in excess of documented out-of-pocket costs directly related to the registration of the disputed domain name.

It is also suggestive of the Respondent's bad faith when the trademark of the Complainant was registered well before the allocation of the disputed domain name. (See Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735) The Complainant's ESSILOR trademark is registered since 1972 and has become known in various countries, including Israel since. The Respondent registered the disputed domain name long after the Complainant registered the ESSILOR trademark.

Also, as determined above, the disputed domain name is identical to the Complainant's name and trademark. Previous WIPO panels ruled that "*a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion of Internet traffic from the Complainant's site to the Respondent's site*" (see Edmunds.com, Inc v. Triple E

Holdings Limited, WIPO Case No. D2006-1095). To this end, prior WIPO and IL-DRP Panels have established that attracting Internet traffic by using a domain name that is identical or confusingly similar to a registered trademark is evidence of bad faith under paragraph 4(b)(iv) of the UDRP and 4.1(d) of the IL-DRP (see Humana Inc., op. cit. supra; Edmunds.com v. Ultimate Search, Inc., WIPO Case No. D2001-1319; see also Marriott Worldwide Corporation and Marriott International, Inc. v. Barak Gill, IL-DRP Case 36, 10 April 2011).

The Panel finds it difficult to believe that the Respondent was not aware of the trademark ESSILOR at the time he allocated the disputed Domain Name on January 13, 2013. At that time, the Complainant has been using the mark ESSILOR for over 40 years. The Respondent failure to bring evidence showing he did not know of the Complainant also serves against the Respondent and strengthens the fact that the Respondent was aware of the Complainant and the mark ESSILOR before the allocation of the disputed domain name.

The Panel therefore finds that the Respondent requested the allocation of the disputed domain name in order to intentionally attempt to attract, for commercial gain, Internet users to its web site 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.

Given these circumstances the Panel finds that that there are circumstances showing that the Respondent acted in bad faith as provided in Rule 4.1(b) and 4.1(d) thus, it is the finding of the Panel that the Complainant met the burden of showing that the Respondent used the disputed domain name in bad faith in accordance with Rule 3.4.

7. Decision

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



Jonathan Agmon
Sole Panelist

Date: May 19, 2013.