

Maccabi Healthcare Services v. Eran Cohen

IL-DRP Panel Decision

1. The Parties

The Complainant is Maccabi Healthcare Services, Israel, represented by Mr. Joseph A. Klieman, Advocate.

The Respondent is Eran Cohen, of Holon, Israel.

2. The Domain Name and Registrar

The disputed domain name <maccabisiudi.co.il> is registered with InterSpace Ltd.

3. Procedural History

The Complaint was filed with ISOC-IL on December 9, 2014. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On December 9, 2014 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on December 10, 2014, 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 created on July 3, 2014.

The Complainant is the second largest healthcare organization in Israel. The Complainant was founded in 1941 as an independent healthcare organization which is not politically affiliated. The Complainant has been using the mark MACCABI since its establishment. The Complainant engages in the healthcare services and care insurance through affiliated companies. Since 1995 the Complainant has been operating under the National Healthcare Insurance Law.

The Complainant, through its affiliated companies, owns two trademark registrations for the mark MACCABI SIUDI: Israeli trademark registration No. 216100 – MACCABI SIUDI (logo), with the registration date of October 30, 2008 and Israeli trademark registration No. 216101 – MACCABI SIUDI (logo), with the registration date of October 30, 2008.

The Complainant also own numerous trademarks registration for the mark MACCABI, for example: Israeli trademark registration No. 216178 – MACCABI (logo), with the

registration date of October 30, 2008; Israeli trademark registration No. 216179 – MACCABI (logo), with the registration date of October 30, 2008 and more.

The Complainant also developed its presence on the internet and is the owner of multiple domain names, consisting of the mark MACCABI. For example: <maccabi4u.co.il> and <maccabi-health.co.il>.

The disputed domain name currently resolves to a WordPress website, which displays blog homepage with the title “Maccabi Tel Aviv – Playing like Nursing”.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain name was previously used by Complainant for the benefit of the Care Insurance of Complainant's members.

The Complainant argues that the disputed domain name was operated on behalf of Complainant, by Clal Insurance Ltd.

The Complainant argues that, by mistake, the disputed domain name was not renewed on April 2014. Later, Complainant discovered that the disputed domain name was registered by the Respondent, and all communication attempts made by Complainant with the Respondent were unsuccessful.

The Complainant further argues that the disputed domain name is associated with Maccabi and the Care insurance field. The Complainant further argues all publication made by the Complainant and its affiliates, refer to the disputed domain name.

The Complainant further argues that the disputed domain name is similar to Complainant's trademarks.

The Complainant further argues that the Respondent has no rights or legitimate interests in the disputed domain name. The Complainant contends that the disputed domain name is used to express personal opinions about Hapoel Tel-Aviv soccer team.

The Complainant further argues that the Respondent registered the disputed domain name in bad faith, and it is using the disputed domain name solely in order to benefit from the publications made by Complainant and Clal Insurance.

For all of the above reasons, the Complainant requests 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 LiveDNS Domain Name Registration Agreement provides that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See Section 12.3; see also section 13 - <https://domains.livedns.co.il/Terms.aspx>). Respondent, therefore, by applying for and registering the disputed domain name agreed to the IL-DRP and the Rules.

It is also noted that the Rules now 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 disputes regarding the allocation of a domain name by a Holder may be brought by a Complainant on the following grounds:

- 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

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.

The disputed domain name comprises of the Complainant's name "Maccabi" and the additional Hebrew word written in English characters "Siudi", and the suffix .co.il. The suffix .co.il is ignored for the purpose of determination the similarity between the disputed domain name and the MACCABI SIUDI mark, 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 Complainant owns two trademark registrations for the mark MACCABI SIUDI. For example: Israeli trademark registration No. 216100 – MACCABI SIUDI (logo), with the registration date of October 30, 2008 and Israeli trademark registration No. 216101 – MACCABI SIUDI (logo), with the registration date of October 30, 2008.

Former WIPO and ISOC Panels have ruled 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 (see *Reebok International Ltd. v. Uzi Cnaan*, ISOC-IL Case; See also, *Kabushiki Kaisha Toshiba dlbla Toshiba Corporation v. Liu Xindong*, Case No. D2003-0408). The Panel opine that this rulings applies also when the disputed domain name is composed of English characters that comprise a transliteration of the exact Hebrew pronunciation of the Complainant trademark.

The Complainant provided sufficient evidence that it has rights in MACCABI SIUDI trademark, and considering its use it has become a well-known trademark in Israel for the provision of healthcare services.

The panel also took into consideration the Complainant evidence showing that the disputed domain name was previously owned by the Complainant. The Respondent did not a respond therefore did not contradict this argument.

It is therefore the finding of the Panel that the disputed domain name is confusingly similar 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 MACCABI SIUDI; and that the Respondent has no rights in the name MACCABI SIUDI.

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

It is also up to the Complainant to show that the Respondent has no rights in the disputed domain 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: *Ktav Publishing House, Inc. v. Moshe Menasheof*, ISOC Case, December 7, 2011; *Neusiedler Aktiengesellschaft v. Kulkarni*, WIPO Case No. D2000-1769; and also *Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited*, WIPO Case No. D2000-0704.)

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 has not authorized the Respondent to use the disputed domain name;
- b. The Complainant provided sufficient evidence that it has rights in the MACCABI SIUDI trademark and that it previously owned the disputed domain name.
- c. There is no indication in the file that the Respondent is known under the disputed domain name.

Having met the burden the Panel finds that the Complainant has shifted the burden of proof to the Respondent.

It is therefore the finding of the Panel that the Complainant has rights in the Name MACCABI SIUDI and that the Respondent has no rights in the Name MACCABI SIUDI.

C. 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(d) provides that this Panel can find that the Respondent acted in bad faith if 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 web site or location or of a product or service on its web site or location.

The disputed domain name is similar the Complainant's well-known trademark. The public recognizes the pronunciation of the disputed domain name with the Complainant. 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 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 (see *Humana Inc., op. cit. supra; Edmunds.com v. Ultimate Search, Inc.*, WIPO Case No. D2001-1319).

It is also suggestive of the Respondent's bad faith when the trademark of the Complainant was registered before the allocation of the disputed domain name (See: *Sanofi-Aventis v. Abigail Wallace*, WIPO Case No. D2009-0735). The Complainant's MACCABI SIUDI trademark is registered in Israel since the year 2008. As stated above, the Complainant's MACCABI SIUDI trademark is well-known in Israel for healthcare services. The Respondent registered the disputed domain name after the Complainant registered its MACCABI SIUDI trademark.

While the Complaint is silent on some salient features required to show bad faith, the Panel conducted several independent searches. Generally, it is noted that complainants should provide a full disclosure to the Panel of all the relevant facts. In this case, the fact that the Respondent failed to provide a response and the Panel decided to make several independent searches tipped the scale in favor of the Complainant, as discussed below.

The Panel preformed an independent search and found that the disputed domain name was operated as a domain name associated with the Complainant at least since 2008. In August 2014, it seems that the disputed domain name was a redirecting website to a different website that engages in insurance for elders.

The Panel finds it difficult to believe that the Respondent was not aware of the trademark MACCABI SIUDI at the time he allocated the disputed domain name in July 3, 2014. The Complainant have been using the mark MACCABI SIUDI continuously since at least 2008. 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 MACCABI SIUDI before the allocation of the disputed domain name. The Respondent failure to provide evidence showing that his current use is performed in good faith is also evidence showing that the disputed domain name is being used in bad faith.

The Panel has made an independent search of the use of the term MACCABI SIUDI using the Google search engine and has come to the conclusion that the Respondent is not known nor related to this trademark. A search using the MACCABI SIUDI also does not refer to either basketball team that are referred to by the Respondent in the current use of the disputed domain name, aside of course by the Respondent himself. It is to be noted that the use of the term MACCABI is related to the World Maccabi Organization for both the Complainant and the Maccabi Tel Aviv basketball team. However, the evidence shows that the Respondent is not affiliated or connected with either of these organizations.

The Panel has reviewed the current use of the disputed domain name and has come to the conclusion that the use made is more than likely directed at maintaining a hold over the disputed domain name, and to block the Complainant from access to a domain name wholly comprising the Complainant's registered trademark. This position is further strengthened by the Respondent's failure to respond to the complaint and silence in these proceedings.

Given the record before me, and the entire set of particular circumstances in this matter, 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.

Given these circumstances the Panel finds that that there are circumstances showing that the Respondent acted in bad faith as provided in 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, <maccabisiudi.co.il> be transferred to the Complainant.



Jonathan Agmon
Sole Panelist

Date: January 11, 2015.