

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

In the matter of the **Domain <mustela.co.il>**

between

LABORATOIRES EXPANSCIENCE
10, avenue de l'Arche
92419 Courbevoie, FRANCE

Represented by
NAMESHIELD (Anne Morin)
Email: domain@nameshield.com
(The "Petitioner")

and

Second Opinion BV LTD
15 Abba Hillel
Ramat Gan, ISRAEL
(The "Respondent" or "Holder")

DECISION

I. Procedure

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Name "mustela.co.il" 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").
2. Notification of the pending Petition, including copies of all submitted material, and notification of appointment of the Panel under the Rules, was sent on August 31st, 2014, 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 September^{15th}, 2014, to submit a Statement of Response or any other relevant information to the Panel.
3. The Respondent did not provide any Response to this Petition.

II. Factual Background

1. The Complainant, LABORATOIRES EXPANSCIENCE, is a French Company, established in 1950, selling cosmetic brands for baby products in the pharmaceutical market worldwide.
2. The first MUSTELA trademark was registered by the Complainant in 1951.
3. The Complainant registered the domain www.mustela.com in 1998, and has since registered several other international domains consisting of the same mark.
4. The disputed Domain www.mustela.co.il was registered by the holder on 19.7.09, and has not been actively used since registration, other than as a parking page.

III. The Parties' Claims

A. The Petitioner

1. The Petitioner claims to be a leading cosmetic brand in the European pharmaceutical market for baby products. Growing steadily, the Company now sells more than 10 million products a year throughout the world, in about 60 countries and especially in Israel.
2. The Petitioner owns many trademark registrations, which include the term MUSTELA®. The Petitioner provided reference to several such international Trademark registrations, including the following: 154904 from 16/7/51, 574185 from 1/8/91, 619839 from 9/5/94, 867154 from 22/7/05, and 958744 from 17/01/08.
3. The Petitioner states that it has several registered Domains. The main Domain through which it communicates its business is www.mustela.com (registered on 03/12/1998), but it also owns many other International Domain Names, all consisting of the term "Mustela".
4. Petitioner notes that the term "Mustela" has no meaning in and of itself, and any internet search of this world will yield a connection to the Petitioner. Therefore, its similarity with the Petitioner's trademark is self evident.
5. Petitioner claims that Respondent should have been aware of the Petitioner and its Trademarks, being in the medical business itself, and therefore should have been aware of the Petitioner's rights at the time of registration. Petitioner adds that the fact that Respondent did not make actual use of the website is out of fear of infringement of petitioner's rights.
6. Petitioner claims that in accordance with the requirements of the Rules, all elements indicating that the Domain should be transferred to the Petitioner, can be found in the Petition as follows:
 - a. The domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
 - b. Holder has no rights in the name; and
 - c. Registration and/or use of the Domain are in bad faith.

5. 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 the .IL country code. By registering a Domain, any Holder agrees to abide by these Rules.
2. In order for a case to be brought before an 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 or argue insufficient or partial 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 the 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 and information available to the Panel.

a. Name is Same or Confusingly Similar

The requirement in the Rules is that "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".

The Disputed Domain Name, disregarding the standard "co.il" suffix, consists of the term "mustela" in its entirety, and is therefore identical to the trademark "mustela".

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, since it is a common suffix indicating that the domain is registered as a commercial Israeli website (see for example ISOC IL-DRP case in the matter of <Crayola.co.il>). Therefore, the suffix should be ignored, and the question

remains whether the term "mustela" is the same or confusingly similar to a name of the Petitioner.

The petitioner is the owner of several international Trademark rights in the term "mustela", earliest of which was registered in 1951, which is clearly long before the Respondent registered the Disputed Domain.

Beyond the information provided by the Petitioner, let it be noted that the Trademark "MUSTELA" has been registered by the Petitioner in the Israeli Trademark Registry since 1973. Though the petitioner neglected to mention this registration (possible due to language barriers), this fact strengthens the claim for local Trademark recognition in the aforesaid term, and therefore establishing strong similarity between the disputed Name and the Petitioner's Trademark.

Thus, the Panel finds that the Domain is the same as a trademark and service name of the Petitioner, and therefore the first requirement under the rules, is fulfilled.

b. Complainant has Rights in Name

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

- Petitioner launched "Mustela" services in 1951, and has been providing baby products in the European pharmaceutical market under the same Trade Name since that time.
- Over the years the Petitioner has increased its market internationally and is currently selling its products in over 60 countries, including Israel.
- The petitioner holds several registered domain names, all including the name "mustela", including www.mustela.co.eg, www.mustela.com.jo, www.mustela.com.lb, www.mustela.com.sa, www.mustela.com.sy, etc.
- The term "Mustela" has become well known around the world. A google search of the term "Mustela" yields various results, all of which are related to the Petitioner's skincare and baby products worldwide.
- Petitioner's rights to the name can also be gathered from a previous WIPO case, in which the Panel recognized the Petitioner's rights in the term "Mustela", and agreed to transfer domains incorporating said term, back to the Complainants (see case No. D2006-1604 **Laboratoires Expanscience v. Juan Enrique Cobos**).

All of the above clearly indicates that to date, the Petitioner has clear rights in the name "Mustela", as a well-known mark, registered Trademark and Trade Name, and has established rights in the Disputed Domain.

c. Respondent has no Rights in Name

Respondent has no known association whatsoever with the Petitioner or its services, and is in no way an authorized dealer, distributor or licensee of the Petitioner.

The Panel has no indication of any claim or application on behalf of the Holder for registration of any Trademark rights in the term "Mustela" or with the Petitioner.

The term "Mustela" is not a generic term in any way, nor does it appear in any dictionary. It is clearly a distinctive term. Therefore, any meaning attributed to it is by way of trade name or trade mark. Respondent has not demonstrated any such connection or use of the term "Mustela", nor any potential generic use.

Moresoever, the Holder, Second Opinion Ltd, appears to be a professional in the medical area. As such, it should have been familiar with the "Mustela" trademark, as it is in a closely related field of expertise, and has been in business and internationally known long before registration of the disputed Domain.

Finally, the website under the Disputed Domain is parked on a web-hosting page, consisting of reference to various commercial links. It is not being put to any actual use by the Holder, makes no reference to it or its business, and may at times even refer to the Complainant's competition. Nothing anywhere in the current website establishes any connection whatsoever to the Holder.

The Holder failed to provide a Statement of Response to this Petition, and thereby all the above claims remain unrefuted.

Based on the above, the Petitioner has created a Prima Facie case establishing that the Respondent has no legitimate interests in the Disputed Domain.

Therefore, in light of all the above, the Panel finds sufficient grounds to establish that the Holder has no rights in the name.

d. Registration or Holding in Bad Faith

Section 3.4 requires that "the application for allocation of the Domain Name was made or the Domain Name was used in bad faith". Though the Rule requires that either the registration or the use be in bad faith, it appears that in this case, there are multiple acts on behalf of the respondent which are indicative of bad faith both in registration and in use, as follows:

Bad Faith in Registration of the Domain:

- The Petitioner has been providing its services since 1950, first trademark being registered in 1951. The Holder registered the disputed

domain in 2009. It is difficult to contend that the Holder had no reason to be aware of the existence of the Trademark Registration.

- The term "Mustela" is not a generic or commonly used term, has no inherent meaning of its own and has no direct relevance to the Respondent himself or any activity conducted by him, and it is therefore highly likely that the Respondent was aware of the existence of the petitioner and of his rights in the Name at the time of registration.

Bad Faith in Use of the Domain:

- Since the date of registration and to this present date, the Domain directs to a website consisting of a Parking Page by the service provider, referring to several commercial links. There has been no active use of the Domain by the Respondent and no mention of the term "Mustela" or any use thereof.
- As mentioned in the WIPO Overview of Panel Views on Selected UDRP Questions, when a parking page is used regarding a term that is not a generic term but is trademark based, as is the case with Mustela, such links are generally considered unfair use resulting in misleading diversion.

<http://www.wipo.int/amc/en/domains/search/overview2.0/#26>

- According to Section 4.1 of the Rules, evidence of bad faith can be expressed as follows: " 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". In this case, the Respondent, who did not present any claims in response to this herein Petition, clearly has no interest in holding the Domain or using it for any purpose of its own, but is solely interested in gaining profit from some rightful owner who may present an attractive offer in return for the name. As found by several WIPO Panels, passive holding of a website, even without taking active action in aiming to obtain considerable gain, can still be considered bad faith use of a Domain. (see *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), <)
- The Petitioner failed to reply to this Petition, thus all the above claims, as made by the Petitioner, remain un rebutted. Lack of response does not automatically prove bad faith, but particularly in cases regarding use of a distinctive term, evidence must be provided to indicate Holder's interests in the Distinctive Term. Lack thereof provides

stronger indication of bad faith (see similar circumstances in WIPO UDRP case D2007-1193 *Facebook Inc. v. Privacy Ltd* regarding the name face-book.com).

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 both in application for registration of the Domain, and in use thereof.

V. Decision

In light of all of the above, Panel finds that the Disputed Domain is the same and identical to many Registered Marks of the Petitioner, the Petitioner has established sufficient Prima Facie Evidence supporting its rights to the Disputed Domain, the Respondent presented no rights in the Domain, and the Respondent has acted in bad faith in registering and in holding the Domain.

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: November 30th, 2014