

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

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

between

Spotify AB

Birger Jarlsgatan
Stockholm, Sweden
Represented by
Adin-Liss Law Offices
Tel Aviv, 6618003, Israel

(The "Petitioner")

and

Mr. Barak Gill

18 Michael Ne'eman St.,
Tel Aviv, 69581, Israel

(The "Respondent" or "Holder")

DECISION

I. Procedure

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Name "spotify.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 Petitioner is a Swedish Company founded in 2006, providing international online commercial music streaming services under the name of "Spotify". The Petitioner has been operating the Spotify music Streaming Services since 2008, offering access to millions of songs and tens of millions of users worldwide.
2. The Respondent registered the Disputed Domain on November 6th, 2013.
3. The Disputed Domain currently refers only to a web hosting page.
4. On May 29th 2014 the Petitioner sent a Cease and Desist letter to the Holder, informing him that he was in violation of the Petitioner's rights, requesting him to refrain from doing so and to transfer the Domain to the Petitioner. The Respondent did not reply.

III. The Parties' Claims

A. The Petitioner

1. The Petitioner claims to be a leading International Music Streaming Service, enjoying extensive commercial success, and having become a market leader in the field of digital music, receiving continuous positive and enthusiastic reviews from different sources.
2. The Petitioner owns the Israeli and European Trademarks "Spotify", as well as over 100 international domain names consisting of the term "Spotify" in many countries.
3. Though it is not currently possible to access the Spotify music streaming service from Israel, the Petitioner claims that the Spotify service is also well known in Israel. This can be demonstrated by a local google search, which yields many results describing and complementing the services.
4. Petitioner claims that in accordance with the requirements of the Rules, the Complaint contains all the required elements indicating that the Domain should be transferred to the Petitioner, as follows:
 - a. Disputed Domain is identical with Petitioner's trademark;
 - b. Petitioner has rights in the name;
 - c. Holder has no rights in the name; and
 - d. 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 prima facie evidence 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 Domain, 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 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 consists of the term "spotify" and of the suffix "co.il".

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 "Spotify", of which the Disputed Domain consists, is the same or confusingly similar to a name of the Petitioner.

The term "Spotify" of the domain name is clearly identical to the term "spotify" in which the Petitioner holds registered trademarks both in Israel and internationally.

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

1. The petitioner is the owner of over 100 domain names all around the world, consisting of the term "Spotify", with various suffixes.
2. The petitioner is the owner of several Trademark rights in the term "Spotify", both worldwide and in Israel.
3. It should be noted that the Domain was registered by the Respondent on Nov 6th 2013, whereas the Israeli Trademark was registered only later, on April 3rd 2014. However, as previously ruled in several WIPO decisions: "Registration of a domain name before a complainant acquires trademark rights in a name does not prevent a finding of identity or confusing similarity under the UDRP".
(<http://www.wipo.int/amc/en/domains/search/overview2.0/#14>)
4. It is evident that additional circumstances exist, indicating that the Complainant had rights in the name prior to the Domain Registration Date: First, Spotify was established in 2006 and in operation since 2008. It has been the owner of a European Community Trademark registered in 2008, as well as a WIPO registration from the same time period. This alone can establish the petitioner's rights in the name.
Second, Spotify provides an internet based music streaming service. By nature, such a service is less geographically based, but rather more international. The Spotify service has already been reviewed in local articles and blogs since 2012 and possibly earlier, thus establishing online presence in Israel prior to registration of the Disputed Domain by the Holder.
5. The term "Spotify" is not a generic term, does not appear in a dictionary and has no meaning in and of its own. It is a non-descriptive term, which only has the meaning attributed to it by the public. This can also be gained by conducting a google search of the term "Spotify", both in English and in Hebrew, yielding results directly describing the Petitioner's music streaming services. This also establishes the Petitioner's rights in the Name.

From all of the above it is evident that the Petitioner has established a Prima Facie claim to rights in the Disputed Domain. The Respondent has not provided a Letter of Response, and therefore these claims remain uncontended.

c. Respondent has no Rights in Name

The Respondent is unknown to the Petitioner, has no association whatsoever with the Petitioner or its services, and has never been authorized by the petitioner to use the Trademark or to register the Disputed Domain.

After having registered the Domain, the Respondent took no action in actually using it for any purpose whatsoever. The domain has been parked on a web-hosting page, and has not been put to use at all by the Holder.

In addition, the specific Respondent in this case has a history of registering Domain names in his name without any rights or connection whatsoever. In a recent case, the same Respondent registered a Domain in the name of another online music Service, "Deezer.co.il", and the II-DRP Panel in the matter ruled that the Domain be transferred from the Holder to the Owner of the Rights in the Name. This indicates not only bad faith as detailed below, but also a tendency to register names regardless of rightful ownership.

The Holder failed to provide a Statement of Response to this Petition.

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 Respondent appears to have a repetitive behavior of registering Domain Names in his name that should have rightly been registered by different entities who actually hold the trademark rights in those names. In a recent such case as mentioned above, the same Respondent herein registered the domain "deezer.co.il", also involving a music service provider, and an ISOC II-DRP Pane ruled that the Domain be reallocated to its rightful owner. Previously, the Respondent registered the domain מריוט.co.il, in which he also had no evident rights, and which a Panel reallocated to Marriott Worldwide [see II-DRP decision in the matter of *Marriott Worldwide vs. Barak Gill*, from April 10, 2012]. These behaviors are clearly indicative of a pattern of registering domain names in which the Holder has no legitimate interest, typical of cybersquatting, and clearly indicating bad faith.

Previously, in the case of "deezer.co.il", the Panel noted that according to an isoc.org.il whois database search that it requested, the Respondent, Mr. Barak Gill, holds in excess of **at least 20 nonrelated domain names**, most of which seem to have no prima facie connection with the Respondent, but have been registered under his name over the past few years. This is a clear pattern of bad faith in registration. As also previously ruled by WIPO: "A "pattern of conduct" as required in Paragraph 4.b.(ii) typically involves multiple domain names directed against multiple Complainants" (see Smoky Mountain Knife Works v. Deon Carpenter, eResolution Case Nos. AF-230ab; Gruner + Jahr Printing & Publishing Co., G + J McCall's LLC, Rosie O'Donnell and Lucky Charms Entertainment, Inc. v. Savior Baby, WIPO Case No. D2000-1741)

- The term "spotify" 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 therefore the Respondent had no other reason in applying for registration of the Disputed Domain other than for the reason specified in section 4.1(b) of the Rules: "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;".

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. There has been no active use of the Domain by the Respondent and no mention of the term "Spotify" or any use thereof.
- As mentioned above, a pattern of holding a repeat number of non-related Domains, none of which are in actual use, and none of which have any prima facie connection to the Holder itself, amounts to Bad Faith in use of the Domain.
- 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 either the Cease and Desist Letter presented by the Petitioner, or 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.

- In addition, by holding the Domain, the Respondent is preventing the Petitioner from making use of a local website bearing its international trademark. The Spotify streaming service is currently unavailable in Israel, but the Petitioner, who started providing its services only to select users in Scandinavian countries, has now expanded its user base to over four continents, and has been incrementally expanding its service and launching it in new countries, through use of local domains, over the years. By holding on to the Disputed Domain, the Holder is preventing the Petitioner from expanding its business in Israel in a manner identical to that used in other countries. As stated in Section 4.1 d of the Rules, evidence of Bad Faith is when: "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; ". Evidence of such a pattern of conduct can be found above, therefore supporting this claim.
- The Petitioner failed to reply to this Petition, as he did not reply to the Cease and Desist letter sent by the Petitioner. Thus all the above claims, as made by the Petitioner, remain unrebutted. In a previous IL-DRP ruling against the same Respondent, it has been stated as follows: "...the Complainants provided as evidence a Cease and Desist letter addressed to the Respondent, which the Respondent failed to properly respond to. Previous Panels stated that "when receiving such notice, good faith requires a response." (*Gaggia S.p.A. v. Yokngshen Kliang, WIPO Case No. 02003-0982*) This Panel concurs with such reasoning and finds that Respondent's inaction shows lack of legitimate interest in the disputed domain name and lack of good faith in the registration or use thereof (See *Carrefour and Carrefour Property v. MIC Domain Management, WIPO Case No. 02009-0489*)."
[Marriot vs. Barak Gill re. <מריוט.co.il>].
- 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 Well Known and Registered Marks of the Petitioner, the Petitioner has established substantial circumstances 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