

The American Israeli Gas Corporation Ltd. v. Karin Bar Lev

IL-DRP Panel Decision

1. The Parties

The Complainant is the American Israeli Gas Corporation Ltd. of Ramat Gan, Israel, represented by Eyal Price and Hila Shachar of Ramat Gan, Israel.

The Respondent is Karin Bar Lev, of Hertzliya, Israel.

2. The Domain Name and Registrar

The disputed domain name <אמ"ישראלגז.co.il> is registered with LiveDns Ltd.

3. Procedural History

The Complaint was filed with ISOC-IL on June 22, 2011. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On July 3, 2011 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on July 4, 2011, 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.

On July 12, 2011 the Respondent transmitted by e-mail an informal message to the Panel, stating, in Hebrew, that she would be interested to postpone the proceedings.

On July 13, 2011 the Panel handed a decision, stating that unless otherwise authorized, the IL-DRP proceeding will be held in English. Additionally, the Panel held that if the Respondent requires additional time for transmitting a Response to the Complaint, the Respondent may submit a formal request, according to the Rules.

On August 3, 2011, the Respondent transmitted its Response to the Complaint. The Respondent stated that the Response was transmitted on due date, but for unexplained reasons, was not received by the Panel. The Respondent's communication and Response were transmitted to the Panel in Hebrew.

4. Procedural Issues - The Respondent's Communication of August 3, 2011

The Respondent's communication of August 3, 2011, does not meet several of the requirements which the Rules establish.

According to the Rules, the Respondent's Response was due on July 19, 2011. The Response was received by the Panel on August 3, 2011. Furthermore, the Response and the accompanying communication were transmitted in Hebrew whereas the Rules state that "***Unless otherwise authorized by the undersigned, this IL-DRP proceeding will be held in English***". The Panel held in its July 4, 2011 notice to the Respondent that "**The Statement of Response shall be in English**. Any additional materials may be in either English or Hebrew. Documents not in English or Hebrew shall be furnished with a certified translation to Hebrew or English".

The Respondent did not transmit a proper motion for an extension to file the Response, nor did the Respondent officially request that the Statement of Response be in Hebrew. The Respondent however stated in her Response that the demand that English be the language of the Response is without merit. No further explanation was made why Respondent believes the language requirement is without merit.

The Respondent claims that she transmitted the Response on on July 19, 2011, but for unexplained reasons, was not received by the Panel.

Rule 11 grants the Panel the authority to "conduct proceedings in such a manner as it deems appropriate while giving due consideration to the speedy resolution of the Dispute and the technologies available."

Although the Respondent's conduct is with disregard of the Rules, the Panel finds that in order to reach a just decision, the Panel will take the Response into consideration and allow the Respondent to articulate her arguments for the case. The Panel notes, however, that the Respondent failed to comply with the Rules and failed to remedy this situation. In view of the outcome of this case the Panel makes no further determination with respect to this issue.

5. Factual Background

The disputed domain name was registered by the Respondent on December 29, 2010.

The Complainant is a company incorporated under the laws of Israel. The Complainant is the largest liquefied petroleum gas retailer in Israel, supplying gas and energy-related appliances to hundreds of thousands of households. The Complainant operates in the Israeli market for the last 60 years.

The Complainant is the owner of multiple Israeli trademark registrations for the mark AMISRAGAS and AMISRAGAS (in Hebrew characters). For example: Israeli trademark registration No. 112380 – AMISRAGAS (in both English and Hebrew characters), with the Registration date of June 5, 1998; Israeli trademark registrations No. 112377– AMISRAGAS (in both English and Hebrew characters), with the Registration date of June 5, 1998; Israeli trademark registration No. 182714 – AMISRAGAS (logo - in Hebrew characters), with the Registration date of December 10, 2006, and more.

In addition, the Complainant is the owner of domain names<amisragas.co.il> and <amisragas.com>, which consist of the mark AMISRAGAS.

On January 4, 2011, the Complainant's attorney sent the Respondent a cease and desist letter, requesting that the Respondent refrains from using the AMISRAGAS mark and transfers the disputed domain name to the Complainant. The Complainant offered to pay the Respondent its out-of-pocket costs to register and maintain the disputed domain name.

On January 20, 2011, the Respondent's attorney replied and offered to sell the disputed domain name to the Complainant "for an amount to be agreed between the parties".

On January 24, 2011, the Complainant's attorney sent the Respondent another letter, stating that the Complainant will be willing to pay the Respondent only its out-of-pocket costs and that the Respondent is acting in bad faith by offering to sell the disputed domain name for a greater amount.

On February 14, 2011 the Respondent's attorney sent an additional response letter to the Complainant and claimed that the Respondent acted in good faith.

The disputed domain name currently resolves to a parking webpage stating that the website is under construction.

6. Parties' Contentions

A. Complainant

The Complainant argues that its AMISRAGAS trademark is a well-known trademark.

The Complainant further argues that the AMISRAGAS mark has gained vast goodwill and is associated with the Complainant by the public in Israel.

The Complainant further argues that the Respondent has no rights or legitimate interest in the AMISRAGAS trademark.

The Complainant further argues that it did not authorize the Respondent to use its AMISRAGAS trademark.

The Complainant further argues that the Respondent acted in bad faith when registering the disputed domain name. The Complainant contends that the Respondent registered the disputed domain name to make profit by attracting internet users to a website that will be built under the disputed domain name, by misleading the consumers to believe that there is a connection between the Complainant and the disputed domain name.

The Complainant further argues that fact that the Respondent registered the domain name with the suffix .co.il which is associated with commercial activities, is evidence of its bad faith.

The Complainant further argues that fact that the Respondent offered to sell the disputed domain name to the Complainant for an amount greater than its out of pocket expenses is also evidence of its bad faith.

The Complainant further argues that the Respondent had known of the Complainant and its use of the AMISRAGAS mark, when registering the disputed domain name.

The Complainant further argues that the Respondent's actions constitute various civil injustices.

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

B. Respondent

The Respondent argues that she did not act in bad faith since she is not a competitor of the Complainant nor intends to use the Complainant's name to draw the Complainant's customers. The Respondent contends that she sees herself as a legitimate service provider that provides domain names.

The Respondent further argues that registering the disputed domain name in order to make profit cannot be regarded as bad faith, since it is the same as performing any other service for profit.

The Respondent further argues that the agreement between a Registrar and the Israeli Internet Association ("ISOC") provides that the Registrar is prohibited from purchasing domain names with the intention of transferring them to third parties for profit. The Respondent contends that this provision implies that the broad public is allowed to purchase domain names with the intent to sell them for profit.

The Respondent further argues that ISOC is acting in bad faith and with conflict of interest, since it makes profit from all the parties, as the entity responsible of the allocation of .il domain names, and responsible of the arbitration proceedings.

The Respondent further argues that there is no satisfactory explanation why the owners of registered trademark, who did not apply for the allocation of a relevant domain name during the sunrise process, deserve to receive the domain names at the expense of others.

The Respondent further argues that as the owner of the disputed domain name, she denies any attempt to replace her as the legal owner of the disputed domain name.

For all of the above reasons, the Respondent requests the denial of the Complaint.

7. Discussion and Findings

A. Procedural Issue: The IL-DRP Proceeding and Jurisdiction

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.

The Respondent rejected ISOC-IL's authority to allow this Panel to decide, whether the disputed domain name be transferred to the Complainant or not.

The Respondent submitted to this process and Rules when she applied for and registered the disputed domain name. The LiveDns domain name registration agreement provides that the applicant for the domain name accepts the ISOC-IL Rules

for the Allocation of Domain Names Under the Israel Country Code Top Level Domain ("IL") ("Registration Rules") (see <https://domains.livedns.co.il/Terms.aspx>, which also provides a link to the ISOC-IL registration rules).

The Registration Rules Provide in section 5.4 that **"These Rules and the procedures thereunder ("Rules") shall bind the Applicant upon submission of the Application and throughout the entire time that the Domain Name is allocated to the Holder. These Rules prevail over any other representations made by ISOC-IL whether prior to, or after such allocation."**

Section 20 of the Registration Rules provides situations, in which ISOC-IL is authorized to cancel the allocation of a domain name. Among these situation is "Upon the decision by an IL-DRP Panelist or Panel".

Section 24.4 of the Registration Rules provide that "the [domain name] holder agrees to the jurisdiction of the IL-DRP."

The Respondent, therefore, by applying for and registering the disputed domain name agreed to the IL-DRP and the Rules. It should be noted that the LiveDns registration agreement also specifically provides that the holder submits himself to the IL-DRP procedures and decisions.

Therefore this Panel rejects the Respondent claims that it has no authority to decide who is the rightful owner of the disputed domain name.

The purpose of the IL-DRP Panel is not to determine any dispute between ISOC-IL and the Respondent and any arguments brought forth in this respect are ignored.

It should be noted that the IL-DRP proceeding does not precludes access or petition to an Israel Court of Law, by either the Complainant or the Respondent.

This administrative proceeding is intended to resolve claims of intellectual property rights owners of abusive and bad faith registrations, which are in violation of their rights.

This is supported by section 2 of the Registration Rules, which states: "The allocation of a Domain Name to a holder, grants the holder with a right-of-use for the allocation period, as part of the Domain Name resolution service provided by the Registry. A Domain Name is not subject to proprietary rights and accordingly, the aforementioned right-of-use does not constitute ownership or bestow property rights."

Also, section 5.2 of the Registration Rules constitutes the Respondent's representation and warranties he made, prior to the allocation of the disputed domain name:

"Submission of a Domain Name allocation application by an Applicant, constitutes the Applicant's representation and warranty that the Intended Holder is a legal entity and that the allocation or use of the Domain Name by the Intended Holder does not infringe the legal rights of any other third party. Further, it constitutes the Applicant's consent that ISOC-IL will not bear any liability for the allocation and use of a Domain Name."

To this end, the Respondent's contentions that trademark owners had to register during the sunrise process in order to ensure ownership of a relevant domain name are rejected. Nothing in the Rules require intellectual property owners to use a sunrise period to secure their rights in domain names. On the contrary, it is the duty of the applicant of a domain name to ensure he has rights to the domain name and will not infringe third party rights when requesting or using a domain name.

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.

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.

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 word AMISRAGAS in Hebrew Characters 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 word AMISRAGAS (in Hebrew characters) 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 AMISRAGAS (in Hebrew characters).

The Complainant owns multiple trademark registrations for mark AMISRAGAS (in English and in Hebrew). For example: Israeli trademark registration No. 112380 – AMISRAGAS (in both English and Hebrew characters), with the Registration date of June 5, 1998; Israeli trademark registrations No. 112377– AMISRAGAS (in both English and Hebrew characters), with the Registration date of June 5, 1998; Israeli trademark registration No. 182714 – AMISRAGAS (logo - in Hebrew characters), with the Registration date of December 10, 2006, and more.

It should be noted that the fact that some of the Complainant's Israeli trademark registrations consist also of the AMISRAGAS mark in English characters, has no significance in this matter. Previous 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 disputed domain name is identical to the complainant's AMISRAGAS trademark (in Hebrew).

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 AMISRAGAS (in Hebrew characters) name; and that the Respondent has no rights in the AMISRAGAS (in Hebrew characters) name.

As noted above the Complainant showed sufficient evidence showing it has rights in the AMISRAGAS (in Hebrew characters) trademark.

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

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 Respondent does not claim that she is known under the disputed domain name.
- b. The Complainant has no relationship whatsoever with the Respondent and has not authorized the Respondent to use the disputed domain name;
- c. The Complainant has provided sufficient evidence that its trademark is well known. The Complainant is the largest liquefied petroleum gas retailer in Israel, supplying gas and energy-related appliances to hundreds of thousands of households. The Complainant operates in the Israeli market for the last 60 years. It is very difficult indeed to believe that the Respondent was unaware of the vast goodwill of the Complainant's trademark. It should be noted that the Respondent did not claim otherwise;
- d. The Complainant is the owner of Israeli trademark registrations, for the mark AMISRAGAS, both in English and in Hebrew characters. These trademark registrations were registered well before the Respondent requested and received the

allocation of the disputed domain name and some of them date back to the year 1949;

Having met the burden, the Panel finds that the Complainant has shifted the burden of proof to the Respondent. The Respondent failed to bring evidence to support any claim that she may have rights in the Name.

The Respondent claims that she gained rights in the disputed domain name by purchasing it. This contention is baseless. Domain names are not purchased. They are being allocated for a predetermined time by domain name providers such as ISOC. Requesting and being allocated a domain name does not, by itself, result in rights to a domain name. A domain name is comprised of letters and numbers which may in some cases correspond to trademarks. Obtaining rights in trademarks is mostly a question of use. The Applicant has brought ample evidence it has rights to the AMISRAGAS trademark and name. The Respondent, on the other hand, failed to bring any evidence. The Respondent does not claim she is known by the AMISRAGAS (in Hebrew characters) trademark. The Respondent does not claim she has rights to the AMISRAGAS trademarks, or name, in Hebrew or in English. The Respondent did not bring any evidence supporting it has rights to the AMSIRAGAS name or trademark, in English or Hebrew.

It is therefore the finding of the Panel that the Complainant has rights in the AMISRAGAS (in Hebrew characters) trademark and that the Respondent has no rights in the AMISRAGAS (in Hebrew characters) 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.

Previous 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 of the disputed domain name primarily for the purpose of disrupting the business of a competitor; or circumstances indicating 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 Respondent admitted that it registered the disputed domain name for the sole purpose of selling it for profit.

The Respondent declined the Complainant's offer to purchase the disputed domain name for her out-of-pocket expenses. The Respondent stated that she will be willing to sell the disputed domain name for a sum of money to be decided. The fact that the Respondent offered to sell the disputed domain name for amounts that are undoubtedly 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 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 is the owner of the trademark, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name.

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.

It is 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 AMISRAGAS (in Hebrew and in English characters) trademark is registered in Israel since 1949. As stated above, the Complainant's AMISRAGAS trademark is well-known in Israel. The Respondent registered the disputed domain name well after the

Complainant registered its AMISRAGAS (in Hebrew and English characters) trademark.

As noted, the Panel finds that it is highly unlikely that the Respondent was not aware of the Complainant's well-known trademarks at the time she allocated the disputed Domain Name.

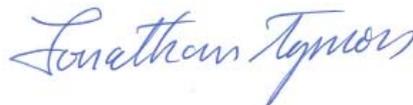
Also, the disputed domain name is identical to the Complainant's Israeli trademark in Hebrew, and is the exact Hebrew transliteration of the Complainant's trademark in English. Previous WIPO panels ruled that "a likelihood of confusion is presumed, and such confusion will inevitably result in the diversion 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, previous 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).

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 mark as to the source, sponsorship, affiliation, or endorsement of its web site.

Given these circumstances the Panel finds 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, <אמישראגז.co.il> be transferred to the Complainant.



Jonathan Agmon
Sole Panelist

Date: August 15th, 2011.