

IL-DRP PANEL
FOR THE INTERNET SOCIETY OF ISRAEL

In the matter of the Domain

<LawPubShop.co.il>

Between

LawPub

(Economic Company, the Israel Bar Association)

From 18 Hamasger St, Tel Aviv

Email: support@lawpub.co.il

(The "Petitioner")

and

Idan Ben-Or

From 3 HaTa'as Street,

Ramat Gan

Email: i@idanbenor.co.il

(The "Respondent" or "Holder")

DECISION

I. Procedure

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Name "LawPubShop.co.il" be reallocated to the Petitioner.

A Panelist was appointed in accordance with the Procedures for Alternative Dispute Resolution under the 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, and notification of appointment of the Panel under the Rules, was sent on Jan 19th, 2020 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, to submit a Statement of Response or any other relevant information to the Panel.
3. The Petitioner provided such Statement, within the allotted timeframe.

II. Factual Background

1. The Complainant is the Israeli Bar Publishing House, currently known as the Economic Company of the Israel Bar Association.
2. The Respondent is Mr. Idan Ben Or, a private individual, who is a SEO consultant and in the business of web marketing and promoting (as stated in his own web page).
3. The Respondent registered the Disputed Domain on October 22nd, 2019.

III. The Parties' Claims

A. The Petitioner

1. The Petitioner identifies itself as the Economic Company of the Israel Bar, and claims to be best known as the Israeli Bar Publishing House, a limited company, and a subsidiary of the Bar, is mostly owned by it, and has its own Board of Directors.
2. The Petitioner claims to be the owner of the Disputed Domain and to have been acting under it for the past 12 years, providing legal products and services to thousands of lawyers, and states that it owns several domains using the term "Law Pub". (No direct evidence was provided neither as to original registration of the disputed Domain, or reference to additional related Domains held by the Petitioner).
3. The Petitioner mentioned that it has a well known reputation within the legal community, and that it is recognized by the term "LawPubShop". In support of this claim, the Petitioner indicated that a google search of the specific term yields hundreds of references to the Bar Publishing house and its activities under the term LawPubShop.
4. The Petitioner states that in Oct 2019, upon discovery that the Disputed Domain had been accidentally released, it contacted the Holder by phone and by mail, in attempt to request that he return the Domain, but encountered refusal on its behalf. No evidence of such communication was submitted.

B. The Respondent

1. The Respondent is Mr. Idan Ben Or, who registered the Domain in October 2019.
2. The Respondent did not provide a direct description of his line of business, but as can be ascertained from the information presented, he is the CEO of a company involved with digital marketing and Search Engine Optimization (SEO).
3. The Respondent claims that the Petitioner was no longer using the Domain, and therefore he purchased it, designating it as a website for providing legal services and marketing.

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. Let it be emphasized that the IL-DRP proceedings are meant to be concise, specific, straight-forward cases, as an easily accessible alternative procedure. The IL-DRP sets forth clear guideline recommendations as to how the Procedure should be conducted, aimed at providing expedited resolution to Domain Name disputes, as described in the preamble to the Rules. The procedure is not intended to substitute court review in cases where there are contractual disputes or complex business contentions between the parties, which will require lengthy processes of evidence and cross examination.
3. Historically, the framework within which the Israeli IL-DRP rules were established, similar to the WIPO Uniform Domain Name Dispute Resolution Policy, was aimed at mitigating and preventing all instances of "cybersquatting", which according to ICANN is: "bad faith registration of another's trademark in a domain name."¹
4. As phrased in *WIPO Administrative Panel Crough and McNeil v. Stein*, case no, D2005-1201 and applicable to the IL-DRP rationale as well:

¹ <https://www.icann.org/resources/pages/cybersquatting-2013-05-03-en>

"The Policy was adopted to deal as is with the problem of cybersquatting, the registration of domain names consisting of, including, or confusingly similar to marks belonging to another for the purpose of profiting from the goodwill associated with said marks."

5. In order for a case to be brought before an II-DRP Panel, the Petitioner must show prima facie indications that certain grounds exist. The following must all be fulfilled:
 - 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.
6. Keeping all of the above in mind, the Panel will proceed to review existence of the grounds for the request, based on the II-DRP guidelines, and in consideration of the purpose and relevance of the facts at hand to the rationale of II-DRP proceedings.

a. **Name is Same or Confusingly Similar to a Name of the Complainant**

The first 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 Domains consists of the combined term "lawpubshop" 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 II-DRP case in the matter of <Crayola.co.il>).

The first apparent issue which needs to be addressed is whether or not the term "lawpubshop", is the same or confusingly similar to a Name of the Complainant. Hence the question arises - what precisely is "the Name of the Complainant", to which the Domain name may be confusingly similar.

In the Letter of Complaint, the Petitioner identifies itself under the name of "**LawPub (The Economic Company of the Israeli Bar)**".

As for the first PART of this Name, "lawpub" – it consists of the generic word "Law", the abbreviation "Pub", which can stand for "publication", "publicity" and various other possible terms.

It is visually evident that this term may be similar to PART of the Disputed Domain "lawpubshop". As stated in the **WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition** (hereinafter **the WIPO Overview**), it has been ruled in the past that a Domain which includes in its entirety a Trademark of the Petitioner, may indicate an infringement of this right:

Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

Hence the next question arises – is "Lawpub" a legal name or mark of the Petitioner. As mentioned above – No indication of a relevant registered Trademark has been presented or found.

The Panel proceeded to review a potential listing of "lawpub" as Domain Name, which may possibly indicate a name used by the Petitioner. Such internet registration was indeed found. A review of the webpage associated with the Domain lawpub.co.il yields an error notice, and a historic search through the websiteinformer.com or webarchive.net web searches indicate no historic use of this Domain by the Petitioner.

In conclusion regarding the first part of the Domain – it appears there is not sufficient indication that the current Name of the Petitioner is Confusingly Similar to the Disputed Domain.

Further, The Petitioner claims that the domain "lawpubshop.co.il" in its entirety is confusingly similar to its Name.

As reviewed in the Section b below, the Complainant does not claim rights in any relevant registered Trademark, and indeed a search conducted by the Panel as well reveals that there is no apparent Trademark Registration of the term "lawpubshop". Hence the question arises whether the Domain is confusingly similar to an unregistered name of the Complainant.

A historic search of past use of the Disputed Domain through the Internet Archive Search Engine² clearly shows that in the past, this Domain was indeed used by an entity known as the Israeli Bar Publishing House. However, at some point during the year 2015, the internet web page started referring to "The Economic Company of the Israeli Bar" as the Name by which it is to be known, rather than The Bar Publishing House. For several years it maintained both names in its title, but by 2017, it presented itself only as the The Economic Company.

Hence, whereas historically the Complainant could have attempted to claim that the main component of the Disputed Domain "LawPubShop" is confusingly similar to its unregistered Name (the Bar Publishing House), it appears that at time of filing of the Complaint, it has indicated a change in its name, becoming "The Economic Company", which in no way can be considered confusingly similar with the Domain.

This claim is re-enforced by the fact that as of 2017, the disputed Domain consists of a re-direct page stating that the Publishing House has been upgraded, and can be found at a new web site – www.ibar.co.il . On this new webpage, the Petitioner identifies itself by its new name ""the Economic Company of the Israeli Bar, and very little, if any, use is made of the term "LawPubShop".

In light of the above, it appears that historically, the Domain may have been Confusingly Similar to a Name of the Petitioner. This claim is not fully supported, but the Panel finds no need to fully analyze the historic proceedings, since at the time of filing of the Complaint, the Domain was no longer confusingly similar to the new name by which the Petitioner chose to identify itself.

Since this argument has not been fully exhausted, the Panel will proceed to evaluate the existence if additional grounds which may indicate infringement of the Petitioner's rights under the UDRP proceedings.

a. Complainant has Rights in the Name

1. The II-DRP rules require fulfillment of all grounds specified in Section 3 of the Rules. This Section requires prima facie proof that the Complainant has rights in the Name.
2. One method of indicating rights in a Name would be to provide proof of registration of a relevant Trademark. The Complainant did not provide any such indication, and a quick search conducted by the Panel indicated no such Mark.

It has been noted that the Israeli II-DRP guidelines are very similar to those established by WIPO Uniform Domain Name Dispute Resolution Policy, and therefore local guidance is often taken from WIPO Panel decisions and guidelines. As stated in the **WIPO Overview:**

"To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual

public (e.g., consumer, industry, media) recognition, and (v) consumer surveys."..... In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning."

Therefore, it is up to the Complainant to meet a heavier burden of proof indicating its rights in the Domain.

3. In the case at hand, not only is the Disputed Domain not identified with a Registered Trade Mark, but it also consists of a combination of three Generic Terms: "law" "pub" and "shop". As such, the Petitioner must provide significant support for its claim to rights in the name, indicating that nonetheless, it has become a well know mark which is recognized by the public and associated with its rights.

One such claim to rights may be clear indication of actual and active use of the Name. The Petitioner needs to provide clear and concrete evidence that it has acquired rights in the name through usage over time, and that third parties identify the Petitioner with the Name.

As mentioned in the WIPO Case **No. D2008-1010, Thomas Pick aka Pick Inc. v. EUROPREMIUM LTD, Elaine Maria Gross**, sufficient evidence needs to be provided:

"Two common methods of proving that one has established secondary meaning in respect of a particular trade mark are, (i) to demonstrate substantial use in the course of trade of the trade mark in question over a reasonable period (e.g. by producing details of sales and advertising expenditure and samples of one's business literature, advertisements etc.); and (ii) to produce evidence of third party use of the trade mark to identify the trade mark claimant's goods or services (e.g. correspondence from suppliers/customers, press cuttings etc.)"

The Complaint did not include proof or description of its previous holding of the Name. It merely mentioned that it made use of the Domain for the past 12 years.

According to a search conducted by the Panel from public sources, the www.website.informer.com webpage states that the Disputed Domain was first registered by the Petitioner in 1999.

But it is clear that prior registration of a Domain does not necessarily or automatically grant the Holder any Rights in a name which consists of generic words and is not registered as a Trademark.

In support of its claim, the Petitioner claims that "The Complainant has the only right of using of the domain LawPubShop.co.il, as a short search on Google for the Domain LawpubShop.co.il shows no less than 842 results regarding the activities of Complainant and the importance of the Domain LawPubShop.co.il."

The Petitioner provided a screen shot of the first page of the aforesaid google search. However, closer review of the search results will show that the Name was indeed used often by the Petitioner, mostly in its mail references, but these references merely show that the Petitioner itself included the Domain in its own mail references. This neither indicates any substantial business activity nor any third party use. All references listed as examples by the Petitioner indicate its own use of the Name.

But even more important than the original use of the Domain, the Petitioner neglected to mention in its Complaint that as of earlier in 2017, the Disputed Domain became inactive, and only maintained a Page stating that: "We have upgraded. Please visit us at www.ibar.org.il".

This information has been validated by a historic search both thru www.website.informer.com and the Wayback Machine at https://web.archive.org/web/2019*/lawpubshop.co.il, both indicating that since 2017, the Disputed Domain has not been actively used. Hence, even if the Petitioner had indicated some original rights in the name, it appears that at a certain point in time it chose to forfeit these rights, and to stop using the Disputed Name as its main point of reference.

Let it be noted that the fact that the Petitioner neglected to mention that it has been redirecting traffic from the Disputed Domain to a different name – also contributes to tipping the balance of proof against the Petitioner itself.

In light of all of the above, the Panel concludes that the Domain consists of non-registered, generic terms, which require a higher burden of proof to indicate Rights. This burden of proof was not clearly supported by the Petitioner's claims. Even in the event that some right was presented, the Petitioner chose to forfeit this Name at some point, around the year 2017, and to conduct its business under another name. Hence, at the point at which it claims to have technically forgotten to renew the Domain Registration – it was already practicing its business under another name, and therefore did not raise the burden of proving its rights at the time of registration by the Respondent.

b. Respondent has no Rights in Name

The above analysis indicates that the first two of four required grounds for Petition have not been clearly fulfilled, at best. Hence, there is no real need to analyze the existence of the Third requirement, that the Respondent have no Rights in the Name.

However, merely to strengthen the above claims, the following points are noted:

- The name consists of Generic terms, in which any Party may show an interest, on relatively light grounds

- The Respondent submitted a plan for using website for a business that at least prima facie has reasonable connection to the generic terms - a portal for legal professionals to register, receive updates and Publicity. Such business may clearly and legitimately be interested in a Domain such as is disputed herein.

Though the II-DRP guidelines do not specify what may be deemed Rights in a Name as demonstrated by a holder, it may be a relevant indication to note that under the ICANN UDRP Policy:

" Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of [Paragraph 4\(a\)\(ii\):.....\(i\)](#) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; " Though not applicable under local rules, the Panel may gain reference from this guideline. It is noted that the Respondent did not provide information as to when he created his business plan, or what steps he has taken to implement it. Since only a brief period of time has passed since purchasing the Domain, it is not unreasonable for the Respondent to be only in early stages of his plan, and therefore even this minimalistic information will suffice to indicate Rights in the name.

Based on all of the above, Panel concludes that the third requirement under the Rules is not fulfilled, and the Respondent has indicated having at least some level of alleged rights in the Domain Name.

c. Registration or Use in Bad Faith

1. Section 3.4 of the Rules requires that "the application for allocation of the Domain Name was made or the Domain Name was used in bad faith". The section continues to list a non-exhaustive set of circumstances which, if present, will be considered bad faith. Most of these do not seem applicable under the current circumstances.
2. The Petitioner possibly attempts to claim, in mentioning "the daily financial loss" the Respondent has caused, that "the Holder has requested allocation of the domain name primarily for the purpose of disrupting the business of a competitor;" (section 3.4(2)). The Petitioner provided no evidence in support of such claim. However, the Respondent submitted a copy of the communication between the Parties, in which it explained not only that the Domain was free, but also offered the Petitioner, as an act of good will, to temporarily redirect potential customers to an alternative web page of choice by the Petitioner, so as to help mitigate any potential damages to the Petitioner. Such letter remained unacknowledged.

3. The Petitioner claims, as an indication of bad faith, that : "The Respondent main business is marketing and SEO Consultant, therefore, he probably knows that the Domain name LawPubShop.co.il was accidentally freed with no any intention to permanently releasing it."

The Panel finds no grounds for this conclusion. Prior to the time of registration of the Domain by the Respondent, the relevant page consisted of a link redirecting visitors the Petitioner's new web page at www.ibar.co.il. Hence, the Respondent may have used is prior knowledge of digital marketing in order to anticipate the expiration of the previous registration, but since the Petitioner indicated that it was transferring its business to another web page, there is no way to expect the Holder to be aware of the Petitioner's intentions!

4. None of the claims by the Petitioner provide an indication of bad faith on behalf of the Respondent. The Panel is of the opinion that the Respondent clearly sought out the Disputed Domain, because, as a professional SEO, in the field of digital marketing, it believed that the Domain has public value, in and of itself. There is a fine line between registering a Domain solely for one's legitimate advantage, and registering a domain in a way that infringes another's rights. In the current case, the circumstances indicate that the Respondent's action constitutes legitimate business interest, and not an act of bad faith.

A similar conclusion was reached by a WIPO panel, also based on accidental release of a Domain by the Petitioner:

"Accordingly, given that Complainant is required to prove its case on the balance of probabilities (see section 4.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition), and while sympathising with the harm caused to the Complainant by its omission to renew its domain name, the Panel concludes that the Complainant has failed to establish the third element of paragraph 4(a) of the Policy." ***Titoni AG v. Synergy Technologies, LLC, Domain Administrator, Case No. D2019-0395***

In light of all of the above, the Panels finds that the fourth component of the Rules requiring bad faith on behalf of the Respondent, was not fulfilled.

V. Decision

In light of all of the above, Panel finds that the Disputed Domain is not identical to a Mark of the Petitioner, the Petitioner has not clearly established substantial sufficient circumstances supporting its rights in the Disputed Domain, the Respondent presented potential rights in the Domains, and the Respondent has not acted in bad faith in registering or holding the Domain.

Therefore, the Panel concludes that **the Petition is denied and the Disputed Domain shall NOT be transferred to the Petitioner.**

Leehee Feldman, Adv.

Sole Panelist

Date: March 11th, 2020