

Dispute Resolution Panel

For the Internet Society of Israel

Ellen Shankman, Adv.

In the matter between

AXA S.A.

(The "Complainant")

Represented by Maitre Patrice de CANDE

Layer

SELARL MARCHAIS DE CANDE

And

Anthony Bitterman

(The "Respondent")

Regarding the domain name

axa.co.il

(The "Domain Name")

DECISION

Procedural Background

The panel was established on 3 May 2009, in accordance with the Procedures for Alternative Dispute Resolution under the .IL ccTLD by Dispute Resolution Panels ("IL-DRP Procedures"), http://www.isoc.org.il/domains/ildrp_rules.html_ (in English) and http://www.isoc.org.il/domain_heb/ildrp_rules.html_ (in Hebrew), in order to address Complainant's request to cancel the allocation of the Domain Name (axa.co.il) to Respondent and to transfer the Domain Name to the Complainant.

Respondent was notified that a complaint had been filed and both parties notified of the appointment of the Panel. Confirmation of receipt of the notification was made in a telephone call to the Panelist by Respondent. Further, the parties were specifically reminded of notification of the deadline for response, and Respondent has submitted a response.

Further, on 31 May 2009, pursuant to the authority granted by Section E of the IL-DRP Rules, additional information was requested from both sides specifically with regard to the element of "bad faith". Both sides responded to the request.

Per Section 8.2 of the IL-DRP Procedures, either party may request that the dispute be reviewed by an extended panel within 7 days of the notification. Further, per Section 8.4 of the IL-DRP Procedures, either party may request exclusion of the appointed Panelist on the grounds of any potential conflict of interests. No such requests were made.

Complainant's Arguments:

1. AXA SA is the holding company of the AXA Group, whose main business is in the field of insurances and financial services. The group is widely known under the trade name AXA.
2. The AXA Group has numerous subsidiaries in many countries around the world and the Complainant enjoys nowadays a worldwide reputation.
3. 67 million clients across the globe trust the AXA Group, which generates 94 billion Euro in revenues per year, thanks to its 170000 employees and exclusive distributors (Annex 1).
4. The AXA Group is famous for its numerous activities in services like finance, real estate or insurance, proposed both to individuals and to business companies.
5. The domain name <axa.co.il> is identical or confusingly similar to trademarks and service marks in which the Complainant has rights.
6. Complainant provided a list of trademarks and domain names held by the Complainant, including Israel trademark "AXA" Registration N°82074 filed on January 9, 1992, in class 36 (Annex 2),
7. Complainant also claims that it is the owner of the following trademarks:
 - International trademark "AXA" N°490 030 filed in December 5, 1984, in classes 35, 36 and 39, duly renewed and designating Algeria, Ostrich, Bosnia, Croatia, Egypt, Spain, Hungary, Italia, Morocco, Monaco, Portugal, North Korea, Romania, Russia, Saint Martin, Slovakia, Slovenia, Sudan, Ukraine, Viet-Nam, Yugoslavia, Benelux, Switzerland and Liechtenstein (Annex 3);
 - Community trademark "AXA" N°000373894 filed on August 28, 1996 in classes 35 and 36 and duly renewed (Annex 4);

American trademark "AXA" N^o 679597 registered on March 17, 1992 in classes 35 and 36 and duly renewed (Annex 5).

8. Complainant claims that the above-mentioned trademarks, registered all over the world and containing the word AXA, are prior to the registration of the disputed domain name <axa.co.il> on November 7, 2006, and are widely used by the Complainant and its licensees in connection with classes 35 and 36 of the international classification, i.e. insurance services and financial service.

9. The Complainant or its subsidiaries are also, among others, the owner of the following domain names, all registered prior to the Respondent's registration of the domain name axa.co.il:

gTLDs:

- . AXA.COM, registered on October 24, 1995;
- . AXA-INSURANCE.BIZ, registered on November 7, 2001;
- . AXA-INSURANCE.INFO, registered on October 31, 2001;
- . AXA-FINANCIAL.COM, registered on February 25, 1999;
- . AXA-ASSISTANCE.COM, registered on March 11, 1998;

ccTLDs:

- . AXA.FR, registered on May 20, 1996;
- . AXA.COM.HK, registered on October 18, 1996;
- . AXA-INSURANCE.COM.HK, registered on March 4, 1998;
- . AXA.US, registered on April 24, 2002;
- . AXA.CH, registered on January 23, 1996;
- . AXA.COM.MX, registered on September 18, 1997;
- . AXA.PT, registered on November 11, 1997;

10. The contested domain name <axa.co.il> wholly incorporates the Complainant's distinctive trademark AXA, which has no particular meaning and is therefore highly distinctive, and as such creates sufficient similarity to be confusingly similar.

11. In this respect, numerous panels hold in previous decisions that confusing similarity is established when a domain name wholly incorporates a Complainant's trademark in its entirety. Moreover, the addition of the suffix ".co.il" is ineffective, citing IL-DRP Case Acer, Inc. v. Ms Marilyn Sharon, concerning the domain name <acer.co.il>:

"The Domain Name is confusingly similar as the ACER trademark registered in Israel since 1991 in classes 9 and 42. The addition of the suffix ".co.il" does not distinguish the Domain Name from the ACER trademark. To the contrary, the

suffix represents that the Domain Name is merely registered for a commercial organization (see Rule 2.7). As such the suffix "co.il" is purely descriptive of the domain name address type. As such the Domain Name and the ACER trademarks are confusingly similar."

12. In addition, Complainant claims that it must be underlined that the likelihood of confusion is also ascertained because of the notoriety of AXA and its trademarks (Annex 1). Therefore, Complainant argues that it is undoubtedly established that the litigious domain name <axa.co.il> is identical or at least confusingly similar to the trademarks and domain names over which the Complainant has rights.

13. The Respondent has no rights or legitimate interests in respect of the domain name <axa.co.il>. Complainant claims that "[o]bviously, the Respondent does not have any legitimate interest in respect of the domain name <axa.co.il>.

14. Complainant claims that "it is crystal clear that the registrant does not have any legitimate interest in using the litigious domain name since the name ANTHONY BITTERMAN does not review any relationship with the word "AXA" directly or indirectly in any form." The Respondent has consequently neither prior right nor legitimate interest to justify the use of the already well-known and worldwide trademark AXA.

15. The Complainant has never licensed or otherwise permitted the Respondent to use its trademarks or to register any domain name containing the above-mentioned trademarks. Therefore, there is no relationship whatsoever between the Complainant and the Respondent.

16. The Respondent has clearly adopted the Complainant's trademark for its own use and incorporated it into its domain name without the Complainant's authorization.

17. Complainant claims that under these circumstances, the absence of any permission by the Complainant proves that the Respondent has no right or legitimate interest in respect of the litigious domain name.

18. Complainant claims that the domain name has been registered and is being used in bad faith.

19. The domain name has been registered for the purpose of attracting Internet users to the Respondent's web site, by reproducing the "AXA" trademarks and creating a likelihood of confusion between the AXA's trademarks and domain names and <axa.co.il>.

20. Again Complainant claims that "[i]t is obvious" that the Respondent has registered its domain name aware of the Complainant's rights. Complainant

again refers to the lists of its domain names and trademarks and claims that it enjoys nowadays a worldwide reputation, especially in Europe, in United-States and in the Mediterranean region (Annex 1).

21. Furthermore, AXA's trademark and activities are well-known on the Israeli web. For instance, by entering the name "AXA" on the Israeli page of the search engine Google, www.google.co.il, the following page of results appears [results omitted here]. All results lead to AXA's official websites, or to websites providing information about the Complainant's activities.

22. Therefore, the Respondent must have undoubtedly been aware of the risk of deception and confusion that would inevitably follow when registering the disputed domain name since it could give the impression that his website, and thus even the Respondent himself, were somehow endorsed by the Complainant, when in fact they were not.

23. Complainant claims that under these circumstances, it is "inconceivable" that the Respondent registered the domain name unaware of the Complainant's rights. The Respondent should have known at the time of application that AXA was likely to request for its use the litigious domain name in Israel. Consequently, the Respondent infringed Rule 8 of the ISOC-IL Registration Rules, pursuant to which:

"A submission of an Application by an Applicant constitutes the Holder's representation and warranty that the Holder is a legal entity and that the allocation or use of the Domain Name by the Holder does not infringe the legal rights of a third party", claiming as well that the Respondent infringed the "good faith duty", which is, again citing *Acer, Inc. v. Ms Marilyn Sharon*, "a tenet of Israeli law and covers all contractual and legal acts performed by a person."

24. The litigious domain name has not only been registered in bad faith, but is also being used in bad faith.

25. Firstly, the election of the suffix ".co.il" demonstrates that the Respondent's website was created for commercial purpose.

26. Secondly, the Respondent's website provides streaming services based on a music search engine called "musicXposure".

27. The objective of such website is to increase its notoriety, by extending its community of users.

28. The homepage of the Respondent's website suggests links leading to online community's websites, where people share any kind of information, in order to increase the notoriety of the Respondent's website.

29. Whereas the Respondent would have been able to select another word than "AXA" for his website's domain name, it is obvious that the Respondent, by reproducing the "AXA" trademarks and creating a likelihood of confusion between the AXA's trademarks and domain names and <axa.co.il>, is trying to attract internet users to his website, in order to extend its community of users.

30. Therefore, the Respondent is deliberately trying to gain unfair benefit of AXA's reputation, for its own interest, and is using the litigious domain name <axa.co.il> with bad faith.

31. LIST OF ANNEXES

Annex 1: AXA Group's annual report 2007;

Annex 2: Israeli trademark "AXA" N°82074

Annex 3: International trademark "AXA" N°490 030;

Annex 4: Community trademark "AXA" N°000373894;

Annex 5: American trademark "AXA" N°1679597.

32. Further, in response to the request for additional information, Complainant added:

"We note that the Respondent's website changed, since we filed the Complaint before the Israel Internet Association to a video site. As with the previous Respondent's website, the objective of such website is to increase its notoriety, by extending its community of users/visitors. It is crystal clear that the Respondent is trying to make money by using its website, as the Respondent sells advertising space on his website.

For instance, the litigious website's homepage contains such advertising space up on the right hand corner [link to bicycle ad, snapshot of website homepage provided omitted here]. Consequently, at the opposite of the Respondent's declaration of June 11, 2009, the litigious website contains monetization elements, since advertising spaces are sold.

Moreover, it is very likely that advertisement space's income depends of the number of visitors/users on a website.

To this end, by reproducing the "AXA" trademarks and creating a likelihood of confusion between AXA's trademarks and domain names, and <axa.co.il>, the Respondent is trying to attract internet users to his website, in order to extend its community of users, and to increase its advertising income.

Therefore, the Respondent not only registered the litigious domain name in bad faith, but is also using it in bad faith."

Respondent's Arguments:

1. Claimant never made any demand directly to Respondent, and instead only instituted these proceedings.
2. The domain name was free and available for 10 years. The Axa group could have acquired the domain name from 11/01/96 until 7/11/2004.
3. In 2004 Respondent was looking for a domain name with 3 letters, easy to remember and simply starting with the letter A, the only one available was axa.
4. Respondent claims that it checked if in Israel there was any company or product which was related to the word AXA. After a few days of checking in the Israeli search engines, Respondent claims he didn't find anything, so he reserved the domain name axa.co.il.
5. Respondent claims "Obviously if there would have been a company representing the Axa group, we wouldn't have reserved this name. Until this day there is still not a company named axa in Israel. And if you look at the axa website you can see clearly on the map that they are not in Israel. And in the whole site nothing is mentioned about opening axa in the near future in Israel.

See picture attached

The screenshot shows the AXA website's 'Le site du Groupe AXA' page. The navigation menu includes 'The AXA Group', 'Corporate Governance', 'Corporate Responsibility', 'Investor Relations', 'Individual Shareholders', 'Press Corner', and 'Publications'. The main content area is titled 'AXA in the Middle East' and features a map of the region. A blue callout box with a red border points to the location of Israel on the map, containing the text 'AXA GROUP ARE NOT IN ISRAEL ???'. Below the map, there is a 'Back' button and a section for 'AXA Assistance' which describes the company's international network and provides contact information.

6. Respondent distinguishes Acer as being well known in Israel, and thus acknowledges that acer.co.il should have been returned to Acer, but argues that the case is not the same for AXA.

7. Respondent argues that on the contrary Axa Group is not known at all in Israel, therefore it creates no interest for the Israeli people. Out of curiosity we asked Israeli people if they had ever heard of Axa and the answer was 100% no. So we do not benefit of your reputation, and there can be no confusion in Israel with our domain axa.co.il

8. Respondent claims that it did not and does not have any intention to cause Claimant any harm or to the image of the Axa group, as there isn't any publicity on its axa.co.il site, and there is no connection or similarity with your activity.

9. Respondent claims that Complainant's own example given, proves again why there can't be any confusion with the Axa Group and axa.co.il . "By searching for the word Axa in the search engines google .co.il or google.fr and google.com the result speaks for itself, in the first 50 pages you find the sites of the Axa Group with different domains that all lead to the Axa Group, and we didn't find the domain name axa.co.il. According to the professionals in referencing in search engines, if you are not in the first 2 pages, you don't exist for the user. As we are not in the first pages no client of Axa will enter in our site axa.co.il. The only way to enter into our site is really writing www.axa.co.il I doubt that any European customer or elsewhere decides to look for Axa in Israel."

www.axa.com

www.axaonline.com

www.axakiwisaver.co.nz

www.axa-equitable.com

www.axapphealthcare.co.uk

www.axaasiapacific.com.au

www.axa-achievement.com

www.axa-im.com

www.axa-art.com

www.axa.ca

www.axa-gulf.com

..... The list is too long just check on Google.

<http://www.google.co.il/search?q=axa&hl=en&start=0&sa=N>

10. Respondent adds "Your arguments don't prove that there can be any confusion and are not acceptable to us. Google found 10,900,000 pages with the word "axa". I have never seen a company that has so many websites and different domain names."

11. Respondent claims that 90% of the domain names in the world are registered with family names privately where the domain name has nothing to do with the name of the company.

12. Respondent cites two other examples in which Complainant tried and failed to obtain domain names.

a) "In October 2000 you have already tried to get back a domain name www.axachinaregion.com which has failed.

<http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-1377.html>

- The Complainant has not satisfied the Panel that the Respondent had no rights or legitimate interest in the domain name, nor that the domain name was registered in bad faith. Consequently, pursuant to paragraph 4 of the Policy and paragraph 15 of the Rules, the Panel decides that the Respondent shall not be required to transfer the domain name "axachinaregion.com" to the Complainant."

b) "Axa.cn which belongs to a company in China since 2005, is a sex site which you didn't succeed to get back while your company has been there since 1993.

- http://www.institutentreprise.fr/fileadmin/Docs_PDF/travaux_reflexions/Mondialisation/20_etudes_de_cas/AXA.pdf "

13. The axa.co.il site was registered on 07/11/2004 at isoc.org.il respecting all the rules of the organization. Respondent registered this site and are developing a search engine of music and video, [the site is still in Beta] which has nothing to do with insurances of the Axa Group.

14. Respondent pushes back on the bad-faith claim made by Complainant and states : « I'm a bit upset about the way this has been done. You accuse us of registering and using axa.co.il in bad faith etc. while you do not exist in Israel. Most of all you accuse honest people attacking us with lawyers, without having the courtesy to contact us directly before. Maybe if you would create one day a company in Israel which would create work for people maybe then we can think about it."

15. Respondent claims that today it is "impossible" to find a domain name with 3 letters in co.il, and thus the domain name is important to them.

16. Respondent suggests that Complainant has alternatives in .co.il and could reserve Axagroup.co.il, www.axaonline.co.il, "or like the other domains you have just with co.il, you have a lot of possibilities" Respondent claims they do not have such viable alternatives for registering a domain with 3 letters.

17. In response to the additional information requested, Respondent declared that it utilizes no monetization elements on his website.

Additional information:

Of my own accord I requested information of other domains held by the Respondent in the .IL ccTLD space.

Discussion:

Grounds for Decision

The Procedures state:

“B. Grounds for IL-DRP

3. Disputes regarding allocation of a Domain Name by a Holder may be brought by a third party ("Complainant") 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. Evidence of Allocation or Use in Bad Faith

4.1. 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

- c. *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*
- d. *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*
- e. *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.”*

Thus, in order to prevail, a Complainant must establish all four elements: confusing similarity to the Name, rights in the Name, that the Holder has no rights in the Name, and an element of bad faith.

Confusingly Similar

The first question is: Is the Domain Name the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the Complainant?

I find the answer to this “yes”. The Domain Name axa.co.il is confusingly similar to the registered trademarks of the company, which include, inter alia, “AXA”.

Complainant’s Rights in the Name

The second question is: Has Complainant established that it has rights in the name?

I find the answer to this “yes”. Complainant has provided evidence of registration of the trademark “AXA” in Israel, and holds multiple domain names with the term “axa”. Further I find that the Complainant has established that its mark is well-known *in the insurance industry*.

I note that I found Complainant’s claims numbered 1-10 above persuasive, but do not accept the inevitability of reaching the same conclusions that imply that only Complainant is in a position to confer rights to someone else for use of the name with regard to anything raised in Complainant’s claims 15-17.

Respondent’s Rights in the Name

The third question is: Does the Respondent have rights in the Name?

I find the answer to this “no”. Respondent has demonstrated no “rights” in the Name “axa”.

In particular, I wish to comment on specific claims made by both parties:

I disagree with Complainant’s apparent assumption in its claims numbered 13-15 that the mere assertion of “obviously” somehow takes the place of providing evidence or support for such assertion. This holds true as well to assertions of “obvious” provided with regard to the element of ‘bad faith’ as well.

I disagree with Respondent’s assumption that seeking a three letter name gives someone rights to the name. It does not.

I also do not accept Respondent’s argument that no other 3 letter names were available, nor do I have any evidence or way to weigh the argument that no other combinations were available except “axa” at the time.

I disagree with Respondent’s contentions that because the Complainant did not acquire the Domain Name initially that it forfeits rights in its name. It should not

be incumbent upon a party to acquire all possible variations of its mark in domain name strings in order not to forfeit any rights or prevent allocation of such domain names to others.

Bad Faith

The fourth question is whether there appears to be any evidence of bad faith in the allocation or use of the Domain Name.

In my opinion 'bad faith' cuts both ways. I find that there is an arguable question of fact regarding evidence of bad faith on the part of both parties, and thus raises this dispute to one that should be determined by a trier of fact and is therefore outside the scope of this proceeding.

In a non-exclusive list of possible evidence of bad faith, Section 4.1. (e) states:

e. 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."

I find that the Respondent does attempt to draw users to its website but do not see conclusive evidence that it is done in the creation of a likelihood of source, sponsorship or affiliation with Complainant.

Further, Respondent raises the question of bad-faith on the part of the Complainant – which is also relevant to determination of this matter.

The domain name has been held and used by Respondent since **2004**. There is sufficient question raised on the issue of whether Complainant is inappropriately seeking late in the game to acquire a domain name that it now wishes to hold by an expedited and relatively inexpensive procedure which is intended for clear cut cases of abuse only. If so, there may be other more appropriate methods/mechanisms to resolve this issue.

In my opinion, it is *imperative* to protect legitimate trademark rights in the domain name space. However, overreaching trademark owners, in attempting aggressively to utilize the wrong mechanisms in order to obtain domain names that are more appropriately the subject of competing interests and arguable legitimate use, for which such dispute is more appropriately decided by a trier of fact, must also answer for alleged 'bullying' efforts.

While I am not prepared based on the evidence provided to make any determination of whether such is the case in the subject domain name dispute, it is another factor that supports my opinion that this dispute is not suitable for expedited resolution under the IL-DRP procedure.

In addition to the factual questions regarding bad faith this cases raises serious interesting questions of trademark law that should be determined in a more appropriate forum. Whether deliberately or unintentionally, both Complainant and Respondent raise arguments that go to the substantive issues of trademark infringement and use, confusion, mistake, passing-off, what the holder 'knew' or 'should have known', unfair competition and dilution regarding use of the mark in the domain name string and monetization on a website.

The IL-DRP was designed to provide an alternative inexpensive expedited dispute resolution mechanism to resolve clear issues of bad faith registration or use of a domain name. The substantive issues raised are outside the scope of these proceedings, and any conflict regarding these matters should be determined by resolution between the parties or by a court of law.

Decision

Section F, paragraph 16 of the IL-DRP Rules provides:

"F. Panelist/Panel Decision

16. Decision that Dispute Unsuitable for IL-DRP

16.1. Notwithstanding the above, at any stage the Panelist/Panel may refrain from issuing a decision regarding a dispute if it determines that the case is not suitable for expedited resolution under this procedure. “

In light of the above, I find that the current dispute is not suitable for expedited resolution under this procedure.

Date: 25 June 2009

Ellen B. Shankman, Adv.

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