

Bamarom Hafakot 2004 Ltd v. Arie Sheffer

IL-DRP Panel Decision

1. The Parties

The Complainant is Bamarom Hafakot 2004 Ltd. and represented by Adv. Livna Katsir.

The respondent is Arie Shefer, is a private individual.

2. The Domain Name and Registrar

The disputed domain name <bamarom-hafkot-tvia.co.il> is registered with Domain The Net Technologies Ltd.

3. Procedural History

The Complaint was filed with ISOC-IL on January 24, 2019. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On January 24, 2019, the IL-DRP appointed Jonathan Agmon as the sole panelist.

On January 28, 2019, in accordance with the Rules, 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 February 3, 2019, the Respondent requested that the proceedings will be conducted in the Hebrew language. On February 7, 2019, the Panel issued a decision denying the request.

On February 13, 2019, the Respondent filed his response both in English and in Hebrew.

On February 24, 2019 the Complainant requested the panel to allow a filing of an answer to the Respondents' response. On the same day the panel granted the request limiting the submission of a brief answer to 3 pages, within three days. The Respondents' objection to such filing was noted by the panel.

On February 28, 2019, the Complainant submitted an answer.

4. Factual Background

The disputed domain name <bamarom-hafakot-tvia.co.il> was created on June 18, 2017.

The Complainant, Bamarom Hafakot 2004 Ltd. ("Complainant") is a corporation. The Complainant did not specify what types of business it is engaged in and only annexed a certificate of its registration from 2004.

The Complainant is using the BAMAROMHAFAKOT mark for its business. The Complainant BAMAROM HAFAKOT is not registered as a trademark. The Complainant is not operating any website.

The Respondent is a private individual who states that he is leading a public campaign against the Complainant's alleged fraudulent actions.

The disputed domain name <bamarom-hafkot-tvia.co.il> resolves to a website containing information regarding legal proceedings that the Complainant has been involved in, short videos from talk shows, investigative reports about the Complainant, information about other endeavors of the owners of the Complainant and its legal counsel.

5. Parties' Contentions

A. Complainant

The Complainant argued that the disputed domain name is confusingly similar to its registered Name "Bamarom Hafakot 2004 Ltd". It argued that the Respondent has no rights in the Name. In addition, it contended that the disputed domain name consists of unfair use, that the website is defamatory, it interferes with the Complainant's business and infringes its' copyrights.

In the response submitted, the Complainant contended that the Respondent is a "systematic thief", repeated the claims made in the Complaint and emphasized the bad faith use the Respondent is making in the disputed domain name. In addition, the Respondent claimed that the statement clarifying the website is not the Complainant's website was added only after this complaint was filled.

It should be noted that the Complaint may be described as a bare-bones complaint providing very limited information. Moreover, apart from proof of its registration as a corporation, the Complainant did not submit any evidence alongside the Complaint.

In the response it submitted a number of screen shots from the Respondent's website, a screenshot, of what appears to be the Complainant's Facebook page, a copy of settlement agreement with a confidentiality clause and a number of IL-DRP decisions.

B. Respondent

The Respondent argues that the disputed domain name is not confusingly similar. The Complainant's corporate name is "Bamarom Hafakot 2004 LTD.", whereas the disputed domain is <bamarom-hafakot-tvia.co.il>. The two differ in two words - the disputed domain name does not include the year "2004," and adds the word "tvia," which translates into the word "lawsuit" in the Hebrew language. In addition, the home page of the Respondent's website displays a boldly written statement in white letters and a red background, to emphasize that the website is not the Complainant's website.

These differences and clear statement, argues the Respondent, ensure that Internet users will not be confused or misled.

In addition, the respondent states that the Complainant does not have any active website, nor does it have any domain name registrations. This, claims the Respondent, shows there could be no confusion caused to Internet users.

Furthermore, the Respondent claims he purchased the disputed domain name in good faith, as his website provides a "public service": it holds all the relevant information regarding legal actions to which the Complainant is or was a party to, and by supplying the public with the necessary criticism, information and "know how" regarding defending oneself in legal proceedings submitted by the Complainant.

Moreover, the Respondent claims that the Complainant has no goodwill or positive reputation in the BAMAROM HAFKOR mark. He states that even several Facebook groups were established to protect the public from the Complainant's actions. Since, according to the Respondent, the Complainant has no website, no good will and no "good" reputation, his actions can't be misleading, can't interfere with the Complainant's business and his website can't be defamatory.

Furthermore, the Respondent emphasizes the fact that he has no monetary gain or other benefit from the website under the disputed domain name, and therefore, all his actions should be taken to have been made in good faith.

6. Discussion and Findings

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 submitted to this process and Rules when he applied for and registered the disputed domain name with Domain The Net Technologies Ltd. registration agreement provides that the applicant for the domain name accepts the ISOC-IL registration rules (see <https://domains.livedns.co.il/Terms.aspx>).

The ISOC-IL registration rules provide that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See section 12.3). The Respondent, therefore, by applying for and registering the disputed domain name agreed to the IL-DRP and the Rules.

It is also noted that the Rules now adopted by ISOC-IL follow closely those of the Uniform Dispute Resolution Policy (UDRP), therefore the WIPO Arbitration and Mediation Center extensive jurisprudence (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.

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.

7. Preliminary – Language of the Proceedings:

On February 3, 2019, the Respondent filed a request that these proceedings shall be conducted in the Hebrew language. The Respondent stated that all the parties are fluent in Hebrew. Therefore, to prevent further complication of the proceedings, the Panel should hold these proceedings in the Hebrew language.

The Complainant did not timely respond to the request. The Complainant filed a late response stating that it leaves the matter to the decision of the Panel.

The IL-DRP provides that “all the information transmitted via e-mail shall be in English,” that all documents submitted must be in English or Hebrew and that the Panel may order those documents in any language, be provided with a translation in whole or in part into either Hebrew or English (see Rule 5.4). In addition, section 15.3 of the IL-DRP provides that English shall be the official language of the decision.

It is unclear exactly what the words “all the information transmitted via e-mail” in Rule 5.4 mean because the entire proceedings are conducted via e-mail. However, be that as it may, the fact that the Rules’ official language is English, that the Rules only specify that documents submitted may be in the Hebrew or English languages, and that the decision is to be drafted in English provide ample support to the conclusion that the Rules mandate that the proceedings, including the content complaint and response, be in the English language.

Unlike other domain names dispute resolution mechanisms, such as the UDRP, the IL-DRP does not grant the Panel with discretion to amend the language of the proceeding nor to accept an agreement by the parties to change the language of the proceedings. Until such time, when the IL-DRP is amended to grant a Panel the discretion to determine the language of the proceedings, the Panel is of the opinion that it lacks the capacity to disregard or judicially amend the IL-DRP or the Rules.

In the present case, the Complainant did not provide its’ consent to changing the language of the proceedings and in any event, the Panel is of the view that even with such consent, the language of the proceedings cannot be changed without a further amendment of the Rules, which as noted is outside the jurisdiction of this Panel. The Panel notes that since the Hebrew language is an official language in Israel, ISOC-IL should consider making the necessary amendment to allow the parties to have the proceedings conducted in the Hebrew Language and also allow the decision to be similarly drafted in the language the parties are more comfortable with. See Rule 11 of the UDRP.

As a result, the language of the proceedings shall be the English language. The parties were notified of the Panel’s decision by an interim decision on February 7th, 2019.

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.

In the present case, the Complainant argued it was the owner of the BAMAROM HAFKOT trademark, but did not provide any evidence to show that it has a registered trademark. The Complainant also did not provide any evidence to show that it has reputation or goodwill in the mark. The single piece of evidence containing a cropped image of a part of a Facebook page of Bamarom Audition is far from sufficient to show that the Complainant has reputation and goodwill in the BAMAROM HAFKOR mark.

The Complainant did provide evidence showing that its legal name is Bamarom Hafakot 2004 Ltd. Therefore, the Complainant can base its complaint on Section 3.1 of the Rules.

When reviewing the first element the Panel examination is limited to the identity between the Name and the disputed domain name. This is a threshold requirement that the Complainant must meet irrespective of the other facts surrounding the case. In the present case, the disputed domain name consists of the Complainant's Name (without the year of its registration) with the additional generic word "tvia", hyphens and the suffix "co.il".

Previous UDRP panels have ruled that the mere addition of a non-significant element does not sufficiently differentiate the domain name from the registered trademark: "The incorporation of a trademark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark" (See *Britannia Building Society v. Britannia Fraud Prevention*, WIPO Case No. D2001-0505). The same conclusion applies when the rights are established by a Name (in accordance with the II-DRP Rules), and not a registered trademark.

This panel finds that the addition of a generic term such as "lawsuit" – "tvia" and hyphens is insufficient to distinguish the disputed domain name from the Complainant's registered legal name.

This, alongside the addition of the suffix "co.il", does not escape the conclusion that the disputed domain name is confusingly similar to the Complainant's registered name.

Accordingly, the panel finds that the disputed domain name is confusingly similar to the Complainants' registered legal name.

B. Rights in the Name

Next, it is up to the Complainant to show that the Complainant has rights in the BAMAROM-HAFKOT Name, and that the Respondent has no rights in the Name.

As noted above, the Complainant was unsuccessful in showing trademark rights or goodwill or reputation in the mark. The only showing made by the Complainant was that it registered the corporation name – BAMAROM HAFKOT 2004 Ltd. In fact, the Facebook cropped image provided displays a number of names, including BAMAROMAUDITION, BAMAROM, BAMAROM OLAM HABIDOR, and BAMAROM HAFKOT. Accordingly, the Complainant barely made a thin showing of rights in the Name through its registration as its corporation name. The Complainant has provided that it has not approved or permitted for the Respondent to use its trademark or Name.

The Respondent claims that he has legitimate rights in the name as he, as he puts it, provides a public service and vital information to the public regarding the Complainant's ways of action, with information on how to conduct oneself in case of a lawsuit brought by the Complainant. In plain words, the respondent is claiming that the disputed domain name is being used for genuine noncommercial free speech.

Under UDRP Rules and decisions, panels have established two approaches to the matter (See WIPO Overview 3.0 section 2.6.2):

The first approach: The right to criticize does not extend to registering a domain name that is identical or confusingly similar to the owner's registered trademark or conveys an association with the mark.

The second approach: Irrespective of whether the domain name as such connotes criticism, the respondent has a legitimate interest in using the trademark as part of the domain name of a criticism site if the use is fair and non-commercial.

See: WIPO Case No. D2009-0022 The First Baptist Church of Glenarden v. Melvin Jones; WIPO Case No. D2014-0780 Mr. Willem Vedovi, Galerie Vedovi S.A. v. Domains By Proxy, LLC / Jane Kelly; WIPO Case No. D2016-2608 Azimo Ltd. v. Vladimir Zubkov ("Azimo").

In Azimo three supporting considerations were offered by the panel: (1) whether the domain name has been registered and is used genuinely for the purpose of criticizing the mark owner; (2) whether the registrant believes the criticism to be well-founded and lacks intent for commercial gain; and (3) whether it is immediately apparent to Internet users visiting the website at the domain name that it is not operated by the owner of the mark.

The Panel prefers the second approach. This approach is in accordance with the fundamental statute of Free Speech under the Israeli legal system, before and after the legislation of Basic Law: Human Dignity and Liberty (See Motion for Civic Appeal 10520/03 Itamar Ben Gvir v. Amnon Dankner (published by Nevo, November 12, 2006, paragraph 10); Supreme Court of Justice 5421/03 Shin. Yud. Nun – Leshiviun Yezug Nashim v. The council for Film Review, (published by Nevo, March 3, 2003).

In the present case the Respondent has shown that the domain name has been registered and is used genuinely for the purpose of criticizing and informing the public about the

Complainant. No other information or product is shown or offered on the website and no evidence to show that the Respondent has any commercial gain from his activities were brought forth by the Complainant. Moreover, it is apparent that Internet users visiting the website under the disputed domain name will immediately know that the website is not operated by the Complainant.

This Panel finds that the Respondent truly believes his views of the Complainant, and they are well-founded in the evidence filed and lack any commercial gain. (See also WIPO Case No. D2000-0190 Bridgestone Firestone, Inc., Bridgestone/Firestone Research, Inc., and Bridgestone Corporation v. Jack Myer)

The Complainant cited In re Noam Kuris (“Kuris”) IL-DRP decision in support of its case. The Panel finds that the Kuris is distinguishable. In Kuris the respondent did not submit a response from which the panel there could learn of any legitimate rights the respondent might have had in the Name. As explained at length this is not the case here.

Accordingly, having considered the parties submissions and arguments, the Panel finds that on balance, the Complainant failed to prove this element and that the Respondent has shown a legitimate interest in using the Name as a part of the disputed domain name for free speech purposes and the use appears to be fair and non-commercial.

C. Application or Use in Bad Faith

In light of the Panel’s finding in terms of Section 3.3 of the Rules, it is unnecessary for the Panel to render a determination in the issue of application or use in bad faith in detail in the present case. However, due to the uniqueness of this present case, the Panel will render his opinion as to section 3.4 to the Rules.

The Complainant must show that the Respondent registered and is using the disputed domain name in bad faith (section 3.4 of the Rules). Section 4 of the Rules provides circumstances that may prove bad faith under section 3.4 of the Rules.

The burden placed on the Complainant is to bring evidence showing circumstances that indicate that the Respondent registered or used the disputed domain name in bad faith.

A Panel will look into the totality of the circumstances in each case, and these can include evidence of the degree of distinctiveness or reputation of the mark, the failure of the Respondent to file a response and the implausibility of any good faith use to which the domain name may be put.

As mentioned above the Complainant argued, that the Respondent’s use of the disputed domain name amounts to bad faith and inter alia, consists of unfair use. The Complainant further argued that the website operated by the Respondent is defamatory, infringes copyrights and interferes with its’ business. The Respondent rejects all these claims and

stipulates that the true intention of the Complainant is to silence the Respondent and thus prevent the public from obtaining knowledge on the Complainant.

The Panel notes that non-commercial fair use without intent to tarnish the reputation of a Complainant is a defence under the second element (See also WIPO Overview 3.0, at par. 3.12). Therefore, if the Complainant was able to show that the statements made on the website under the disputed domain name are defamatory and intended for commercial use than such use may be found as to be evidence of the Respondent's bad faith.

Previous panels have turned to Israeli legislation and precedent in order to determine good or bad faith under section 3.4 of the Rules (See among others: *Habitat v. Amir Hadad*, July 31, 2000; *Disney Enterprises, Inc. v. Mr. Arick Gross*, January 28, 2000). Therefore, the Panel will further examine the claim through the scope of Israeli Law.

The Complainant's claims of "unfair use" and "interference with its business" are relevant to Commercial Torts Law, 5759-1999 (Commercial Torts Law). However, in order for the Commercial Torts Law to apply the Respondent must be a "business" see Sections 1– 4 to the Commercial Torts Law:

The Complainant did not contest the fact that the Respondent is a private individual, nor did it argue that the Respondent has any monetary or other gain from operating the website under the disputed domain name. Therefore, The Complainant failed to show that it can rely on the Commercial Torts Law to make a showing that the Respondent acted in bad faith, whether in registration or in use.

As the Complainant does not operate a website, it is not clear what "interference", the disputed domain name and website can possibly pose. It should be noted that the Facebook page does not assist the Complainant's case. First, as noted above it is unclear that it is owned by the Complainant. Second, the Complainant did not bring any evidence to show that the Facebook page serves as a commercial website in the sense that it conducts business there through. Third, there is no evidence showing that the disputed domain name unfairly affects access of the Complainant's clients to the Facebook page.

As to "passing off", the burden to show goodwill lays with the Complainant. The Complainant did not submit any evidence whatsoever to show goodwill or reputation it has acquired under the Name. The Complainant did not submit any evidence to show any damages were caused to its business, due to the use of the disputed domain name by the Respondent (See Civic appeal 945/06 *General Mills Inc. v. Meshubach Taasiut Mazon Ltd.* (published by Nevo October 1, 2009)). The Complainant's claim regarding the timing of posting the statement explaining that the Respondent's website is not affiliated with the Complainant, was not shown by evidence. The Complainant did not submit any screenshots of the Respondent's website prior to the submission of the Complaint and therefore the Panel refuses to accept this argument.

As for defamatory publications via the disputed domain name and the Respondent's website, the Prohibition on Defamation Law, 5725-1965 ("Defamation Law"), allows certain "allowed publication" (see section 13) or Defences (see sections 14 and 15) and no evidence was filed to show that the publications amount to a defamatory publication. Be that as it may, the Panel

balances the Complainants' claims against the Respondents' free speech rights. Since no evidence that the statements made by the Respondent on the website under the disputed domain name are defamatory was filed by the Complainant, on the balance the Panel finds that the Complainant failed to show the Respondent's use of the disputed domain name amounts to defamatory publications.

The Complainant therefore failed to show that the Respondent registered or is using the disputed domain name in bad faith.

The Panel further notes that this case is special because of its unique circumstances, according to which hardly any evidence was filed by the Complainant, while the Respondent was able to make a showing that he is using the disputed domain name to criticise the activities of the Complainant. As the right to free speech is a fundamental right under the Israeli legal system, and since, under the particular circumstances of this case, and in view of the evidence filed, the Panel found that the Respondent has legitimate interest in the disputed domain name, it would also flow that the registration or use of the disputed domain name was not in bad faith (See: *supra* Bridgestone; FA1207001455024 Cedars-Sinai Medical Center v. Initiative Legal Group; WIPO Case No. D2008-0647 Sermo, Inc. v. CatalystMD, LLC)

7. Decision

For all the foregoing reasons, in accordance with the Rules, the Panel denies the Complainant.



Jonathan Agmon

Sole Panelist

Date: March 12, 2019.