

IL-DRP PANEL

For the Internet Society of Israel

Before
Yoram Lichtenstein, Adv. Sole Panelist (the "**Panelist**")

In the matter of
the domain name "www.eco-lab.co.il" (the "**Domain Name**")

between

Ecolab USA, Inc.
1 Ecolab Place
Saint Paul MN 55102
USA

(the "**Complainant**")

and

EcoSupp Health, Inc.
4 Harechev St.
Tel Aviv 6777137
Israel

(the "**Respondent**")

DECISION

1. The Parties

The Complainant is a company incorporated in the USA and duly registered under the laws of Delaware.

The Respondent is a private Israeli citizen (as no corporation under said name is registered under the Israeli Companies Registrar).

2. Procedural Background

This panel was established on December 19, 2018, in accordance with the Procedures for Alternative Dispute Resolution under the .IL ccTLD by Dispute Resolution Panel (https://www.isoc.org.il/domain-name-registry/dispute_resolution/ildrp-rules in Hebrew and http://en.isoc.org.il/domains/ildrp_rules.html in English) (the "**Rules**"), in order to address the Complainant's request to cancel the registration of the Domain Name.

The Respondent (who is the registered holder of the Domain Name) was notified that a petition had been filed on December 23, 2018 and both parties had been notified

of the appointment of this Panelist. Petition and all its annexes were submitted to Respondent.

Confirmation of the receipt of notification was made on January 8, 2019 while Respondent had requested 15 days extension to submit its response. Decision on this matter was given on January 9, 2019, and Respondent was allowed a 15 days extension to submit its response. On January 24, 2019 a response was filed and sent to all parties hereto.

Therefore the following decision is based on the Petition, the Response and all attached Annexes.

3. Complainant's claims

Complainant is a global "Fortune 500" business founded in 1923, dealing with water, hygiene and energy technologies and services and is a global supplier of medical related solutions. It operates its business operates within 90 countries worldwide (Israel included).

Since 1986 Complainant had used its trademark "ECOLAB" extensively in the USA, and elsewhere (Israel included).

Complainant had registered 5 Israeli trademarks (Nos. 64883, 64884, 64885, 64886, 270417). Complainant is also the owner of multiple trademarks registered and requested worldwide, with the mark "ECOLAB" (registered textually or in a graphic manner) ("**the Mark**" hereby addresses "ECOLAB" registered mark).

Complainant had used the Mark continuously in commerce worldwide (and in Israel), also using its website www.ecolab.com since 1996 and www.ecolab.co.il since 2011.

Respondent supplies various laboratory tests based on bodily fluids locally in Israel, while those tests are not performed by Respondent as by third parties and uses the marks "ECOLAB" and "ECO-LAB" in relation thereto.

No Israeli company had been registered under Respondent's name.

Complainant was not aware of this Israeli business at first, and as becoming aware – had sent a cease-and-desist letter to Respondent ("Or Biba").

Complainant claims that:

1. The domain name "ECO-LAB" is virtually identical to the Mark ("ECOLAB") as the added hyphen is the sole difference.
2. Such addition does not create and distinction between the marks.
3. The suffix co.il needs to be ignored for determining similarities of the Mark and the Domain Name.
4. Therefore the Mark and the Domain Name (ECOLAB) are confusingly similar.
5. Complainant has rights in the Mark due to long and extensive use thereof.
6. Respondent has no rights in the Domain Name: no registered trademark, no agreement with Complainant, no non-commercial or other legitimate fair use and no other rights or interests.
7. The Domain Name was registered in bad faith as it is reasonable to conclude that Respondent was aware of it due to its strength and similar services in the health industry.
8. Alternatively, the Domain Name is used in bad faith, as the Respondent uses the Domain Name to attract consumers for commercial gain by creating likelihood of confusion.

9. Therefore Complainant requests the Domain Name be transferred to it.

4. Respondent's Arguments

The Respondent claimed that the pre-conditions within the Rules (articles 3 and 4) were not met. Particularly such claim is directed at the contention that the Domain Name was not registered and used in bad faith and that the misleading potential of the Domain Name of a potential "Internet surfer" are insignificant.

Respondent claims that the hyphen adds meaning to the Domain Name as it is understood as shortening of two relevant words – Ecological and Laboratory. Contrary to the name "Ecolab" which is not perceived as shortening yet as a separate word. Furthermore, it claims that such name is directly relevant to the business of the Respondent.

Respondent claims it had invested "many resources for several years" in support of the "ECO-LAB" mark (with hyphen).

Respondent claims that Complainant had not proved rights in "ECO-LAB" and that it had invested many resources in promoting said mark. It further claimed that even when no SEO efforts were executed under its mark itself, yet much effort was invested under the Domain Name. It further claims that there is no overlap between the parties' areas of practice, so there also can't be any risk of confusion.

As both parties' fields of business are "far apart" from being similar (Respondent deals with dietary supplements and laboratory tests for nutritional supplement adjustment) so clientele base is quite different (institutions and companies versus private clientele). It further claims that Complainant is not recognized in Israel. Therefore, it claims, Respondent had no interest in using Complainant's goodwill and had no commercial gain from such activity in order to attract Complainant's customers.

Respondent presents the mistaken discovery of Respondent's activity by Complainant as a sign of good faith and lack of will to use the Complainant's goodwill. It further claims that the fact that Complainant had discovered the use of the Domain Name only after a long period of time shows that it had suffered a minor misleading effect, if any.

Finally, it requests that if its position is denied by this Panel, it should be awarded 8 months at least in order to transfer its activity to another website and minimize its damage.

5. Discussion and Findings

The IL-DRP is an alternative dispute resolution procedure devised to allow expedited dispute resolution regarding the allocation of online domain names without allowing the panelist certain discretion that the relevant courts may apply.

Upon registering a domain name with the suffix co.il, the Respondent agreed to abide by the Rules, and this procedure is conducted by the Rules.

According to article 3 of the Rules -

"Disputes regarding allocation of a Domain Name by a Respondent 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 Respondent 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."

Those grounds are cumulative and must be established sufficiently by Complainant.

5.1 Is Domain Name is same or confusingly similar to the Mark?

The Rules require that the Domain Name will be the same or confusingly similar to the Mark.

The disputed Domain Name comprises of the name ECO-LAB (the Mark with an additional hyphen ("-") within) and the suffix .co.il.

It has been consistently ruled that the suffix is to be ignored for the review whether the Domain Name and the Trademark are the same or similar (for example see the cases of **L'Oreal v. La Belle Cosmetics Ltd.** over the domain name "essie.co.il" under the IL-DRP, hereby – "**the L'Oreal Decision**" and **Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic**, case No. D2000-1698 over the domain name "guinness.com" under the UDRP). Further more see IL-DRP cases such as the **Mrs. Hanada Assal v. Itai Ayalon** (Domain name – "regalo", August 5th, 2018, Panelist: Naomi Assia), **Namaste technologies v. Elad Peretz** (Domain name - "vaporiza", June 19th, 2018, Panelist: Leehee Feldman) and others.

The addition of the hyphen in the Mark is an addition of a non-significant element does not sufficiently differentiate the Domain Name from the Mark (See **Bodega Vega Sicilia, S.A. v. www.portaldedominios.com**, WIPO case No. D2000-1026). Such added meaning Respondent had claimed is insufficient to create a true distinction between the two.

Respondent claims that the name was chosen not as a word, but as an amalgamation of two words – "Ecological" and "Laboratory". Nevertheless, this seems to be subjective and not apparent to the eye of an "reasonable" observer. The sound of the Mark, the look of it and the way it is perceived by the reasonable observer would not be as Respondent claims.

As a side note, the Respondent's a laboratory does not deal with ecological aspects of the surrounding but medicinal ones. "Ecology" is defined by the online Merriam-Webster dictionary as "a branch of science concerned with the interrelationship of organisms and their environments". Indeed the term may have certain connection with Respondent's business yet it does not define it nor allows it any rights therein.

The Respondent claims there is a difference regarding potential clients of both services and goods (private persons per corporate purchases), yet the extreme similarity of the Mark and the Domain Name makes this claim mute.

It is further noted that the Rules empower this Panel to decide whether a similarity between the registered Mark and the Domain Name exists, but they do not include the consideration of whether there is a-similarity of classes of goods or services. Nevertheless, in this matter, Complainant had registered the Mark on various classes of goods and services, in a manner that even if there is no exact overlap between

Complainant's goods and services with Respondent's, there is still an overlap in the relevant classes themselves, and that is sufficient for this decision.

Last but not least on this matter, Respondent claims that the Domain Name is descriptive of its services. These are claims that might be held in other various relevant proceedings or courts, yet it is outside the scope of these limited proceedings.

Hence, my decision is that the Domain Name is confusingly similar to the Mark.

5.2 Does Complainant hold rights in the Mark?

Complainant had shown it holds a registered numerous trademarks under the Mark "ECOLAB" (to which the Domain Name is confusingly similar) in various forms in Israel and worldwide. Complainant had further shown that it operates under the Mark for a considerable period of time and accumulated significant goodwill.

Thus, it has been proven to my satisfaction that Complainant holds rights in the Mark in Israel.

5.3 Does Respondent hold rights in the Mark?

Complainant claims that Respondent has no rights in the name based on lack of evidence.

Respondent, on the other hand tries to focus its contentions on the ECO-LAB mark (with an added hyphen). Yet, as I have ruled, such difference is insignificant for our matter and the marks are confusingly similar, if not the same.

Respondent claimed that it had invested "many resources for several years" in support of the "ECO-LAB" mark. Such a claim was raised without any detail or relevant documentation. Indeed, this Panel is not equipped to deal with complex factual conflicts, yet the claims need to be reasonably substantiated in the documents filed under such proceedings. I am not aware of how long had the Respondent used the "ECO-LAB" mark prior to purchasing the Domain Name, what was the scope of its investment made in the goodwill of said Mark (as opposed to the strength of the domain) by Respondent, nor any other relevant data.

Respondent had not shown sufficient claims or evidence of its right or interests in the Domain Name upon purchase or nowadays. The sole Appendix A does prove that Respondent had invested certain resources in SEO activity of the domain (not the "ECO-LAB" mark), yet this does not assist the Respondent in determining whether it had acquired rights in the Mark.

I was not made aware of any use of the Mark by the Respondent prior to Complainant registration of the Mark in Israel or any similar fact that might convince me that Respondent had acquired rights in the Mark.

Therefore, it is my decision that the Respondent does not hold any legal right in the Mark or the Domain Name.

5.4 Was the application for allocation of the Domain Name made or the Domain Name was used in bad faith?

Article 3.4 requires that "the application for allocation of the Domain Name was made or the Domain Name was used in bad faith". Those conditions are alternative

and Complainant may prove only one of them to meet the requirements set by the Rules.

Article 4.1 of the Rules supplies not exhaustive examples of what should be considered bad faith use of the name, and those are -

- a. the **Respondent 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 Respondent has requested allocation of the domain name **primarily for the purpose of disrupting the business** of a competitor; or
- c. circumstances indicating that the Respondent 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 Respondent 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 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.

As the Mark has accumulated significant goodwill in Israel and abroad regarding certain classes of goods and services, and as at least one of the trademarks was registered in Israel in 1986 while the Domain Name was purchased in 2016, it is my decision that the Mark was reasonably known to Respondent (or should have been known if a web-search would have been executed (on the registrar's website or on Google).

Due to the difference in the scope of use and the veterancy of the use of the parties hereto, it is reasonable to assume that the Domain Name was registered (at least partially) in an attempt to gain certain, limited, online-traffic by using a well-known Mark, even if the fields of activity are not the same but adjacent.

It is further reasonable to conclude that such use of traffic due to the veterancy and power of the Mark is being made up till now.

In such circumstances, the use of the Domain Name confusingly similar to the Mark, in fields adjacent to Complainant's activity covered by the Mark, with no proven right to such use, teach us that the use was bad faith in accordance to the Rules.

So I conclude that the registration and the use of the Domain Name, currently, are made in a manner that corresponds with the IL-DRP bad-faith terms.

To remove any doubt, this decision is not to blemish the Respondent's intent, legal or moral position in any way, yet it corresponds with the procedural definitions of bad faith under the IL-DRP.

Nonetheless, it seems that Respondent had built a business under said Domain Name while Complainant did not bother to act in order to protect its rights from 2016

till this day. Such use should have been known to Complainant immediately had it checked the use or had the use been troubling it significantly.

Therefore, it seems that this use of the Domain Name does not caused it substantial harm, enough to initiate legal court proceedings or initiate these proceedings earlier. Especially when Complainant still holds the "ECOLAB.co.il" domain name. For that matter, I wish to allow Respondent reasonable time to relocate its business under an alternative domain name while limiting the harm that might be caused to it.

6. Decision

Therefore, based on all of the above, the Panel concludes that in accordance with the Rules, the registration of the Domain Name to its current Respondent is to be TRANSFERRED to Complainant as requested, on June 30, 2019.

Yoram Lichtenstein, Adv.
Sole Panelist

Date: February 13, 2019