

Skype Limited. v. Ronen Legativi

IL-DRP Panel Decision

1. The Parties

The Complainant is Skype Limited of Dublin, Ireland, represented by Don C. Moody, United States of America.

The Respondent is Ronen Legativi, of moshav Alma, Israel.

2. The Domain Name and Registrar

The disputed domain name <skypeisrael.co.il> is registered with Domain The Net Technologies Ltd.

3. Procedural History

The Complaint was filed with ISOC-IL on May 9, 2011. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On May 19, 2011 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on May 24, 2011, the Panel transmitted by e-mail to the Respondent a copy of the Complaint and attached materials, providing the Respondent 15 days to respond to the Complaint. The Respondent did not submit a Response to the Complaint.

4. Factual Background

The disputed domain name was registered by the Respondent on July 10, 2008.

The Complainant, Skype Limited markets a software program that enables voice and data communication over the internet, under the name "Skype". The Skype software has more than 560 million registered users.

The Complainant is the owner of many worldwide trademark registrations, which consist of the mark Skype. For example: United States trademark registration No. 3005039 – SKYPE, with the registration date of October 4, 2005; Israeli trademark registration No. 170106 – SKYPE, with the registration date of March 6, 2005; Community trademark registration No. 005903786 –SKYPE, with the registration date of April 11, 2008, and many more.

The Complainant was assigned the rights in the SKYPE trademarks from its predecessor in interest, Skype Technologies S.A.

The Complainant and its affiliated entities have also developed their presence on the Internet, and are the owners of numerous domain names, consisting of the mark SKYPE. For example: <skype.com>, <skype.net>, <skype.org>, <skype.biz>, <skype.co.il> and many more.

The Complainant and its affiliated entities have been using the SKYPE mark in commerce since the year 2003.

The disputed domain name currently resolves to an active website, which offers information (in Hebrew) and other services that are related to the Complainant and the Skype software.

5. Parties' Contentions

A. Complainant

The Complainant contends the following:

The Complainant argues that the SKYPE trademark is highly distinctive, as it is not a dictionary word. The Complainant contends that the public identifies the SKYPE trademarks with the Complainant's software.

The Complainant further argues that the disputed domain name is confusingly similar to the Complainant's trademark, as it wholly incorporates, as a dominant element, the Complainant's registered trademark, with the addition of a geographical identifier and the TLD ".co.il" that are insufficient to avoid confusing similarity between the Complainant's trademark and the disputed domain name.

The Complainant further argues that the aside from the Complainant's SKYPE trademark, the Respondent also includes in the website under the disputed domain name the different logo trademarks, that are owned by the Complainant.

The Complainant further argues that the SKYPE trademark achieved the status of a well-known trademark throughout the world, due to the extensive advertising by the Complainant.

The Complainant further argues that the Complainant's and its affiliated entities goodwill in the SKYPE trademark was asserted by many administrative panels around the world, including an ISOC Panel in 2007.

The Complainant further argues that the Respondent has no rights or legitimate interests in the disputed domain name, as the Respondent is not known by "Skype".

The Complainant further argue that it did not license, sold, transferred or in any way authorize the Respondent to use the SKYPE trademark. The Complainant claims that the Respondent is trying to portray himself as the Complainant's representative in Israel by setting "Skype" related pages on different social networks.

The Complainant further argues that the Respondent was aware of the Complainant when registering the disputed domain name, and that the disputed domain name was registered to divert Internet traffic from the Complainant's website for commercial gain.

The Complainant contends that the Respondent registered the disputed domain name in bad faith. The Complainant supports this claim with the facts that the disputed domain name is confusingly similar to the Complainant's trademark and due to the fact that the Respondent incorporates the Complainant's logo's in the website under the disputed domain name.

The Complainant further argues that it sent the Respondent two cease and desist letters. According to the Complainant, the Respondent did not respond to these letters.

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

B. Respondent

The Respondent did not reply to the Complainants contentions.

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 Domain The Net Technologies Ltd. registration agreement provides that the applicant for the domain name accepts the ISOC-IL registration rules (see http://www.domainthenet.com/he/מתהם_שם_רישום_הסכם.aspx). The ISOC-IL

registration rules provide that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See section 24.4). 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) 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.

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.

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 Complainant is the owner of many trademark registrations, which consist of the mark SKYPE, around the world. For example: United States trademark registration No. 3005039 – SKYPE, with the registration date of October 4, 2005; Israeli trademark registration No. 170106 – SKYPE, with the registration date of March 6, 2005; Community trademark registration No. 005903786 –SKYPE, with the registration date of April 11, 2008, and many more.

The disputed domain name comprises of the word "skype" with the Addition of the word "Israel" and the suffix .co.il. The suffix .co.il is ignored for the purpose of determination of the similarity between the disputed domain name 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 addition of the word "Israel" does not serve sufficiently to distinguish or differentiate the disputed domain name from the Complainant's SKYPE trademark, as it is a descriptive element that refers to a geographical location in which the Complainant markets its products.

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" (Britannia Building Society v. Britannia Fraud Prevention, WIPO Case No. D2001-0505).

Also, "The Panel has compared the domain name at issue with the Complainant's trademarks INFOSPACE in their entirety, and concludes that the mere addition of the word "India" at the front of the Respondent's domain name is not sufficient to distinguish it from the trademarks of the Complainant. The Panel notes that such addition appears to be made most likely with a[n] intent to induce Internet users to believe that they are connecting their computers with a site pertaining to an Indian affiliate of the Complainant, or to some kind of "Indian operation" of the Complainant (InfoSpace.com, Inc. v. Hari Prakash, WIPO Case No. D2000-0076).

It is therefore the finding of the Panel that the disputed domain name is confusingly similar 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 SKYPE trademark, and that the Respondent has no rights in the SKYPE trademark.

The Complainant showed sufficient evidence showing it has rights in the SKYPE trademark. Furthermore, the complainant's well established rights in its trademark were asserted by many Administrative Panels, in different countries (See, inter alia: Skype Limited v. Marcello Sacramento, ADR Case No. FA0607000747948; Skype Technologies, S.A. v. Vault Technology, Ltd, DRS Case No. D00002685).

There is no doubt that the Complainant's SKYPE trademark has gained significant goodwill.

It is also up to the Complainant to show that the Respondent has no rights in the Name. Complainant has provided that it has not approved for the Respondent to use its trademark or Name.

While the Complainant bears the "general burden of proof" under Rule 3.3, this burden shifts to the Respondent once 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 the present case, the Complainant alleged that the Respondent has no rights or legitimate interests in respect of the disputed domain name and the Respondent failed to assert any such rights, or legitimate interests.

The Panel finds that the Complainant established such a prima facie case inter alia due to the fact that the Complainant has not licensed or otherwise permitted the Respondent to use its SKYPE trademark or a variation of it. The Respondent did not submit a response and did not provide any evidence to show any rights or legitimate interests in the disputed domain name. Thus, the Respondent did not rebut the Complainant's prima facie case.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

C. 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.

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 disputed domain name is confusingly similar to the Complainant's trademark. 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, prior 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).

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.

The website under the disputed domain name incorporates the Complainant's SKYPE trademarks and logos and offers information (in Hebrew) and various services regarding the Complainant and its products. Furthermore, the design of the website under the disputed domain name is very similar to the Complainant's official <skype.com> website.

These facts, along with the fact that the website under the disputed domain name incorporates advertisements and an online shopping cart, proves that the Respondent is attempting to confuse internet users as to the source of the disputed domain name for commercial gain. This conclusion is also supported by the fact that the Respondent is promoting the disputed domain name by various social networks.

It is also suggestive of the Respondent's bad faith when the trademark of the Complainant was registered before the allocation of the disputed domain name (See: Sanofi-Aventis v. Abigail Wallace, WIPO Case No. D2009-0735). The Complainant's SKYPE trademark is registered in Israel since the year 2000 and is well-known worldwide. The Respondent registered the disputed domain name after the Complainant registered its SKYPE trademark.

In addition, the Panel notes that the Respondent failed to reply to the Complainant's cease and desist letters. Under the present circumstances, this constitutes additional evidence of the Respondent's bad faith (Alstom v. Stockmarket Domain, WIPO Case No. D2008-1542).

These facts are sufficient to establish that the Respondent had registered the disputed domain name in bad faith, as provided in Rule 4.1(b) and 4.1(d) thus, it is the finding of the Panel that the Complainants 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, <skypeisrael.co.il> be transferred to the Complainants.



Jonathan Agmon
Sole Panelist

Date: June 27, 2011