

ADVISORY COMMITTEE PANEL

For the Internet Society of Israel

Brian Negin, Chair

Prof. Danny Dolev

Prof. Moshe Barniv

## In the matter between

Mr. Eran Inbar (“the Petitioner”)

vs.

Mr. Ohayon Israel (“the Respondent”)

## Regarding the domain name

utopia.co.il (“the Domain Name”)

### DECISION

#### Procedure

This panel was established on September 2 in accordance with Section E. of the “Rules for the Allocation of Domain Names under the .il (Israel) Top Level Domain” (“the Rules”) of December 1998 (available at <http://www.isoc.org.il/domains/il-domain-rules.html>) to address Petitioner’s request to transfer the Domain Name from the Respondent to himself. On September 3, the Panel informed the Petitioner of the creation of the panel and asked for further details regarding his request. These details were not provided. On September 10, the panel sent the request to the Respondent for his response, which was given as requested on September 22. On September 25, the panel sent the Respondent’s response to the Petitioner, allowing him until October 6 to address the Respondent’s response. The Petitioner did not submit a response. However, the panel requested that the Respondent provide further clarification of his response by October 27. This he did, and the panel therefore closed the proceedings on October 28, 2002.

## **The Petitioner's Claim**

The Petitioner states that he established a business by the name of "Utopia" ("the Business") in 1995, and ever since has been conducting business under that name. In addition, he claims that the business has been using the trademark "Utopia" since 1995. In support of this trademark assertion, the Petitioner attached a document to his request purporting to be proof of trademark registration. However, the attached document was found to be only a copy of a VAT certificate, stating that the Petitioner is doing business in accordance with the VAT laws under the business name "Utopia."

In light of the nature of the attached document, the panel requested, in accordance with Rule 20.6 of the Rules, that the Petitioner provide documentation in support of his trademark assertion. He did not do so.

The Petitioner further states that the Respondent registered the Domain Name on August 30, 1999 and that the Business "has not provided any authorization .... to make use of the utopia trademark."

In addition, the Petitioner states that the Respondent has been making no commercial use of the Domain Name for over three years, and that the Respondent has no business in the name of "Utopia."

The Petitioner also states that the Respondent knew, or should have known that the Business had the trademark in the name "Utopia".

And finally, the Petitioner states that the Respondent is acting against the Commercial Tort Law, 5759-1999 by unreasonably making it difficult for customers, employees or others to access the Business via the Internet through a domain name based on the Business's name and trademark.(ie- "Utopia").

## **The Respondent's Response**

The Respondent points out that the Petitioner has provided no proof that the Business owns a trademark in the name "Utopia," and that the only "proof" provided by the Petitioner shows that the Petitioner is doing business in connection with the VAT authorities using the name "Utopia."

The Respondent admits that ISOC-IL allocated to him the Domain Name in August, 1999, when the Respondent was founding the company "Utopia Editorial Ltd." ("the Company"). The Respondent attached to his response a copy of a certificate of incorporation of the Company in accordance with the laws of the State of Israel, showing that the Company was registered on March 26, 2000.

The Respondent further states that the Company is a reputable business engaged in the business of film editing and advertising, that it is well known in the Israeli and USA commercial and advertising arena, and that it provides services to numerous large corporations within Israel. In addition, the Respondent states that he has been using the name "Utopia" in the advertising business for the past 25 years.

And finally, the Respondent states that he operates and maintains a web site using the Domain Name as a tool for customer professional workflow, and that a password or exact URL is required to access the sub-pages of the site, making most of the site unavailable to the public.

We gave the Petitioner an opportunity to reply to the above response, but he chose not to do so.

### **Clarifications to the Respondent's Response**

Though the Petitioner did not reply to the Respondent's response, certain matters regarding the Respondent's response required clarification and additional documentation, which we requested in accordance with Rule 20.6 of the Rules, as set out below.

The first of these issues was the connection between the Company and the website. The registered holder of the domain name, [utopia.co.il](http://www.utopia.co.il), is the Respondent, Mr. Ohayon, as a private individual, and not the company Utopia Editorial (Post Production) Ltd.. We therefore requested that the Respondent provide us with information establishing the connection between the website at <http://www.utopia.co.il> and the company Utopia Editorial (Post Production) Ltd..

Second, we asked for a copy of a valid VAT certificate for the company Utopia Editorial (Post Production) Ltd., just as the Petitioner provided such a certificate for his business, to ascertain that the Company was indeed actively carrying on business.

And third, we noted that in the Respondent's response, he stated: "... that a password or exact **url** is required in order to access the sub-pages of the site, therefore, most of the site is not available to the public." However, in visiting the home page (at <http://www.utopia.co.il>), no point of access to a password demand or to any sub-page was apparent. The only identifying element on the home page was the name "Utopia" without reference to the name of the company (Utopia Editorial (Post Production) Ltd.) or to what lies beyond the home page. We therefore requested that the Respondent provide information enabling access to the site beyond the home page, so that we could directly ascertain its

nature.

The Respondent responded that he is the major shareholder of the Company, a fact we verified in the Register of Companies of Israel. The Respondent reiterated that the website is an active site, used solely in connection with the Company's commercial activities. He sent us a VAT certificate for the Company that was issued on August 26, 2002, corroborating that the Company is indeed actively carrying on business. As regards access to the site, he stated that the sub-pages of the site contain work-in-progress, which is primarily confidential information and trade secrets of the Company and its customers, and therefore he prefers not to disclose its content at this time. And finally, he noted that reference to the Company has been added to the home page, a fact we were able to verify by visiting the site.

#### Decision

Based on the above, we find that the Petitioner has failed to establish a factual basis on which to support his claim. The Petitioner has not proven that he has a trademark in the name "Utopia," though he has a business under that name. The Respondent, too, has no trademark in the name "Utopia," but he was first to request and receive allocation of the Domain name ("first come, first served" principle embodied in Rule 3 of the Rules). The Respondent has also proven, prima facie, that he is using the Domain Name to carry on the legitimate business of the Company, at least since August 2002 (if not earlier), when the VAT certificate was issued, where the Domain Name and the Company name are substantially similar.

The Petitioner has failed to establish that the Respondent has acted in bad faith in registering and using the Domain Name, and therefore he is not entitled to have the Domain Name transferred to him based on bad faith registration and use of a domain name (see the ACP decisions in [waltdisney.co.il](http://www.waltdisney.co.il) and [habitat.co.il](http://www.habitat.co.il), at <http://www.isoc.org.il/domains/acp.html>, establishing "good faith" as the underlying test for assessing the rights of parties in domain name disputes).

The Petitioner has also failed to establish that the Respondent is unreasonably preventing him from carrying out his business over the Internet in violation of Article 3 of the Commercial Tort Law, 5759-1999, and therefore is not entitled to have the domain name transferred to him based on that law.

Therefore, we deny the Petitioner's request. The Domain Name shall remain allocated to the Respondent.

Date: November 4, 2002

Brian Negin, Chair

Prof. Danny Dolev

Prof. Moshe Barniv

