

DISPUTE RESOLUTION PANEL
FOR THE INTERNET SOCIETY OF ISRAEL

Dr. Yuval Karniel

In the matter between

Pfizer Inc., Pfizer Products Inc. and Pfizer Pharmaceuticals Israel Ltd.

Represented by Adv. Eitan Shaulsky and/or Advocate and Patent Attorney Stanford T. Colb and/or Advocate and Patent Attorney Daniel Kliger and/or Advocate Sarah Colb and/or Advocate Inbal Navot- Eisenthal

(the "**Petitioner**")

and

Mr. Yaniv Karakukly

(the "**Respondent**")

Regarding the domain name

<**viagra.org.il**>

(the "**Domain Name**")

DECISION

1. Procedural background

On January 27 2008, the Petitioner filed a petition to the Israeli Dispute Resolution Panel of the ISOC-IL ("IL DRP") in accordance with the provisions of Rule 19.3 of the Rules for the Allocation of Domain Names under the il Top Level Domain (December 1998, as amended 2000) (hereinafter: the "**Rules**") requesting Advisory Committee Panelist to transfer to the Petitioner the registration of the domain name Viagra.org.il. (hereinafter: the "**Petition**" as applicable).

IL-DRP has appointed Dr. Yuval Karniel as a Panelist in the Petition (the "Panelist"). Pursuant to the appointment of the Panelist, a notice was delivered to the Respondent on 4th March, 2008 by e-mail, requesting the Respondent to provide a full and complete

response to the statements and allegations made in the Petition. After receiving no response from the Respondent, another notice was sent to the Respondent by fax. Once more, Respondent failed to respond Petitioner's arguments.

2. Arguments by the Parties

2.1. Arguments by Petitioner

2.1.1 The Petitioner has alleged the following salient facts in support of the Request:

1. The Petitioner is the owner of the Viagra trademark (The : "**Trademark**") in Israel. The Trademark is registered in Israel in the name of the Petitioner.
2. The Trademark is well known through Israel and the world, and the Petitioner has accumulated goodwill in the Trademark.
3. The Petitioner owns many websites to advertise its activities, sells its products and bring information to the public.
4. The petitioner invested extensive effort and resources in the trademark and in bringing the trademark to the attention of the public.
5. On June 17, 2007, the Domain Name was allocated to the Respondent.
6. The Respondent Operated a website on the Domain Name on which he offered tablets called Viagra for sale.
7. After the Petitioner had sent a letter to the Respondent in which it demanded that the Respondent assign the Domain Name to Pfizer, the following occurrences took place:
 - (a) the web site was blocked,
 - (b) a URL automatic redirection to a website at www.vra.co.il appeared in the web site,
 - (c) the administrative contact details of the Domain Name were changed to fictitious details.

2.1.2 Petitioners' Claims:

1. The Respondent is infringing the Petitioner s' registered Trademark and harming the Petitioner's right to exclusive use of its Trademark, as set forth in the Trademark Ordinance.
2. Respondent is committing a tort of passing off by misleading the public and causing it to believe that there is some connection between the Respondent, the Domain Name and the Petitioners.
3. By luring browsers, the Respondent is misleading the public regarding the origin of the website, the entities which it is connected to and the products which it offers for sale.
4. Respondent is committing the tort of unfair intervention, by preventing the Petitioners from exploiting their rights in the trademark.
5. Respondent is being unjustly enriched at the expense of the Petitioners and is gaining profit without any legal right. The Respondent acted in bad faith by registering the Domain Name.

6. Respondent is misappropriating, diluting and harming the Petitioners' goodwill in the Trademark.
7. The registration of the Domain Name in the name of the Respondent should be cancelled and registered in the name of the Petitioners. In addition, the Respondent is requested to pay the costs of the proceedings.

2.2 Arguments by Respondent

Respondent has failed to respond the Petitioner's arguments.

3. Opinion

The Panelist has taken the required steps to provide actual notice of the Complaint to the Respondent, in compliance with the Rules, and has asked the Respondent to provide a full and complete response to the statements and allegations made in the Complaint. However, the Respondent failed to respond the claims.

According to rule 17 (Ex- Parte Decisions), where one party refuses to respond or provide information or additional material to the Panelist, the Panelist may make its determination on the material provided by one party alone or on the material before it. In line with the Rules, the Panelist has to take his decision on the basis of the statements and documents submitted by the Petitioners that it deems applicable.

Therefore, after reviewing and assessing the claims and the evidences the Petitioners have supplied, the panelist accepts the allegations and claims set forth by Petitioner, as further detailed on the following grounds:

1. The following evidences and proofs were provided by the Petitioner:
 - (i) The Petitioner has submitted evidence of its registration of the mark VIAGRA in Israel.
 - (ii) The Petitioner has shown that he invested extensive resources in the development of the medicine and in increasing awareness of VIAGRA mark.
 - (iii) Therefore, The Petitioner is the owner of the VIAGRA trademark and good will in Israel
2. The IL DRP establishes an objective, four-part standard for good faith behavior for the setting of domain names. Based on this four-part test, the Petitioner must prove each of the following elements to support reassignment of a domain name:

(i) the Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the Petitioner; and

3.2. the Petitioner 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.

2.1. Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the complainant

The Domain Name registered by the Respondent is identical to the VIAGRA trademark of the Petitioners. The addition of the code "org.il", which is primarily intended for non-commercial entities, has no distinguishing capacity whatsoever in this context.

2.2 Petitioner has rights in the Name

As detailed above, the Petitioner provided evidence of its ownership of the VIAGRA trademark.

2.3 Respondent has no rights in the Name

The Respondent has not filed any response to support a claim that it has a legitimate right and interest under any grounds.

Since the Respondent has failed to respond to the Complaint, the Panelist may accept all reasonable allegations set forth by the Complainant as true and accurate

2.4. Application for allocation of the Domain Name was made or the Domain Name was used in bad faith

2.4.1. Once again, it is noted that the Respondent has failed to respond to the Complaint. Therefore, the Panelist may accept all reasonable allegations set forth by the Petitioner as true and accurate.

2.4.2. Section 4 of the IL DRP sets out a non-exhaustive list of circumstances which point to bad faith conduct by the Respondent. In the matter before us, it is clear that the Respondent behavior falls into section 4.1 (e) , stating as follows:

"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".

- 2.4.3. The Petitioner proved that the Respondent has registered the domain name primarily to attract internet user to buy the VIAGRA medicine in the Respondent site, by intentionally creating a likelihood of confusion with the Complainant's Name as to the source of this medicine.

There does not appear to be any other reasonable explanation for the Respondent's choice of the Domain Name in light of the Complainant's demonstrated prior rights in the Mark,

- 2.4.4. Moreover, the Petitioner's evidences of other behaviors of the Respondent which indicate that the Respondent registered the Domain Name and acted in bad faith: immediately after the Petitioners have sent a letter of claim to the Respondent, in which they asserted that the Respondent infringes their VIAGRA trademark, the Respondent Site was blocked and the website administrative contact details were changed to fictitious contact details. In addition the website content has been erased, except for an the automatic message which appeared, redirecting the Internet users to another website. Such other website, offers for sale a medicine named Viagra, with contains similar attributes to the VIAGRA medicine.

3. All of the above evidences indicate in myriad of ways that the Respondent exploited the rights of the Petitioners in the VIAGRA a bad faith manner. Accordingly, the Panelist is of the view that the Respondent has registered and used the Domain Name in bad faith

4. Decision

For all the foregoing reasons, the domain name VIAGRA.OR.IL shall be reassigned to the Petitioner in accordance with ISOC-IL's Rules and IL-DRP procedures.

The Petitioner shall bear all of the expenses of this dispute resolution.

Dr. Yuval Karniel

Dated: April 30th, 2008