

**IL-DRP PANEL
FOR THE INTERNET SOCIETY OF ISRAEL**

In the matter of the **Domain**
<caffemauro.co.il>

Between

Caffe Mauro S.p.A

From Reggio Di Calabria, 89018, Italy
Represented by their legal counsels
Dr. Shlomo Cohen & Co.
E-mail: cohens@shlomocohen.co.il

(The "Petitioner")

and

Alon Bilia

From 11 Tsafsa St,
Ramat Yishai, Israel
Email: alon@espresso-center.co.il

(The "Respondent" or "Holder")

DECISION

I. Procedure

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the Domain Name "Caffemauro.co.il" be reallocated to the Petitioner.
A Panelist was appointed in accordance with the Procedures for Alternative Dispute Resolution under the IL-DRP Rules, as were in effect at time of petition, in order to address the Petitioner's above request (<https://en.isoc.org/il-cctld/dispute-resolution-panels-2>) (hereinafter – "the Rules").
2. Notification of the pending Petition, and notification of appointment of the Panel under the Rules, was sent on March 21st, 2022 to the Respondent's email address as recorded in the ISOC Domain Name Registry. In accordance with section 9.3 of the Rules, the Respondent was allotted 15 days, to submit a Statement of Response or any other relevant information to the Panel. A reminder of said requirement was sent out on April 4th, 2022.
3. The Petitioner failed to provide any response.

II. Factual Background

1. The Complainant is an international producer and distributor of coffee and coffee related products, including an array of coffee products and blends, as well as other coffee accessories, under the CAFFE MAURO brand.
1. The Respondent is Mr. Alon Bilia, who is the owner of B.A. Kedma Coffee Ltd. ("Kedma Coffee") - an Israeli private company that imports and markets coffee products, coffee machines and other related goods.
2. The Respondent registered the Disputed Domain on October 22nd, 2019.

III. The Parties' Claims

A. The Petitioner

1. The Petitioner claims to be the leading producer of coffee and coffee related products, all under the well known brand of Caffe Mauro, which is known locally and internationally. Among other things, Complainant produces and distributes an array of quality coffee products and blends, as well as other coffee accessories, e.g. cups, glasses and barista tools and accessories, under the famous CAFFE MAURO Marks.
2. Complainant owns numerous registrations and applications in Israel and around the world for the CAFFE MAURO Marks in connection with its world-famous coffee products, commencing as early as 2006.
3. Petitioner claims to have been extensively advertising and marketing the Caffe Mauro brand for decades, and to be well recognized by consumers globally.
4. Petitioner claims to have discovered that the Respondent has registered and has been using the Disputed Domain. Therefore Complainant approached Respondent several times, and requested, among other things, the transfer of the Disputed Domain Name to Complainant. However, Respondent rejected Complainant's request, and offered that Complainant purchase the Disputed Domain Name from him.

B. The Respondent

1. The Respondent, Mr. Alon Bilia, failed to provide any response to this Petition.
2. In previous communication between the Parties, as provided by the Petitioner, Mr Bilia claims that his business Kedma Coffee has been selling Mauro Coffee products for years without any interruption, he does not believe he is acting unlawfully, and sees no reason to deviate from this practice.
3. Let it be noted that at the time the Petition was filed, the website served the Respondent for marketing its coffee products related to the disputed Name. Any purchase from said website was re-directed to Respondent's additional website, < <https://www.espresso-center.co.il/>>, where sales were conducted.

At the time of writing of this Decision, the website was no longer active and leads to a static landing page.

IV. Discussion

1. The IL-DRP is an alternative dispute resolution procedure intended to provide expedited resolution to disputes regarding the allocation of Domain Names, in accordance with the Rules for Allocation of Domain Names under the .IL country code. By registering a Domain, any Holder agrees to abide by these Rules.
2. Let it be emphasized that the Il-DRP proceedings are meant to be concise, specific, straight-forward cases, as an easily accessible alternative procedure.
3. Historically, the framework within which the Israeli Il-DRP rules were established, similar to the WIPO Uniform Domain Name Dispute Resolution Policy, was aimed at mitigating and preventing all instances of "cybersquatting", which according to ICANN is: "bad faith registration of another's trademark in a domain name."¹
4. As phrased in *WIPO Administrative Panel Crough and McNeil v. Stein, case no, D2005-1201* and applicable to the IL-DRP rationale as well:

"The Policy was adopted to deal as is with the problem of cybersquatting, the registration of domain names consisting of, including, or confusingly similar to marks belonging to another for the purpose of profiting from the goodwill associated with said marks."

5. In order for a case to be brought before an Il-DRP Panel, the Petitioner must show prima facie indications that certain grounds exist. The following must all be fulfilled:
 - a. 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
 - b. The Complainant has rights in the Name; and
 - c. The Holder has no rights in the Name; and
 - d. The application for allocation of the Domain Name was made or the Domain Name was used in bad faith.
6. Keeping all of the above in mind, the Panel will proceed to review existence of the grounds for the request, based on the Il-DRP guidelines.

a. Name is Same or Confusingly Similar to a Name of the Complainant

The first requirement in the Rules is that "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".

The Disputed Domains consists of the combined term "caffemauro" and of the suffix "co.il".

¹ <https://www.icann.org/resources/pages/cybersquatting-2013-05-03-en>

It has been previously ruled that the suffix "co.il" is to be disregarded for the purpose of determining similarity of a Domain to a Registered Mark, since it is a common suffix indicating that the domain is registered as a commercial Israeli website (see for example ISOC II-DRP case in the matter of <Crayola.co.il>).

Therefore the question of similarity applies directly to the term "CaffeMauro". This domain incorporates the complainants name and alleged mark, in its entirety.

As stated in the **WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition** (hereinafter **the WIPO Overview**), it has been ruled in the past that a Domain which includes in its entirety a Trademark of the Petitioner, may indicate an infringement of this right:

"Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element."

Hence the next question arises – is "CaffeMauro" a legal name or mark of the Petitioner.

As is further elaborated in the following section, the Petitioner is the owner of numerous trademarks consisting of the name "CaffeMauro", both locally and internationally, as well as the Domain www.caffemauro.com.

The Complainants first Trademarks were registered under the name as MAURO DEMETRIO S.p.A., which in itself is similar in part to the disputed Domain (in the non-descriptive name "MAURO"), while later trademarks were already registered in the current name of the Petitioner, **Caffe Mauro** which is identical to the main part of the disputed domain.

This information is sufficient in and of itself to indicate that the Name of the Petitioner is Confusingly Similar to the Disputed Domain.

b. Complainant has Rights in the Name

1. The second II-DRP rule requirement is that the Complainant provide prima facie proof that the Complainant has rights in the Name.
2. The Complainant provided substantial indications of its rights in the disputed name, as described below, all of which together constitute clear indications of the Petitioner's Rights in the Disputed Domain:
 - Petitioner owns multiple international trademarks of the name Caffe Mauro from as early as the year 2000, as well as the <caffemauro.com> Domain.
 - Caffe Mauro is registered as an Israeli Trademark from 2006 (It is noted that Holder name has changed over the years, but this has not been contested and therefore will be attributed to Petitioner).
 - Petitioner's mark and brand is well known locally and internationally, supported by extensive marketing, and distributed by an exclusive local distributor, thus making it a well known mark.

Thus, the Panel finds that the Petitioner has established elaborate claims to rights in the Disputed Domain, which have not been contended.

c. Respondent has no Rights in Name

Let it first be noted that the Respondent failed to respond to this Petition, and therefore did not raise the burden of establishing its rights in the disputed domain.

From the written correspondence between the Parties, as included in the Complaint, the Respondent agrees to be selling Caffe Mauro Products. Reliance upon its historic practice of selling Mauro coffee products does not create a prima facie case for the existence of rights in the name itself.

Let it also be noted that since the filing of the Complaint, the Domain has become inactive. In the submitted Correspondence between the parties, the Respondent states that in the event that the use of its logo, color scheme or the name “Mauro” may infringe on the petitioner’s rights, he will remove them from the web site. Shortly after the filing of this Petition, the Respondent removed all allegedly infringing content from the disputed domain. Such act may be an indication that the Respondent himself is aware of potentially infringing behavior on his behalf due to lack of rights in the Domain.

Therefore, in light of all the above, the Panel finds sufficient grounds to establish that the Holder has no rights in the name.

d. Registration or Use in Bad Faith

Section 4 of the Rules sets out various circumstances which, if present, constitute evidence of the allocation or use of a domain in bad faith.

This list is not exhaustive, but can be used as grounds for assessing Respondent behavior. Section 4.1 (5) states the following:

“5. 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.”

In this case, several acts on behalf of the respondent are indicative of bad faith:

- The Respondent registered the Domain in 2019, long after the Petitioner has registered its international domains, and has been actively marketing its products both internationally and locally. Given the extent of the Petitioner’s reputation, it is most likely that the Respondent was aware that in registering the Disputed Domains, he will be preventing the Petitioner from operating a site in a Domain which includes its long-standing Registered Mark, and any activity would undoubtedly mislead the public to associate the Domain with the Petitioner.

- In its Website, the Respondent used the name “Caffe Mauro Israel”, used copyright protected images taken from the Petitioners promotional materials without permission, and created a misleading misconception that the site is the formal representative of the Caffe Mauro Mark and Brand.
- Customers who were attracted to the respondents site due to its branding, colors or mention of “Caffe Mauro”, were then re-directed to the Respondents commercial site at <espresso-center.co.il> in order to complete their purchase. Such behavior indicates an attempt to mislead potential customers by creating confusion between the Disputed Domain based on its similarity with the Petitioner’s Marks, indicative of Bad Faith. As clearly state in the ISOC-IL Panel decision re <Mariott.co.il> : “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, previous 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*).”
- In his response to the Petitioner’s cease and desist letter, the Respondent claimed that he purchased the Domain under free market terms, and is willing to negotiate sale of said Domain as any common market commodity. Since the respondent seemed quite willing to part with the disputed domain, and since he conducts his actual commercial business from a completely different web site, this behavior hints the existence of “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”, as described in Section 4.1 of the Rules, indicating bad Faith registration.
- The Petitioner failed to reply to this Petition or to the reminder thereof. Such behavior tends to tip the scale in favor of the existence of bad faith on behalf of the Holder, as mentioned by previous Panels as well (For example in the case of *Marriot vs. Barak Gill re. <מריוט.co.il>* (“*This Panel concurs with such reasoning and finds that Respondent's inaction shows lack of legitimate interest in the disputed domain name and lack of good faith in the registration or use thereof (See Carrefour and Carrefour Property v. MIC Domain Management, WIPO Case No. 02009-0489)*”).

In light of all of the above, the Panels finds that Respondent acted in bad Faith in registration and holding of the Disputed Domain.

V. Decision

In light of all of the above, Panel finds that the Disputed Domain is the same and identical to many Well Known and Registered Marks of the Petitioner, the Petitioner has established

substantial circumstances supporting its rights to the Disputed Domain, the Respondent presented no rights in the Domain, and the Respondent has acted in bad faith in registering and in holding the Domain.

Therefore, the Panel concludes, in accordance with the Rules, that the **Disputed Domain shall be re-assigned to the Petitioner**, within 30 days of the date of this decision.

Leehee Feldman, Adv.
Sole Panelist

Date: May 9th, 2022