

Keshet Broadcasting Ltd v. Sahaf Kadosh

IL-DRP Panel Decision

1. The Parties

The Complainant is Keshet Broadcasting Ltd (C.N. 511786352), 12 Raul Wallenberg St., Tel Aviv, Israel, represented by Pearl Cohen Zedek Latzer Baratz.

The Respondent is Sahaf Kadosh 2 Havered St., Rishon Letzion, 75505, Israel.

2. The Domain Name and Registrar

The disputed domain name <www.mako12.co.il> (hereinafter: “**the Disputed Domain Name**”) is registered with Mr. Sahaf Kadosh.

3. Procedural History

The Complaint was filed with ISOC-IL on July 15th, 2019. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL (“**IL-DRP**”) under the IL-DRP Rules (“**Rules**”).

On July 16th, 2019 the IL-DRP appointed Naomi Assia as sole panelist (“**Panelist**”).

In accordance with the Rules, on July 16th, 2019, the Panelist transmitted to the Respondent a copy of the Complaint by e-mail and attached materials. On July 30th, 2019 the Respondent requested an extension to submit his Response, which was granted by the Panelist. The Response was submitted on August 16th, 2019.

4. Factual Background

The Disputed Domain Name <www.mako12.co.il> was assigned to the Respondent on April 27th, 2017.

The Complainant, Keshet Broadcasting Ltd., is the owner of a broadcasting company located in Tel Aviv, Israel, which provides broadcasting services, production and distribution services of multimedia content.

The Complainant has been operating under the name MAKO since 2008.

The Complainant owns the domain name <mako.co.il>.

The Complainant is the owner of the domain name <mako.co.il>. The Complainant owns several IL trademark registrations, among them no. 200059 for “MAKO – מִקּוֹ” (hereinafter: the “MAKO Mark”) and no. 298452 for  (“KESHET12”). Yet, neither the Complainant nor the Respondent owns a trademark registration for “MAKO12”.

The Disputed Domain name <mako12.co.il> is currently inactive and empty of content.

5. Parties' Contentions

A. Complainant

The Complainant argues that the Disputed Domain Name is similar to the Complainant's MAKO Mark as they both share the word “MAKO”.

The Complainant argues that the use of the Domain by the Respondent is clearly misleading and in violation of the Complainant's Intellectual Property rights, as MAKO is a registered trademark by the Complainant.

The Complainant further argues that the Disputed Domain Name was registered and is being used in bad faith. The only reason the Respondent registered the Disputed Domain Name was for purposes of commercial gain, seeing that the domain is empty of content.

The Complainant also argues that the registration by the Respondent of the Disputed Domain Name which includes both the word “MAKO” and the number “12” is not coincidental, but rather a planned measure taken by the Respondent to disrupt the Complainant activities as the number “12” is the TV channel allocated to the Complainant.

B. Respondent

The Respondent argues that the Complainant approached him in order to purchase the Disputed Domain Name, however the negotiation was unsuccessful.

The Respondent indicated that he purchased the Disputed Domain Name on April 27th 2017, and renewed it on July 25th 2018.

The Respondent argues that the Disputed Domain Name was registered in good faith to serve as a platform for trading and/or for creating a social community network in the field of water sports.

The Respondent explained that he chose the name “MAKO12”, same as the name of a specific model of a pedal kayak, which he planned to import however these plans have not yet implemented.

The Respondent elaborated on his family members’ background in water sports, himself included.

The Respondent argues that he has legitimate rights in the combination “MAKO12” as this term is not a registered trademark of the Complainant. Further, the Respondent stated that he registered the Disputed Domain Name long after the Complainant filed for the trademark “KESHET12” (September 24, 2017) and therefore this Complaint was filed in bad faith.

The Respondent further argues that the Complainant is a financially well-established company that could have applied for a trademark registration for “MAKO12” if believed it has rights therein.

The Respondent argues that the Complainant does not use the term “MAKO12” in its publications.

The Respondent further argues that the attempt of the Complainant to purchase the Disputed Domain Name constitutes bad faith.

The Respondent’s intent was for use of the Disputed Domain Name in the field of water sports, which is different from the Complainant’s broadcasting business. There is no evidence of an attempted sale of the disputed domain name to the Complainant; Moreover, there is no evidence of an attempt to disrupt the Complainant’s business.

The Respondent lastly argues that he does not infringe the Complainant trademark rights as his use of the Disputed Domain Name does not mislead Internet consumer to his website, where competing products and/or services are offered. In this context, the Respondent cited *decision no 76629/12 Swissa et al. vs. TOMMY HILFIGER LICENSING LLC et al.* The Panelist would like to indicate that this decision addresses parallel imports issues and has no relevance to this case.

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 with Gorni Interactive Ltd. registration agreement provides that the applicant for the domain name accepts the ISOC-IL registration rules.

The ISOC-IL registration rules provide that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See section 12.3). 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.

Paragraph 3 of the IL-DRP Rules provides 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.

The requirements of Rule 3 of the IL-DRP are conjunctive. A consequence of this is that failure on the part of a complainant to demonstrate one element of the Rule 3 will result in failure of the complaint in its entirety.

A. Name is Same or Confusingly Similar

The Complainant is required 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 an Israeli trademark application no. 200059 for a block-letters mark MAKO in classes 9, 38, and 41 as well as trade mark application no. 298452, KESHET12 and device in classes 9, 38, and 41. The MAKO mark was filed on May 7th 2007, while, no. 298452 KESHET 12 filed on September 24th 2017.

The Disputed Domain Name <mako12.co.il> comprises of the term "mako," the number "12" and the suffix ".co.il". It is well established that (in this case ".co.il") serves no purpose other than a purely technical one, it may be disregarded for the purpose of determining whether the Disputed Domain Name is identical or confusingly similar. This issue was considered for example in *Allianz SE v. IP Legal, Allianz Bank Limited, WIPO Case No. D2017-0287*; *Arthur Guinness Son & Co. (Dublin) Limited v. Dejan Macesic, WIPO Case No. D2000-1698*; and *America Online, Inc. v. Johuathan Investments, Inc., and AOLNEWS.COM, WIPO Case No. D2001-0918, etc.*

Further, the term "mako" is identical to the MAKO mark registered in 2008 by the Complainant. Numbers in general do not entitle to a trademark protection, thus the additional number "12" is a merely descriptive element and, in the Panelist's view, may also be disregarded for purposes of assessing confusing similarity. The addition of any number, for that matter, to the word "mako" in the Disputed Domain Name, has minimal impact on what the viewer focuses on, namely, the word "mako" (*see Nintendo of America Inc v. Marco Beijen, Beijen*

Consulting, Pokemon Fan Clubs Org., and Pokemon Fans Unite, WIPO Case No. D2001-1070).

According to paragraph 1.8 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0 Edition*, the consensus view is that:

*“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.”* (Emphasis added – NA).

Moreover, the Complainant owns a trademark registration “KESHET12” which includes the number “12”; the Complainant is also broadcasting under TV Channel 12 and despite of the fact that he is not using the term “MAKO12” as a whole, the connection between the term “mako” and the number “12” is inevitable.

On this basis, the Disputed Domain Name is confusingly similar to the MAKO mark belonging to the Complainant as it shares the word “mako”.

B. Rights or Legitimate Interests

The Complainant is required to show that it has rights in the term “mako12” and that the Respondent has no rights in the name.

Given the conclusion that the Disputed Domain Name is confusingly similar to the MAKO mark, the Panelist determines that the Complainant has made a prima facie case that the Respondent has no rights or legitimate interests in the Disputed Domain name. Thus, the onus is on the Respondent to come forward with tangible evidence that it possesses such rights or interests (*see, Ustream.TV, Inc. v. Vertical Axis, Inc, WIPO Case No. D2008-0598*).

According to paragraph 2.1 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0 Edition*, the consensus view is that:

“where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name.”

The Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name by showing any of the following circumstances, in particular but without limitation (*see* paragraph 2.1 of the *WIPO Overview*):

“(i)...the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or

(ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or

(iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

In this case, the Respondent has argued neither that it has been commonly known as the Disputed Domain Name nor that it is using the Disputed Domain Name for legitimate non-commercial or fair use purposes. Instead, the Respondent asserts that it has registered the Disputed Domain Name as part of its preparations to provide an online platform for selling kayaks and the like by means of parallel imports, and to provide information services and/or social community network services, all in the field of water sports, which is the hobby of the Respondent.

As evidence to support this assertion, the Respondent has furnished the Panelist with a screenshot from an Internet website of a kayak called “mako12”. Obviously, this is very poor evidence of the preparation necessary to start a business. The Respondent holds the Disputed Domain Name for over two years now, during which the Respondent did not make a single thing in order to start his business, such as communicating with the kayaks’ manufacturer, building an active website, financial projections, etc. Instead, during all this time, the Disputed Domain Name remained empty of content. It can therefore be concluded that the Respondent has failed to present evidence of demonstrable preparations to use the Disputed Domain Name in a bona fide offering of goods or services in connection with the intended business, what so ever (*see Sybase, Inc. v. Analytical Systems, WIPO Case No. D2004-0360; Andrey Ternovskiy dba Chatroulette v. Quan Wen Jun, WIPO Case No. D2017-1553*).

In view of the above, the Panelist indicates that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

D. Registration 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.

According to paragraph 3.1 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0 Edition*, the consensus view in this issue is that 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:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name 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 the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered 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 the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the respondent's website or location.

As noted above, the Complainant argues that the Respondent acted in bad faith because the Respondent's use of the Disputed Domain Name was made only for commercial gain of the MAKO Mark, seeing that the domain is and was empty of content. The Disputed Domain Name, according to the Complainant was meant only for the purpose of selling for valuable consideration in excess of the Respondents out-of-pockets cost directly related to domain registration.

In the opinion of the Panelist, the pleadings of both parties are lack of significant arguments and the Panelist finds no reason to raise them for the Parties. Yet, the Panelist cannot ignore the fact that the MAKO Mark is considered to be a well-known mark in Israel.

The Complainant is continuously using the MAKO Mark as from 2008. Typically, evidence should be presented in order to determine whether a mark is a well-known mark, however in this case evidence are accessible on a daily basis to all, including the Panelist.

According to paragraph 4.8 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0 Edition*, the consensus view is that:

"In some circumstances, a panel may also rely on personal knowledge (e.g., to take "judicial notice" of the reputation of a well-known mark, or a corporate affiliation/structure)". (Emphasis added – NA).

In the absence of any evidence to the contrary, knowledge of the Complainant's rights in the Complainant's well-known mark MAKO, may be imputed to the Respondent at the time of registration of the disputed domain name.

Relevant reference can be observed in *Skype Limited v. Benjamin Decraene, WIPO Case No. D2005-01112*, in which the Panel held that:

"There are, however, certain situations when a respondent is clearly aware of a complainant, and it is clear that the aim of the registration was to take advantage of the confusion between the domain name and any of the complainant's potential rights. In these cases, bad faith can be found. This could occur when a respondent is aware of a complainant's potential rights and registers the domain name to take advantage of any rights that may arise from a complainant's enterprises."

Even though the Complainant does not own a trademark registration for the combination MAKO12, but owns trademark registration for MAKO, the Respondent nonetheless should have been aware of the Complainant and its rights in this term MAKO12 as well, especially in view of the fact that the Complainant is operating under TV channel 12. A simple Internet search for MAKO12 have yielded many obvious references to the Complainant and its website.

Yet, the Respondent managed to demonstrate a relation with the Disputed Domain Name by presenting an information sheet about a specific model of a kayak called “mako12”, however this relation is questionable for the following reasons:

(i) said information sheet does not bear any date (apart from the printing date) showing that this particular model of the kayak was indeed existed at the time of registration of the Disputed Domain Name; and

(ii) the Panelist must wonder why choosing a name of a particular model of a kayak, that would be obviously replaced by an improved model with a different name, such as “mako14”. The former model of the kayak at issue was called “mako10”. Previous models, if were, are no longer available for purchase in the manufacturer’s website. Hypothetically, a reasonable respondent that plans to sell smart phones, would not choose a domain name such as <iphone6.co.il> as it does not make any sense. Same logic applies to this case; and

(iii) lastly, if the Respondent genuinely planned to start its business, he would have not considered the Complainant’s offer to sell him the Disputed Domain Name.

The Respondent condensed that the website is currently empty and there is no evidence of an attempt to disrupt the Complainant’s business.

In this context, paragraph 3.3 of the *WIPO Overview of WIPO Panel Views on Selected UDRP Questions, 3.0 Edition*, states that:

“non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding”

The Respondent failed to present evidence that show a justified reason why he has not started with the required preparation for use the in a bona fide offering of goods or services in connection with his business.

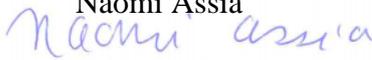
To summarize - the Disputed Domain Name is confusingly similar to a highly distinctive and famous mark in Israel, remained empty of content for a long period

of time, the Respondent failed neither to demonstrate evidence of preparations to use the Disputed Domain Name nor present any evidence of one or more justified reasons for the delayed use of the Domain, the Respondent's negotiation for the purpose of selling the Domain - therefore the Panelist views with a degree of scepticism that the Disputed Domain Name was merely registered for legitimate purpose.

For these reasons, the Panelist finds that the Respondent's registration and use of the Disputed Domain Name is in bad faith.

7. **Decision**

For the foregoing reasons, the Panelist orders that the disputed domain name <www.mako12.co.il> be transferred to the Complainant.

Naomi Assia

Sole Panelist

September 15, 2019