

## **Barilla G. e R. Fratelli S.p.A. v. Zion Daya Salaes and Marketing Ltd.**

### **IL-DRP Panel Decision**

#### **1. The Parties**

The Complainant is Barilla G. e R. Fratelli S.p.A., of Parma, Italy, represented by Mr. Luca Barbero, Italy.

The Respondent is Zion Daya Salaes and Marketing Ltd., of Holon, Israel.

#### **2. The Domain Name and Registrar**

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

#### **3. Procedural History**

The Complaint was filed with ISOC-IL on September 14, 2012. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On November 6, 2012 the IL-DRP appointed Jonathan Agmon as the sole panelist.

In accordance with the Rules, on November 7, 2012, the Panel transmitted to the Respondent by e-mail a copy of the Complaint and attached materials, providing the Respondent 15 days to respond to the Complaint.

On November 13, 2012, the Respondent sent an email correspondence to the Complainant, indicating that the Respondent wishes to foreclose the proceeding. On November 14, 2012, the Complainant replied to the Respondent and suggested the Respondent to notify the Panel that the Respondent is willing to transfer the disputed domain name to the Complainant.

On November 15, 2012, the Respondent submitted to the Panel a request to transfer the disputed domain name to the Complainant and bring the IL-DRP proceeding to an end.

#### 4. Factual Background

The disputed domain name was created on August 16, 2010.

The Complainant is an Italian company that was founded in the year 1877 and engages in producing and marketing Italian food.

The Complainant is the owner of numerous trademark registrations for the mark BARILLA worldwide. For example: Israeli trademark registration No. 65255 – BARILLA (logo), with the registration date of September 12, 1991; International trademark registration No. 349555 – BARILLA (logo), with the registration date of September 26, 1968; International trademark registration No. 675652 - BARILLA, with the registration date of June 20, 1997; International trademark registration No. 815202 – BARILLA (logo), with the registration date of August 7, 2003, and many others.

The Complainant also developed its presence on the internet and is the owner of multiple domain names, consisting of the mark BARILLA. For example: <barilla.com>, <barilla.info>, <barilla.eu>, <barilla.mobi> and many others.

The disputed domain name currently resolves to an inactive website, which displays sponsored links.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant argues that the disputed domain name is identical to its registered BARILLA trademark.

The Complainant further argues that the Complainant's BARILLA mark had become a well known mark throughout the world due to the Complainant's promotional investments.

The Complainant further argues that the sponsored links that are published on the website under the disputed domain name contain specific references to the Complainant's BARILLA mark.

The Complainant further argues that it contacted the Respondent, through an agent, and offered an amount of 150 Euros for the transfer of the disputed domain name. The

Complainant contends that the offer was declined by the Respondent, who indicated that it was too low.

The Complainant further argues that it sent, through its representatives, a cease and desist letter, which instructed the Respondent to refrain from using the disputed domain name and transfer it to the Complainant. The Complainant contends that the Respondent replied to the cease and desist letter and claimed that the Respondent does not intend to transfer the disputed domain name for free and requested 5000 Euros for the transfer of the disputed domain name. The Complainant further contends that the Respondent subsequently requested 2000 Euros for the transfer of the disputed domain name.

The Complainant further argues that the Respondent did not make any preparation to use the disputed domain name in connection with a *bona fide* offering of goods or services.

The Complainant further argues that the Respondent acts in bad faith, trying to attract for commercial gain Internet users by creating a likelihood of confusion with the Complainant's BARILLA trademark as to the source, sponsorship, affiliation or endorsement of its website.

The Complainant further argues that it did not license, sold, transferred or in any way authorize the Respondent to use its BARILLA trademark.

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

## **B. Respondent**

The Respondent states in his Response that he has never used the disputed domain name and has no knowledge of the sponsored links that are displayed on the website under the disputed domain name.

The Respondent has further stated that he agrees to transfer the disputed domain name to the Complainant.

## **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 and agreed to this

process and Rules when he applied for and registered the disputed domain name through Domain The Net Technologies Ltd. registration agreement that provides that the applicant for the domain name accepts the ISOC-IL registration rules (see [http://www.domainthenet.com/he/domain\\_registration\\_agreement.aspx](http://www.domainthenet.com/he/domain_registration_agreement.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 like organizations interpreting the UDRP) can be used as examples of how previous panels have adopted and interpreted provisions similar to the Rules and UDRP.

As stated above, the Respondent had consented to the transfer of the disputed domain name to the Complainant. Previous WIPO and ISOC Panels stated that "A genuine unilateral consent to transfer by the Respondent provides a basis for an immediate order for transfer without consideration of the paragraph 4(a) elements. Where the Complainant has sought transfer of a disputed domain name, and the Respondent consents to transfer, then pursuant to paragraph 10 of the Rules the Panel can proceed immediately to make an order for transfer. This is clearly the most expeditious course (see Williams-Sonoma, Inc. v. EZ-Port, WIPO Case No. D2000-0207)." (See The Cartoon Network LP, LLLP v. Mike Morgan, WIPO Case No. D2005-1132; Wikimedia Foundation Inc. v. Adam Yohanan, IL-DRP Case, January 9, 2011).

Similarly, in our case, the Respondent's Consent to transfer the disputed domain name makes it unnecessary to proceed and examine whether the Complainant had sufficiently established the elements of section 3 of the Rules.

Although there may be some circumstances that would require considering the merits of the case (See, for example: Brownells, Inc. v. Texas International Property Associates, WIPO Case No. D2007-1211 and Messe Frankfurt GmbH v. Texas International Property Associates, WIPO Case No. D2008-0375), in the present case, the Panel does not find it necessary to address the merits of the Complaint. This finding is based on the Panel's impression that the Respondent's consent is genuine.

Accordingly, the Panel orders the transfer of the disputed domain name to the Complainant.

**7. Decision**

For all the foregoing reasons, in accordance with the Rules, the Panel orders that the domain name, <barilla.co.il> be transferred to the Complainant.



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Jonathan Agmon

Sole Panelist

Date: November 20, 2012.