

IL-DRP PANEL

FOR THE INTERNET SOCIETY OF ISRAEL

IN THE MATTER OF THE DOMAIN <GARYSHAFIR.CO.IL>

The Complainant: **Mr. Gary Shafir**
63 MAGEN DAVID
HERZLIYA, ISRAEL

Represented by Adv. Ariel Dubinsky and Tslil Paskay
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-V e r s u s-

The Respondent: **Mr Guy Snir**
8 Fishman Maimon
Tel Aviv 6741067
Israel
E-Mail: guysnir@gmail.com

Decision

1. The Parties

1. The Complainant is an architect licensed to practice in Israel. The Respondent is Mr. Guy Snir of Israel.

2. The Domain Name and Registrar

2. The disputed domain name <garyshafir.co.il> is registered with LiveDns Ltd..

3. Procedural History

3. The Complaint was filed with ISOC-IL on November 20, 2018. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("IL-DRP") under the IL-DRP Rules ("Rules").
4. On November 27, 2018, the IL-DRP appointed the undersigned as the sole panelist.
5. In accordance with the Rules, on November 28, 2018, 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.
6. The Respondent has not filed a response to the Complaint. The Respondent contacted ISOC-IL and contended that he was not involved in the registration of the disputed domain name (although no other contact details are registered as the disputed domain name holder). Accordingly, this decision is being given on an ex-parte basis, in accordance with section 17 of the Rules.
7. After reviewing the Complaint, and in accordance with section 13 of the Rules, the panel ordered the Complainant to submit additional information and supporting materials regarding the goodwill obtained by the Complainant in his name. On January 3, 2019, the Complainant complied with the Order, and submitted an affidavit and certain supporting material (hereinafter: "the Affidavit").

4. The Arguments Raised in the Complaint and subsequent Affidavit

8. The Complainant is an architect and interior designer, who has been working in this field since 1981. According to the Complainant's website www.garyshafir.com, the Complainant has been involved in numerous projects in Israel. According to the Complainant, he has acquired goodwill in his name, and has been using his name in the course of trade when providing architecture related services.
9. The disputed domain name garyshafir.co.il was owned by the Complainant for many years, but he mistakenly failed to renew it.
10. The website operated in the disputed domain name (hereinafter: "The Website") presents the Complainant's name in a dominant manner on top of various blog posts and links.
11. The Complainant sent a letter to the Domain Name Holder, as well as the technical person listed in the Domain Name registration details, demanding them, among others, to cease using the Domain Name and to transfer it to the Complainant. However, they have not responded.

6. Discussion and Findings

12. By registering the disputed Domain Name through LiveDns, the Respondent agreed to LiveDns' domain registration agreement, available at <https://domains.livedns.co.il/Terms.aspx>. This Agreement provides that the domain registrant agrees to the registration rules of ISOC-IL. The registration rules of ISOC-IL incorporate by reference the IL-DRP Rules. Accordingly, the Respondent has agreed to the applicability of the IL-DRP dispute resolution mechanism, and the Rules.
13. The Rules provide that disputes concerning 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 Domain Name was made or the Domain Name was used in bad faith".

Following below, we shall review the applicability of these criteria:

(A) Same or Confusingly Similar; and (B) Complainant Has Rights in the Name

14. The Complainant has to prove that 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.
15. The disputed domain name is <garyshafir.co.il> -- it comprises the Complainant's full name together with the suffix <.co.il>. Accordingly, there is no doubt that the disputed domain name is the same or confusingly similar to the Complainant's name.
16. The main issue in this matter is that the Complainant does not own a trademark registration covering his name. According to WIPO's WIPO Overview of WIPO Panel Views on Selected UDRP Questions (Third Edition), WIPO's position on this issue is as follows:

"Personal names that have been registered as trademarks would provide standing for a complainant to file a UDRP case. The UDRP does not explicitly provide standing for personal names which are not registered or otherwise protected as trademarks. In situations however where a personal name is being used as a trademark-like identifier in trade or commerce, the complainant may be able to establish unregistered or common law rights in that name for purposes of standing to file a UDRP case where the name in question is used in commerce as a distinctive identifier of the complainant's goods or services. Merely having a famous name (such as a businessperson

or cultural leader who has not demonstrated use of their personal name in a trademark/source-identifying sense), or making broad unsupported assertions regarding the use of such name in trade or commerce, would not likely demonstrate unregistered or common law rights for purposes of standing to file a UDRP complaint" (*WIPO Overview of WIPO Panel Views on Selected UDRP Questions* (Third Edition, 2017), section 1.5).

17. Accordingly, when the Complaint is based on unregistered rights, the burden lying on the Complainant is heavier than the standard burden, and the Complainant has to establish common law rights in his name, and that his name serves as a source identifier for the goods or services he provides. According to WIPO's case law, "Whether a person's name has acquired secondary meaning (and hence may claim protection as a common law trademark) requires a factual determination. Factors that a panel might consider include (a) whether the name is common (which reduces the possibility of acquiring secondary meaning) (b) whether the name was used in connection with goods or services in a commercial context; and (c) the time period over which the name was so used" (WIPO decision in *Adam Anshel v. Domains By Proxy, LLC / Tzvi Milshstein*, WIPO Case No. D2015-1570, <adamanshel.com> et al.).
18. Most WIPO cases dealing with this issue concern celebrities, well-known actors, etc. The Complainant in this matter does not enjoy such level of goodwill among the general public. Furthermore, the Complainant has not submitted substantial material to substantiate his goodwill. Nonetheless, according to the Complaint and the subsequent Affidavit, the Complainant has been working as an active architect since 1981 (for almost 40 years), has been involved in a large number of projects, and is currently involved in scores of pending construction projects. It is also evident that the Complainant has been commercially offering his services under his name – Gary Shafir – all these years. Furthermore, the Complainant's name – Gary Shafir – is not a very common name. Additionally, when performing a Google search for the search term "Gary Shafir", all of the results in the first page (and most of the overall results) are related to the Complainant. Finally, some of the indications from the Website for bad faith on Respondent's part (see sections 27-29 below) also strengthen the assessment that the Complainant has obtained common law rights in his Name.
19. Taking all the above considerations and the circumstances of the matter into account, in the panel's opinion the Complainant has met the threshold of establishing rights in the Name.
20. In view of the above, the panel concludes that the Complainant has satisfied these requirements under the Rules.

C. Respondent has no rights in the Name

21. The Complainant must prove that the Respondent has no rights in the Name.
22. The Complainant contends that the Respondent registered the disputed domain name for the sole purpose of diverting customers who are looking for the Complainant's services. Furthermore, the Complainant argues that the Respondent uses the disputed domain name in bad faith.

23. The Respondent has not responded to these allegations. Furthermore, the fact that the Name is the personal name of the Complainant (which is not very common) renders it clear that the Respondent (whose name is not similar) does not have any rights in the Name.
24. In view of the above, the panel determines that the Respondent has no rights in the Name.

D. Application and use of the disputed domain name in bad faith

25. Section 4 of the Rules provides as follows:

"4.1. For the purposes of Paragraph 3.4 above, the following circumstances, in particular but without limitation, if found to be present, shall be evidence of the allocation or use of a domain name in bad faith:

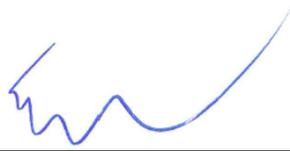
- a. the Holder continues to hold the domain name during or after termination of employment or work for hire contract where the domain name allegedly should have been allocated to the employing/contracting party; or
 - b. the Holder has requested allocation of the domain name primarily for the purpose of disrupting the business of a competitor; or
 - c. 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 or service mark or to a competitor of that Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name; or
 - d. the Holder has requested allocation of 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 there is evidence of having engaged in a pattern of such conduct; or
 - e. 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."
26. The Complainant argues that the sub-section (e) applies in this case: the Complainant contends that by diverting internet users to the Website operating under the disputed domain name, the Respondent causes the Complainant to lose business from consumers looking for the Respondent's website.
 27. The Complainant has not explained nor substantiated this contention with any evidence. Nonetheless, upon reviewing the Website operating under the disputed domain name

(including printouts attached with the Complaint), there are clear indications for the bad faith registration and use of the disputed domain name:

28. The central part of the website consists of several blog posts about several issues unrelated to each other, such as: jeep trips, transportation companies and second hand forks and "accessibility architect". Most of them consist of links to third party websites of companies operating in these fields. Moreover, the website consists of a long side column, the top of which bears the text "garyshafir" (the Complainant's Name) without any reasonable context. Below this header, the side column further consists of various clickable titles in various subjects. Many of these titles consist of the wording "accessibility architect", or are otherwise related to construction, home design and related subject matter. Furthermore, many of these titles use the words "accessibility architect" in an artificial manner which does not make any sense. For instance: "offices for sale in Beerot Itzhak over accessibility architect", linking to a third party website of a real estate company selling offices.
29. This type of activity is a clear indication that the Website is intended to unlawfully attract users who are looking for architect services, or to sell third party advertising to third party companies. Furthermore, the use of such links (which are probably sponsored) to third party websites related to the field of architecture (the Complainant's field of activity) cannot be a coincidence, and is indicative of bad faith registration and use of the disputed domain name (see WIPO decision in *Owens Corning v. NA*, WIPO Case No. D2007-1143, <pinkbatts.com>). In fact, this is another indication for the goodwill obtained by the Complainant in his Name, in the relevant field of architecture.
30. Additionally, the list in section 4.1 of the Rules is not exhaustive. As aforesaid, the Respondent received a cease and desist letter from the Complainant, but has not responded to it. Even if the Respondent had assumed that the letter was groundless, one would have expected the Respondent to respond to the letter. Under the WIPO case law, "When receiving such notice, good faith requires a response" (*Gaggia S.p.A. v. Yokngshen Kliang*, *Gaggia S.p.A. v. Yokngshen Kliang*, WIPO Case No. D2003-0982; see also ILDRP decision regarding the domain name <havaianas.co.il>). Accordingly, the Respondent's failure to respond to the cease and desist letter is also indicative of bad faith use of the disputed domain name.
31. In view of the above, the panel holds that the application for allocation of the Domain Name was made or the Domain Name was used in bad faith.

7. Decision

32. For all the foregoing reasons, in accordance with the Rules, the panel accepts the Complaint. Accordingly, I hereby order that the disputed domain name <garyshafir.co.il> shall be transferred to the Complainant within 30 days of the date of this decision.



Eran Liss, Adv.
Sole Panelist
Date: January 23, 2019