

Ben Tzion Daniel Levi v. Interdate Ltd., Yuval Katz

IL-DRP Panel Decision

1. The Parties

The Complainant is Ben Tzion Daniel Levi of Israel, represented by Adv. Jonathan Klinger, Adv. Rotem Shapira, Adv. Moti Friedman and Adv. Guy Zabar.

The Respondents are Interdate Ltd. and Yuval Katz of Ra'anana, Israel, represented by Adv. Dan-Or-Hof and Adv. Tal Kaplan, of Pearl Cohen Zedek Latzer.

2. The Domain Name and Registrar

The disputed domain names <swinger.co.il> and <swingersparty.co.il> are registered with LiveDns, Ltd.

3. Procedural History

The Complaint was filed with ISOC-IL on May 27, 2010. The Complaint was transmitted to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On June 7, 2010 the IL-DRP appointed Jonathan Agmon to head a three member Panel, alongside Leehey Feldman and Ellen Shankman.

In accordance with the Rules, on June 8, 2010, the Panel transmitted to the Respondents by e-mail a copy of the Complaint, providing the Respondent 15 days to respond to submit his Response.

On June 18, 2010 the Respondent submitted a request for an extension of 21 days to file his Response with the ISOC-IL. On the same day the Panel transmitted to the Complainant a request for his position. On June 18, 2010 the Complainant informed that Panel that he does not object to the requested extension. On June 20, 2010 the Panel granted the Respondents an extension of time to submit its Response to the Complaint until July 10, 2010.

On June 18, 2010 the Complainant submitted a request to order the Respondent to refrain from using the disputed domain names until a decision in these proceedings is granted. On June 20, 2010 the Panel declined the Complainant's request on the grounds that the Rules do not provide the Panel with the appropriate authority to do so.

On July 7, 2010 the Respondents submitted their Response.

4. Factual Background

The disputed domain name <swingersparty.co.il> was registered by the Respondent Yuval Katz ("**Respondent 2**") on March 4, 2010.

The disputed domain name <swinger.co.il> was registered by Respondent Interdate Ltd. ("**Respondent 1**") on March 31, 2010.

The Complainant is an individual that operates in the Israeli swingers' community. The Complainant is a leading figure in the Israeli Alternative Lifestyle Community ("**IALC**"), which operates the website <swingers.co.il>. The Complainant is registered as the administrative and technical contact of the <swingers.co.il> domain name.

Prior to their registration by the Respondents, the disputed domain names were registered by Paz Kol Hakesher, an Israeli based company which appears to be operated by the Complainant.

The Respondent 1 is an Israeli based application software company, which specialize in creating and operating websites and providing various internet services. The Respondent 2 is a shareholder and director of the Respondent 1 (jointly hereafter: "**The Respondents**").

The Respondents own and operate a substitute website for the Israeli swingers' community under the domain name <zigzug.co.il> since the year 2000.

The disputed domain names are used to redirect users to the website operating under the domain name <zigzug.co.il>.

5. Parties' Contentions

A. Complainant

The Complainant argues that the disputed domain names describe the Complainant's services, in which he gained goodwill among the swingers' community in Israel

The Complainant further argues that word "swingers" is his trade name. The Complainant claims the disputed domain names are identical or confusingly similar to his trade name.

The Complainant further argues that he had gained common law rights in his SWINGERS trade name.

The Complainant further argues that the Respondents have no rights or legitimate interest in the SWINGERS trade name as they are known by different trade names.

The Complainant argues the following evidences the Respondents acted in bad faith:

1. that the Respondents registered the disputed domain names, and makes use of the SWINGERS trade name, while knowing about the Complainant and his activities;
2. that the Respondents registered the disputed domain names in order to attract Internet users while creating a likelihood of confusion as to the origin of the domain names and affiliated websites;
3. that the Respondents registered the disputed domain names in order to manipulate and abuse the Complainant's market share while relying on the Complainant's goodwill; and

4. that the Respondents took advantage of the fact that the Complainant did not renew the disputed domain names in time and registered them in their name upon their expiration, in order to redirect them to the Respondent website.

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

B. Respondents

The Respondents argue that the Complainant has no legal standing in this proceeding, since the <swingers.co.il> website is owned by the company Paz Kol Hakesher and not by the Complainant.

The Respondents further argues that their website <zigzug.co.il>, which the disputed domain names redirect to, has gained considerable popularity among users who are looking for content and services regarding the swingers community and lifestyle.

The Respondents further argue that they registered the disputed domain names in good faith after learning that they are available for registration to the general public.

The Respondents further argue that the disputed domain names are not the same nor are they confusingly similar to a trademark, trade name, registered company name or legal entity registration of the Complainant. The Respondents further argue that the Complainant does not own registered trademark rights for the SWINGERS mark. Further, the Respondents argue that the company name for Paz Kol Hakesher, the owner of the domain name <swingers.co.il>, does not consist of the words "swinger", "swingers" or "swingersparty".

The Respondents further argue that the terms "swinger", "swingers" or "swingersparty" are dictionary terms that are either generic or highly descriptive terms and have no degree of distinctiveness. The Respondents therefore argue that these terms cannot be attributed to the Complainant.

The Respondents further argue that the terms "swinger", "swingers" or "swingersparty" did not acquire secondary meaning in the relevant market. The Respondents claim that there are many other websites in the Israeli swingers' scene that make use of these terms.

The Respondents further argue that they are making a bona fide commercial use of the disputed domain names to provide services to the swingers' community.

The Respondents further argue that the fact that they redirect the disputed domain names to another website, which operated under the domain name <zigzug.co.il>, does not indicate bad faith.

The Respondents further argue that the use of the word SWINGER or SWINGERS in the disputed domain names does not create likelihood of confusion as to the source, sponsorship or affiliation of the disputed domain names. The Respondents further argue that they do not attempt to create such confusion.

For all of the above reasons, the Respondents request the denial of the Complaint.

6. Discussion and Findings

A. Preliminary

Both the Complaint and the Response refer to ISOC-IL's allegedly failure to notify the Complainant of the upcoming renewal dates for the domain names.

The Panel finds that these claims are not within the scope of these proceeding. The Rules exclusively determine that such claims are not reviewable by the IL-DRP. Specifically, Paragraph 2 of the Rules contains a list of disputes that are not reviewed by the IL-DRP. Clause 2.6 provides the following:

"Disputes challenging allocation to a Holder, based on ISOC-IL's malfeasance in the allocation of a Domain Name. Challenges based on ISOC-IL's action/inaction may be brought to an Israeli Court."

The Panel will therefore disregard any and all claims made by the Complainant and the Respondents that refer to ISOC-IL's alleged malfeasance in the allocation of the domain names.

B. General

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 Respondents submitted to this process and Rules when they applied for and registered the disputed domain names. The ISOC-IL registration rules provide that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See section 24.4). The Respondents, therefore, by applying for and registering the disputed domain names agreed to the IL-DRP and the Rules.

As previous Panels noted 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.

The Rules provide 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 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.

C. Same or Confusingly Similar

It is up to the Complainant to show that the disputed domain names are identical or confusingly similar to a trademark, trade name, registered company name or legal entity registration of the complainant.

The disputed domain names comprises of the words "swinger", "swingers" and "party" and the suffix .co.il. The suffix .co.il is ignored for the purpose of determination the similarity between the disputed domain names and the SWINGER name since it is a common suffix showing that the domain name is part of the .il domain and associated with commercial activities (.co suffix) (See Sao Paulo Alpargatas S.A v. Ilan Omer, IL-DRP Panel Decision).

The relevant part of the disputed domain names are therefore "swinger" and "swingers party".

The Complainant does not own a trademark registration for the terms "swinger" or "swingers party".

The absence of a trademark application or registration at the time of the registration of the disputed domain names does not necessarily preclude a finding by the Panel that the Complainant has the requisite rights in that mark for purposes of paragraph 4(a)(i) of the Policy, as has been long noted by prior UDRP panels. (See, for example, *Great Plains Metromall, LLC v. Gene Creach*, NAF Case No. FA97044; *DigiPoll Ltd. v. Domain Administrator*, WIPO Case No. D2007-0999 and *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. D2000-0050).

It has been the decision of previous UDRP Panels that in determining if a complainant has defensible rights in an unregistered mark, the panel should analyze whether the complainant has established common law rights in the mark by assessing the complainant's showing of a secondary meaning that is directly associated with the complainant. Factors typically considered influential in such an analysis are longevity of use, amount of sales, nature and extent of advertising, consumer surveys and media recognition (see: WIPO Overview of WIPO Panel Views on Selected UDRP Questions and *The British Broadcasting Corporation v. Jaime Renteria*, WIPO Case No. D2000-0050).

The Complainant contends that he is known under the "swingers" trade name and that he acquired common law rights in this trade name, among others, by operating the <swingers.co.il> website.

The Panel notes that the terms "swinger" or "swingers party", when used for services rendered to the swingers' community in Israel, are considered descriptive.

It has been previously decided by UDRP Panels that when a disputed domain name is consisted of descriptive terms, the Complainant must provide very substantial evidence of acquired distinctiveness or secondary meaning (see *Patricia Kelley v. Innovation HQ, Inc.* WIPO Case No. D2009-1723).

From the few items the Complainant has provided as evidence, it is indicated that the Complainant and the <swingers.co.il> website, are a source from which the public can

find information regarding the swingers' community and events. There is no indication that the Complainant use of the SWINGERS trade name resulted in the achieving a secondary meaning. Furthermore, the Panel performed an Internet search for the word "swingers" in Israel and found that it generates multiple results, which lead to different swingers website operated by different entities.

The Panel cites the following with approval: "Mere evidence of use in relation to a website and a bare submission that there have been substantial website page views during that period is insufficient, even in relation to a not-for-profit business, in order to enable the Panel to infer the requisite degree of secondary meaning to support a claim of common law trade mark rights." (See Patricia Kelley v. Innovation HQ, Inc., Supra).

The Panel finds that in this case, the Complainant failed to prove that the public associates the SWINGERS trade name only with the Complainant and that he is entitled common law rights for his SWINGERS trade name.

The Panel also notes that the Complainant did not provide evidence to show that the SWINGERS term is a registered company name or legal entity registration of the complainant

As a result, the Panel finds that the Complaint did not prove the first element of this proceeding. Previous UDRP Panels have asserted that "Where a complainant does not prove one or more of these elements, the panel is compelled to issue a decision denying the complaint, regardless of the complainant's ability to prove the other element(s) required by the Policy. Accordingly, under such circumstances, any discussion by the panel with respect to such other element(s) would be unnecessary in reaching a decision to deny the complaint" (See: Doheny Plumbing, Inc. v. PAO Industries, Inc., Case No. D2007-1827; Admerex Limited v. Metyor Inc., WIPO Case No. D2005-1246).

Given that, it is unnecessary for the Panel to make a finding with respect to the second and third elements of the Policy and the Panel refrains from doing so.

7. Decision

For all the foregoing reasons, in accordance with the Rules, the Complaint is Denied.

Jonathan Agmon
Presiding Panelist

Leehee Feldman
Panelist

Ellen Shankman
Panelist

Date: August 1, 2010

Concurring opinion of Ellen Shankman:

The determination of whether use of a descriptive term has acquired sufficient secondary meaning to rise to the level of a protectable trademark is primarily a heavily evidentiary question, and I believe questions of such legal/factual complexity are inappropriate for this forum.

Notwithstanding, I fully agree with the decision of this panel to deny the complaint.

Ellen Shankman
Panelist

Date: August 1, 2010