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AT&T Intellectual Property II, L.P. v. Khalil Kharman

IL-DRP Panel Decision

1. The Parties

The Complainant is AT&T Intellectual Property II, L.P., located in Reno, Nevada USA, represented by Gilat, Bareket & Co. Tel-Aviv, Israel.

The Respondent is Khalil Kharman, located in Osefiya, Israel.

2. The Domain Name and Registrar

The disputed domain name <att.co.il> is registered with Domain The Net Technologies Ltd. (the "Registrar")

3. Procedural History

The Complaint was filed with ISOC-IL on July 7, 2016. The Complaint was transmitted to the Israel Dispute Resolution Panel of ISOC-IL ("IL-DRP"). On July 17, 2016, Neil Wilkof was appointed in accordance with the Procedures for Alternative Dispute Resolution under the .ILccTLD IL-DRP Rules, http://www.isoc.org.il/domains/ildrp_rules.html) (hereinafter – "the Rules").

Pursuant to the Rules, on August 3, 2016, notification of the Complaint, including copies of all submitted material, and notification of appointment of the Panel under the Rules, was sent 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, until August 18, 2016, to submit a Statement of Response or any other relevant information to the Panel. Pursuant to Procedural Order No 1, dated August 10, 2016, the due date for submission of a response by the Respondent was extended to August 23, 2016. On August 22, 2016, the Respondent submitted to ISOC-IL as an email response.

4. Factual Background

The Complainant, which is an American multinational telecommunications corporation, *inter alia* is the owner of the following marks:

Israel Registration No. 153278 for AT&T (word and device), registered on January 2, 2003, for services in class 38;

Israel Registration No. 153279 for AT&T (word and device), registered on January 2, 2003, for services in class 42;

Israel Registration No. 187826 for AT&T (word and device), registered on August 7, 2007 for goods in class 9.

(Hereinafter: "the AT&T Mark")

The disputed domain name, <att.co.il> (the "Disputed Domain Name") was registered on September 6, 2007.

5. Parties' Contentions

A. Complainant

The Complainant holds all trademark and related intellectual property assets, including trademarks registered in Israel, for its parent company[1] (the Complainant and its parent company will be severally and jointly referred to as the "Complainant").The Complainant provides a full range of voice, broadcast, data, networking and e-business services and it serves millions of client worldwide.

In the United States, the Complainant is the largest communications holding company by revenue, and is the largest provider of fixed telephones and it is the second largest provider of mobile telephones. As of May 2014, the Complainant was the 23rd largest company in the world based on a composite of revenues, assets and market. As of May 2015, the Complainant was the 20th largest mobile telecon operator in the world, servicing more than 123.9 million mobile customers.

The Complainant has registered the AT&T Mark throughout the world, including in Israel, as early as 1996, long before the registration of the Disputed Domain Name. A previous panel, acting under rules very similar to those of ISOC-IL, has found the AT&T Mark to be "renowned worldwide."

The Complainant communicates its business on the website www.att.com and it advertises its goods and services on approximately 3,000 ATT-formative domains.

The Complainant has been engaged in Israel in product development, innovation and international communication. In 2007, the Complainant launched a research and development center in Israel, the same year that the Disputed Domain Name was later registered.

The Respondent is a teacher of computers at a high school in Nazareth, Israel called "Na'amat.

[1] The identity of the parent company is not indicated in the Complaint.

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Prior to the filing of the Complaint, the Complainant's attorney sent a cease-and-desist letter to the Respondent[2], notifying the Respondent of its rights in the Disputed Domain Name and requesting that the Respondent assign the Disputed Domain Name to the Complainant. Following this, in a telephone conversation with the Complainant's attorney, the Respondent requested payment of the sum of $20,000 for the assignment of the Disputed Domain Name to the Complainant. The Complainant offered the Respondent payment of the sum of $100 for all out-of-pocket expenses, but this offer was rejected by the Respondent.

The Complainant engaged a private investigator to carry out an investigation prior to the filing of the Complaint. The investigator determined that the Respondent is the owner of other domain names. In paragraph 44.4 of the Complaint, the Complainant states that "[d]uring the conversation with the investigator, **the Respondent confirmed that the Disputed Domain <att.co.il> as well all his other domain names are offered for sale and that he is ready to sell them to anyone who is willing to offer the highest price** (emphasis in the original)".

At the time of the filing of the Complaint, the Disputed Domain Name is not available (when one searches the Disputed Domain Name, he receives a message in Hebrew that states that "This site cannot be reached"; "att.co.il's server DNS address could not be found"). However, at the time that the Complainant became aware of the Disputed Domain Name[3] the website under the Disputed Domain Name was being used alternatively as a "parking "page", including providing sponsored links to other websites and as a sponsored pop-up ad for various goods and services. The Disputed Domain Name was active as a "parking page" at least until August 1, 2015.

In light of the foregoing, the Complainant filed the Complaint on July 6, 2016.

B. Respondent

Respondent has submitted its response in the form of a one-page email communication.

Respondent is a high school teacher in a village in Israel. In September, 2007, he registered the Disputed Domain Name, with the purpose of building a website for furniture, noting that the village in which he grew up, and the neighboring village, Daliet El Carmiel, are each known for being the home of a number of furniture stores. He pointed out that the Arabic word for furniture is "اثاث", [which is phonetically very similar to the letters "att"]. Respondent states that has not done "much with the domain" since registration in his name because "he lacked the skills or time to learn building websites."

Respondent acknowledges that he was contacted by a private investigator. Respondent told the private investigator that he "bought this domain initially to build websites for furniture", but only later learned "that the domain name belongs probably to a big company like Apple. I didn't even know about the AT&T as a company in the US. As a matter of fact, any average person like me would not even know who is AT&T and what it does." He referred to a

[2] The date of the cease-and-desist letter is not indicated in the Complaint.

[3] No date is indicated in the Complaint.

recorded message between the private investigator and himself that substantiates his claims. However, no such recording was submitted with his response.[4]

As well, Respondent referred to an email exchange through a website that took place in 2011 between a lawyer and himself as evidence that he registered and maintained the Disputed Domain Name in good faith.

6. Discussion and Findings

According to Rule 3 of the Procedures, the Complainant must prove the following:

(a) 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

(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.

A. Identical or Confusingly Similar

The AT&T Mark consists of "AT&T" plus a logo. In the view of the Panel, "AT&T" is the dominant portion of the AT&T Mark and it is reproduced in its entirety in the Disputed Domain Name. The Panel takes judicial notice that the ampersand is a symbolic form of the word "and" (as a technical matter, an "ampersand" cannot be incorporated into a domain name. See, e.g., PG&E Corp v. Anderson, WIPO Case No. D2000-1264). In any event, the ampersand lacks distinctive power in determining whether a mark is confusingly similar to a disputed domain name.

Moreover, it is well-established that the addition of a country code top-level domain ("ccTLD") lacks any distinctive power in determining whether a mark is confusingly similar to a disputed domain name. See, e.g., Busy Body, Inc. v. Fitness Outlet Inc., WIPO Case No. D2000-0127 ("[…] the addition of the generic top-level domain (gTLD) name '.com' is … without legal significance since use of a gTLD is required of domain name registrants") . The same applies to a ccTLD such as <co.il>.

[4] On September 12, 2016, ISOC-Il contacted the Respondent by telephone and asked whether the Respondent had in error failed to attach a copy of the recording. The Respondent replied that he had assumed that the Panel would reach out to the private investigator for a copy of said recording. When the Respondent was advised that the Panel does not take such actions with respect to the submission of evidence by the parties, the Respondent stated that he would provide a copy of the recording. The recording was then submitted by the Respondent on that same day. Under these circumstances, because the recording was not submitted by the Respondent at the time of the submission of his response, the Panel will disregard its later submission by the Respondent.

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The Disputed Domain Name incorporates the AT&T Mark. Neither the absence of the ampersand nor the addition of the ccTLD changes the conclusion that there is a confusing similarity between the AT&T Mark and the Disputed Domain Name.

B. Complainant's Rights in the Mark

The registration of the AT&T Mark, including in Israel as early as 1996, predates the registration of the Disputed Domain Name, being September 6, 2007. Accordingly, the Panel finds that the Complainant has rights in the AT&T Mark.

C. Registrant's Rights in the Mark

There is no evidence that the Respondent has registered any mark that consists of, or contains, the AT&T Mark, or any material portion thereof. There is no evidence that the Complainant has entered into any agreement, authorization or license with the Respondent with respect to the use of the AT&T Mark. The name of the Respondent does not bear any resemblance to the Disputed Domain Name, nor is there any basis to conclude that the Respondent is commonly known by the AT&T Mark or the Disputed Domain Name.

The Respondent does not use of the Disputed Doman Name in connection with a bona fide offering of goods or services, nor is the Respondent making any legitimate noncommercial or fair use of the Disputed Domain Name.

Based on the foregoing, the Panel finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name.

C. Allocation or Use of the Disputed Domain Name in Bad Faith

Rule 3.4 of the Procedures provides, in the disjunctive, that the Complainant must show either that the Disputed Domain Name was allocated **or** that is has been used in bad faith. For the reasons set forth below, the Panel is of the view that the Respondent has acted in bad faith both in connection with both the allocation and use of the Domain Name.

Rule 4 of the Procedures sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent with respect to allocation or use of a disputed domain name, as follows:

"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."

Allocation--The Respondent explains that he selected the Disputed Domain Name because his village, and a near-by village, are both well-known for furniture and that he intended to build a website site for furniture. However, Respondent has not submitted any evidence to support the claim that his village or the neighboring village, Daliet El Carmel, are known for their furniture industry or that he had any connection to the furniture industry, either before or after the allocation of the Disputed Domain Name.

In that connection, the Arabic word "اثاث" , means "furniture" and the English language consonant equivalent for this word is "att". However, the Panel also takes judicial notice that the pronunciation of the word in English must take into account the equivalent to both consonants and vowels. This means that the pronunciation will be "athath", or the near equivalent thereto. As such, anyone seeking to reproduce the word "اثاث" in English would be expected to use the word "athath", or the near equivalent thereto, and not merely the letters "att".

The Respondent denies any prior familiarity with the AT&T Mark. However, the Panel notes that the Respondent is a high school teacher of computers and that the AT&T mark is known throughout the world in the area of computers and technology (see, e.g. AT&T Intellectual Property II L.P v. Peter Younan, NAF Case FA1302001487604 ("Complainant and its trademarks are world renowned making it highly unlikely that Respondent [located in Egypt] was not aware of Complainant and its trademarks prior to registering the at-issue domain name")). As well, the private investigator stated that the Respondent made reference to reading "The Marker" during the course of their conversation. The Panel takes judicial notice that "The Marker" is a daily news publication in Israel dedicated to business, technology and related subjects both in Israel and abroad.

Based on the foregoing, the Panel rules that the Respondent did not select the Disputed Domain in good faith.

Use—It is sufficient under Rule 3.4 of the Procedures that the Panel has ruled that the allocation of the Disputed Domain Name was made in bad faith. Nevertheless, as a matter of completeness, the Panel will also address the question of whether the use of the Disputed Domain Name has been made in bad faith.

The Respondent has, by his own admission, not taken any steps since 2007 to create a website for furniture. At most, at least until some point in August 2015, the Respondent merely used the site as a parking page or a sponsored pop-up. Currently, the website under the Disputed Domain Name is not available.

The Respondent does not deny or otherwise refute that he is the owner of other domain names, registered both in Israel and abroad. Nor does the Respondent deny or otherwise refute that he expressed an interest in selling the Disputed Domain Name, just as the Respondent expressed an interest in selling other domain names for which he is the registrant.

The fact that the Disputed Domain Name was deactivated does not change the conclusion that the Respondent has acted in bad faith. Instructive in this regard is the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0"), paragraph 3.2, which states as follows--

"3.2 Can there be use in bad faith when the domain name is not actively used and the domain name holder has taken no active steps to sell the domain name or contact the trademark holder (passive holding)?"

In the instant case, there is unrefuted evidence that the Respondent offered to sell the Disputed Domain Name. Thus, the conduct of the Respondent cannot be seen as an act of passive holding.

Based on all of the foregoing, the Panel finds that the Respondent has both registered and is using the Disputed Domain Name in bad faith.

7. Decision

For the foregoing reasons, in accordance with the Procedures, the Panel orders that the Disputed Domain Name <att.co.il> be transferred to the Complainant.

Neil J. Wilkof, Sole Panelist

Date: October 10, 2016