

**IL-DRP PANEL  
FOR THE INTERNET SOCIETY OF ISRAEL**

In the matter of the **Domains**  
<**monsterenergy.co.il**>  
And <**monster-energy.co.il**>

between

**Monster Energy Company**

(a Delaware Corporation)  
1 Monster Way  
Corona, CA 92879  
United States of America

Represented by Adv. Ellen Shankman  
Email: [ellen@ellenshankman.com](mailto:ellen@ellenshankman.com)

(The "Petitioner")

and

**Yaron Barbi**

Of Bys Productions Ltd  
11 Hativat Yiftach St.  
Hod Hasharon 45512  
Israel

Email: [Barbi.yaron@gmail.com](mailto:Barbi.yaron@gmail.com)

(The "Respondent" or "Holder")

**DECISION**

***I. Procedure***

1. ISOC-IL received a Petition on behalf of the Petitioner, requesting that the two Domain Names "monsterenergy.co.il" and "monster-energy.co.il" be reallocated to the Petitioner.

A Panelist was appointed in accordance with the Procedures for Alternative Dispute Resolution under the IL-DRP Rules, in order to address the Petitioner's above request ([http://www.isoc.org.il/domains/ildrp\\_rules.html](http://www.isoc.org.il/domains/ildrp_rules.html)) (hereinafter – "the Rules").

2. Let it be noted that in accordance with section 5.2 of the Rules, "The Petition may include any number of Domain Names held by a single Holder", and the Panel maintains discretion to separate the Petition into different proceedings if need be. In the current dispute, the circumstances a priori do not require such separation, and therefore both Domains will be resolved within a single Decision herein.
3. Notification of the pending Petition, including copies of all submitted material, and notification of appointment of the Panel under the Rules, was sent on March 26<sup>th</sup>, 2019, 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, to submit a Statement of Response or any other relevant information to the Panel.
3. The Petitioner responded to said request, within the allotted timeframe, with two distinct e-mail replies. The first (re-iterated several times), provided a contact number to be used "if you want to buy this domain". Pursuant to this email, the Panel explained the IL-DRP proceeding to the Respondent, referring to the relevant Rules. In response, and with the required timeframe, the Respondent provided an additional email, containing a very brief reply to the Petition, which will be deemed a minimal response. Both letters will be acknowledged as part of the communications included in this proceeding.
5. The Petitioner submitted an additional email response thereafter, which shall also be taken into consideration under these proceedings.

## ***II. Factual Background***

1. The Petitioner is "Monster Energy Company", founded in 2002 as a Delaware Company (by a different name, which it changed to the current in 2012), leading its business from California, USA.
2. The Respondent is Bys Productions Ltd, represented by Mr. Yaron Barbi.
3. The Respondent registered both of the Disputed Domains on February 12<sup>th</sup>, 2012.

## ***III. The Parties' Claims***

### ***A. The Petitioner***

1. The Petitioner is a Delaware Company by the Name of Monster Energy, claiming to be the world's leading manufacturer of Energy Drinks. The Complainant's MONSTER ENERGY brand is used in connection with beverages, clothing, sports gear, stickers, and other products and is well known throughout the United States and internationally.

2. Complainant is the owner of extensive rights in and to the MONSTER ENERGY mark and has been marketing a line of beverages by this name since 2002 in the USA, and commencing in 2008 in European countries as well.
3. Complainant has registered and has pending trademark registration of the name internationally as well as in Israel. These have become well known and used since 2002 in connection with the MONSTER ENERGY drink as well as other consumer products.
4. The Company was originally known as The Hansen Beverage Company, and on January 5<sup>th</sup>, 2012, changed its name to The Monster Company.
5. Complainant states that sales of its MONSTER ENERGY drinks have generated more than US \$23 billion in gross worldwide sales, with estimated retail revenues in excess of US \$40 billion.
6. The Complainant owns the domain name [www.monsterenergy.com](http://www.monsterenergy.com), at which it launched its website on August 19, 2003, and has millions of users and views over the years. This website is naturally accessible to users from Israel as well.
7. Complainant notes that the success and fame of its MONTSER ENERGY brand have also led to many attempts to exploit the consumer recognition and goodwill attached to the MONSTER ENERGY brand, resulting in more than a dozen cases in which dispute resolution panels have recognized the Complainants rights in the MONSTER ENERGY trademark.
8. Complainant provided a description of phone conversations and email exchange with the Respondent, in which it offered to reimburse the Respondent for its costs in buying the Domain, and requesting transfer of such. The Complainant attached an email refusing any such negotiation, and went on to quote a phone conversation in which the Respondent requested the likes of some \$10,000 in exchange for the names. The Respondent also allegedly offered his services to MEC for promotion of their drinks in Israel, which he considered to be a reasonable deal which can include transfer of the Domains as well. The Petitioner refused to negotiate a business deal as the grounds for transfer of the Domains.

#### B. The Respondent

The Respondent is Mr. Yaron Barbi for Bys Productions Ltd, also affiliated with the domain [www.monochrome.co.il](http://www.monochrome.co.il).

The Respondent provided very little information in reply to this Complaint. He first responded to the presentation of the Complaint with a short email including a contact number, and a statement that *"If you want to buy this domain, Contact us:.."*.

After having the IL-DRP process explained by the Panel, and being re-directed to the relevant rules and regulations, the Respondent provided a brief email claiming mostly that *"the Domain was purchased in 2012 with the real intention of marketing the energy drink"*, and that he had an appeal to import and market the drink. No evidence was provided in support of this claim, and no other information was submitted on behalf of the Respondent.

## **IV. Discussion**

1. The IL-DRP is an alternative dispute resolution procedure intended to provide expedited resolution to disputes regarding the allocation of Domain Names, in accordance with the Rules for Allocation of Domain Names under the .IL country code. By registering a Domain, any Holder agrees to abide by these Rules.
2. Let it be emphasized that the IL-DRP proceedings are meant to be concise, specific, straight-forward cases, as an easily accessible alternative procedure. The IL-DRP sets forth clear guideline recommendations as to how the Procedure should be conducted, aimed at providing expedited resolution to Domain Name disputes, as described in the preamble to the Rules. The procedure is not intended to substitute court review in cases where there are contractual disputes or complex business contentions between the parties, which will require lengthy processes of evidence and cross examination.
3. Historically, the framework within which the Israeli IL-DRP rules were established, similar to the WIPO Uniform Domain Name Dispute Resolution Policy, was aimed at mitigating and preventing all instances of "cybersquatting", which according to ICANN is: "bad faith registration of another's trademark in a domain name."<sup>1</sup>
4. As phrased in *WIPO Administrative Panel Crough and McNeil v. Stein*, case no, D2005-1201 and applicable to the IL-DRP rationale as well:

"The Policy was adopted to deal as is with the problem of cybersquatting, the registration of domain names consisting of, including, or confusingly similar to marks belonging to another for the purpose of profiting from the goodwill associated with said marks."

5. In order for a case to be brought before an IL-DRP Panel, the Petitioner must show prima facie indications that certain grounds exist. The following must all be fulfilled:
  - 3.1. the 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.
6. Keeping all of the above in mind, the Panel will proceed to review existence of the grounds for the request, based on the IL-DRP guidelines, and in consideration of the purpose and relevance of the facts at hand to the rationale of IL-DRP proceedings.

### **a. Name is Same or Confusingly Similar to a Name of the Complainant**

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<sup>1</sup> <https://www.icann.org/resources/pages/cybersquatting-2013-05-03-en>

The requirement in the Rules is that "the Domain Name is the same or confusingly similar to a trademark, trade name, registered company name or legal entity registration ("Name") of the complainant".

The Disputed Domains consists of the term "monsterenergy" or "monster-energy" and of the suffix "co.il".

It has been previously ruled that the suffix "co.il" is to be disregarded for the purpose of determining similarity of a Domain to a Registered Mark, since it is a common suffix indicating that the domain is registered as a commercial Israeli website (see for example ISOC II-DRP case in the matter of <Crayola.co.il>).

Hence the question arises, whether or not the term "monsterenergy", with or without a hyphen, which is the essence of the Domain name, is the same or confusingly similar to a Name of the Complainant.

Since Israeli II-DRP guidelines are very similar to those established by WIPO Uniform Domain Name Dispute Resolution Policy, local guidance is often taken from WIPO Panel decisions.

It has long been established, in numerous cases by international WIPO Panels, that where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing<sup>2</sup>. It is quite clear that the MONSTER ENERGY Mark is completely incorporated in both disputed domain names.

Reference can also be made to the WIPO decision regarding Petition by the same Complainant regarding the Domain monsterenergy.store, where the Panel concluded as follows:

"Aside from the space between words, the disputed domain name is identical to the MONSTER ENERGY Trademarks, and certainly is confusingly similar to the MONSTER ENERGY Trademarks. The Panel agrees that the gTLD does nothing to further distinguish the disputed domain name from the MONSTER ENERGY Trademarks."

**Monster Energy Company v. Steve Carman / WhoisGuard Protected, WhoisGuard, Inc.,**  
Case No. D2017-0358

With regard to the second disputed Domain, <monster-energy.co.il>, which includes the identical components of the Complainant's Mark, separated by a hyphen, it has been clearly ruled that such hyphen does not in any way diminish the sense of identity or of being confusingly similar with the original term. As stated in WIPO panel **Fort Knox National Company v. Ekaterina Phillipova** Case No. D2004-0281

"From the point of view of the Panel, the fact of including a hyphen between the words *true* and *pay* does not make a sufficient difference between the domain name and the Complainant's trademark. On the contrary, and considering the requirement that the disputed domain name and the trademark must be confusingly similar, this Panel believes

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<sup>2</sup> Section 1.7 of the WIPO Jurisprudential Overview 3.0  
<https://www.wipo.int/amc/en/domains/search/overview3.0/#item17>

that the expression true-pay is similar to the trademark TRUEPAY and, therefore, may confuse the public about the business origin, the quality of products or services, and about the owner of the domain name".

The Petitioner demonstrated longstanding rights in the term Monster Energy, from as early on as 2002. In use of the identical name MONSTER ENERGY, the complainant demonstrated trademarks, name of a Product, and in January 2012 (prior to registration of the Domain), the Complainant changed its name to Monster Energy, which again is identical to the disputed domain.

In light of the above, it is evident that the Domain name is identical or confusingly similar to the Name and Marks of the Complainant, and the first requirement is thus fulfilled.

## **b. Complainant has Rights in the Name**

1. The II-DRP rules require fulfillment of all grounds specified in Section 3 of the Rules. This Section requires prima facie proof that the Complainant has rights in the Name.
2. It is very clearly evident from the information presented above, that the Petitioner had rights in the name, at the time of filing the claim, and even at the time of registration of the Domain (though this is not always a pre-requisite for establishment of prima facie evidence of Rights).  
These rights include:
  - Israeli Registered Trademarks of the name MONSTER ENERGY , from 2010
  - Various International registered trademarks under same name, from 2002
  - The Complainant's Company name is identical to the disputed Domain
  - The Complainant has very strong international presence, particularly on social media, with its brand MONSTER ENERGY, which has been growing over the years.
  - The Complainant owns several domain names, incorporating the name MONSTER ENERGY.
3. It has already been concluded by WIPO Arbitration Panels that:  
"It has been a consensus view among UDRP panels that if the complainant owns a registered trademark, then it generally satisfies the threshold requirement of having trademark rights". **Horten Advokatpartnerselskab v. Domain ID Shield Service CO., Limited / Krutikov Valeriy Nikolaevich**, WIPO Case No. [D2016-0205](#), <horten-canada.com>.
4. Reference can also be made to the Respondents second email response, in which he stated that "The domain was purchased in 2012 with the real intention of marketing **the energy drink** through a motorcycle racing platform and motor sport shows that I held" (emphasis not in original). In this reply, the Respondent refers to a well know drink, evidently that of the Petitioner. He does not indicate his own connection with the domain, but only his intention to profit from such a well known

name, in connection with his own independent line of business. Such reference only enforces the Holder's recognition of the Petitioner's rights in the Name.

Therefore it is concluded that the Petitioner provided at least the required Prima Facie evidence in favor of ownership of its rights in the Name.

### **c. Respondent has no Rights in Name**

Above analysis indicates that the first two of four required grounds for Petition have been fulfilled. The Third claim requires that the Respondent have no Rights in the Name.

1. The Respondent, Mr. Barbi, did not provide a full Statement of Response stating his Rights or connection with the Domain. In his second brief email, he only claimed that:

"The domain was purchased in 2012 with the real intention of marketing the energy drink through a motorcycle racing platform and motor sport shows that I held in cooperation with the Ministry of Culture and Sport ".

This statement of intention provides no indication that the Respondent has any rights or actual connection to the Name, other than a business intent of marketing it – which does not constitute any Rights.

2. The Complainant clearly states that "The Respondent is not an authorized dealer, distributor, or licensee of the Complainant, nor has he been otherwise allowed by the Complainant to make any use of the highly". The Respondent in no way addressed or refuted such claim, which enforces a prima Facie case established by the Complainant, against the Holder's potential rights in the Names.

3. Neither of the Domains are currently being used by the Respondent, and do not reveal an active web page, which could possibly indicate any rights. A search on the Internet Archive at <https://web.archive.org>, also seems to enforce the claim that there is no recorded past activity for the Domains.

As stated by a WIPO panel regarding use of the Domains **<monsterenergy.lol>** and **<monsterenergy.online>**:

"Another element to consider is the fact that no active use of the disputed domain names appears to have taken place which makes it even more difficult to conceive which rights or legitimate interests the Respondent would have in domain names that reproduce in their entirety a well-known trademark " (*Monster Energy Company v. Cameron Jackson* Case No. D2016-1868)

Based on all of the above, Panel concludes that the third requirement under the Rules is clearly fulfilled, and the Respondent has indicated no rights or interest vested in the Domain Name.



## **d. Registration or Use in Bad Faith**

Section 3.4 of the Rules requires that "the application for allocation of the Domain Name was made or the Domain Name was used in bad faith". The Rule requires that either the registration or the use be in bad faith, and it appears that in this case there are sufficient indications on behalf of the Respondent which are indicative of bad faith both in registration and in use, as follows:

### Bad Faith in Registration of the Domain:

#### 1. Previous knowledge of the Name –

The Complainant has been using the Name Monster Energy for its products since 2002. In addition to its earlier International Trademarks, it applied for Trademark Registration in Israel in 2010, and was registered in 2012. In 2012 the Complainant also changed its name to Monster Energy.

All of the above activity happened prior to registration of the Domains by the Respondent.

Since the term Monster Energy has no independent meaning of its own, there is no evident explanation for registration of the Domains other than in connection with the Complainant's mark. The Holder must have been familiar with the Petitioner Trademark (as also alluded to in his response), yet still continued to register the Domains incorporating it in its entirety.

#### 2. Section 4.1 provides a non-binding list of cases which, if found, will be considered evidence of bad faith. Among these are:

*"... 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."*

According to evidence submitted by the Petitioner (and not refuted by the Respondent), the Respondent had expressed interest in reaching a deal with the Petitioner, in which he would agree to sell the Domains at their "value", which he considered clearly to be well beyond the reasonable realm of reimbursement for expenses. This behavior on the Holder's behalf can indicate Bad Faith both in registration and in holding (see also below).

### Bad Faith in Holding the Domain

#### 1. The Respondent has registered two Domains, neither of which refers to an active web page at the time of filing of the Complaint, and as mentioned above, seem to never have resolved to active pages. As mentioned by repeated WIPO panels<sup>3</sup>, *"from the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or "coming soon" page) would not prevent a finding of*

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<sup>3</sup> WIPO Overview 3.0 Paragraph 3.3



*bad faith under the doctrine of passive holding.*” Such holding in and of itself does not necessarily constitute bad faith, unless supported by additional factors, among which can be *“(i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use”*<sup>4</sup> . Both of these factors are present herein, as the Respondent's email replies provided very little indications other than his intent to market "the energy drink".

2. In addition, section 4.1 of the rules indicates that the following will be considered evidence of allocation or use in bad faith:

*"Circumstances indicating that the Respondent 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."*

The Complainant stated in its Petition that "the Respondent said that he would only accept an amount that he considered to represent the value of the Domain Names, and said that they were similar to other domain names “like Coca-Cola or Nike” and threw out the number “on the order of USD \$10,000”.

This is part of the Petitioner's description of the Respondent's attempt to negotiate selling the Domain to the Petitioner. It is clear that his intention is to gain valuable consideration in return. The Respondent did not refute this.

In a previous similar WIPO case regarding the Domain <monsterenergy.team>, the panel concluded that

"In this case, the Complainant has a well-known trademark, no response to the Complaint has been filed, and the Respondent's broker offered to transfer the Disputed Domain Name for sums well in excess of its registration costs. This Panel regards such conduct as *prima facie* evidence of bad faith use in the absence of a response."

Though there may be more indications of bad faith arising from the Respondent's behavior in the case at hand, all of the above shall suffice to indicate *prima facie* evidence that the Responding registered and used the Domains in bad faith.

## **V. Decision**

In light of all of the above, Panel finds that the Disputed Domains are both the same and identical to many Well Known and Registered Marks of the Petitioner, the

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<sup>4</sup> Same

Petitioner has established substantial circumstances supporting its rights in the Disputed Domains, the Respondent presented no rights in the Domains, and the Respondent has acted in bad faith in registering and in holding the Domains.

Therefore, the Panel concludes that

**the Disputed Domains shall be transferred and re-assigned to the Petitioner,**  
within 30 days of the date of this Decision.

*Leehee Feldman, Adv.*  
Sole Panelist

Date: May 29<sup>th</sup>, 2019