



Philip Morris Products S.A. v. Ofer Laster

IL-DRP Panel Decision

1. The Parties

The Complainant is Philip Morris Products S.A., of Nuechatel, Switzerland, represented by D. Mirkin & Co., Israel.

The Respondent is Ofer Laster, of Haifa, Israel.

2. The Domain Name and Registrar

The disputed domain name <marlboro.co.il> is registered with LiveDns, Ltd.

3. Procedural History

The Complaint was filed with the Israel Internet Association ("**ISOC-IL**") on December 17, 2008. The Complaint is filed to the Israeli Dispute Resolution Panel of ISOC-IL ("**IL-DRP**") under the IL-DRP Rules ("**Rules**").

On December 23, 2008, the IL-DRP appointed Jonathan Agmon as the sole panelist.

On December 24, 2008 attorney for the Complainant requested a hearing to be held. The Panel informed the parties a hearing is unnecessary in view of the nature of the proceedings (See Preamble to the Rules, Rule13).

On December 29, 2008 the Complainant filed additional supplemental documents.

In accordance with the Rules, on December 30, 2008, the Panel transmitted by email to Respondent a copy of the Complaint and attached materials, providing the Respondent 15 days to respond to the Complaint.

On January 8, 2009, the Respondent submitted his response.

4. Factual Background

On September 30, 2007, the disputed domain name was registered by the Respondent.

The Complainant is a corporation manufacturing tobacco products under the MARLBORO trademark.

The Complainant is the owner of over 40 20 registered trademarks in Israel covering the MARLBORO mark.

The Complainant is one of the leading brands in the tobacco industry and is regarded as one of the best known brands in the world.

The Complainant did not authorize the Respondent to use the MARLBORO mark in any way.

On December 15, 2008 the Complainant's attorney sent the Respondent a cease and desist letter requesting that the Respondent transfer the disputed domain name to the Complainant.

At the time Complainant sent the cease and desist letter, the Respondent was operating a landing/parking web page offering links to various products. This websites also included a statement that the disputed domain name may be for sale by its owner.

On December 22, 2008 the Respondent responded to the cease and desist letter arguing that the disputed domain name was available for the past ten years and that the Internet operates in a system of a free market and that every interested party can register the disputed domain name during that time. Moreover, Respondent provided that the MARLBORO mark is also used as the name for a music festival, the name of a college and the name of various cities and areas in the US. The Respondent further argued that the mark MARLBORO is generic and belongs to the Complainant only in the tobacco field.

The Respondent further argued that there was nothing in the operated website relating to the Complainant, and that no trademark belonging to the Complainant was shown therein. The Respondent further argued that from the time the web site was established a notice appeared thereon that the web site is associated with another body (not connected with the tobacco field) who will establish a web site thereon.

The disputed domain name is currently resolved to a website which shows that it is an extension of the Marlboro College in Israel. Marlboro College is a College of the arts located in Marlboro, Vermont, USA.

5. Parties' Contentions

A. Complainant

Complainant argues he is the owner of various trademarks in Israel for the MARLBORO mark and that the mark BARLBORO is a famous mark in Israel.

Complainant argues that MARLBORO is one of the most famous brands in the world.

Complainant further argues that the disputed domain name is a misleading domain name, and that it is absolutely similar in its main component MARLBORO to the famous and registered mark of the Complainant. Complainant further argues that the disputed domain name is absolutely identical to the Complainant's word mark MARLBORO.

Complainant further argues that the Respondent has no rights of any kind to the word or name MARLBORO or to the registered trademark of the Complainant.

Complainant argues that the Respondent acted in bad faith, trying to obtain registration, and having obtained the registration, for purposes of selling the domain to the highest bidder. The Respondent argued that this is clear from the landing page on which the disputed domain name was offered for sale. Complainant argues that these acts fall within the definition of "Bad Faith" under Rule 4.1(C) of the Rules.

Complainant also argues that the Respondent approached a representative of the Complainant and said that if the Complainant does not purchase the rights to the disputed domain name, the rights shall be sold to another party.

Complainant further argued that the Respondent did not answer to the letter sent to him by registered mail requesting him to transfer the disputed domain name.

Finally, Complainant argued that the Respondent, by his actions, dilutes the trademarks belonging to the Complainant, prevents the Complainant from using the disputed domain name, enriches himself unjustly at the expense of the Complainant, and misleads the public or the average consumer causing him to think that the Complainant is the owner of the disputed domain name.

B. Respondent

The Respondent argued that he registered the disputed domain name on behalf of a business partner who is interested in opening a branch of Marlboro College in Israel. The Respondent further argues that he told his business partner that they should build a website in order to publish it and attract students.

The Respondent argues that a representative of the Complainant in Israel, Mr. Itay Lavi, contacted him two months ago, and claimed the Complainant is considering building a website using the disputed domain name. The Respondent argues that the Complainant through her local importer in Israel offered to buy the disputed domain name for NIS700. The Respondent refused to transfer the disputed domain name and argues he was threatened to be sued by Complainant's representative.

The Respondent further argues that the mark MARLBORO is a generic name, not owned by anybody.

The Respondent argues that the Complainant holds the rights for the MARLBORO name in the context of tobacco only.

The Respondent further argues that the Complainant can build a website under its name or the importer's company "Alyashar Import", or that Complainant can use marlboro-cigarettes.co.il or a similar domain name.

The Respondent further argues that the Complainant had been able to register the disputed domain name for many years but didn't do so, therefore others can use the disputed domain name.

The Respondent argues he never used the disputed domain name in "bad faith" and his intention was never to sell the disputed domain name.

Finally, the Respondent is also questioning the validity of this tribunal and these proceedings stating that "I don't understand the meaning of this mediation which you forcefully made me a part of. If the domain name will be transferred to this person, then this so called "mediation" is legitimizing a theft."

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. Respondent submitted to this process and Rules when he applied for and registered the disputed domain name. The LiveDNS Domain Name Registration Agreement provides that "the [domain name] holder agrees to the jurisdiction of the IL-DRP." (See Section 12.3; see also section 13 - <https://domains.livedns.co.il/Terms.aspx>). 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 interpreting the UDRP) can be used as examples of how previous panels have adopted and interpreted provisions similar to the Rules.

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 ("**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 disputed domain name was made or the disputed domain name was used in bad faith.

A. Same or Confusingly Similar

It is up to the Complainant to show that 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.

The disputed domain name comprises of the word MARLBORO and the suffix .co.il. The suffix .co.il is ignored for the purpose of determination the similarity between the disputed domain name and the 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). The relevant part of the disputed domain name is the word MARLBORO.

The Complainant is a corporation manufacturing tobacco products. One of the Complainant's products is manufactured and sold under the trademark MARLBORO.

The Complainant is the owner of over 40 registered trademarks in Israel covering the trademark MARLBORO. For example, Complainant is the owner of currently valid Israeli trademarks serial number:

14378 for the word mark MARLBORO in class 34, of March 18, 1955;
57401 for the word mark MARLBORO in class 34, of October 21, , 1983;
55497 for the word mark MARLBORO in class 25, of January 9, 1983;
55494 for the word mark MARLBORO in class 18, of
January 9, 1983;
; and
15811 for the mark MARLBORO (logo) in class 34, of January 17, 1957

The MARLBORO mark has been noted to be one of the strongest brands in the world in 2007 and 2008. A survey by INTERBRAND provides that the MARLBORO brand ranks the MARLBORO brand at number 14 in 2007 and number 18 at 2008 with global sales of US\$21,300,000,000.

In another survey by Millward Brown the MARLBORO brand was noted as the 10th strongest brand in the world in 2008.

It is the finding of the Panel that the disputed domain name is identical to the Name/trademarks used and owned by the Complainant.

B. Rights in the Name

Next, it is up to the Complainant to show that Complainant has rights in the Name; and that the Respondent has no rights in the Name.

As noted above the Complainant showed sufficient evidence showing it has rights to the Name and MARLBORO trademark. The registration of a trademark under a disputed domain name has been held by many WIPO panels as sufficient evidence to show that the Complainant has sufficient rights in the Name. (See *Consortio del Formaggio Parmigiano Reggiano v. La Casa del Latte di Bibulic Adriano*, WIPO Case No. D2003-0661)

It is also up to the Complainant to show that the Respondent has no rights in the Name. Complainant has provided that it has not approved for the Respondent to use their trademarks or Name.

While the Complainant bears the "general burden of proof" under Rule 3.3, this burden shifts to the Respondent once Complainant makes a prima facie showing that the Respondent lacks rights or legitimate interests. (See: *Neusiedler Aktiengesellschaft v. Kulkarni*, WIPO Case No. D2000-1769; see also *Dow Jones & Company and Dow Jones LP v. The Hephzibah Intro-Net Project Limited*, WIPO Case No. D2000-0704.)

In this case the Panel finds that the Complainant has indeed made a prima facie showing that the Respondent does not have rights or legitimate interests in the disputed domain name within the meaning of Rule 3.3. This finding is based on the following, non-disputed facts brought forward by the Complainant:

- a. The Complainant has no relationship whatsoever with the Respondent and has never authorized the Respondent to use the disputed domain name or any other domain name;
- b. It can be assumed that the Complainant's trade and service mark are well known, as the Complainant is one of the largest tobacco manufacturers in the world and the Name has been one of the most well known marks in the world and also in Israel;
- c. There is no indication in the file that the Respondent is known under the disputed domain name;
- d. Use of the disputed domain name on behalf of a unknown third party for the purpose of using the disputed domain name for operating an educational entity without showing of an approval or request from such institution, or without making any real bona fides effort relating to such a venture.

It is therefore the finding of the Panel that the Complainant has rights in the Name and that the Respondent has no rights in the Name, and that the Complainant has satisfied the requirements in Rule 3.2 and 3.3.

C. Application and Use in Bad Faith

Finally, it is up to the Complainant to show that the Respondent applied for allocation of the disputed domain name or the disputed domain name was used in bad faith (Rule 3.4).

Rule 4.1 provide a non-exclusive list of circumstances which can be helpful in showing that the Respondent acted in bad faith when he applied for or used the disputed domain name: "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 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

c. 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

d. 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.

Rule 4.1(b) provides that this Panel can find that the Respondent has acted in bad faith if there are circumstances showing that the Respondent has requested allocation of the disputed domain name primarily for the purpose of disrupting the business of a competitor; or circumstances indicating that the Respondent has requested allocation or holds the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name allocation to the complainant who is the owner of the trademark or service mark or to a competitor of that the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name.

In addition Rule 4.1(d) provides that this Panel can find that the Respondent acted in bad faith if there are circumstances showing that the Respondent 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.

As shown by the Complainant, the disputed domain name was used as a landing/parking page before he was contacted by the Complainant. WIPO panels have asserted that the Respondent's bad faith can be illustrated by the domain name's resolution to a PPC parking page with links to websites selling products. WIPO panels held that "[i]f though, the links are based on the trademark value of the domain names, the trend in UDRP decisions is to recognize that such practices generally do constitute abusive cyber squatting (see e.g. *Champagne Lanson v. Development Services/MailPlanet.com Inc.*, WIPO Case No. D2006-0006 (pay per click landing page not legitimate where ads are keyed to the trademark value of the domain name); *The Knot, Inc v. In Knot We Trust, LTD.*, WIPO Case No. D2006-0340 (same); *Brink's Network Inc v. Asproductions*, WIPO Case No. D2007-0353 (same)." (See also to similar effect *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. D2007-1415 and *Alpine Entertainment Group, Inc. v. Walter Alvarez*, WIPO Case No. D2007-1082).

To this panel adds the fact that the Respondent has registered numerous domain names under the .il domain some of which are marks which are easily recognized in Israel as indicating sources other than the Respondent. The list includes the following domain names: leumy.co.il; ynte.co.il; ynwt.co.il; ynrt.co.il; tad2.co.il; twa.co.il; pez.co.il; reebok.co.il; marlboro.co.il; leviev.co.il; bulgari.co.il; benetton.co.il; ealla.co.il; googke.co.il; foogle.co.il; goohle.co.il; uniliver.co.il; and wakka.co.il.

In addition, use of a disputed domain name that is identical to a trademark as a landing/parking website with a possible offer for sale is not a bona fide use if the disputed domain name serves as a "bait" to attract customers to the Respondent's website, rather than merely as a descriptor of the Respondent's products (see e.g. *Adobe Systems Incorporated v. Domains OZ*, WIPO Case No D2000-0057).

In addition, this panel finds the use of the Marlboro College name without support from the Marlboro College itself as additional indication that the Respondent is acting in bad faith. An approval, email or any support from the Marlboro College can be seen as an indication that the Respondent did not receive such authority.

Given these circumstances the Panel finds that there are circumstances showing that the Respondent acted in bad faith as provided in Rule 4.1(b) and 4.1(d) thus, it is the finding of the Panel that the Complainant met the burden of showing that the Respondent registered and used the disputed domain name in bad faith in accordance with Rule 3.4 of the Rules.

7. Decision

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



Jonathan Agmon
Sole Panelist

Date: January 27, 2009