

Decision

[ZA2017-0261]

**.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)**

ADJUDICATOR DECISION

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| CASE NUMBER: | ZA2017-0261 |
| DECISION DATE: | 17 May 2017 |
| DOMAIN NAME | lurpak.co.za |
| THE DOMAIN NAME REGISTRANT: | Akulina Ermakova |
| REGISTRANT'S LEGAL COUNSEL: | n/a |
| THE COMPLAINANT: | Mejeriforeningen Danish Dairy Board |
| COMPLAINANT'S LEGAL COUNSEL: | BrandIT GmbH |
| 2 nd LEVEL ADMINISTRATOR: | ZA Central Registry (CO.ZA) |

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **10 March 2017**. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **13 March 2017**. The SAIPL verified that the Dispute together with the amendment to the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure. On **14 March 2017** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **14 March 2017** ZACR confirmed that the domain name had indeed been suspended.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **17 March 2017**. In accordance with the Regulations the due date for the Registrant's Response was **19 April 2017**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **20 April 2017**.
- c) The SAIPL appointed **Rachel Sikwane** as the Adjudicator in this matter on **28 April 2017**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Complainant is a company incorporated in Denmark.
- 2.2 Lurpak is a Danish brand of butter that is owned by the Complainant. The Lurpak product is sold in over 75 countries around the world.
- 2.3 The Complainant is the registered proprietor of, *inter alia*, International Trade Mark Registration No. 1167472 LURPAK and South African Trade

Mark Registration No. 2012/28851 LURPAK. The Complainant's registered rights in both of these trade mark registrations date back to 2012.

- 2.4 The Disputed Domain Name, lurpak.co.za, was registered on 9 August 2016.
- 2.5 The Disputed Domain Name came to the Complainant's attention and, on 20 February 2017, the Complainant caused a letter of demand to be addressed to the Registrant notifying the Registrant of the Complainant's LURPAK trade mark rights and calling on the Registrant to, *inter alia*, transfer the Disputed Domain Name to the Complainant.
- 2.6 On 20 February 2017, the Registrant responded saying "5000 US\$, we can transfer now, thank you!".
- 2.7 In its further email of 28 February 2017, the Complainant re-iterated its trade mark rights and again called on the Registrant to transfer the Disputed Domain Name to the Complainant, in order to avoid further legal proceedings. The Complainant offered to compensate the Registrant for its "out of pocket expenses" in the amount of 100USD.
- 2.8 On 28 February 2017, the Registrant responded saying "Hello, Anyway my best offer is 2999 US\$, we can transfer it now. Thanks!"
- 2.9 The Complainant proceeded to file the Dispute and request the SAIPL to adjudicate the matter and issue a decision for the transfer of the Disputed Domain Name to the Complainant.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant alleges that the Disputed Domain Name is identical or similar to a name or mark in which the Complainant has rights.
- b) In particular, the Complainant alleges that the Disputed Domain

Name is identical to its LURPAK trade mark, which is registered, *inter alia*, in South Africa and on the WIPO International Register.

- c) The Complainant also alleges that the Disputed Domain Name, in the hands of the Registrant, amounts to an abusive registration.
- d) The Complainant has not found that the Registrant is commonly known by the Disputed Domain Name, nor has it found any evidence that the Registrant has a history of using, or preparing to use, the Disputed Domain Name in connection with the *bona fide* offering of goods and services.
- e) The Complainant alleges that the Registrant was aware of the Complainant's trade mark rights at the time of registering the Disputed Domain Name, given that the Complainant's trade mark rights predate the registration of the Disputed Domain Name.
- f) In addition, when the Complainant contacted the Registrant in February 2017 and alerted it to its registered trade mark rights in the LURPAK trade mark, the Registrant's final response was "my best offer is 2999 US\$". The Complaint alleges that the Respondent's conduct in this regard is indicative of the Registrant's intention to unduly profit from the Complainant's rights and is confirmation that the Disputed Domain Name amounts to an abusive registration.
- g) The Complainant contends further that the Disputed Domain Name points to a pay-per-click website where Internet users are able to find links to websites that relate not only to the Complainant's products, but also to the Complainant's competitors' products.
- h) The Complainant also submits that the Registrant is engaged in registering domain names containing well-known trade marks. To this end, the Complainant furnished a list of domain names that had a matching registrant email address to the Registrant's email address. The domain names that appeared on the list included aircanada.in,

avis.me, dolceandgabana.co.in and flyemirates.fr.

3.2 Registrant

The Registrant did not respond to the Complaint lodged by the Complainant, therefore, no arguments were raised by the Registrant to rebut the Complainant's contentions.

4 Discussion and Findings

Regulation 3 provides that in order to succeed in a domain name dispute based on an alleged abusive registration, a complainant is required to prove, on a balance of probabilities, that the following three elements are present:

- (a) *that the complainant has rights in respect of a name or mark; and*
- (b) *that such name or mark is identical or similar to the domain name in dispute; and*
- (c) *that the domain name in the hands of the registrant is an abusive registration.*

4.1 Complainant's Rights

4.1.1 The Complainant is the proprietor of at least two trade mark registrations (dating back to 2012) for the trade mark LURPAK.

4.1.2 The Registrant has not responded to the Dispute and there is no evidence before the Adjudicator that would give her reason to doubt that the LURPAK trade mark registrations are in force and *prima facie* valid and enforceable.

4.1.3 The Disputed Domain Name consists of only, and in its entirety, the Complainant's LURPAK trade mark. The Disputed Domain Name is identical to the Complainant's LURPAK trade mark.

4.1.4 The Complainant has, therefore, on a balance of probabilities, succeeded in establishing rights in a mark, namely the LURPAK trade mark, that is identical to the Disputed Domain Name.

4.2 Abusive Registration

4.2.1 In the Regulations, an abusive registration is defined as a domain name which either –

(a) was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the complainant's rights; or

(b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the complainant's rights.

4.2.2 Regulation 4 sets out several factors which may indicate that a domain name is an abusive registration. The Complainant has asserted a number of these factors as its grounds for lodging the Dispute.

4.2.3 The Adjudicator notes that the Registrant responded to the Complainant's cease and desist letter by requesting payment of an amount of money that far exceeds any documented "out of pocket expenses" that a domain name registrant would ordinarily incur to register and maintain a domain name.

4.2.4 Regulation 4(1)(a)(i) provides that where there are circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to sell, rent or otherwise transfer the domain name to a complainant or to a competitor of the complainant, or any third party, for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name, such circumstances may indicate that the domain name is an abusive registration.

4.2.5 It is also noted that the Disputed Domain Name resolves to a pay-per-click website that advertises the Complainant's Lurpak product and products belonging to the Complainant's competitors.

4.2.6 Regulations 4(1)(a)(iii) and 4(1)(b) provide that where there are

circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to disrupt unfairly the business of the complainant; or where the registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the complainant, such circumstances may indicate that the domain name is an abusive registration.

- 4.2.7 The Complainant has also presented evidence that the Registrant is engaged in a pattern of making abusive registrations by registering domain names that incorporate various well-known trade marks and brands.
- 4.2.8 Under Regulation 4(1)(c), evidence, in combination with other circumstances indicating that the domain name in dispute is an abusive registration, that the registrant is engaged in a pattern of making abusive registrations may also indicate that the domain name is an abusive registration.
- 4.2.9 The Adjudicator finds that the above actions by the Registrant fall within the scope of the referenced sections of the Regulations.
- 4.2.10 The Registrant has not responded to the Dispute nor led evidence to challenge the Complainant's contentions that have given rise to the Adjudicator's findings.
- 4.2.11 Accordingly, the Adjudicator finds that the above factors indicate, on a balance of probabilities, that the Disputed Domain Name is an abusive registration.

5. Decision

For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, lurpak.co.za, be transferred to the Complainant.

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[RACHEL SIKWANE]

SAIPL SENIOR ADJUDICATOR

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