

Decision

[ZA2017-0262]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0262
DECISION DATE:	2 June 2017
DOMAIN NAME	mozilla.co.za
THE DOMAIN NAME REGISTRANT:	Zhao Ke
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Mozilla Foundation & Mozilla Corporation
COMPLAINANT'S LEGAL COUNSEL:	Hogan Lovells (Paris) LLP
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 **20 March 2017**. On **3 April 2017** the SAIPL transmitted by email to the ZA Central Registry a request for the registry to suspend the domain name at issue, and on **4 April 2017** the ZA Central Registry confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIPL’s Supplementary Procedure.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **6 April 2017**. In accordance with the Regulations the due date for the Registrant’s Response was **10 May 2017**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **11 May 2017**.
- c) The SAIPL appointed **Kelly Thompson** as the Adjudicator in this matter on **17 May 2017**. On **17 May 2017**, the SAIPL appointed **Kareema Shaik** as the Trainee Adjudicator in this matter. The Adjudicator and Trainee Adjudicator have both 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 contested domain name, <mozilla.co.za>, was registered on 8 February 2015. At the date of lodging the Complaint, the domain name resolved to a website displaying sponsored links and a link offering the domain name for sale. The Registrant is Zhao Ke of Weihai Rd. 655, Shanghai, 200041, China.
- 2.2 The Complainants, jointly, are Mozilla Foundation, a non-profit organisation, and its wholly-owned subsidiary, Mozilla Corporation, both of 331 East Evelyn Ave, Mountain View, California, 94041, United States of America (hereinafter collectively referred to as “*the Complainant*”).

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- 2.3 Mozilla Corporation is the worldwide licensee of all Mozilla Foundation's trade marks, including the trade mark on which the Complaint is based i.e. MOZILLA.
- 2.4 The Complainant is the proprietor of the following trade mark registrations:
- 2.4.1 US trade mark no. 2815227 MOZILLA registered on 17 February 2004 in class 9;
- 2.4.2 US trade mark no. 3187334 MOZILLA registered on 19 December 2006 in class 9; and
- 2.4.3 IR no. 974622 MOZILLA registered on 13 August 2008 in class 9.
- 2.5 In addition to its registered trade marks, the Complainant claims to have developed a considerable reputation in its MOZILLA trade mark as a result of having used its mark for a number of years, including in South Africa, and that as a result, it has acquired rights to protect its mark at common law.
- 2.6 The Complainant was founded in 1998 and supports and develops open source software programs. The Complainant states that it is best known for creating the Mozilla Firefox internet browser, which was released in November 2004. The Complainant has received numerous awards, as has its Mozilla Firefox internet browser. The Complainant also owns numerous domain names incorporating MOZILLA, including <mozilla.org>, <mozilla.com> and a number of country code extensions.
- 2.7 According to an article annexed as part of Annex 4 of the Complaint, about 15 to 20% (or almost one million) South African internet users were using the Mozilla Firefox internet browser in about May 2007. Mozilla Firefox was also released in Afrikaans in 2007. It was announced, in November 2014, that Mozilla Firefox OS was expanding to South Africa. The operating system was released locally in April 2015 in four official South African languages, English, Afrikaans, Xhosa and Zulu. Mozilla Firefox internet browser was the 3rd most used web browser in South Africa during the period October 2015 to November 2016, according to StatCounter, a web traffic analysis tool. The Complainant's South African Facebook page was launched on 23 January 2015.
- 2.8 The Complainant submits that its MOZILLA trade mark has acquired well-known

status worldwide and is, therefore, protected in South Africa (and internationally) under Article 6bis of the Paris Convention for the Protection of Industrial Property and in terms of the South African Trade Marks Act no. 194 of 1993.

2.9 The Complainant's use of MOZILLA in South Africa predates the date of registration of the contested domain name, <mozilla.co.za>.

3 Parties' Contentions

3.1 Complainant

- a) The Dispute is based on Regulation 3(1)(a) which requires a complainant to assert that:
 - 3.1(a)(i) it has rights in respect of a name or mark which is identical or similar to the domain name; and
 - 3.2(a)(ii) in the hands of the registrant the domain name is an abusive registration.
- b) Regulation 3(2) requires the Complainant to prove on a balance of probabilities that the elements in paragraph 3.1(a) are present.
- c) The Complainant contends that the contested domain name is identical to the mark in respect of which the Complainant has rights, i.e. MOZILLA.
- d) An abusive registration is defined in Regulation 1 as being a domain name that:

“(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”.
- e) The Complainant contends that, as a result of its trade mark registrations and its reputation in its MOZILLA trade mark, the registration of the domain name constitutes an abusive registration in terms of Regulation 3(1)(a). The

domain name was both registered and has been used in an abusive manner which is taking advantage of and/or causing unfair detriment to the Complainant's rights.

- f) Given the nature of the internet and the Complainant's worldwide reputation in its MOZILLA trade mark, the Complainant contends that the Registrant cannot argue that he did not have knowledge of the Complainant's rights at the time of registering the domain name. The Registrant, therefore, registered the domain name in full knowledge of the Complainant's rights. The Complainant relies on the decisions of Nominet DRS 04331 (<verbatim.co.uk>), eBay Inc. v Sunho Hong, WIPO Case No. D2000-1633 and E. & J. Gallo Winery v Oak Investment Group, WIPO Case No. D2000-1213 to argue that knowledge of a complainant's rights is generally indicative of abusiveness.
- g) The Complainant relies on various factors set out in Regulation 4 which may indicate abusiveness.
- h) The Complainant submits that the Registrant registered the contested domain name primarily to "*sell, rent or otherwise transfer it to the Complainant, for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with the Disputed Domain Name*", in terms of Regulation 4(1)(a)(i). The Complainant relies on the fact that the contested domain name resolved to a website offering the domain name for sale for USD 9999. The Complainant also received two unsolicited emails inviting the Complainant to make an offer to purchase the domain name. Although it is not clear whether the emails emanated directly from the Registrant, the contents thereof indicate strongly that the invitation originated from the Registrant.
- i) The Complainant also submits that, since the contested domain name is identical to the mark in respect of which the Complainant has rights, the Registrant acquired the domain name to:

3.1(i)(i) intentionally block the registration of the domain name by the

Complainant, in terms of Regulation 4(1)(a)(i); and

3.1(i)(ii) prevent the Complainant from exercising its rights, in terms of Regulation

- j) A further contention by the Complainant is that 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, as contemplated in Regulation 4(1)(b). The Complainant submits that the Registrant is using the domain name, which is identical to the Complainant's well-known trade mark, to intentionally attract internet users searching for the Complainant's official South African website and divert them to the Registrant's website.
- k) The Complainant also relies on Regulation 4(1)(c) in that the registration of a domain name may be considered to be abusive where the Registrant is engaged in a pattern of registering domain names. The Registrant has registered a number of domain names incorporating well-known trade marks (including <armani.info>, <barclayscard-us.com> and <dolceandgabbana.net>) and has been involved in over 20 domain name disputes involving third party trade marks. The Complainant furthermore relies on the rebuttable presumption of abusiveness contained in Regulation 4(3) and refers to three WIPO decisions issued against the Registrant in the 12 months before this Dispute was filed, namely *Sopra Steria Group v. Zhao Ke*, WIPO Case No. D2016-0151 (<soprasteriahr.com>), *Arla Foods Amba v. Zhao Ke*, WIPO Case No. DMX2016-0012 (<arlafoods.mx>) and *Rolls-Royce Motor Cars Limited v. Zhao Ke*, WIPO Case No. DMX2016-0006 (<rolls-roycemotorcars.mx>).

3.2 Registrant

- a) The Respondent did not reply to the Complainant's contentions.

4 Discussion and Findings

4.1 Complainant's Rights

4.1.1 We find that the Complainant has rights in respect of the trade mark MOZILLA as contemplated by Regulation 3(1)(a). In our view, the Complainant has tendered evidence sufficient to establish, on a balance of probabilities, a reputation in its MOZILLA trade mark in South Africa and rights to defend its mark at common law. The Complainant has adduced evidence of use of its trade mark in South Africa dating back to at least May 2007. Such evidence is uncontested. In view of this finding, it is not necessary for us to consider whether the Complainant's US and International trade mark registrations also constitute "rights" in terms of the Regulations.

4.2 Abusive Registration

4.2.1 The Complainant relies on, *inter alia*, two factors set out in Regulation 4(1) indicating abusiveness which, in our view, decide the matter.

4.2.2 The Complainant has provided evidence to show that the Registrant registered the domain name primarily to "*sell, rent or otherwise transfer it to the Complainant, for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with the Disputed Domain Name*", in accordance with Regulation 4(1)(a)(i). Such evidence stands uncontested.

4.2.3 The Complainant has also provided sufficient evidence that the Registrant is engaged in a pattern of making abusive registrations as envisaged in Regulation 4(1)(c). Not only has the Registrant registered a number of domain names incorporating third party trade marks, it has also been involved in a number of domain name disputes in which adverse findings were made against it.

4.2.4 Although not referred to in the Complaint, the *proviso* to Regulation 5(c) provides that abusiveness shall be presumed where the domain name is identical to a mark in which a complainant asserts a right. The burden of proof shifts to the registrant to show that the domain name is not abusive. The presumption applies to this Dispute and has not been rebutted.

4.2.5 In the circumstances, we find that the contested domain name is an abusive

registration. Accordingly, we uphold the Complainant's Dispute.

5. Decision

- 5.1 For all the foregoing reasons, in accordance with Regulation 9, we order that the domain name, <mozilla.co.za>, be transferred to the second Complainant (Mozilla Corporation).

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