

Decision

ZA2017 -0264

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0264
DECISION DATE:	30 JUNE 2017
DOMAIN NAME	KAUFLAND.CO.ZA
THE DOMAIN NAME REGISTRANT:	FU WANG
REGISTRANT'S LEGAL COUNSEL:	NONE
THE COMPLAINANT:	KAUFLAND WARENHANDEL GMBH & CO. KG
COMPLAINANT'S LEGAL COUNSEL:	VON SEIDELS
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 "SAIIPL") on **28 April 2017**. On **2 May 2017**, the SAIIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **2 May 2017** ZACR confirmed that the domain name had, indeed, been suspended. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIIPL's Supplementary Procedure.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **3 May 2017**. In accordance with the Regulations the due date for the Registrant's Response was **31 May 2017**. The Registrant did not submit any response, and accordingly, the SAIIPL notified the Registrant of its default on **1 June 2017**.
- c) The SAIIPL appointed **Deon Bouwer** as the Adjudicator in this matter on **9 June 2017**. The Adjudicator has submitted a Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Complainant, a company registered in Germany, belongs to the Kaufland Group of Companies and operates a chain of supermarkets under the KAUFLAND trade mark in Germany, the Czech Republic, Slovakia, Poland, Croatia, Romania and Bulgaria.
- 2.2 The Complainant is the owner of various trade mark registrations for the KAUFLAND trade mark, predominantly in Europe and Asia ("the Kaufland trade mark registrations"). The Complainant holds no trade mark registration

and neither does it trade in South Africa.

- 2.3 The Complainant became aware of the registration of the Disputed Domain Name when the Registrant contacted the Complainant on **24 August 2016**, some two months after the date on which the Disputed Domain Name was registered i.e. **16 June 2016**, enquiring whether the Complainant was "*interested in acquiring*" the Disputed Domain Name.
- 2.4 The Disputed Domain Name is not in use and apart from the Registrant's approach on **24 August 2016**, there is no evidence that the parties have been in communication.
- 2.5 The Complainant now objects to the registration of the Disputed Domain Name.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant submits that it holds rights to the KAUF LAND trade mark, which rights predate the rights of the Registrant, by virtue of the Kaufland trade mark registrations, the fact that its KAUF LAND trade marks "*have already been found to be well-known and of strong reputation in Administrative Proceedings under the UDRP*" and, also, the use of the KAUF LAND trade mark on websites "*run*" by the Complainant.
- b) The Complainant further submits that the Disputed Domain Name is identical to its KAUF LAND trade mark.
- c) The Complainant also submits that the Registrant has registered the Disputed Domain Name, primarily, to:
 - i. Sell or otherwise transfer the domain name to the 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;
- ii. Block intentionally the registration of the domain name by the Complainant;
 - iii. Disrupt unfairly the business of the Complainant; and/or
 - iv. Prevent the Complainant from exercising its rights in that the Complainant is prevented from registering its identical trade mark as a domain name and operating its website from such domain name.
- d) Additionally, the Complainant asserts that the Registrant is using, or has registered, the Disputed Domain Name in a way that leads people or businesses to believe that the Disputed Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- e) The Complainant, accordingly, submits that the Disputed Domain Name is an abusive registration.

3.2 Registrant

- a) The Registrant is in default and has filed no papers.

4 Discussion and Findings

- a) The Registrant did not submit any response to the Complaint and the Adjudicator must therefore accept *prima facie* the veracity of the Complainant's allegations. The Adjudicator must, however, analyse the Complainant's version in order to satisfy himself that the allegations contained in the Complaint are acceptable and probably true (see ZA2007/0010 Multichoice Subscriber Management vs J P Botha and ZA2012/0117 Antonie Goosen vs SARS).

- b) Regulation 3(1)(a) requires a Complainant to prove each of the following elements on a balance of probabilities in order for the Disputed Domain Name to be transferred on the basis that it is an abusive registration, namely that:
- i) The Complainant has established rights in respect of a name or mark; and
 - ii) The name or mark in which the Complainant has rights is identical or similar to the Disputed Domain Name; and
 - iii) In the hands of the Registrant, the Disputed Domain Name is an abusive registration.
- c) Regulation 1 defines "*rights*" and "*registered rights*" to "*include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law, but are not limited thereto*".
- d) The above definition is broad and the term "*rights*" is clearly not restricted to rights founded on the principles of trade mark law, only, but recognises rights going beyond those in terms of the Trade Marks Act No. 194 of 1993 or common law trade mark rights. Such rights must, however, find recognition in law in South Africa (see ZA2007-0008 privatesale.co.za).

4.1 Complainant's Rights

4.1.1 Although the Complainant holds no statutory or common law trade mark rights in the KAUF LAND trade mark in South Africa, it holds various trade mark registrations in Europe.

4.1.2 Furthermore, although the Complainant did not submit any evidence confirming that it had used the KAUF LAND trade mark or that the KAUF LAND trade mark has received any exposure in South Africa prior to the date on which the Registrant registered the Disputed Domain Name, it is clear from the evidence that the Complainant has used the KAUF LAND mark, extensively, in various countries in Europe

and Asia.

4.1.3 The Adjudicator considers himself bound by the decision of the appeal panel in Xnets.co.za ZA20110077, where the panel stated as follows:

"5(c) It is not necessary for present purposes to quantify, or qualify, where the line is to be drawn as to when 'rights' can be said to exist on the part of a Complainant or when they do not. As was stated by the majority panel in www.seido.co.za ZA20090030 (Appeal decision AD) at paragraph 5.7:

'The extent or strength of the "right", as defined in the Regulations, require to be shown by a Complainant to have locus standi conferred on it on a balance of probabilities under Regulation 3(1)(a) is not clear but we have been guided by earlier decisions on this point. (See WIPO Decisions Surfcult.com [2002 – 0381] and Dinkybomb.com [D 2004 – 320] and SAIPL Decisions Suncityvacations.co.za [ZA20080023] and Bikeandleisuretrader.co.za [ZA20080018]). Our view is that the threshold in this regard should be fairly low ' [Emphasis added]

(d) As has been recorded by Nominet Advisory the main point of the test is to make sure that the person who complains is someone with a proper interest in the complaint. The notion of "rights" for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. By definition, rights include "intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African Law, but is not limited thereto". An indication of the quality (or quantification) of rights is indicated by the WIPO Decisions to the effect that the location of a registered trade mark is irrelevant when finding "rights" in a mark for the purposes of a complaint.

(e) "These rights acquired in the United States are relevant for this

administrative proceeding, although the complainant is from the Cayman Islands and the Respondent from Thailand. As indicated by the panel in Bennet Coleman and Co. Ltd vs Steven S Lallwani, WIPO case no.D2000-0014 and Bennet Coleman and Co. Ltd vs Long Distance Telephone company, WIPO case no. D20000015, "the essence of the domain name registration may be questioned by comparing it to a trade mark registered in any country"

4.1.4 The Disputed Domain Name, clearly, incorporates the Complainant's mark KAUFLAND in its entirety, and is the dominant and only distinctive feature of the Disputed Domain Name. The Adjudicator accordingly finds that the Disputed Domain Name is similar to the Complainant's KAUFLAND mark as required in terms of Regulation 3(a).

4.1.5 In view of the above, the Adjudicator finds that the Complainant has established that it holds rights in respect of the KAUFLAND trade mark, which is identical to the Domain Name. The Complainant therefore has *locus standi* to lodge the Complaint.

4.2 **Abusive Registration**

4.2.1 "Abusive Registration" is defined in the Regulations to mean a domain name which either –

i. 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

ii. 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(1) provides for a number of grounds (non-exhaustive) which may indicate that the Disputed Domain Name is an abusive registration.

4.2.3 In the absence of any explanation by the Registrant as to why he holds a *bona fide* interest in the Disputed Domain Name which incorporates the distinctive KAUF LAND trade mark, in which the Complainant holds rights, there can, in the circumstances, be no doubt that, as the Complainant submits, the Registrant registered the Disputed Domain Name either to: -

- i. Sell or otherwise transfer the domain name to the 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; or
- ii. Block intentionally the registration of the domain name by the Complainant; or
- iii. Disrupt unfairly the business of the Complainant; and/or
- iv. Prevent the Complainant from exercising its rights in that the Complainant is prevented from registering its identical trade mark as a domain name and operating its website from such domain name.

5. Decision

5.1 For all the foregoing reasons, the Adjudicator finds that the Disputed Domain Name is an abusive registration and, in accordance with Regulation 9, orders that the Disputed Domain Name be transferred to the Complainant.

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DEON BOUWER

SAIIPL SENIOR ADJUDICATOR

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