

Decision

[ZA2013-0135]

.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA2013 - 0135
DECISION DATE:	7 June 2013
DOMAIN NAME	electroluxcentralvac.co.za
THE DOMAIN NAME REGISTRANT:	Johan Van Zyl
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	AB Electrolux (Sweden)
COMPLAINANT'S LEGAL COUNSEL:	Kristian Elftorp Melbourne IT Digital Brand Services AB
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIIPL”) in terms of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIIPL’s Supplementary Procedure on **2 April 2013**. On **3 April 2013** SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on the same day UniForum SA confirmed that the domain name had indeed been suspended.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **5 April 2013**. In accordance with the Regulations the due date for the Registrant’s Response was **7 MAY 2013**. The Registrant did not submit any response, and accordingly, the SAIIPL notified the Registrant of its default on the **8 MAY 2013**.
- c) The SAIIPL appointed **Vanessa Lawrance** as the Adjudicator in this matter on **21 May 2013** and **Sizwe Snail Ka Mtuze** was appointed as Trainee Adjudicator in this matter on **21 May 2013**. The Adjudicator and Trainee Adjudicator have submitted their Statements of Acceptance and Declarations 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, AB Electrolux, is a Swedish company that is recognised world-wide as a producer of appliances and equipment for kitchen and cleaning. These products are also sold in South Africa. The Complainant is represented in these proceedings by Melbourne IT Digital Brand Services AB.
- 2.2 The Complainant produces and sells appliances under brand names such as ELECTROLUX, AEG, AEG-ELECTROLUX.

2.3 The disputed domain name, **electroluxcentralvac.co.za**, wholly incorporates the name ELECTROLUX, which the Complainant alleges is protected by the South African Trade Marks Act and the common law.

2.4 In response to a letter of demand to the Registrant on 17th September 2012, it demanded payment from the Complainant of an amount of US\$12 000 in exchange for the transfer of ownership.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant claims that its trade mark ELECTROLUX has, due to extensive and long-term use, acquired a reputation and international recognition. The Complainant claims that the trade mark ELECTROLUX has acquired the status of an internationally well-known trade mark.
- b) The Complainant contends that the domain name complained of is identical or similar to a name or mark in which the Complainant has rights as envisaged in Regulation 3(1)(a). The Complainant continues to state that a dominant part of the domain name **electroluxcentralvac.co.za** comprises the word **Electrolux**, which is identical to the registered trade mark **ELECTROLUX**, which has been registered by the Complainant as a trade mark and domain names in numerous countries all over the world.
- c) It appears from the evidence that the complainant has registered the trade mark **ELECTROLUX** as a word and figure mark in several classes worldwide, including in South Africa.
- d) The Complainant also registered domain names incorporating "**ELECTROLUX**" in many jurisdictions.
- e) The Complainant alleges that the disputed domain name was registered and has been used in a manner which takes unfair

advantage of, or is unfairly detrimental to, the Complainant's rights and is accordingly an abusive registration in accordance with the Regulations.

- f) The complainant contends that the addition of the suffixes "central" and "vac" is not relevant and will not have any impact on the overall impression given by the dominant part of the domain name, ELECTROLUX: the Complainant's instantly recognizable, world-famous trade mark. The Complainant contends that the inclusion of the words "central" and "vac" does not reduce the risk of confusion.
- g) Furthermore it contends that the addition of the country code top-level domain (ccTld) "co.za" does not have any impact on the overall impression of the dominant portion of the Domain Name and is therefore irrelevant to determine the confusing similarity of the domain name to its trade mark.
- h) The Complainant alleges that there is a considerable risk that the trade public will perceive the domain name complained of either as a domain name owned by the Complainant somehow commercial related to the Complainant.
- i) The domain name exploits the goodwill and the image of the trade mark, which it submits may result in dilution and other damage for the Complainant's trade mark.
- j) The Complainant submits that the Registrant's request for payment of US\$12 000 in exchange for transfer of ownership of the domain name, an amount clearly exceeding the Registrant's out of pocket expenses, is evidence of the fact that his registration of the domain name is abusive.
- k) Furthermore the Complainant submits that the domain name is not used in connection with a *bona fide* offering of goods or services. The

domain name was previously connected to a web site offering genuine ELECTROLUX products for sale, thus conveying the false impression that the Registrant is an authorized dealer for the Complainant's products.

- l) The website presently linked to the domain name complained of promotes and offers for sale products of the Complainant's competitors.
- m) The Complainant concludes that the domain name complained of in the hands of the Registrant is an abusive registration in terms of Regulation 3(1)(a).

3.2 Registrant

- a) The Registrant did not submit any response to the Complaint. The adjudicator must therefore *prima facie* accept the veracity of the Complainant's allegations.
- b) That having been said it is established practice that the Adjudicator must analyse the Complainant's version in order to satisfy herself that the allegations contained in its Complaint are acceptable and probably true (**ZA2007-0010 Multichoice Subscriber Management v JP Botha and Antonie Goosen v SARS ZA2012-0117**).

4 Discussion and Findings

4.1 Complainant's Rights

It is accepted that the Complainant has rights in the trade mark ELECTROLUX and it is a well-known international trade mark, which is identical or similar to the domain name in dispute.

4.2 Abusive Registration

- 4.2.1 **In the WIPO UDRP decision of D2009-0777 AB Electrolux v. Ilgaz Fatih Micik, to which the Complainant referred, relating to the**

domain name <electrolux-aeg-servisi.com>, the panel decided that the Respondent's addition of the generic term “service” did not reduce the possibility of confusion, citing the previous decisions of Sanofi-aventis, Sanofi-Aventis Deutschland GmbH v. Andrey Mitrofanov, WIPO Case No. D2007-1772; and Giata Gesellschaft für die Entwicklung und Vermarktung interaktiver Tourismusanwendungen mbH v. Keyword Marketing, Inc., WIPO Case No. D2006-1137.

- 4.2.2 It is a well-established legal principle that a domain name that comprises a trade mark coupled with a generic term, is still confusingly similar to the trade mark. In this regard, the Adjudicator refers to the SAIPL decisions **ZA2007-0003 Telkom SA Limited v Cool Ideas 1290 CC and ZA2007-0004 Telkom SA Limited and TDS Directory Operations (Pty) Ltd v The internet Corporation.**
- 4.2.3 With the above in mind, it appears that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.
- 4.2.4 The Respondent's use of a domain name confusingly similar to the Complainant's ELECTROLUX trade mark increases the likelihood that internet users would be confused, and associate the disputed domain name with Complainant (see **ZA2007-0006 Standard Bank v Daniel Cox**).
- 4.2.5 The registrant's attempt to sell the domain name to the Complainant for \$12000 is an act evidencing an abusive registration. Reference is made to the decision **D2001-0243 Booz-Allen & Hamilton Inc. v. Servability Ltd** as well as **ZA2007-0003 Telkom SA Limited v Cool Ideas 1290 CC**.
- 4.2.6 Against this background, it appears that the disputed domain name is an abusive registration in terms of Regulation 4(1).

5. Decision

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

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