

Decision

ZA2013 - 0139

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2013 – 0139
DECISION DATE:	28 June 2013
DOMAIN NAME	monsterenergy.co.za
THE DOMAIN NAME REGISTRANT:	Infinite Trading 81 CC
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Monster Energy Company
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
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") on **16 April 2013**. On **17 April 2013** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **17 April 2013** UniForum SA confirmed that the domain name had indeed been suspended. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amended dispute on **25 April 2013**. The SAIPL verified that the amended 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 **25 April 2013**. In accordance with the Regulations the due date for the Registrant's Response was **24 May 2013**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **4 June 2013**.
- c) The SAIPL appointed **Victor Williams** as the Adjudicator in this matter on **13 June 2013**. 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 Registrant registered the disputed domain name, monsterenergy.co.za, on 5 September 2007. The Complainant claims to have rights in the trade

mark MONSTER ENERGY, and that the disputed domain name, monsterenergy.co.za, which is identical to its trade mark, is accordingly abusive.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant claims to have various registrations for the trade marks MONSTER and MONSTER ENERGY in South Africa and worldwide.
- b) The Complainant also claims to have made extensive use of the MONSTER and MONSTER ENERGY trade marks, since approximately 2002.
- c) It appears, however, that the Complainant only adopted the corporate name Monster Energy Company with effect from 5 January 2012. Its former name was Hansen Beverage Company D/B/A Monster Beverage Company.
- d) It appears furthermore that the MONSTER ENERGY trade mark is used worldwide and, since 2008, also in South Africa. Not only are MONSTER ENERGY drinks sold, but the Complainant sponsors, under the name MONSTER ENERGY, various athletic competitions and athletes worldwide.
- e) The monsterenergy.com website was launched on 19 August 2003 and, between 1 September 2010 and 1 October 2012, this site had in excess of 72 000 visits from South Africa.
- f) Although the Complainant only sold its MONSTER ENERGY drink in

South Africa from 2008, its first application for registration of the MONSTER trade mark was made in class 32 in June 2004, and proceeded to registration in May 2007.

- g) The Complainant claims that it has rights in the MONSTER ENERGY trade mark, which is identical to the domain name complained of. Because of the identity of the disputed domain name and the Complainant's MONSTER ENERGY trade mark, the Complainant claims that the burden is shifted to the Registrant to show why the disputed domain name is not abusive.
- h) There is no relationship between the Complainant and the Registrant.

3.2 Registrant

- a) The Registrant did not answer the Complainant's contentions.

4 Discussion and Findings

- a) Because the Registrant did not submit any response to the Complaint, the Adjudicator must *prima facie* accept the veracity of the Complainant's allegations. That having been said, it is established practise that the Adjudicator must analyse the Complainant's version in order to satisfy himself that the allegations contained in the Complaint are acceptable and probably true (reference is made to ZA2007/0010 Multichoice Subscriber Management vs J P Botha and ZA2012/0117 Antonie Goosen vs SARS).
- b) The domain name complained about what was registered on 5 September 2007. To succeed, it accordingly falls upon the Complainant to prove rights in the name MONSTER ENERGY existing in South Africa prior to 2007.

4.1 Complainant's Rights

- 4.1.1 The Adjudicator finds that there is no evidence that the Complainant's reputation in its MONSTER ENERGY trade mark spilled over to South Africa prior to the date of registration of the disputed domain name. It can accordingly not be found that the Complainant had a prior reputation or common law rights in its trade mark in this country. This does not mean that no one in this country was aware of the MONSTER ENERGY trade mark prior to September 2007.
- 4.1.2 On 21 June 2004, the Complainant filed application for registration of the trade mark MONSTER in class 32 in respect of "beverages, including, carbonated soft drinks, carbonated drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, carbonated and non-carbonated energy or sport drinks, non-carbonated tea, fruit juice drinks, water and nutritional supplements". This trade mark proceeded to registration on 16 May 2007 and, at that date, the Complainant acquired rights in the trade mark MONSTER in class 32 dating back to 21 June 2004, namely before the disputed domain name was registered.
- 4.1.3 The disputed domain name contains the word "MONSTER" together with the descriptive term "ENERGY". This is not a likely combination of words, and it seems to indicate knowledge, on the part of the Registrant at the time of registering, of the Complainant's use of MONSTER ENERGY in respect of its beverages. The Registrant provided no alternative reason why this domain name was chosen (if it were not to take advantage of the rights of the Complainant in the trade mark MONSTER (or MONSTER ENERGY), as was claimed on behalf of the Complainant).

4.1.4 Although the Complainant had not started using the trade mark MONSTER ENERGY in South Africa by the time the disputed domain name was registered, it had commenced making fairly wide use of this mark in other countries worldwide about five years previously. It is, accordingly, possible that the Registrant became aware of the Complainant's trade mark and registered the corresponding domain name to obtain some sort of advantage therefrom. The Complainant made this claim in its complaint and the Registrant did not respond thereto.

4.2 Abusive Registration

4.2.1 Although having been granted the opportunity to explain why it chose to register a domain name identical to the Complainant's trade mark, the Registrant has not done so.

4.2.2 The Adjudicator is not convinced that the onus to prove that the domain name registration is NOT abusive has shifted to the Registrant (in light thereof that no prior rights in the trade mark MONSTER ENERGY-but only MONSTER- have been proved to exist prior to the registration of the disputed domain name).

4.2.3 However, MONSTER ENERGY is certainly a mark that the Complainant now has rights in. For as long as the Registrant holds the domain name monsterenergy.co.za, the Complainant will not be able to attract custom to its product using the domain name corresponding to its trade mark in the co.za domain space. The registration of the disputed domain name accordingly presents an obstacle to the Complainant's business in this country. In addition, the Complainant is prevented from exercising its right to register the

co.za domain name corresponding to its trade mark.

4.2.4 On the balance of probabilities, therefore, and in light thereof that no reason for its registration was given, it is found that the domain name registration is abusive. The Adjudicator accordingly finds in the Complainant's favour.

5. Decision

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

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VICTOR WILLIAMS
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za