

## Decision

**[ZA2015-0215]**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2015-0215</b>
DECISION DATE:	<b>9 November 2015</b>
DOMAIN NAME	<b>agilent.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Satish Jamgade</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>Agilent Technologies Inc</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Adams and Adams (Nishi Chetty)</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA )</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **04 September 2015**. On **07 September 2015** the SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **14 September 2015** the 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 **16 September 2015**. In accordance with the Regulations the due date for the Registrant's Response was **15 October 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **15 October 2015**.
- c) The Complainant did not submit any formal Reply as none was necessary.
- d) The SAIPL appointed **NOLA BOND** as the Adjudicator in this matter on **29 October 2015**. 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 AGILENT TECHNOLOGIES, INC. The Complainant was created in 1999 and according to the Complainant's uncontested facts is a leader in the life sciences, diagnostics and applied chemical markets.
- 2.2 The Complainant is the proprietor of the following South African trade mark

registrations and application:

- Trade mark registration no. 1999/20269 AGILENT in class 09
- Trade mark registration no. 1999/20272-7 AGILENT in classes 16, 35, 36, 37, 41 and 42.
- Trade mark registration no. 2013/02879 AGILENT in class 05;
- Trade mark registration no. 2013/03308 AGILENT in class 10; and
- Trade application no. 2014/15708 AGILENT in class 01.

2.3 The Complainant is the proprietor of the following domain names:

- agilent.com;
- agilent.co.in;
- agilent.co.uk;
- agilent.co.nz; and
- agilent.nz.

From the respective domain names and hosted webpages, the Complainant provides information regarding its products, services and details of its representatives in various countries throughout the world.

2.4 It was submitted by the Complainant that as a result of their extensive marketing, advertising and use of the mark AGILENT in South Africa and internationally, the trade mark, AGILENT, is classified as a well-known mark within the meaning as provided for by the Paris Convention. In support of the contention the Complaint refers to two international cases involving the Complainant. Namely WIPO Case no. **D2007/1799** and the decision of the National Arbitration Forum in *Agilent Technologies v Gelmangroup LLC, Nat. Arb Forum Dec 24 2001*, wherein it was found by the Adjudicators that the mark AGILENT was well known.

The Complaint also claims common law rights to the mark AGILENT in South Africa as a result of its extensive use of the mark in South Africa.

2.5 On 13 August 2015, the Registrant contacted the Complainant with the view to sell the domain name, AGILENT.CO.ZA, to the Complainant.

The Complainant did not forward a letter of demand to the Registrant advising that the domain name wholly incorporated its registered trade mark. However, a representative of the Complainant contacted the Registrant on 14<sup>th</sup> August 2015 and inquired what the purchase price for the domain name was.

On 14<sup>th</sup> August 2015, the Registrant contacted the Complainant's representative and advised that the price for the domain name would be €4300.00. The amount equated to approximately R64 000.00 at the exchange rate on the day of offer.

On 28<sup>th</sup> August 2015, the Complainant received a follow up email from the Registrant advising that should the domain name be sold to a third party, the domain name would not be available again.

The Complainant did not contact the Registrant further and moved forward with the current domain name dispute.

### **3 Parties' Contentions**

#### **3.1 Complainant**

a) The Complainant contends that the Registrant's domain name AGILENT.CO.ZA is identical to the Complainant's registered trade mark, AGILENT, as the domain name wholly incorporates the Complainant's trade mark, AGILENT.

The Complainant also contends that the domain names are identical or similar to marks in which they have common law rights. Such

rights fall within the Regulation 3(1)(a) as held in ZA2007-0001.

- b) The Complainant contends that as a result of its extensive use , reputation and registered rights in the mark, AGILENT, the registration of the domain name by the Registrant constitutes an abusive registration in terms of Regulation 3(1)(a) in that the Registrant has registered the domain name primarily to:
- 1) 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 [Regulation 4(1)(a)(i)];
  - 2) Block intentionally the registration of a name or mark in which the Complainant has rights [Regulation 4(1)(a)(ii)];
  - 3) Disrupt unfairly the business of the complainant [Regulation 4(1)(a)(iii)] by preventing the Complainant or its authorised users from operating a website from the domain;
  - 4) Mislead people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant [Regulation 4(1)(b)];
  - 5) Prevent the Complainant from exercising its rights; [Regulation 4(1)(a)(iv)]
- c) The Complainant, furthermore, submits that the registration of the domain name was abusive in that the Registrant failed to provide complete contact details [Regulation 4(1)(d)].
- d) The Complainant also drew the Adjudicator's attention to the fact that the Registrant has registered a further 18 domain names

incorporating various registered trade mark and the ccTLD “CO.ZA”. The Complainant avers that in terms of Regulation 4(1)(c) the registration of a domain name may be considered to be abusive where the Registrant is engaged in a pattern of registering domain names.

### **3.2 Registrant**

- a) The Registrant failed to submit any response to the Complainant’s contentions.

## **4 Discussion and Findings**

### **4.1 Complainant's Rights**

4.1.1 The Complainant is the proprietor of the registered trade mark, AGILENT in South Africa. The Complainant’s statutory rights in the mark, AGILENT, date back to 01 November 1999. As such, the Complainant’s rights in the mark, AGILENT, predate the registration of the domain name, AGILENT.CO.ZA, on 12 August 2015.

The domain name, AGILENT.CO.ZA is identical to the Complainant’s trade mark registration for the trade mark, AGILENT. The domain name contains no further elements.

### **4.2 Abusive Registration**

4.2.1 An abusive registration means 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 Complainants' rights.

The Complainant is required to prove, on a balance of probabilities, that the required elements are present and that the registration of the domain name is abusive.

4.2.2 However, in terms of Regulation 5(c) "*the burden of proof shifts to the Registrant to show that the domain name is not an abusive registration if the domain name (not including the first and second level suffixes) is identical to the mark in which the Complainant asserts rights, without any addition;*"

4.2.3 Regulation 5(c) therefore creates a rebuttable presumption that a domain name registration is abusive if it is identical to the Complainant's registered trade mark without any additions. In such circumstances, the Registrant is required to show that the domain name is not abusive. Regulation 5, as referred to by the Appeal Adjudicators in Case No. ZA2011-0078, provides a non-exhaustive list of factors which the Registrant may raise to indicate that the disputed domain name is not an abusive registration.

The Registrant has failed to enter any evidence to rebut the presumption that the registration of the domain name, AGILENT.CO.ZA, is abusive. As such, the Adjudicator holds that the registration is presumed to be abusive by virtue of the fact that it is identical to the Complainant's registered trade mark without any further additions.

#### 4.3 The Complainant's Contentions

4.3.1 It is not necessary to deal in detail with the Complaint's averments regarding the abusive nature of the registration of the domain name,

AGILENT.CO.ZA, as the Registrant has failed to discharge the onus placed upon him by Regulation 5(c) and therefore the domain name registration is presumed to be abusive by virtue of the fact that it wholly incorporates a registered trade mark without any further addition.

That being said, it is important to note that from the evidence before the Adjudicator it is evident that the Registrant's primary intention in registering the domain name, AGILENT.CO.ZA, was to sell the domain name back to the Complainant for an exorbitant amount far in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name. The Registrant was evidently aware of the Complainant's rights and by attempting to sell the domain name to the Complainant for an excessive amount clearly acted in bad faith.

Furthermore, the Complainant's contention that the Registrant is engaged in a pattern of registering domain names in which he has no legitimate rights is further noted. In WIPO case D2008-1560, the Panel took into account the conduct of the Respondent and the fact that he was or had been involved in a number of domain name disputes. In holding that the Respondent had registered and was using the domain name in bad faith, the Panel stated that the Respondent "*has engaged in a pattern of conduct involving the disregard of the trademark rights of others.*" In Nominet case DRS 002806, the Expert found that the Registrant's conduct in registering multiple domain names which contained a registered trade mark constituted a pattern of conduct.

From the evidence presented by the Complainant, it appears that the Registrant has registered a number of domain names incorporating

South African registered trade marks and/or well known trade marks. As held by this Adjudicator in Case no. ZA2015-0209, the registration of a plethora of domain names incorporating registered trade marks cannot simply be ignored or put down to pure co-incidence. Such behaviour must be identified where relevant and discouraged. The Adjudicator therefore holds that the Registrant appears to be engaging in a practice of registering domain names which contain South African registered trade marks. Such conduct is abusive and the Adjudicator therefore finds on a balance of probabilities that the registration of the domain name, AGILENT.CO.ZA is abusive taking into account the provisions of Regulation 4(1)(c).

## 5. Decision

- 5.1 For all the foregoing reasons, and in accordance with Regulation 9, the Adjudicator orders that the domain name, AGILENT.CO.ZA be transferred to the Complainant.

.....  
**Nola Bond**  
SAIIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)