

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0202
DECISION DATE:	24 August 2015
DOMAIN NAME	leecooper.co.za
THE DOMAIN NAME REGISTRANT:	Marcel Richman
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Red Diamond Holdings SarL
COMPLAINANT'S LEGAL COUNSEL:	Spoor & Fisher
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZACR (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **15 June 2015**. On **17 June 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 **17 June 2015** ZACR confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute [together with the amendment to 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 **22 June 2015**. In accordance with the Regulations the due date for the Registrant's Response was **20 July 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **22 July 2015**.
- c. The SAIPL appointed **Janusz F Luterek** as the Adjudicator in this matter on **30 July 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

- a. Complainant is the owner of various LEE COOPER trade marks in respect of clothing and fashion (accessories) in general. LEE COOPER represents a global brand and a company that has been in business since 1908.
- b. Complainant is the proprietor of a number of registered trade marks in respect of LEE COOPER, some dating back to 1976.

3) Parties' Contentions

a. Complainant

- i. In September 2014 a letter of demand was sent to the Registrant, advising that the use of the LEE COOPER trade mark by the Registrant in relation to the domain name constituted an infringement of the Complainant's registered LEE COOPER trade marks.
- ii. After multiple exchanges of correspondence between the Complainant's attorneys, the Complainant's licensee in South Africa (i.e. Lonstein Fashion) and the Registrant, the Registrant provided confirmation by email that the www.leecooper.co.za website had been removed. This confirmation was subsequently communicated by Lonstein Fashion to the Complainant's attorney, accordingly the www.leecooper.co.za website is currently inactive.
- iii. On 29 October 2014, the Complainant's attorneys issued a transfer ticket, in respect of the leecooper.co.za domain name, which was never accepted by the Registrant. In light of the above, on 14 November 2014, the Complainant's attorneys addressed correspondence to the Registrant, enquiring as to his availability to re-issue a transfer ticket.
- iv. The Registrant failed to respond to the aforesaid correspondence and thus on 9 December 2014, the Complainant's attorneys addressed correspondence to the Registrant requesting that he cooperate by transferring the domain name to the Complainant.
- v. On 9 December 2014, the Complainant's attorneys received correspondence from the Registrant advising as follows:

*"There is a standard ZAR25 000.00 excl. VAT transfer fee applicable to all domain transfers.
Please forward the invoice details you wish to utilise."*

- vi. To date no explanation has been provided by the Registrant as to the purpose of the demanded amount, however, the Complainant has determined that this is not an official fee payable to the Registry.
- vii. On 24 February 2015, the Complainant's attorneys offered USD900 for the immediate transfer of the domain name. The USD900 was offered to the Registrant to ensure that he was at least sufficiently compensated for his out-of-pocket expenses in initially registering and/or renewing the offending domain name. This offer was rejected and the original demand for ZAR25 000.00 was restated as being not negotiable.
- viii. In light of the above, and due to the fact that the Registrant is holding the domain name at ransom, the Complainant has stated that it has no other option than to file this complaint.
- ix. The Complainant submits that the domain name is identical to a trade mark in which it has rights (3(1)(a)) and the Registrant has registered the offending domain name in a manner which, at the time when it was registered, took unfair advantage of and was unfairly detrimental to the Complainant's rights.

b. Registrant

- i. The Registrant as a Respondent did not reply to the Complainant's contentions.

4) Discussion and Findings

a. Complainant's Rights

- i. Complainant has rights in respect of a name or mark which is identical or similar to the domain name in dispute, for example, LEE COOPER B76/3521.

- ii. It is to be noted that each registration is in respect of the name LEE COOPER in block letter form. There is thus no other matter as part of any of the registrations which detract from or dilute the distinctiveness of the trade mark LEE COOPER. In addition, the Complainant's registrations for the trade mark LEE COOPER are in relation to an array of goods all of which in some form relate to clothing and fashion (accessories) in general.
- iii. In support of its submission, the Complainant refers to SAIPL Decision ZA2007-0007 at para 4.7, wherein the Panel states that:

" The name forming the subject of the domain name in question is the mark FIFA. This is identical to the mark in which the Complainant had alleged registered and common-law rights, and which the adjudicator find established for the purposes of this complaint. This shifting of the burden disposes of the matter, in that the Registrant has not responded to the complaint."

The Adjudicator concurs with the view in this decision and its applicability in the present complaint since the Registrant has not responded to the complaint.

b. Abusive Registration

- 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.
- ii. Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.
- iii. The offending domain name was registered on 22 June 2010. The Complainant was incorporated in 1908 and commenced selling its product into the South African market since at least 2000, approximately 10 years prior to the registration of the offending domain name. The Complainant has since at least 2000 made

extensive use of the LEE COOPER trade mark in South Africa and its earliest South African registration dates back to 1976. Clearly the Complainant's rights and, in particular, its statutory and common law rights in the LEE COOPER trade mark pre-date the Registrant's registration of the offending domain name.

- iv. The registration of the disputed domain name, which is so similar to the LEE COOPER trade mark, by the Registrant, has the effect that the Complainant is barred from registering or using the disputed domain name for itself. The Adjudicator is in agreement with the WIPO UDRP decision of Red Bull GmbH vs. Harold Gutch where the Panel found that the mere registration of a domain name that contains the well-known mark of another effectively prevents the trade mark owner from reflecting their distinctive and well-known mark in the corresponding domain name.
- v. The circumstances relating to the registration of the disputed domain name in the name of the Registrant are unknown and since the Registrant has failed to respond to the Complaint, the only conclusion that can be drawn is that the Registrant was never within his rights to register the disputed domain name in its own name. Thus, in terms of Regulation 5(c) the burden to show that the registration was not abusive shifts to the Registrant, who as stated previously failed to respond and has not discharged that burden.
- vi. Thus, under the circumstances there is sufficient evidence indicating that the Registrant has registered or otherwise acquired the domain name in an abusive manner in accordance with Regulation 4(1):
 1. to block intentionally the registration of a name or mark in which the Complainant has rights;
 2. to disrupt unfairly the business of the Complainant; or
 3. to prevent the Complainant from exercising his, her or its rights.

vii. Thus, under all the circumstances the registration of the domain LEECOOPER.CO.ZA is held to be abusive.

c. Offensive Registration

i. NOT APPLICABLE

5) Decision

a. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, LEECOOPER.CO.ZA be transferred to the Complainant.

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Janusz F Luterek
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za