

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0217
DECISION DATE:	9 November 2015
DOMAIN NAME	rainbow-vacuumcleaners.co.za rainbowvacuumcleaners-sa.co.za rainbowvacuumcleaner.co.za
THE DOMAIN NAME REGISTRANT:	Marglo
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Rexair LLC
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
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 "SAIPL") on **17 September 2015**. On **18 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 **18 September 2015** ZACR confirmed that the domain names had indeed been suspended. The SAIPL verified that 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 **21 September 2015**. In accordance with the Regulations the due date for the Registrant's Response was **20 October 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **21 October 2015**.
- c. The SAIPL appointed **Janusz F Luterek** as the Adjudicator in this matter on **28 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

- a. The Complainant is Rexair LLC, a company duly organized in accordance with the laws of Delaware. The Complainant has manufactured the RAINBOW Cleaning System for more than 75 years which is sold in over 70 countries around the world.
- b. The complainant is the proprietor of registered trade marks in respect of RAINBOW dating back to 1996.

3) Parties' Contentions

a. Complainant

- i. On 17 October 2014, a letter was dispatched to the Registrant by email, demanding that the domain name registrations be transferred to the Complainant. The Complainant never received a response to this letter of demand, despite sending a copy of the letter to the email address for the Registrant as located under the "Contact Us" tab on its website. The Complainant also received a 'read receipt' message that confirms that the Complainant's email containing its letter was opened by the intended recipient.
- ii. The Complainant submits that the Registrant has no legitimate interest in the domain names and his motives for registering the domain names are at the very minimum, suspicious. It is difficult to infer that the domain names were chosen for any reason other than to be able to imitate the Complainant, and/or to indicate that there is some kind of relationship with the Complainant. The Complainant has shown significant rights in and to its RAINBOW trade mark. These well-established and widely known rights, as well as the fact that the Registrant actually deals in Complainant's products, suggest that the Registrant must have known of the Complainant's reputation and trade mark rights prior to the registration of the disputed domain names, given the Complainant's use of this trade mark for more than fourteen (14) years.
- iii. Complainant further submits that the registration of the disputed domain names, which are all so similar to the RAINBOW trade mark, by the Registrant, has the effect that the Complainant is barred from registering or using the disputed domain names for itself.

- iv. The Complainant refers to the WIPO UDRP decision of Red Bull GmbH vs. Harold Gutch (02000-0766) where the Panellist *in casu* found that the mere registration of a domain name that contains the well-known mark of another is considered a trade mark infringement because it effectively prevents the trade mark owner from reflecting their distinctive and well-known mark in the corresponding domain name itself. The Complainant submits that this decision can be applied to the facts at hand.
- v. Lastly, the Complainant submits that the Registrant has, over the course of a few years, registered three domain names that all wholly incorporate the Complainant's registered and well-known trade mark. From this it is clear that the Registrant is engaged in a pattern of making abusive registrations.
- vi. The Complainant submits that all three of the disputed domain names are abusive registrations in the hands of the Registrant.

b. Registrant

- i. The Registrant as the 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, RAINBOW 1992/9752.
- ii. It is to be noted that each registration of the Complainant is in respect of the name RAINBOW 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 RAINBOW. In addition, the Complainant's registrations for the trade mark RAINBOW are in relation to goods and/or services which in some

form relate to vacuum cleaners and cleaners of that type in general.

- iii. In support of its submission in respect of each of the domain names in respect of which the complaint has been filed, the Complainant refers to SAIPL Decision AB Electrolux AB vs. Johan van Zyl (ZA2013- 0135) in which it was held that "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".

Therefore, the combination of the trade mark RAINBOW with the addition of "vacuumcleaners-sa", "-vacuumcleaners" and "vacuumcleaner" creates a domain name that can only be regarded as confusingly similar to the Complainant's prior registered RAINBOW trade mark.

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. Regulation 4(1) provides a non-exhaustive list of factors that indicate that a domain name is an abusive registration. These include:
 - (a) Circumstances indicating that the Registrant has registered or otherwise acquired the domain name to disrupt unfairly the business of the Complainant.
 - (b) Circumstances indicating that the Registrant is using, or has registered, the domain names in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.
 - (c) Evidence, in combination with other circumstances indicating that the domain name in dispute is an abusive

registration, that the registrant is engaged in a pattern of making abusive registrations.

- ii. The Registrant registered the disputed domain name <rainbowvacuumcleaners.co.za> on 7 October 2011, the domain name <rainbowvacuumcleaners-sa.co.za> on 10 October 2011 and domain name <rainbowvacuumcleaner.co.za> on 21 January 2014, each registration of which was after the Complainant obtained registration of its RAINBOW trade mark in South Africa and more than fourteen (14) years after the Complainant started using its RAINBOW trade mark in South Africa.
- iii. The websites located at www.rainbowvacuumcleaner.co.za and www.rainbowvacuumcleaners-sa.co.za direct to virtually the identical webpage, and www.rainbow-vacuumcleaners.co.za re-directs to the website located at www.rainbowvacuumcleaner.co.za.
- iv. From the abovementioned websites, it is evident that the Registrant is involved in the maintenance, repair and replacement of the Complainant's products. This only exacerbates the likelihood of consumers being deceived or confused into believing that the Registrant's business is officially endorsed by or affiliated with the Complainant. Such confusion will harm the business, reputation and goodwill that the Complainant has spent many years and resources building up, in the event that poor quality services are rendered by the Registrant, and attributed to the Complainant.
- v. 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). Accordingly, the registration of the domains in suite by the Registrant is held to be abusive.

c. Offensive Registration

i. NOT APPLICABLE

5) Decision

For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain names, rainbow-vacuumcleaners.co.za, rainbowvacuumcleaners-sa.co.za, and rainbowvacuumcleaner.co.za be transferred to the Complainant.

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Janusz F Luterek

SAIIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za