

Decision

[2013-0151]

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

ADJUDICATOR DECISION

CASE NUMBER:	2013-0151
DECISION DATE:	17 December 2013
DOMAIN NAME	burberry.co.za
THE DOMAIN NAME REGISTRANT:	Zhu Xumei
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Burberry Ltd
COMPLAINANT'S LEGAL COUNSEL:	Spoor & Fisher
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 **3 October 2013**. On **9 October 2013** the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **10 October 2013** UniForum SA confirmed that the domain name had indeed been suspended. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIIPL’s Supplementary Procedure.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **11 October 2013**. In accordance with the Regulations the due date for the Registrant’s Response was **8 November 2013**. The Registrant did not submit any response, and accordingly, the SAIIPL notified the Registrant of its default on **13 November 2013**.
- c) The SAIIPL appointed **J F Luterek** as the Adjudicator in this matter on **3 December 2013**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Registrant registered the domain burberry.co.za in the name of Zhu Xumei on 22 July 2013.
- 2.2 The complainant is Burberry Ltd, the proprietor of several registered South African trade marks 2000/8268 – 8270, 2002/6039 and 6040, and 2008/4627 all of which are for the word mark “BURBERRY”.
- 2.3 The Registrant did not respond in any way to the complaint filed by the complainant despite notice having been sent to the address provided by the registrant and as reflected on co.za – the Whois server.

- 2.4 The Registrant made an offer on 25 September 2013 to the complainant to sell them the domain burberry.co.za for US\$ 2000. On 27 September 2013 the asking price was reduced to US\$ 900. Instra charges US\$ 105 for registering a co.za domain and thus the Registrant was asking far in excess of their out of pocket expenses.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant is a well-known global luxury brand company involved in the design, manufacture, advertising, distribution and sale of high quality apparel, bags, scarves, cosmetics, perfumes, glasses, watches, and other accessories. Over the past 85 years, Burberry has continuously used the BURBERRY word mark (the "Mark"), as well as other similar and related marks, in connections with its products.
- b) The Complainant has obtained numerous registered trademarks and service marks around the world in connection with its goods and services (the "BURBERRY Marks"). The South Africa Department of Trade and Industry has granted Burberry trademark registration specifically including the word BURBERRY for many goods and services including South African trade marks 2000/8268 – 8270, 2002/6039 and 6040, and 2008/4627.
- c) The Domain Name is identical to the well-known BURBERRY Marks. "BURBERRY" is a well-known and distinctive designation that is entitled to a strong level of protection. See, ZA2008-0015 UXOTTICA U.S. HOLDING CORP. vs. PRESHAL IYAR.
- d) Burberry has not granted any license or consent, express or implied, to use the BURBERRY Marks in a domain name or in any other matter to the party listed in the Whois information. Registrant has no rights or legitimate interests in the "burberry.co.za" domain name.

- e) Registrant has never been known by the "burberry.co.za" domain name, unlike Burberry, which has made a name for itself with its BURBERRY work mark since 1856, see WIPO Case No. D2000-0610Marriott Int'l, Inc. v. Thomas, Burstein & Miller.
- f) Registrant offered for sale of the Domain name at \$2,000 to the Complainant, and the Complainant requested to transfer the Domain name without charge, then the Registrant changed the offer to \$900. The Registrant is clearly attempting to profit from the sale or transfer of the disputed domain name in bad faith. As of September 30, 2013, Instra, the registrar of the Domain Name is offering \$105 per year for .co.za domain. The requested price for the domain name is in excess of any out-of-pocket expenses that the Registrant reasonably would have incurred in registering the domain name.

3.2 Registrant

- a) No response was filed by the Registrant.

4 Discussion and Findings

- a) The Complainant has obtained numerous registered trademarks and service marks around the world in connection with its goods and services (the "BURBERRY Marks"). The South Africa Department of Trade and Industry has granted Burberry trademark registration specifically including the word BURBERRY for many goods and services including South African trade marks 2000/8268 – 8270, 2002/6039 and 6040, and 2008/4627. The Domain Name is identical to the well-known BURBERRY Marks. "BURBERRY" is a well-known and distinctive designation that is entitled to a strong level of protection. See, ZA2008-0015 UXOTTICA U.S. HOLDING CORP. vs. PRESHAL IYAR. The Registrant offered to sell the domain name to the Complainant at a price in excess of their out of pocket expenses and even offered to reduce the price.

4.1 Complainant's Rights

4.1.1 Complainant has rights in respect of the Burberry trade mark which is identical or similar to the domain name in dispute. These trade marks have been registered since as early as 4 May 2000 and predate the Registrants registration of the burberry.co.za domain name by over a decade.

The domain name is identical or similar to said Burberry trade mark in which the Complainant has rights and this thus falls within the ambit of Regulation 3(1)(a) and the ZA2008-0015 Luxotica ruling.

4.2 Abusive Registration

4.2.1. On the face of it, and considering the offer to sell the domain name firstly for US\$ 2000 and then later at a reduced cost of US\$ 900, when the Registrant's out of pocket expenses were US\$ 105, this indicates that the burberry.co.za domain has been used in a manner that takes unfair advantage of the Complainant's rights as per WIPO Case No. D2001-0777, National Association for Stock Car Auto Racing, Inc. v. Imaging Solutions and the domain name in the hands of the Registrant is an abusive registration in terms of Regulation 3(1)(a).

5. Decision

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

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