

Decision

[ZA2015-0228]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0228
DECISION DATE:	14 March 2016
DOMAIN NAME	TEREX-CRANES.CO.ZA TEREX-USED-CRANES.CO.ZA
THE DOMAIN NAME REGISTRANT:	Clayton Booyesen
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Terex Corporation
COMPLAINANT'S LEGAL COUNSEL:	The GigaLaw Firm
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **17 December 2015**. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **07 January 2016**. 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. On **08 January 2016** the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name at issue, and on **08 January 2016** 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 **08 January 2016**. In accordance with the Regulations the due date for the Registrant’s Response was **05 February 2016**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **08 Feb 2016**.
- c) On **21 January 2016** the **Administrator** sent a notification of possible settlement of a domain name dispute in terms of regulations 12(1) and 31(2) prior to the appointment of an adjudicator. However, the Complainant rejected the settlement offer.
- d) The SAIPL appointed **Tana Pistorius** as the Adjudicator in this matter on **22 February 2016**. 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 a successful company and in 2014 it had net sales of US\$7.3 billion and is traded on the New York Stock Exchange under the symbol TEX.

3 Parties’ Contentions

3.1 Complainant

- a) Complainant is the owner of the following trademark registrations for the mark TEREX in South Africa:

Mark	Trade Mark Number	Date of registration
TEREX	1968/05715	21 December 1970
TEREX	1977/05416	10 November 1978

The Complainant attached as Annex 3 printouts from the South African “Companies and Intellectual Property Commission” online database for each of the South African trademark registrations listed above.

- b) Complainant is the owner of the trademark registrations for the mark TEREX in the United States:

Mark	Trade Mark Number	Date of registration
TEREX	1,347,216	09 July 1985
TEREX	2,156,535	12 May 1998

The Complainant attached as Annex 4 printouts from the U.S. Patent and Trademark Office’s “Trademark Electronic Search System” for each of the U.S. trademark registrations listed above.

- c) Complainant avers that it is the registrant of the domain names <terex.co.za> (registered on 08 March 1999) and <terex.com> (registered on 02 November 1995), each of which the Complainant uses in connection with a website about its products and services.
- d) The Complainant notes that previous panels under the UDRP have found that the Complainant has rights in the TEREX trade mark, namely WIPO Case No. D2014-1742 *Terex Corporation v Williams Sid, Partners Associate*; WIPO Case No. D2010-1468 *Terex Corporation and Genie Industries Inc v Powko Industries LLC*; and WIPO Case No. D2008-0733 *Terex Corporation v Texas International Property Associates*.
- e) The Complainant avers that the Disputed Domain Names are confusingly

similar to its trade marks. The inclusion of the words “cranes” and “used cranes” in the Disputed Domain Names exacerbates the confusing similarity, especially because these words are associated with the goods and services for the TEREX trade mark. The Complainant refers to ZA2013-0135 (*AB Electrolux (Sweden) v Johan Van Zyl*); ZA2014-0163 (*Comair Limited v Themba Shezi*); WIPO Case No. D2010-2124 *Costco Wholesale Corporation and Costco Wholesale Membership Inc v Kenneth Terrill*; WIPO Case No. D2006-0604 *Gateway Inc v Domaincar*, and WIPO Case No. D2011-101 *Guccio Gucci SpA v Hainei Zhou*.

- f) The Complainant notes that the Registrant is using the Disputed Domain Names without the permission or consent of Complainant, in connection with a website that prominently displays an unauthorized version of the TEREX trade mark.
- g) The Complainant avers that the Registrant is using the TEREX trade mark as a “meta tag” for the HTML source code for the websites using the Disputed Domain Names. This is likely to mislead people or businesses into believing that the Disputed Domain Names are connected with the Complainant. The Complainant refers to WIPO Case No. D2001-1070 *Nintendo of America Inc v Marco Beijen et al*; WIPO Case No. D2006-0572 *Tata Sons Limited v tataconnect*; and WIPO Case No. D2002-0904 *Luxottica Srl v Lux Ottica LLC*.
- h) The Complainant notes that the Disputed Domain Names are abusive registrations because they “lead people or businesses to believe that the domain names are registered to, operated or authorised by, or otherwise connected with the complainant” (Regulations, para. 4(1)(b)) and because the Registrant “is engaged in a pattern of abusive registrations” (Regulations, para. 4(1)(c)).
- i) The Complainant notes that this Dispute is similar to another case namely WIPO Case No. D2010-1468 *Terex Corporation and Genie Industries Inc v Powko Industries LLC* where the panel readily found bad faith where two of the disputed domain names resolved to commercial sites that, while

- primarily devoted to Complainants' products, contained links leading to other websites operated by Registrant, which offer products that compete with Complainants' products.
- j) The Complainant avers that the Registrant knew of Complainant's TEREX trade mark when he registered the Disputed Domain Names, leading to evidence of bad faith. The TEREX trade mark has been registered in multiple countries for 45 years – and the Complainant's use of the Disputed Domain Names is obviously intended to create an association with the Complainant. The Registrant must have been aware of Complainant's marks and this constitutes strong evidence of wrongdoing with reference to WIPO Case No. D2003-0922 *Six Continents Hotels Inc v Albert Jackson*; and NAF Case No. FA95573 *Marriott International Inc v Momm Amed Ia*.
- k) The Complainant avers that the Disputed Domain Names are likely to confuse consumers to believe that they have reached a website of the Complainant with reference to WIPO Case No. D2008-1078 *The Dow Chemical Company v dowaychemical eva_hwang@21cn.com +86.7508126859*.
- l) The Complainant reiterates that it has never authorized the Registrant to use the TEREX trade mark in any manner and as a result, Registrant's alleged offering of used TEREX-branded cranes does not negate a finding of bad faith – especially because, as the Registrant is also offering for sale "other brands of mobile used cranes and spare parts," namely cranes and spare parts that are not TEREX-branded. The Complainant refers to WIPO Case No. D2004-0107 *Paragon Gifts Inc v Domain.Contact*.
- m) The Complainant points out that the Registrant has no reseller, distributor or agency agreement with the Complainant. Furthermore, the Complainant also notes that the Registrant does not qualify as a reseller as the Registrant's website offers competitive goods from companies other than Complainant. The Complainant also notes that as a result of the prominent use of the TEREX trade mark and Complainant's logo on Registrant's

website, it appears as if the website is actually affiliated, connected or associated with Complainant. The Complainant also notes that a domain name is an abusive registration even where the Registrant may be a reseller of authentic goods, when, as in the case at hand, the Registrant uses the relevant trade mark in the domain name with reference to ZA2008-0022 (*Samsung Electronics Co. Ltd v Sean Elseworth*).

- n) The Complainant notes that the disclaimer on the Registrant's website that it "is not an official Terex agent" does not legitimize the Respondent's actions as this purported disclaimer is not conspicuous with reference to WIPO Case No. D2000-0847 *Madonna Ciccone p/k/a Madonna v Dan Parisi & Madonna.com*. Furthermore, the Complainant notes that it does not dispel initial interest confusion that is inevitable from Respondent's actions as decided in WIPO Case No. D2001-0313 *Xerox Corp v Imaging Solution*.
- o) The Complainant lastly avers that by registering two domain names that contain the TEREX trade mark and using both of them in connection with a website that sells competing products, the Registrant has demonstrated a "pattern" of abusive registrations in terms of paragraph 4(1)(c) of the Regulations.

3.2 Registrant

- a) Regulation 18(1)(a) provides that a Registrant must respond to the statements and allegations contained in the Dispute in the form of a Response. In such a Response, the Registrant must detail any grounds to prove the domain name is not an abusive registration.
- b) The Registrant failed to submit a Response and the Adjudicator must decide the matter on the Dispute (see Regulation 18(3)).
- c) Regulation 28(2) provides that in the absence of exceptional circumstances, an Adjudicator shall draw such inferences, as she considers appropriate, from the failure of a party to comply with a provision or requirement of the Regulations.

- d) The Registrant conceded the Complainant's rights in the trade mark TEREX in two e-mail messages and although these were not regarded as a response they strengthen the Complainant's case.
- e) The Adjudicator draws the following two inferences:
 - (i) the Registrant does not deny the facts that the Complainant asserts, and
 - (ii) the Registrant does not deny the conclusions that the Complainant draws from these facts.
- f) Notwithstanding these inferences, the Adjudicator has analysed Complainant's version in order to satisfy herself that the allegations contained in its Complaint are acceptable and probably true (see ZA2007-0010 (*Multichoice Subscriber Management v JP Botha*)).

4 Discussion and Findings

- a) Regulation 3 provides that a Complainant is required to prove, on a balance of probabilities, that the following three elements are present in order to succeed in a domain name dispute based on an alleged abusive registration: (a) that the Complainant has rights in respect of a name or mark; (b) that the name or mark is identical or similar to the Disputed Domain Names; and (c) that the Disputed Domain Names, in the hands of the Registrant, are abusive registrations.

4.1 Complainant's Rights

- 4.1.1 The cornerstone of the Complainants' case is proof on a balance of probabilities that it has rights in the trade mark TEREX and that this trade mark is identical or similar to the Disputed Domain Names.
- 4.1.2 The Complainant is the registrant of the domain names <terex.co.za> and <terex.com>, dated respectively from 1999 and 1995, and the Complainant uses these domain names in connection with a website about its products and services. This does not vest any rights in the Complainant for the purposes of this Complaint.

- 4.1.3 The Complainant notes that its trade marks are registered. The Complainant attaches extracts of the CIPC's electronic register and the U.S. Patent and Trademark Office's "Trademark Electronic Search System" as proof of the trade-mark registrations. The Adjudicator does not regard this as adequate evidence of the Complainant's trade-mark rights. As a rule, only copies of official certificates of registration issued by registration authorities are apt to demonstrate trade mark rights (see D2001-0709 *Red Bull GmbH v Ian Andrew*).
- 4.1.4 As noted above, the Registrant conceded the Complainant's rights in the trade mark TEREX in two e-mail messages and this concession strengthens the Complainant's case.
- 4.1.5 Previous panels under the UDRP have found that Complainant has rights in the TEREX trade mark, namely in WIPO Case No. D2014-1742 *Terex Corporation v Williams Sid Partners Associate*; WIPO Case No. D2010-1468 *Terex Corporation and Genie Industries Inc v Powko Industries LLC*; and WIPO Case No. D2008-0733 *Terex Corporation v Texas International Property Associates*.
- 4.1.6 Based on these considerations the Adjudicator holds that the Complainant has trade mark rights in the mark TEREX.
- 4.1.7 The Disputed Domain Names are TEREX-CRANES.CO.ZA and TEREX-USED-CRANES.CO.ZA. The Adjudicator finds that neither the addition of "cranes" or "used cranes" to the mark TEREX, nor the suffix ".co.za" influences the consideration of similarity (see D2002-0810 *Benetton Group SpA v Azra Khan*).
- 4.1.8 It follows that the Complainant has established that it has rights in respect of the mark TEREX and that this mark is similar to the Disputed Domain Names.

4.2 Abusive Registration

- 4.2.1 Were the Disputed Domain Names 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?

4.2.2 The Complainant's trade mark and the Registrant's Disputed Domain Names are similar, and the Adjudicator accepts that the Registrant knew of the Complainant's trade mark TEREX when he registered the Disputed Domain Names. Accepting that the Registrant was dealing in the Complainant's products without authority, the Adjudicator would be hard pressed not to find that the Disputed Domain Names have been registered, and used in such a way as to lead people or businesses into believing that they are registered to, operated or authorized by, or otherwise connected with the Complainant.

4.2.3 The Adjudicator is therefore satisfied that on a balance of probabilities, that the Disputed Domain Names are abusive registrations.

5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the Disputed Domain Names, TEREX-CRANES.CO.ZA and TEREX-USED-CRANES.CO.ZA be transferred to the Complainant.

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TANA PISTORIUS
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za