

Decision

2011-0084

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

ADJUDICATOR DECISION

CASE NUMBER:	2011-0084
DECISION DATE:	26 September 2011
DOMAIN NAME	Victronenergy.co.za Bluepower.co.za Victron.co.za
THE DOMAIN NAME REGISTRANT:	Theo Biehler
REGISTRANT'S LEGAL COUNSEL:	None (Registrant Self Help)
THE COMPLAINANT:	Victron Energy B.V
COMPLAINANT'S LEGAL COUNSEL:	Mr. Q.J.A. Meijnen
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 “SAIPL”) on **14 July 2011**. On **19 July 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **20 July 2011** UniForum SA confirmed that the domain name 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 **24 July 2011**. In accordance with the Regulations the due date for the Registrant’s Response was **19 August 2011**. The Registrant submitted its Response on **19 August 2011**, and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL’s Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on 31 August 2011.
- c) In accordance with the Regulations the due date for the Complainant’s Reply was **7 September 2011**. The Complainant submitted its Reply on **6 September 2011**.
- d) The SAIPL appointed **Janusz F Luterek** as the Adjudicator in this matter on **09 September 2011**. 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) A number of foreign trademark applications have been filed by the

complainant including:

- i) The Community Trademark application **VICTRON**, trademark no. 9730045, filing date 11 February 2011, registered in class 9 for:

Apparatus and instruments for the conduction, distribution, conversion, storage, regulation and management of electricity; Rectifiers; Frequency converters; Current converters; Chargers; Inverters for power supply.

- ii) The Community combined word and device mark



, trademark no.

3922051, filing date 7 July 2004, registration date 19 May 2006, registered in class 9 for:

- iii) Community Trademark application **BLUE POWER**, filing date 28 April 2011, trademark no. 9928425, registered in class 9 for:

Apparatus and instruments for the conduction, distribution, conversion, storage, regulation and management of electricity; Rectifiers; Frequency converters; Current converters; Chargers; Inverters for power supply.

- b) South African trademark application **VICTRON**, which is still pending, was filed under application number 2011/10300 on 3 May 2011, in class 9 for:

Apparatus and instruments for the conduction, distribution, conversion, storage, regulation and management of

electricity; Rectifiers; Frequency converters; Current converters; Chargers; Inverters for power supply.

- c) Complainant has used the trade names VICTRON ENERGY, VICTRON and VICTRON ENERGY BLUE POWER in respect of its products and services internationally, but only VICTRON ENERGY BLUE POWER in South Africa, since before the Registration date of the Domain Names in dispute.
- d) Respondent has had extensive communication with the Complainant and in an email dated 23 February 2011 the Respondent stated to a representative of the Complainant that "...he would only consider selling if he gets a minimum of USD 3000."

3 Parties' Contentions

3.1 Complainant

- a) The Complainant is an international operating company founded in 1984. The Complainant designs and produces sine inverters, sine charger/inverters, battery chargers, DC/DC inverters, power switches and further designs autonomous energy systems. Information regarding complainant can be found at www.victronenergy.com. A print of the website of Complainant was attached to their complaint.
- b) Peter [sic] Biehler is a South African based sales and marketing person who registered the domain names victronenergy.co.za, bluepower.co.za and victron.co.za on 9 May 2009 and sold products of Complainant, without permission of Complainant and is not an official dealer or agent.
- c) Since May 2009 the domain names are not connected to a "real" website, other than that the domain names are used as url's to connect to portal sites which have no particular branding other than the domain names themselves, and has been offered for sale to Complainant for US\$ 3000. The domain names are connected to a

portal site which promotes a variety of products that overlap with the products of Complainant.

- d) Complainant alleges that it has used and acquired rights in the trade names VICTRON and VICTRON ENERGY since the year 1984, and the trade name VICTRON ENERGY BLUE POWER since the year 2003. The Complainant further alleges that the trade names and trademarks of Complainant have been intensively used in commerce worldwide in the past decades and continue to be used. The trademarks and trade names are also used on the Complainant's website www.victronenergy.com, which is accessible worldwide and is available in sixteen languages.
- e) The Complainant alleges that the term "VICTRON" has no common usage. It is a fanciful term derived from the founders' initials, is not an acronym and has no dictionary meaning. It only refers to the Complainant's services. Likewise, it alleges that the term BLUE POWER is highly distinctive as the combination of the words "BLUE" and "POWER" is not common. The Complainant further alleges that it invested a lot of time and money to acquire the current goodwill in its trade names and trade marks and that they are highly reputed for the services offered. Finally, the Complainant alleges that use of the trademarks and trade names VICTRON ENERGY, VICTRON, VICTRON ENERGY BLUE POWER and BLUE POWER by the Complainant in many jurisdictions in the world over a significant period of time has served to create enormous reputability and goodwill in the aforementioned trademarks which has caused strong common law rights in the trademarks to vest in the Complainant.
- f) The Complainant alleges that the disputed domain names are identical to the trademarks & trade names of Complainant. It further alleges that the disputed domain names victronenergy.co.za, bluepower.co.za and victron.co.za wholly incorporate the trade

names and trade marks of the Complainant and that the “.co.za” extension may be disregarded for the purpose of determining whether a domain name is identical or confusingly similar to a mark or a trade name and based on this it is self-evident that the domain name VICTRON.CO.ZA is identical to the VICTRON trademark and trade name of Complainant, the domain name VICTRONENERGY.CO.ZA is identical to the VICTRON ENERGY trade name and trademark and BLUEPOWER.CO.ZA is identical to (part of) the trade name VICTRON ENERGY BLUE POWER and the trademark BLUEPOWER and in addition to this, the domain names VICTRON.CO.ZA, VICTRONENERGY.CO.ZA and BLUEPOWER.CO.ZA are also confusingly similar with the trade names and trademarks of Complainant.

- g) The Complainant denies that Jan Klumpenaar gave his permission for Registrant to register the domain names at issue nor discussed the use of local domain names with him and only became aware of the registrations in 2010.
- h) The Complainant denies that Mr Durand acting on their behalf settled the matter with Registrant by agreeing to the transfer thereof from Registrant to Complainant, and that it was only the amount to be paid that was still under discussion.

3.2 Registrant

- a) The Domain names in issue were registered in February 2008 and not May 2009 as alleged.
- b) Jan Klumpenaar for the Complainant did not object to Registrant proposing to register the domain names at issue in January 2008.
- c) Complainant had no rights in South Africa as it alleges, either registered or common law, and the various trade mark applications referred to by Complainant are European Union applications with the

exception of the South African Trademark application 2011/10300 filed on 3 May 2011 for the word “Victron”, which is still a pending application.

- d) Complainant had prior to Registrants registration of the domains had resellers only in two locations in South Africa and was not represented in Gauteng or several other provinces and areas.
- e) The registration of the domain names by the Registrant was not in bad faith as the Registrant had intended to use the domains for marketing and selling products of the Complainant and had discussed this with a representative of the Complainant who had not indicated his objection thereto and over a period of time proceeded to supply the Registrant with marketing materials and technical support for the sale of the products of the Complainant.
- f) Complainant incorrectly refers to the Registrant as Peter Biehler.
- g) Blue Power is stated by the Complainant to be registered as a trademark, however, it has only been applied for in Europe and there is no evidence of such an application as yet in South Africa.
- h) Victron is not a term unique to Complainant and there is a website www.victron.com which is not a website of the complainant but of a US software company and there is also a Marvel™ Comics character called Victron.
- i) The domains had been offered to Complainant by the Registrant without requesting payment and it is Mr Durand on behalf of the Complainant that raised the question of compensation for the domains.

4 Discussion and Findings

4.1 Complainant's Rights

- a) R1166, the Regulations in terms of which this complaint is being adjudicated, requires two elements to be proven on the balance of probabilities by a Complainant before a Complainant will be held to have rights capable of abusing, these two requirements are clearly set out in Regulation 3(1)(a):
 - i) if a complainant asserts, in accordance with the procedure, that the complainant has rights in respect of a name or mark which is identical or similar to the domain name; and
 - ii) in the hands of the registrant the domain name is an abusive registration;
- b) Further, in accordance with Regulation 3(2), the complainant is required to prove on a balance of probabilities to the adjudicator that the required elements in sub regulation (1) are present i.e. that:
 - i) they have a right; and
 - ii) that in the hands of the registrant it is an abusive registration
- c) This has been dealt with in the recently decided SAIPL 2011/0077 of Xnet Internet Services (Pty) Ltd v Sure props.
- d) The Complainant has referred in its Complaint to a number of foreign trademark applications and a South African trademark application all dated after the date of registration of the domains in dispute by the Registrant and thus not relevant to this dispute.
- e) The Complainant has further sought to substantiate its rights in the names VICTRON ENERGY, VICTRON, VICTRON ENERGY BLUE POWER and BLUE POWER by the Complainant's use in many jurisdictions in the world over a significant period of time thereof (since 1984 for Victron and Victron Energy and since 2003 for Victron Energy Blue Power). However, with the exception of Annexures VII

and VIII, no evidence has been filed of such use in South Africa and the documents which have been annexed to the Complaint as Annexure VII and VIII are not dated except for a date which appears at the top of one of the pages but which is not claimed or explained in any manner in the Complaint and is not supported by Affidavit evidence or any form of documentation showing any sales or offers for sale in South Africa prior to the date of registration of the domains. The “Victron Energy Blue Power” sheet in Annexure VII does not refer to any specific installations by date or by name and cannot be considered to be evidence of the trade name being well known in South Africa prior to the registration of the domains. The second document forming part of Annexure VII entitled “Whisper Balls’ for FIFA Worldcup 2010” is undated but appears to be from 2010 as the title suggests, which is after the registration date. Finally, Annexure VIII is alleged to be a screen print of a webpage of the Complainant’s website listing its distributors in South Africa, but this is of little assistance in this matter as from the face of it this was done some time in 2011 and there is no accompanying evidence explaining the significance thereof to establishing common law rights prior to the date of registration of the domains.

- f) Following the Mr Plastic CC v Mr Plastic & Mining Promotional Goods CC ZA2007 - 0001 and the Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd & another 1998 3 SA 938 SCA cases, in order to prove that the Complainant has common law rights which would satisfy Regulations 3(1)(a) and 3(2), the Complainant is accordingly first required to establish that it has indeed acquired a reputation in South Africa in the names as a result of their use. The reputation must be established at the date the Registrant registered the domain names and not at some date thereafter.
- g) The Registrant’s pointing out of the www.victron.com websites also indicates that at least the word Victron is not unique to Complainant

and that other parties may have a better claim to that word although it is not the place of the Adjudicator in this matter to make such a determination.

- h) The Complainant also refers to their own website www.victronenergy.com , however, no evidence is provided of when this website was established nor is any statistical information on how many visitors from South Africa have visited that website and how many enquiries from South Africa it has generated prior to the registration dates of the domains in dispute, or at all.
- i) There is thus a lack of evidence by the Complainant of a reputation in South Africa prior to the date of registration of the domains by the registrant.

4.2 Abusive Registration

- a) As the Complainant has not succeeded in satisfying the requirements of Regulation 3(1)(a) and 3(2) which require the Complainant to prove on a balance of probabilities to the Adjudicator that the Complainant has a right which can be abused by the Registrant, the question of abusive registration cannot arise.
- b) Although it is unnecessary for the adjudicator to comment on whether the registrations would have been abusive if the complainant had proven it had rights in these names, for the sake of completeness, considering Regulation 4(1) and the allegations made and the denials thereto, the Complainant has not shown on a balance of probability that the registrant has registered or otherwise acquired the domain name primarily to sell the domain name to complainant for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name. In this regard the undisputed email submitted by both parties indicate that the Registrant's initial intention was to use the domains to market the products of the Complainant whether as an agent or a

reseller.

- c) The Complainant alleges that because of the registration of the disputed domain names by the Registrant, it is no longer possible for the Complainant to register these domain names itself. According to the Complainant, this means that the registrations prevent the Complainant from exercising its rights, which it believes it has, since it blocks the possibility for Complainant to register domain names in which it claims rights (i.e. VICTRON, BLUE POWER, VICTRON ENERGY) as well as the chance to operate a website for its South African target group. The Complainant concludes that the Registrant exploits the reputation and goodwill of the Complainant's trademarks and takes unfair advantage of their reputation. However, Regulation 4(1)(a)(iv), read in totality, requires not that this be the result at the present time, but that this was the position at the time of the registration of the domains by the Registrant and that this was the Registrant's primary purpose in registering the domains, which as concluded above is not likely to be the case.
- d) Again, although not required to do so for the reasons set out in 4.2.1, for the sake of completeness, as regards the allegation that the disputed domain names are identical to the trademarks & trade names of Complainant. The disputed domain names victronenergy.co.za, bluepower.co.za and victron.co.za wholly incorporate the trade names and trade marks of the Complainant. Contrary to what Complainant has stated, it is self-evident that the domain name VICTRON.CO.ZA is not identical to the VICTRON trade name of Complainant, the domain name VICTRONENERGY.CO.ZA is not identical to the VICTRON ENERGY trade name and BLUEPOWER.CO.ZA is not identical to the trade name VICTRON ENERGY BLUE POWER and BLUEPOWER. However, Regulation 3(1)(a) provides that it would have been sufficient if they were merely similar and not necessarily identical and

thus if the Complainant would have succeeded in proving on a balance of probabilities that part of Regulation 3(1)(a), however, as the Complainant has been unable to prove their rights as concluded in 4.1.9 above, this point is moot.

- e) There is thus a lack of evidence of an abusive registration of the domains.

4.3 Offensive Registration

- a) There have been no allegations that the Registrations are offensive and thus this ground is not being considered.

5. Decision

- a) For all the foregoing reasons, the Dispute is refused.

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JANUSZ LUTEREK
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za