

ADJUDICATOR DECISION

CASE NUMBER: ZA2009-0033

DECISION DATE: 10 September 2009

DOMAIN NAME hackett.co.za

THE DOMAIN NAME REGISTRANT: digitalorange

REGISTRANT'S LEGAL COUNSEL: n/a

THE COMPLAINANT: Hackett Limited

COMPLAINANT'S LEGAL COUNSEL: Pablo Pratmarsó of Ubilibet, Barcelona

THE 2nd LEVEL DOMAIN NAME ADMINISTRATOR: UniForum SA (CO.ZA Administrators)

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1. Procedural History

1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on 13 July 2009. The Administrator verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure and formally notified the Registrant of the commencement of the Dispute on 13 July 2009. In accordance with the Regulations the due date for the Registrant's Response was 10 August 2009.

1.2 The Registrant did not submit any response. Accordingly, the Administrator notified the Registrant of its default. On 14 August 2009 an email was sent to the Administrator by one "Joris",¹ from the address domain@digitalorange.co.za, stating:

"Thank you for contacting digitalorange.

We have registered this domain on behalf of a client of digitalorange who have Hackett as part of their surname. We hope this settles the situation."

1.3 This email does not satisfy the formal requirements of the Regulations and the SAIPL's Supplementary Procedure. What it does mean, however, is that the complaint was, as a matter of fact, received and was considered. Apart from the fact that, as no dispute is raised as to their correctness, the Complainant's assertions can be accepted, two consequences flow:-

¹ The WHOIS details for the domain name in issue, submitted with the complaint, reveal that Mr Joris Kroner was initially reflected as the administrator of the registrant. The latest WHOIS details do not reflect this.

- 1.3.1 The failure to deal with the contentions can lead to the drawing of an adverse inference; and
- 1.3.2 without a proper and complete disclosure of circumstances surrounding the registration and the person's (alleged) surname, the veracity of this (whether relevant or not) must be treated with caution.
- 1.4 The SAIPL appointed Adv Owen Salmon as the Adjudicator in this matter on 17 August 2009. 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 Hackett Limited, a United Kingdom company of The Clove Building, 4 Maguire Street, Butlers Wharf, London (hereinafter "Hackett Ltd").
- 2.2 Hackett Ltd was established in 1979, began operating in the United Kingdom, and later expanded to Spain, France and fifteen other European countries, as well as South Africa, Mexico, Japan and Kuwait. There are more than fifty shops (named HACKETT) around the world.
- 2.3 Hackett Ltd has a worldwide reputation for producing high quality, unique and distinctive menswear and kid's clothing, as well as accessories such as bags, umbrellas, wallets, cufflinks, perfumes and toiletries. HACKETT branded clothes span personal and bespoke tailoring, formal wear including dinner jackets, business clothing such as ties, suits, shirts and trousers and smart casual menswear including jackets and trousers.

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- 2.4 The HACKETT trade mark is registered in seventy different countries, and Hackett Ltd is the owner of eighty three domain names.
- 2.5 Hackett Ltd sponsors the Aston Martin Racing Team, the famous Oxford vs Cambridge boat race and, among others, the British Army Polo Team and the London Rowing Club.
- 2.6 In short, Hackett Ltd has spent a considerable amount of time, money and effort in marketing and promoting the HACKETT brand in South Africa and in other countries such as United Kingdom, Ireland, Spain, France, Italy, Germany, Switzerland, Austria, Netherlands, Belgium, Portugal, Mexico and Japan.
- 2.7 The trade mark HACKETT was registered in South Africa (in 7 classes covering the aforementioned goods) as long ago as 1998.
- 2.8 The Registrant is not listed as holding any distinctive sign that uses the name “Hackett” in the CIPRO registries, the Office for Harmonization in the Internal Market, nor in the WIPO. The Complainant has not granted the Registrant any licence or authorisation to use the HACKETT name or mark.
- 2.9 The domain in question <hackett.co.za> was registered on 17 December 2008. It has not been in use, is inactive, and the latest WHOIS search reveals that (now) the domain is for sale.

3. The Complainant’s Contentions

- 3.1 The “Hackett” name is well-known and widely recognised, both in South Africa and internationally, to identify HACKETT products and the company Hackett Ltd itself. It is impossible that the

registration was effected unaware of the existence of HACKETT, one of the world's most recognized fashion brands.

- 3.2 The domain name exactly matches (most of) Hackett Ltd's registered trademarks, so it is clear that the Registrant's use of it would confuse internet users. As a result, the registration cannot be for any reason other than to misappropriate the reputation built up by the international company. It is impossible to maintain that the Registrant's choice of the <hackett.co.za> domain name is a pure coincidence and not intentional.
- 3.3 Secondly, the Registrant does not have legitimate rights or interests in the domain name, since "he" has never been known by that name. Thirdly, when the Registrant registered the domain name, he was aware of the reputation and the legitimate rights that Hackett Ltd held to the name HACKETT.
- 3.4 Moreover, given that more than six months have elapsed since the domain name was registered (more than enough time, it is alleged, to create a website) the fact that <hackett.co.za> is inactive, and is for sale, shows that the Registrant has no legitimate interests in remaining the owner of the domain name. In view of this, the Registrant must be considered to have no legitimate interests to keep the registration of <hackett.co.za>.
- 3.5 It is the Registrant's clear intent to prevent Hackett Ltd from legitimately becoming the owner of the domain so that he can speculate with the sale of the domain name in the future. That this domain is now for sale shows this. This means that the Registrant is intentionally blocking the registration of a mark in which the Complainant has rights.

3.6 The continued existence of the <hackett.co.za> domain name obstructs Hackett Ltd from access to the internet under its own trade mark and corporate name. It also leads the Complainant's current or potential customers to believe that the domain name is registered or authorized by the Complainant. Therefore, these customers may think that Hackett Ltd does not have a website under the disputed domain name, or that it is technically incapable of keeping it in operation, which may clearly be detrimental to it and will disrupt unfairly its business.

3.7 In conclusion, based on the foregoing, it is alleged that the domain registration is abusive within the meaning of Regulation 3.

4 **The Registrant's Contentions**

4.1 The extent of the response from the Registrant has been set out above.

5 **Discussion and findings**

5.1 The Adjudicator finds that the Complaint has rights in respect of the mark HACKETT as contemplated by Regulation 3(1)(a). The question is whether the registration in the hands of the Registrant is an abusive registration.

5.2 An abusive registration means a domain name which either:-

- (a) 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; or

(b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.²

5.3 The Complainant is required to prove on a balance of probabilities that the required elements are present.³

5.4 In terms of Regulation 4(1)(a), factors which may indicate that the domain name is an abusive registration include circumstances indicating that the registration was primarily to:-

5.4.1 transfer the domain name to a complainant for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring the domain name;

5.4.2 block intentionally the registration of a name or mark in which the Complainant has rights;

5.4.3 disrupt unfairly the business of a Complainant;

5.4.4 prevent the Complainant from exercising its rights.

5.5 Factors which may indicate that the domain name is not an abusive registration, in terms of Regulation 5, are denominated by use of the domain name;⁴ save in the case that the Registrant *"has been commonly known by the name or legitimately*

² The definition under (b) is not relevant for present purposes.

³ Regulation 3(2).

⁴ In the present case there has been no use of the domain name.

*connected with a mark which is identical or similar to the domain name”.*⁵

- 5.6 It is true that Hackett is a surname – that, indeed, is the genesis of the Complainant’s name, one of the founders being Jeremy Hackett. However, it is not a common surname in South Africa, if only 4 references in the current Johannesburg telephone directory give any indication. The Registrant’s (throw-away) reference to part of someone’s surname as being (presumably) the explanation for the registration is no explanation at all, and, rather, instead begs a lot of questions which remain unanswered. As the Complainant asserts, “he” is not known, nor does he have a reputation with this surname – so, the contention proceeds, what of the claim to registration on behalf of a client who has Hackett as part of their surname?
- 5.7 Furthermore, the relevance of the “part of the surname” also fades, to be replaced with a question mark over the veracity of the proffered explanation, given that the domain is now for sale. Has that “part of the surname” changed, that “the client” doesn’t want the particular domain anymore?
- 5.8 The absence of a response from the Registrant on the Complainant’s contentions, coupled with the inferences that beg drawing, as referred to above, lead the Adjudicator to conclude that the Complainant’s contentions have merit.
- 5.9 The probabilities are that the registration was abusive, and it remains so. Accordingly, the Adjudicator upholds the Complainant’s Dispute.

⁵ Regulation 5(a)(ii).

6 Decision

- 6.1 For the foregoing reasons the Adjudicator orders that the domain name be transferred to the Complainant.

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ADV OWEN SALMON
SAIIPL SENIOR ADJUDICATOR
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