

ADMINISTRATIVE PANEL DECISION

Moroccanoil Israel Ltd v Olly & Associates Pty Ltd

Case No: auDRP_12_11

1 The Parties

- 1.1 Complainant is Moroccanoil Israel Ltd of care of Ashurst Australia, Grosvenor Place, 225 George Street, Sydney NSW, 2000.
- 1.2 Respondent is Olly & Associates of 12 Dangar Street, Randwick, NSW.

2 The Domain Name and Registrar

- 2.1 The disputed domain name is <moroccan-oil.com.au> which is registered through AussieHQ Pty Ltd (“registrar”).

3 Procedural History

- 3.1 The complaint was received on 23 October 2012 by Leadr (“provider”). A copy of the complaint and a request to clarify the respondent’s details and to lock the domain name during proceedings were emailed to the registrar on 25 October 2012. On 25 October 2012 the registrar confirmed via email that the disputed domain name had been locked. The provider informed auDA of the complaint on 26 October 2012 by e-mail.
- 3.2 On 26 October 2012 the provider sent the respondent an email and written notification of the complaint lodged against them. The due date for the response to the complaint was confirmed to be 15 November 2012. No response was received from the respondent, either within the time limited under the .au Dispute Resolution Policy or at all.
- 3.3 On 22 November 2012 the provider approached the panelist. The panelist accepted the appointment on 23 November 2012. The panelist confirmed his availability and informed the provider that he had no conflict issues with the parties. The case file was sent to the panelist on 29 November 2012.
- 3.4 The date on which the decision is due is 7 December 2012.

4 Factual Background

- 4.1 The complainant is an Israeli company which manufactures hair care products.
- 4.2 The complainant is the owner of two trade marks. Mark number 1221017 is for the expression “M MOROCCANOIL” and a logo. Mark number 1375954 is for the same expression and a logo incorporating “MOROCCANOIL”, but with that expression running horizontally across the logo instead of vertically. The applicant has also made two

applications for the word, "MOROCCANOIL", numbered 1463962 and 1510617, which have not been registered. The goods and services in respect of which the trade marks are registered may broadly be described as hair care products.

- 4.3 In addition, the complainant provided evidence of the use of the trade marks and "MOROCCANOIL" in promotional activities in Australia and on its global website at <www.moroccanoil.com>. The panel accepts that the complainant has a substantial reputation in the expression "MOROCCANOIL" and in the logos. It also accepts that members of the public and persons working in the fashion industry associate the expression "MOROCCANOIL" and the logos with the complainant's products.
- 4.4 According to an ASIC search provided by the complainant, the respondent is a company incorporated in Australia and its current directors are Kasim Dlakic, Damir Trako and Oliver Trako.
- 4.5 The complainant provided a print out of the website associated with the disputed domain name. It appears to be an online shop selling "natural argan oil" beauty products. The web site does not prominently identify its products as "Moroccan oil", but on occasions, the "small print" does refer to "Moroccan Argan Oil". The website also contains tags for "Moroccan oil". The page of "FAQs" contains the following

What is the difference between Argan Oil, Moroccan Argan Oil and moroccanoil?

Argan Oil is often known as Moroccan Oil or Moroccan Argan Oil. However, *moroccanoil* is a brand of hair care products that uses small amounts of rare and expensive Argan Oil mixed with silicones. We are proud to stock this authentic and organic certified alternative that is even better for your hair and also effective on your skin and nails. (italics in original)

The website prominently displays the expression "Nature's Vitality LOVE, GROW, BE BEAUTIFUL", which appears in fancy writing and is identified as a trade mark.

5 The issues

- 5.1 Under the Policy, in order to succeed, the complainant must establish that:
- (a) the domain name is identically or confusingly similar to a name, trade mark or service mark in which the complainant has rights;
 - (b) the respondent has no rights or legitimate interest in respect of the domain name; and
 - (c) the domain name was registered or is being used in bad faith.
- 5.2 The onus of establishing these elements rests with the complainant. The fact that a response has not been provided by the respondent does not shift

the onus. However, the respondent's failure to put forward an innocent explanation for conduct in which it has engaged may enable an inference adverse to the respondent to be more readily drawn.

5.3 Each of the elements outlined in paragraph 5.1 will be considered in turn.

6 Identically or confusingly similar

6.1 The complainant submitted that the disputed domain name is identical to or confusingly similar to its trade marks. This submission is accepted. The differences between the disputed domain name and the expression "MOROCCANOIL" are inconsequential for present purposes. The expression "MOROCCANOIL" is a key component of the trade marks and the applications for trade marks.

7 The respondent's rights or legitimate interests

7.1 The complainant asserted, and the panel accepts, that the respondent has no rights or legitimate interests with respect to the disputed domain name.

7.2 "Moroccan Oil", or variations of the expression, do not form any part of the respondent's name or, unsurprisingly, those of its directors. The respondent provided no evidence that it had acquired any rights in or in connection with the expressions "Moroccan Oil" or "Moroccan-oil". While it might be accepted that the respondent's product is, or contains Moroccan oil, the products sold from the respondent's website were not sold as Moroccan oil. The respondent's products are sold using the expression "Argan Oil" and the trade mark, "Nature's Vitality LOVE, GROW, BE BEAUTIFUL".

8 Bad faith use

8.1 The Panel considers that the disputed domain name has been used by the respondent in bad faith on the basis of the following:

- (a) the respondent's website is a commercial website operating for profit. The respondent and the complainant trade in the same general industry.
- (b) the respondent referred to "*moroccoanoil*" on the website. The unusual spelling of "moroccoanoil", and the use of italics show that "moroccoanoil" on the website is a reference to the complainant's products and that the respondent was aware of the complainant's products;
- (c) the disparaging references to "*moroccoanoil*" show that the respondent considers that the complainant's products are competitive with its products;
- (d) the respondents product are not sold as Moroccan Oil, but as Algan Oil, or occasionally, Moroccan Algan Oil; and
- (e) the disputed domain name is very similar to "MOROCCANOIL", such that the disputed domain name would not primarily attract

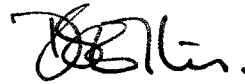
persons seeking Algan Oil, as sold by the respondent, or persons who were familiar with the respondent's "Nature's Vitality" brand. It would instead primarily attract persons seeking the complainant's competitive products, thereby disrupting the complainant's legitimate activities and attracting users by creating confusion between the respondent's products and those of the complainant.

8.2 The respondent did not put forward any evidence which might negative the inference to be drawn from the matters referred to in the previous paragraph. Further, it failed to respond to correspondence from the complainant's representative of 2 and 19 April 2012.

9 Decision

9.1 Having found that the complainant has made out each of the three elements required by the Policy, the Panel decides that the registrar, Aussie HQ, must transfer the disputed domain name, <moroccan-oil.com.au>, to the complainant.

Date: 7 December 2012.



DS Ellis
Sole Panelist