



ABN 69 008 651 232

LEADR Domain Name Dispute Administrative Panel Decision (single panellist)

Regarding the domain name: <morrocanoil.com.au>

Between: Morrocanoil Israel Ltd

and

Clare Bella Ayumi Kim and Marcelo Lacerda Schoon.

Matter: auDRP 12/10

1. The Parties

- 1.1 The Complainant is Morrocanoil Israel Ltd (a private company incorporated in Israel), represented by Ms Lisa Ritson of Ashurst Australia (a Law Firm).
- 1.2 The Respondents are Ms. Clare Bella Ayumi Kim and Mr. Marcelo Lacerda Schoon (in partnership) t/a Amore Gold (Australian registered business name).

2. Subject Matter of Complaint

- 2.1 Domain Name in Dispute: "morrocanoil.com.au"
- 2.2 Jurisdiction: auDRP Rules 3(a) and 3(b)(xv).

3. Basis of Determination

- 3.1 The complaint was submitted for determination by a single panellist under:
 - (a) The provisions of Schedule A of the .au Dispute Resolution Policy and Rules 2010-05 ("auDRP") and,
 - (b) LEADR's Supplementary Rules (LEADR is the Provider).
- 3.2 Section 4 of the auDRP covers Mandatory Administrative Proceedings.
- 3.3 Section 4(a) deals with Applicable Disputes and states: *"You are required to submit to a mandatory administrative proceeding in the event that a third party (a "Complainant") asserts to the applicable provider, in compliance with the Rules of Procedure that:*
 - i) Your domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and*
 - ii) You have no rights or legitimate interests in respect of the domain name; and*

iii) *Your domain name has been registered or subsequently used in bad faith.*

In an administrative proceeding, the Complainant bears the onus of proof."

4. Procedural History

- 4.1 LEADR received the Complaint on **19/10/2012** and sent an acknowledgement to the Complainant on the same day.
- 4.2 On **19/10/2012** a copy of the complaint was submitted, along with a request to clarify the Respondents' details and to lock the domain name during proceedings, by email to the registrar, NetRegistry.
- 4.3 On **25/10/2012** the Registrar confirmed via email that the domain name in dispute had been locked.
- 4.4 LEADR advised auDA of the complaint on **26/10/2012**, via e-mail.
- 4.5 On the **26/10/2012** LEADR sent the Respondent (Clare Bella Ayumi Kim and Marcelo Lacerda Schoon) an email with written notice of the complaint lodged against them. The Complainant was copied in on the notice.
- 4.6 The due date for the response to the complaint was confirmed to be **15/11/2012**.
- 4.7 On **15/11/2012**, Clare Bella Ayumi Kim and Marcelo Lacerda Schoon on behalf of the Respondent (Clare Bella Ayumi Kim and Marcelo Lacerda Schoon) responded to the complaint.
- 4.8 On **22/11/2012** the provider approached the Panelist. The Panelist confirmed their availability and informed LEADR that they had no conflict issues with the parties.
- 4.9 The Case file and relevant correspondence were forwarded to the Panelist, electronically, on **29/11/2012**.
- 4.10 The Panellist accepted the matter on **3/12/2012**.
- 4.11 The Parties to the dispute were notified of the Panelist's appointment on **3/12/2012**.
- 4.12 The Panellist's decision is due on **17/12/2012**.

5. The Complainant's Case - Factual Background

- 5.1 The Complainant is Moroccoil Israel Ltd, a company based in Rishon Lezion, Israel.

- 5.2 The Complainant sells its products around the world using the brand name "Morrocanoil".
- 5.3 The Complainant has been selling its products in Australia through Privity Pty Ltd (distributor) since 2009, using both registered and unregistered "Moroccoil" trade marks.
- 5.4 On 24 January 2008 the Complainant lodged an Australian Trademark Application (#1221017) for "M Moroccoil" (word / fancy) under Goods & Services Class 3: hair care products. The application was accepted on 15 May 2008 and Registration was effected on 8 September 2008.
- 5.5 On 4 August 2010 the Complainant lodged an Australian Trademark Application (#1375954) for "M Moroccoil" (word / fancy) under Goods & Services Class 3: hair care products. The application was accepted on 25 June 2012 and registration was effected on 9 October 2012.
- 5.6 On 7 December 2011 the Complainant lodged an Australian Trademark Application (#1463962) for "Moroccoil" (word) under Goods & Services Class 3: hair care products. The application was accepted on 11 October 2012 and Registration is due on 18 April 2013.
- 5.7 On 27 August 2012 the Complainant lodged an Australian Trademark Application (#1510617) for "Moroccoil" (word) under Goods & Services Class 3: hair care products. Indexing was approved.
- 5.8 The Complainant advertises and markets its products extensively in Australia in relevant publications and journals.

6. Complainant's Arguments (1): The disputed domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights:

- 6.1 The disputed domain name is identical to and/or confusingly similar to the Complainant's Trademarks.
- 6.2 The Respondent's use of "Moroccoil" within Australia infringes the Complainant's rights in its registered Trademark.
- 6.3 Consumers who visit the Respondent's web site will be confused and are likely to wrongly associate both the Respondent, and their hair care products, with the Complainant, and its products.

7. Complainant's Arguments (2): The Respondent has no rights or legitimate interests in respect of the domain name:

- 7.1 The Respondent does not own or trade under any business or company names that include the word "Moroccoil".
- 7.2 The Complainant has never granted any rights to the Respondent to use the Moroccoil trademarks.
- 7.3 The Respondent does not have any rights or legitimate interest in the disputed domain name as it directly infringes the Complainant's registered Trademark.

8. Complainant's Arguments (3): The domain name has been registered or subsequently used in bad faith:

8.1 Paragraph 4(b) of Schedule A to the Policy lists four forms of evidence of registration in bad faith. The relevant clauses apply when the Respondent:

(iii) *has registered the domain name primarily for the purpose of disrupting the business or activities of another person; or*

(iv) *by using the domain name has intentionally attempted to attract, for commercial gain, Internet users to a website or online location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the website or location, or of a product or service on that website or location.*

8.2 The Respondent's website offers hair care products that compete with the Complainant's products and use the word "Moroccan oil" and "Moroccan Argan oil" in their product names and advertising. This is an attempt to divert customers and business away from the Complainant's website to the Respondent's website in a "classic bait and switch" tactic.

8.3 The prominent use of the Moroccoil trademarks in the Respondent's domain name is deliberately designed to wrongfully attract consumers to the Respondent's website, on the basis of an assumed association with the Complainant.

8.4 The Respondent is trading on the Complainant's strong reputation, goodwill and market presence in Australia to attract consumers to its website.

8.5 The Respondent's motives for so doing are to obtain financial gain by selling hair care products that compete with the Complainant's products.

8.6 All of the foregoing constitute bad faith.

9. Remedy Sought

9.1 The Complainant requests that the Respondent be required to transfer the disputed domain name to them.

10. The Respondent's Case - Factual Background

- 10.1 The Respondents confirm that they purchased the disputed domain name knowing that it was essentially the same as "Moroccoil.com" and knowing that "Moroccoil" was a registered trademark.
- 10.2 They claim to have been told by the domain name vendor that they were entitled to register the domain provided they didn't offer "Moroccoil" products for sale.
- 10.3 They admit that their website "Moroccoil.com.au" can be misleading, while asserting that because their products are different to those offered by the Complainant the latter has not suffered loss.
- 10.4 The Respondent agrees that: *"it is best to not use moroccoil.com.au as our website and we are willing to change our website name and stop using moroccoil.com.au BUT we would rather cancel the domain than transfer to MOROCCANOIL as they have harassed and bullied us"*.

11. Decision, with brief reasons

- 11.1 The Respondent accepts that it should not continue to use the disputed domain name as it is misleading.
- 11.2 The Complainant wants the domain transferred into its name. The Respondent wants the domain name cancelled.
- 11.3 Has the Respondent failed all three tests contained in section 4(a) of Schedule A of the auDRP ?

Question 1: Per 4(a) (i) - is the domain name identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights?

- 11.4 **I find** that the domain name: "moroccoil.com.au" is "identical or confusingly similar" to "Moroccoil", being the name, trademark or service mark in which the Complainant has rights.

Question 2: Per 4(a) (ii) – has the Complainant established that the Respondent has no rights or legitimate interests in respect of the domain name?

- 11.5 **I find** that the Complainant has established that the Respondent lacks rights or legitimate interests in respect of the disputed domain name.
- 11.6 **I find**, solely for purposes of this determination, that the Respondent's commercial use of the "Moroccoil" name in Australia constitutes a direct infringement of the Complainant's trademark rights.

Question 3: Per 4(a) (iii) – has the Respondent registered or subsequently used its domain name in bad faith?

- 11.7 **I find** that the Respondent's original registration of the disputed domain, in full knowledge that: (a) the name was identical to "Moroccoil.com" and (b) the Complainant owned "Moroccoil" trademarks in Australia, constitutes an action made in bad faith insofar as a reasonable person in possession of that knowledge would have known that it was wrongful to so register the domain.
- 11.8 **I find** that the Respondent subsequently used the disputed domain name in bad faith, as they acknowledge that use of the word "Moroccoil" in the disputed domain in Australia was likely to confuse some website visitors: *"by using the domain name you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation or endorsement of that website or location or of a product or service on that website or location"* (paragraph 4(b)(iv) of the auDRP, with reference to 4(a)(iii) of the Policy).

12. Remedies Requested

- 12.1 In accordance with 4(i) of the Policy, the Complainant requests a decision that transfers the domain to the Complainant.
- 12.2 The Respondent resists this request and would prefer to cancel the domain registration altogether.
- 12.3 **I determine**, for the reasons given above, that the Complainant has succeeded on all three required arguments and accordingly, in compliance with auDA policies, I order the transfer of the disputed domains from the Respondent to the Complainant.

Signed as a Determination

A handwritten signature in black ink, appearing to read "Jon Kenfield". The signature is stylized and somewhat cursive, with a large loop at the end.

Jon Kenfield
Panellist
17th December 2012