

## **ADJUDICATOR DECISION**

CASE NUMBER:	<b>ZA2009-0031</b>
DECISION DATE:	<b>15 September 2009</b>
DOMAIN NAME	<b>finmedia24.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Llewellyn du Randt</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>Media 24 Limited</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Eben Van Wyk at Cliffe Dekker Hoffmeyr Inc.</b>
THE 2 <sup>nd</sup> LEVEL DOMAIN NAME ADMINISTRATOR:	<b>UniForum SA (CO.ZA Administrators)</b>

## 1 Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on 28 May 2009. On the same day the SAIPL transmitted by e-mail to UniForum SA a request for the registry to suspend the disputed domain name at issue, and UniForum SA confirmed that the disputed 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 ("the Supplementary Procedure").
- 1.2 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on 1 June 2009. Ordinarily, it would not be necessary to go into more detail as to exactly what transpired in the procedure. However, due to certain procedural issues which arose, the Procedural History of this matter is set out more fully below. The official commencement notice was sent out to all the listed address contacts for the domain name namely [co.za@www4.cpt1.host-h.net](mailto:co.za@www4.cpt1.host-h.net), [hostmaster@hetzner.co.za](mailto:hostmaster@hetzner.co.za), [zekini@live.co.za](mailto:zekini@live.co.za), [info@hetzner.co.za](mailto:info@hetzner.co.za) and [llwel@zekini.co.za](mailto:llwel@zekini.co.za). The addresses [co.za@www4.cpt1.host-h.net](mailto:co.za@www4.cpt1.host-h.net), [hostmaster@hetzner.co.za](mailto:hostmaster@hetzner.co.za), [zekini@live.co.za](mailto:zekini@live.co.za) and [info@hetzner.co.za](mailto:info@hetzner.co.za) were obtained from the .co.za public whois server and should therefore have been the correct contact details for the Registrant. The email address [llwel@zekini.co.za](mailto:llwel@zekini.co.za) was listed in the complaint as a contact email address for the Registrant and it is unclear where the Complainant obtained this address.
- 1.3 A hard copy of the Dispute and the Commencement Notice was also sent to the Registrant at its listed physical address according to the .co.za public whois server. This notice was dispatched by Speed Service Couriers on 1 June 2009.
- 1.4 The Registrant disputed that he received the complete set of papers dispatched by the Administrator on 1 June 2009. He claimed that he received copies of the case law relied on by the Applicant as well as the Commencement Notice, but he did not receive the Complaint or the annexures thereto. On 12 June 2009 the Registrant acknowledged receipt of the hard copy and requested that the Registrant's

deadline to respond to the Complaint be moved to 16 July 2009. This was due to an ongoing labour dispute between the Registrant and the Complainant. The ongoing labour dispute has remained an issue and whether or not a Labour Court or Tribunal proceedings are sufficient reason for the domain name proceedings to be suspended is dealt with in more detail below.

- 1.5 On 12 June 2009, the Registrant pointed out that the e-mail address to which the complaint had been transmitted, [llwel@zekini.co.za](mailto:llwel@zekini.co.za) was incorrect and should have been [llew@zekini.co.za](mailto:llew@zekini.co.za), being the Registrant's contact e-mail address according to the .co.za public "whois" server. All messages larger than 1MB sent to this address are deleted as spam, according to the Registrant. As a result the Registrant claimed not to have received the electronic copy of the complaint, together with the annexures thereto.
- 1.6 The Administrator has confirmed that at the time the original complaint was sent by e-mail, the Commencement Notice together with all attachments would certainly have been larger than 1MB. It does, however, appear that due to the use of an incorrect email address (obtained from the Complainant), and an email address which does not accept e-mails exceeding 1MB, the Registrant did not initially receive the Commencement Notice and Complaint via e-mail.
- 1.7 On 12 June 2009, the Administrator resubmitted the dispute by e-mail to the Registrant at his newly nominated email address, being [llew@zekini.co.za](mailto:llew@zekini.co.za). As the Registrant raised certain issues in respect of the labour dispute, these were referred to the Complainant who in turn responded stating that this should not suspend the determination of the domain name dispute. On the strength of what was contained in all relevant correspondence, the Administrator was satisfied that the labour dispute should not suspend the ADR process.
- 1.8 Accordingly, the Administrator granted the Registrant a short extension until 3 July 2009 in order to allow the Registrant time to file a response. This was communicated to the Registrant on 15 June 2009.
- 1.9 As part of the interchange of correspondence with the Administrator, the Registrant claimed that the document which was initially delivered to him by Speed

Service couriers and in relation to which he acknowledged receipt on 12 June 2009, on closer examination, did not include the actual complaint but consisted only of the case law referred to in the complaint as well as the Commencement Notice and Explanatory Cover Notice. The Registrant claimed he had still not received the complaint and the annexures thereto by e-mail. This was conveyed to the Administrator by the Registrant on 12 June 2009.

- 1.10 On 15 June 2009 the Registrant contacted the Administrator and advised it that the Complaint had not been received electronically. The Administrator requested that the Registrant furnish an e-mail address capable of receiving emails in excess of 1MB. The Registrant requested that the dispute be transmitted to [interdev@hotmail.com](mailto:interdev@hotmail.com).
- 1.11 On receipt of the Administrator's correspondence of 15 June 2009 the Administrator granted an extension until 3 July 200 to the Registrant. The Registrant claimed that he was not able to file a response before the deadline and requested that the deadline be extended until 23 July 2009. The reason given for the further extension request was that the Registrant was to be absent from office until 11 July and to allow the Registrant to properly prepare and deal with the litigation relating to a labour dispute between the Respondent and Complainant.
- 1.12 On 17 June 2009, the Administrator sent a further copy of the Complaint by Speed Service couriers to the Registrant's address. The Administrator confirmed with the Registrant that the Complaint had been resent and gave the Registrant the tracking number.
- 1.13 On 29 June 2009 the Registrant confirmed receipt of the hard copy and electronic copy of the complaint.
- 1.14 On 3 July 2009 the Registrant addressed further correspondence to the Administrator claiming that the Complaint as originally filed, was invalid as it exceeded the word count of 5000 as stipulated in the Supplementary Rules.
- 1.15 The Registrant did not respond to the complaint by the extended deadline of 3 July 2009. Accordingly, SAIPL appointed Marilyn Krige as the Adjudicator and Steven Yeates as Junior Adjudicator in this matter on 9 July 2009. The Adjudicator

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.

### 1.16 Word Count

1.16.1 On 3 July 2009 the Registrant raised the length of the complaint in correspondence with the Administrator. Although, at that time, the Registrant had not filed a formal response, as required by the Regulations, the Adjudicator believed that the correspondence should be taken into account.

1.16.2 In terms of Section 9(a) the word limit for the submission of a complaint or a response, as regulated by the provisions of paragraph 16(2)(o) of the Regulation shall be 5,000 words. It is unclear from the Supplementary Rules and the Regulations whether the word limit applies to the entire complaint or merely to a portion thereof. It is, however, generally accepted by panellists making a decision both under the ICANN UDPR and NOMINET proceedings that word limits apply to the substantive sections of the Complaint. (See *Societe des Technologies de l'Aluminium du Saquena Inc vs Success Inc WIPO D2008-2680 and Boutique Tristen & Iseut Inc. vs BB WIPO D 2007-1816*). In this case that would relate to Section X. The application of the word limit to this section of the complaint is also apparent from the dispute template provided by SAIPL. It is the view of the Adjudicator that the word limitation only applied to Section X of the Complaint.

1.16.3 At the time that the original Complaint was submitted, the Adjudicator was of the view that exceeding the word count by over 10% was not a minor breach which could be ignored. A breach relating to the word count, would ordinarily have been dealt with by the Administrator but, on this rare occasion it appears that the defect slipped through the net. It was, however, picked up by the Registrant who brought it to the Adjudicator's attention.

1.16.4 As a result of submissions made by the Complainant, it was clear from the Complainant's own version, that even if all paragraph numbering and punctuation was excluded, the word count for Section X would still exceeded the 5,000 word

limit prescribed by the Supplementary Rules, read together with the requirements of Regulation 16(2)(o). In the Adjudicator's view the Complaint did not comply with the Regulations. The options open to the Adjudicator were either to:

- reject the complaint out of hand;
- remit it back to the Complainant to render it compliant, i.e. reduce the word count;
- ignore the deficiency and proceed to make a decision.

1.16.5 The Adjudicator was of the view that, as this issue would ordinarily have been dealt with by the Administrator as the defect appears to have passed unnoticed, the most equitable manner of dealing with the particular matter was to remit the Complaint back to the Complainant and allow it the opportunity, in terms of the procedure set out in Annexure 5 of the Supplementary Rules, read together with the provisions of Regulation 17, to call on the Complainant, within 5 days from receiving the notification, to comply with the formal requirements of the Regulations of the Supplementary Procedure.

1.16.6 It remains the Adjudicator's view that in the circumstances of this matter it was fair and equitable that the Complainant be entitled to resubmit its complaint to comply with the Regulations without having to pay any additional administration fee.

1.16.7 As a consequence, a Procedural Directive was issued by the Adjudicator. The Complainant was called on to resubmit its Complaint to comply with the word count.

1.16.8 A revised dispute was filed with the South African Institute of Intellectual Property Law (SAIIPL) on 25 August 2009

1.16.9 In accordance with the Procedural Directive, the SAIPL formally notified the Registrant of the revised complaint. In accordance with the revised directive, the Registrant submitted its response timeously and the SAIPL verified that the response satisfied the formal requirements of the Regulations. The Complainant submitted a reply on 31 August 2009.

1.16.10 In accordance with the Regulations the reply was due on 31 August 2009 and the reply was duly submitted.

### 1.17 Extension of time

1.17.1 In terms of the Regulations, extensions of time may be granted by the Administrator in its discretion. One of the issues which arose in relation to the filing of the initial Complaint was whether or not additional extensions should have been afforded to the Respondent to file his reply.

1.17.2 Extensions are generally only allowed when good cause is shown by the requesting party. The Administrator has an obligation to ensure that it acts strictly in granting such extensions and remains mindful of the regulations. The regulations are there to provide an efficient and expeditious means of resolving a domain name dispute. The general powers of the Administrator, including the power to grant extensions, are set out in Regulation 24. Ordinarily, the Registrant would be afforded a period of 20 days from the date of the dispute, to provide the Administrator with a response. The Registrant requested extensions beyond this period.

1.17.3 However, as a Procedural Directive, calling for the refilling of the Complaint to comply with the word count was given by the Adjudicator, the question of an extension became moot. As consequences of Procedural Directive, the Registrant was afforded a *de facto* extension and ample time to properly consider the matter and to file a comprehensive response.

1.17.4 In terms of the Procedural Directive, the Registrant was afforded an additional 7 days from the date on which the amended complaint was received to file a response. The Adjudicator remains of the view that the Registrant had sufficient time to consider this matter and to file a full response

### 1.18 Complaint not received

1.18.1 The issue of the receipt of the Complaint was raised by the Registrant. In terms of Regulation 15, once a Dispute is lodged, a copy must be forwarded to the Registrant who is deemed to be notified about the dispute when the provider

has: (1) sent a hard copy of the dispute to the Registrant's physical address or has faxed a copy to the relevant contact details, and; (2) transmitted an electronic copy by e-mail.

1.18.2 In terms of Rule 15(7), a communication in terms of the Procedure is deemed to have been sent, if sent by courier, on the date marked on the receipt and, if transmitted electronically, on the date the communication was transmitted. In this matter, the dispute is deemed to have been sent for the first time on 1 June 2009. If the Registrant had not contacted the Administrator and informed it of its difficulties experienced in receiving the electronic copy of the dispute and furthermore, of the fact that the hard copy of the dispute was incomplete, the matter would have been referred to the Adjudicator on the basis that no response had been filed.

1.18.3 It is to prevent exactly such an occurrence that the Regulations provide for the dispute to be dispatched to at least two different modes of communication. Assuming that the Registrant lists the correct contact details when registering the domain name in question, it is likely to receive at least one copy of the dispute.

1.18.4 The Registrant did indicate that the original complaint as submitted to it was too large. It is not uncommon in the modern age of electronic communication that individuals and businesses place limitations on the size of e-mails to avoid unsolicited e-mails and viruses. From a practical perspective, the Administrator should be aware of this and ensure that the dispute is capable of being transmitted electronically. While the Administrator cannot be expected to anticipate the maximum size of e-mails allowed by the email address of the Registrants, the Administrator must consider transmitting the Commencement Notice and Explanatory Note in a single e-mail without further attachments. Thereafter, further e-mails containing annexures and copies of the case law should be sent to the Complainant. It is hoped that the Registrant will at least receive the Commencement Notice and the Explanatory Note in an e-mail which is likely to be very small in size and will contact the Administrator if the remaining documents are not successfully delivered.

1.18.5 The issue of whether or not the Registrant received the Complaint and had sufficient time to consider it, has become academic as a result of the Procedural Directive issued in this matter. It is submitted that the Registrant had ample time to consider both the original Complaint as submitted and the revised Complaint and did receive both.

#### 1.19 Ownership of the domain name

1.19.1 The Registrant has claimed in its response that it is not the proprietor of the domain name. The Registrant claims that it gave instructions to a web development agency to register the domain name in the name of Zekini cc, but that this was not done.

1.19.2 The terms and condition of registration of a domain with Uniform S.A. provide that Registrant warrants that the information contained in the application are correct. The Adjudicator, without the benefit of any evidence provided by the Registrant that the web developer did not follow instructions, can only rely on the information contained in the "whois" information pages. The Registrant is, according to the official records, the owner of the domain name. The Adjudicator accepts this. It is unnecessary for the Adjudicator to consider the matter further.

#### 1.20 Response not deposited to under Oath

1.20.1 The Complainant has raised in reply that the response from the Registrant, while purporting to be deposited to under oath, is not completed correctly as the certification page is incomplete. If the response received from the Registrant is to be ignored, the Complaint falls to be assessed as one in which the Registrant is in default. In the case of *embassytravel.co.za ZA 2008-0024* it is held that a matter with less than perfect compliance with the Regulations does result in a nullity. The question must be what weight must be attached to the submission.

1.20.2 The Adjudicator is interested in the facts in this matter. The response submitted by the Registrant is in response to the dispute and purports to be signed under Oath before a Commissioner. To ignore the submission would be to put form above substance. The response has therefore been considered by the Adjudicator

and is dealt with below. This is not to be taken as *carte blanche* to submit irregular submissions and each case will need to be decided on its merits.

### **1.21 Proceedings to be suspended indefinitely due to labour dispute pending between the parties**

1.21.1 The Registrant contends that these proceedings should be suspended due to the ongoing labour dispute between the parties. In terms of the Alternative Dispute Resolution Regulations, section 33, only legal proceedings which suspend a Dispute are those relating to the domain name. There is therefore no basis on which to suspend the present proceedings on the basis advanced by the Registrant.

## **2 Factual background**

2.1 The Complainant was incorporated in South Africa in 1950 and is a leading publishing company in South Africa. The Complainant's operations include the ownership and management of a number of award winning magazines, newspapers, internet businesses, book publishing, printing plants and distribution companies. Amongst its titles is a publication called Fin Week. The Complainant also has a division, trading under the name 24.com which is the largest internet publisher in South Africa. This has various associated divisions including news24, health24, property24, fin24, careers24, netads24 and wheels24.

2.2 The Complainant is the registered proprietor in South Africa of various trade marks including 2005/18460-63 FIN24 registered in classes 16, 35, 36 and 41 and the trade mark registration 2000/16381-86 MEDIA24 in classes 9, 16, 35, 38, 41 and 42. It also owns registrations 2000/20137-40 MEDIA24 and logo in classes 9, 16, 35 and 42, 2001/11969-74 EMEDIA24 in classes 9, 16, 35, 38, 41 and 42 and a pending application for FIN24 under number 2005/18459 in class 9. The Complainant has also applied to register FINMEDIA24 under numbers 2009/07212-16 in classes 9, 16, 35, 36 and 42. These applications were filed on 17 April 2009 and are pending. The Complainant is the proprietor internationally of a number of registrations for the trade mark MEDIA24. It has applied to register the trademark FIN24 in various countries and has secured registered rights in class 9 in China for FIN24 and device.

- 2.3 The Complainant is the proprietor of a number of domains which incorporate fin24 or media24. These include media24.com registered on 20 October 2000, media24.biz registered on 7 November 2001, media24.co.za registered on 26 May 2000, fin24.co.za registered on 17 May 2005, fin24.com registered on 1 May 2000 and 24.com registered on 28 August 1999.
- 2.4 The Registrant is a previous employee of the Complainant. There is an ongoing labour dispute relating to the termination of the contract of employment. The Registrant employment with the Complainant was terminated on 12 December 2008.
- 2.5 In 2008 the Complainant decided to form a new business unit and to combine its business and financial publications including Fin Week, Sake 24, Sake-Rapport, sake24.com, fin24.com and McGregor BFA under the name Finmedia24. It presented a launch of the business unit to its managers on 1 September 2008.
- 2.6 On 23 March 2009, the Complainant sent an internal announcement of the launch of Finmedia24 to its employees. On 26 March 2009, a press release regarding the launch of Finmedia24 was sent to various media publications. The launch was widely published and the Complainant has submitted articles in support of this.
- 2.7 The Registrant registered the domain name finmedia24 on 23 March 2003.

### **3 Complainant's Contentions**

- 3.1 The Complainant contends that the Disputed Domain Name is confusingly similar and/or identical to names and/or trade marks in which the Complainant has rights in that the Domain Name is a combination of the Complainant's trademarks and well-known trade marks FIN24 and MEDIA24. The Complainant also contends that the Disputed Domain Name is confusingly similar to the Complainant's prior domain name registrations and incorporates the Complainant's well-known media24 company name and is identical to the Complainant's Finmedia24 business unit.
- 3.2 The Complainant submits that the Disputed Domain Name is an abusive registration in the hands of the Registrant in that the Registrant intentionally blocked the registration of a name or mark in which the Complainant has rights. The Complainant refers to a number of decisions in support of its contention

namely *ZA2008-0018 (Luxottica Holdings Group vs Preshal Iyar) (the Sunglass Hut matter)* and *ZA2008-0021 (Sun International (IP) Limited vs Will Green), ESAT Digifone Ltd. vs Michael Fitzgerald Trading as Telco Resources, WIPO case number: D2000-0602, Fry Electronics Inc vs Whois ID Theft Protection, WIPO case number: D2006-1435 and Savino Dell Bene Inc. vs Graziano Innocentia Gennari : D2000-113*. The Complainant also refers to the case of *Tourism and Corporate Automation Ltd vs TSI Ltd., case number DAF-0096 WIPO*, for support of its contention that its former employee acted in bad faith in registering the domain name.

- 3.3 The Complainant contends that the Registrant has registered the domain name primarily to disrupt the business of the Complainant. The Complainant alleges that the Registrant, as a former employee of the Complainant, was well aware of the rights in and use made of FIN24 and MEDIA24 by the Complainant. The Registrant only registered the domain name to prevent the Complainant from registering the name of its business unit as a domain name and to prevent the Complainant from operating a website under such domain name and from exercising its rights.
- 3.4 The Complainant contends that the registration finmedia.co.za is an abusive registration. The Complainant may indicate that the registration of the Disputed Domain Name is not an abusive registration by showing certain factors. The Complainant deals with a number of these factors provided for in Regulation 5, namely:
  - 3.4.1 That before becoming aware of the Complainant's cause of complaint the Registrant had not used or made demonstrable preparations to use the Disputed Name in connection with good faith offering of goods and services. The website connected to the Domain Name is still indicated as "under construction".
  - 3.4.2 That before being aware of the Complainant's cause of complaint, the Registrant was not commonly known by the name or legitimately connected with a mark which is identical or similar to the Dispute Domain Name.

3.4.3 That the Registrant, as an ex-employee of the Complainant's group of companies and as a natural person, has no association with it and therefore cannot rely on the Regulations in terms of Regulation 5(a)3).

3.4.4 That the Disputed Domain Name is not used generically in a descriptive manner and the Registrant is not making fair use of it. The Complainant refers to a number of factors which show that there is no fair use and these will be dealt with in more detail below.

#### **4 The Registrant's contentions**

4.1 The Registrant contents in connection with the Complainant's rights that it is not in fact the owner of the Domain Name and that a close corporation called Zekini CC owns the Domain Name and not the individual Llewellyn Du Randt. The adjudicator has dealt with this *supra*.

4.2 The Registrant contents that the Domain Name was registered for developmental purposes and for launching its products which were due to be launched on 30 May 2009 but that this launch date has been suspended, pending the outcome of the labour dispute between the Respondent and the Complainant

4.3 The Registrant claims that its use of the Domain Name is in good faith in that the Registrant had already begun in February 2009 to populate the site and had sent financial statements for the business case to the South African Revenue Services in order to obtain a VAT registration number.

4.4 It adopted the Domain Name taking advantage of the Internet standards like fin for financial and used media as this is used generally and selected 24 for its connotations with 24/7. It claims that there are many Registrants of Domain Names which incorporate 24, fin or media that are not owned by the Complainant, being fin24.co.za, africansunmedia24.co.za and weddingmultimedia24.co.za. In the circumstances, the attempt by the Complainant to extract the Domain Name transfer from it is no more than an attempt to harass the Registrant. The Registrant focuses on the registration of the Domain Name finmedia.com to support its argument that the Complainant cannot claim any exclusive rights in the domain name finmedia24.

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- 4.5 The Registrant claims, as the Domain Name was registered prior to application having been made for the trademark FINMEDIA24, the Complainant is reverse domain hi-jacking. Furthermore, that the articles by the Complainant, which have been submitted to prove the launch of the division called Finmedia24, were written after the Complainant became aware of the ownership of the Domain Name by the Registrant.
- 4.6 The Registrant claims that it gave instructions to its developers to register the Domain Name on 20 March 2009, which date preceded the launch date by the Complainant.
- 4.7 The Registrant claims that the Domain Name is not identical or similar to a name or mark in which the Complainant has rights. The Registrant refers to a plethora of South African companies which are registered which incorporate media, fin or 24 as part of their names. The Registrant claims that the fact that there are various other companies internationally which own Domain Names such as finmedia.com and finmedia.org confirms that the Complainant cannot claim exclusive rights in the combination of Domain Name or any rights in the trademark at all. The Registrant claims that the Domain Name is not an abusive registration in terms of Regulation 3(1)(a) in that :
- 4.7.1 The Registrant has made no attempt to sell the Domain Name to the Complainant and has demonstrated a genuine intention to use the Domain Name;
- 4.7.2 The Registrant has been in the financial business for 6 years and intends to develop his business in this area;
- 4.7.3 The Registrant has only registered one Domain Name for development purposes and another for the final launch of a product line;
- 4.7.4 The use of the Domain Name is descriptive in nature and was registered prior to the launch of the Complainant's business unit;
- 4.7.5 The site is not publicly available due to the labour dispute and these proceedings should be suspended pending the conclusion of that labour dispute;

4.7.6 The Registrant requested that the dispute be denied and, although not specifically requested, it is clear from the contents of the reply that the Registrant asks that the Adjudicator make a finding of reverse Domain Name hi-jacking.

## 5 Discussions and findings

5.1 Regulation 3(1)(a) requires that the Complainant proves each of the following elements in order for the Disputed Domain Name to be transferred:

5.1.1 That the Complainant has established rights in respect of the name or mark which is identical or similar to the Disputed Domain Name;

5.1.2 That in the hands of the Registrant, the Disputed Domain Name is an abusive registration.

5.2 The Complainant's rights in the name finmedia24 and its trademarks MEDIA24 and FIN24.

5.2.1 Regulation 1 of the Alternative Dispute Resolution Regulations defines "rights" to include intellectual property rights, commercial, cultural, religious and person rights protected under South African law but is not limited to these. The definition is broad and rights are not restricted to rights founded on the principles of Trade Mark Law. The Definition recognises rights going beyond those in terms of the Trademarks Act 194 of 1993 or the requirements of common law or passing off. Such rights must, however, find recognition in law.

5.2.2 The Complainant has demonstrated that it owns various registrations in South Africa for the trademark MEDIA24 and FIN24. These rights are recognised in law. The combination of finmedia24 is, however, not yet registered and is only a pending application in various classes in South Africa. The Adjudicator finds that the Complainant cannot show trademark rights in finmedia24 (*ZA2007-0008-(privatesales.co.za)*) The Adjudicator deals with the registered trademarks in more detail below.

5.2.3 The Complainant claims that it owns a business name and Domain Name rights on the basis of the registration of its company name and the Domain Names mentioned above. These claims are rejected. A company or Domain Name

registration does not in itself give rise to any rights. See also *ZA2007-0001 (mrplastic.co.za)* and *ZA 2008-0020 (mixit.co.za)* where the Adjudicators confirmed that the registration of a company name *per se*, confers no rights on an entity in that the name is enforceable against third parties in the sense that the third party can restrict others from using it.

- 5.2.4 The Complainant also contends that it has common law rights in finmedia24 as a consequence of its use. The Complainant claims that although the use has not been extensive in time, in that its business division under the name Finmedia24 was only launched, at the earliest on 20 January 2009, the evidence which it has submitted indicates that its use since the official launch date by way of publications to the trade on 26 March 2009, is at least significant. The Registrant has not disputed that this business entity was launched and that it has traded and continues to trade under the name Finmedia24. This evidence has persuaded the Adjudicator that the Complainant has made out a case in support of its common law rights in the trademark FINMEDIA24.
- 5.2.5 The Complainant has already demonstrated that it is the proprietor of various registrations for FIN24 and MEDIA24. The fact that two different trademarks are combined in a Disputed Domain Name does not hinder a finding of confusing similarity (*see WIPO case number: D2008-1382 Quantas Airways Limited vs .Minh Huynh WIPO case number: D2000-1761 SAAB Automobile AB et al vs Joakim Nordberg*).
- 5.2.6 In this case, the Domain Name in dispute, finmedia24, incorporates the two trademarks which are registered in the name of the Complainant MEDIA24 and FIN 24. In order to succeed in terms of Section 3, the Domain Name in dispute does not need only to be identical to the Complainant's trade mark but may be shown to be confusingly similar. In *ZA2007-003 (Telkom SA Limited vs Cool Ideas 121290 CC)*, the Disputed Domain Name contained the Complainant's registered trademark TELKOM together with the descriptive/generic word media.
- 5.2.7 The Registrant has contended that the Complainant's rights cannot subsist in the mark finmedia24 because its mark is descriptive or generic and the parts of the Domain Name are used extensively.

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- 5.2.8 The Adjudicator finds that although media is descriptive, the combination of finmedia24 is neither descriptive nor generic, but even if it is, there is sufficient secondary evidence attached to the name finmedia24 to confer rights in the combination on the Complainant.
- 5.2.9 The Respondent's contention that the Disputed Domain Name incorporates generic phrases such as media, 24 and fin, which appear in other Domain Names in different combinations, is not relevant to determining the Complainant's rights in this matter. The Complainant does not have to prove rights in the Disputed Domain Name but a name or mark which is similar to the Disputed Domain Name. *(See also D2006-0669 (clicksbusinesscards.com) and D2000-1223 (trashylingeri.com)).*
- 5.2.10 Turning to the issue of the date from which the Complainant established its rights in finmedia24, the Complainant contends that its rights in this trademark, although it had not formally applied for the mark, were established prior to the registration of the Disputed Domain Name. Regulation 3(a) only provides that the Complainant needs to show rights in a mark. Similar matters have been considered by Nominet and the UDRP Policies which have made findings, with which the Adjudicator agrees, that the date on which the rights must exist is the date of the Complaint and not the registration date of the Disputed Domain Name.
- 5.2.11 The Adjudicator consequently finds that the Disputed Domain Name is similar to the Complainant's rights in the mark FINMEDIA24 in terms of Regulation 3(1)(a). The Disputed Domain Name uses a combination of the Complainant's registered trademarks FIN24 and MEDIA24. The fact that the Disputed Domain Name comprises generic words in combination does not assist the Registrant in escaping a finding of similarity.
- 5.3 The Disputed Domain Name in the hands of the Registrant as an abusive registration.

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- 5.3.1 Regulation 4(1) provides for a number of grounds on which the Complainant can rely in showing that the Disputed Domain Name is an abusive registration. For purposes of this dispute, the Complainant claims that it is abusive in that:
- It intentionally blocks the registration of name or mark in which the Complainant has rights;
  - It unfairly disrupts the business of the Complainant.
- 5.3.2 Having considered all the evidence, the Adjudicator finds that a case has been made out that the Registrant is using or has registered the Disputed Domain Name in a way that leads people or businesses to believe the Disputed Domain Name is registered or will be operated by the Complainant.
- 5.3.3 While the Registrant claims that the Domain Name was registered in good faith in order to take advantage of business opportunities and was applied to be registered before the official launch of the business division of the Complainant under the name Finmedia24, it has failed to disclose any evidence to prove this. The Registrant claims in its reply that the information is confidential and will be supplied to SAIPL, if it is called on to do so. The Adjudicator fails to see how this information, especially that relating to the establishment of its business and the registration of the Domain Name in question, can be confidential or in any way negatively influence other legal proceedings. Without this information the Adjudicator can only decide the matter on what is before it.
- 5.3.4 The Registrant has failed to take the Adjudicator into its confidence. Evidence as to instructions given to a developer in Cape Town and application for a VAT number would have helped to establish the good faith intentions of the Registrant.
- 5.3.5 It is significant that the registration of the Domain Name happened only days before the official launch of the new division Finmedia24 by the Complainant. While the Registrant states that he could not have been aware of this launch, the Adjudicator holds the view that the time line is significant in this matter. The Registrant had an employee/employer relationship with the Complainant, which has soured. It is significant that registration of the Domain Name was obtained

around the same time as the launch of the Complainant's business unit when the Registrant would still have had access to and been in discussions with colleagues who were employed by the Registrant. The Adjudicator rejects the Registrant contention that it was mere coincidence which led to the registration of the Disputed Domain Name.

5.3.6 It is significant that the Disputed Domain Name was registered both in the .co.za and .com space. The Registrant has failed adequately to explain the reason for both registrations.

5.4 Factors indicating that the Disputed Domain Name is not an abusive Domain Name:

5.4.1 The factors mentioned by the Registrant in claiming that the disputed name is not an abusive domain name merit some analysis, even though they do not persuade the adjudicator to make a different finding. Regulation 5 provides the grounds on which the Registrant can rely on in showing that the disputed domain name is not an abusive registration. Although the Registrant has not dealt with the grounds individually, it appears that its contentions are limited to regulation.

5.4.2 "5(a)(2) Before becoming aware of the complainant's cause for complaint, he used or made preparations to use the domain name in connection with a good faith offering of goods or services;" and

5.4.3 "5(b) The domain name is used generically or in a descriptive manner and the Registrant is making fair use of it;"

5.4.4 The domain name was registered with the effective date of 23 March 2009. The complainant only became aware of the registration on 1 April 2009. On 2 April 2009, the Complainant addressed a letter to the Registrant demanding that the domain name be transferred to the Complainant. The Registrant refused or failed to respond to the letter dated 2 April 2009 and the Complainant sent a further letter on 17 April 2009. This letter also remained unanswered. A search of the website shows that the domain name resolves to a website indicating that the website will soon be the new home of the domain name. While there was no response to the letters sent to the Registrant, the Adjudicator finds that there is

no demonstrable preparation to use, or use, of the disputed domain name at the relevant time as required by regulation 5(a).

- 5.4.5 The Registrant has not led much evidence to show that the registration of the domain name was not made in bad faith. The Registrant does not dispute that he was previously employed by the Complainant. On termination of that agreement, sometime afterwards, he registered the domain name Finmedia24. The Adjudicator, having analysed the evidence, is of the view that the Registrant would have known of the Complainant's rights, if not in Finmedia24, certainly in MEDIA24 and FIN24. In the case of *Tourism and Corporate Automation Ltdv TSI Ltd., case number DAF0096*, the WIPO panel concluded that the registration of a domain name by a former employee, on those facts, was sufficient evidence of bad faith. The Adjudicator is of the view that only one inference can be drawn from the circumstances in this matter: that the departing employee, the Registrant, was attempting to disrupt the business of his former employer.
- 5.4.6 The Adjudicator refers to the case of *Savino Del Bene Inc vs Graziano Innocenti Gennari D2000-113* WIPO. The panel in that matter held that as a general rule, a former employee does not have a legitimate right or interest in registering in its own name their former employer's trade mark as a domain name.
- 5.4.7 As in the Telkom case quoted above, it is the Adjudicator's conclusion that an ex-employee, still with contacts in his previous employee's business would certainly have known about the value of the domain name. In addition, although the labour dispute does not form part of these proceedings, it is clear that the relationship did not end on a high note. Taking all of these factors into account, the Adjudicator rules that the Registrant must have had the intention to block the registration of Finmedia24 by the Complainant or any of its subsidiaries.
- 5.4.8 Numerous decisions have held that the timing of a domain name registration close to the announcement of a name change or establishment of a business unit is a factor in determining the existence of bad faith (see *Time Warner Inc and EMI Group PLC vs CPIC Netcase D2000-0433 & the London Metal Exchange Ltd vs Syed Hussain D2000-1388*). The Adjudicator finds that on a balance of probabilities the Registrant's passive use of the disputed domain name amounts

to use in bad faith. Since making a finding on regulation 3(a), it is not necessary to make findings in connection with other grounds offered in support that the registration is not an abusive Registration. Consequently, the Adjudicator rejects the Registrant's request to find domain name hijacking .

**6 Decision:**

- 6.1 For all of the foregoing reasons, in accordance with regulation 9, the Adjudicator orders that the domain name Finmedia24 be transferred to the Complainant.



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MARILYN KRIGE  
SAIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)

STEVEN YEATES  
SAIPL JUNIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)