

Decision

[ZA2013-0144]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2013 - 0144
DECISION DATE:	5 July 2013
DOMAIN NAME	absacard.co.za absacredit.co.za absafinance.co.za absaprivate.co.za absacreditcard.co.za absalegal.co.za absamobile.co.za absamoney.co.za
THE DOMAIN NAME REGISTRANT:	Mark John Cartmell / Bizmedia
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	ABSA BANK Limited
COMPLAINANT'S LEGAL COUNSEL:	Mariette Viljoen ADAMS and ADAMS
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") in terms of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure on the **29 April 2013**. On **2 May 2013** SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on the same day UniForum SA confirmed that the domain name had indeed been suspended.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **8 May 2013**. In accordance with the Regulations the due date for the Registrant's Response was **5 June 2013**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **10 June 2013**.
- c) On **11 June 2013** the ASIPL approached **Tana Pistorius** as the Adjudicator and **Sizwe Snail Ka Mtuze** was appointed as trainee adjudicator in this matter on **13 June 2013**. The Adjudicator and Trainee Adjudicator have 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, ABSA Bank Limited, is the proprietor of the trade mark ABSA, registered in South Africa and elsewhere in class 36 in respect of "Insurance, financial, banking and investment services, services in insurance brokers and agents, insurers, financiers, investment consultants, agents and brokers for bonds and other securities; real estate valuation, management and development; leasing and hire purchase services; estate agents; building societies; services related to credit including credit card facilities". This mark was registered in 1991. The Complainant has also registered its

ABSA trade mark and various device marks in relation to a wide range of goods and services in South Africa and in numerous other countries. The Complainant submitted a list of its trade marks and this list comprises of 61 pages.

2.2 The Complainant has also registered many domain names in the co.za domain space, as well as in other domain spaces, that incorporate ABSA trade mark. Some of these domains include <absa.co.za>; <absabank.co.za>; <absabanking.co.za>; <absainvestment.co.za>; <absaloan.co.za>; <absaprivatebank.co.za>; and <absa.biz>. The <absa.co.za> domain name was registered on 1 January 1995.

2.3 The Registrant of the disputed domain names <absacard.co.za> (registered 30 September 2011); <absacredit.co.za> (registered 21 May 2012); <absafinance.co.za> (registered 4 June 2012); <absaprivate.co.za> (registered 4 November 2010) is Bizmedia CC. The Registrant of the disputed domain names <absacreditcard.co.za> (registered 22 February 2013); <absalegal.co.za> (registered 13 March 2013); <absamobile.co.za> (registered 13 March 2013); and <absamoney.co.za> (registered 22 February 2013) is Mr. Mark John Cartmell. Mr Cartmell is the sole member of Bizmedia CC.

3 Parties' Contentions

3.1 Complainant

a) The Complainant contends that the disputed domain names are similar to a name or mark in which the Complainant has rights in terms of Regulation 3(1)(a). The Complainant contends that a dominant part of the disputed domain names comprise of the word ABSA, which is identical to the registered trademark ABSA, which has been registered by the Complainant as a trademark. Complainant claims its ABSA trade mark has become a household name in South Africa and a well-known trade mark for purposes of section 34(1)(c)

of the Trade Marks Act 194 of 1993.

- b) The Complainant alleges that its trade mark ABSA is one of the most well-known brands in South Africa. It has over 12 million customers in South Africa. The Complainant's expenditure on advertisements and promotions is ZAR R1 603 834 450.
- c) The Complainant has not authorised the Registrant to use the ABSA trade mark in the course of his trade. The Complainant sent a letter of demand to the Registrant on 4 March 2013. The Registrant indicated that it is using the disputed domain names to promote an *entity* called "All Promotion SA".
- d) The Registrant offered to sell the disputed domain names to the Complainant for an amount of R10 590 in a letter dated 12 April 2013. The Registrant is offering the disputed domain names for sale on the web site bizmedia.co.za for R10 000 each.
- e) The Complainant alleges that the disputed domain name was registered and has been used in a manner which takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights and is accordingly an abusive registration in accordance with the Regulations.
- f) The Registrant's use of the Complainant's well-known ABSA trade mark in relation to the services offered on the disputed websites overlap with services covered by the Complainant's above classes 36 and 42 ABSA trade mark registrations. The Registrant's active web sites contain information and news regarding finance, credit cards and banking. The Complainant alleges that this amounts to trade mark infringement in terms of Sections 34(1)(a) and/or 34(1)(b) of the Trade Marks Act. The Registrant's conduct also amounts to passing-off.

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- g) Complainant submits that the domain name in the hands of the Registrant is an abusive registration in terms of Regulation 3(1)(a).
- h) Complainant alleges that the disputed domain names are abusive registrations as the Registrant registered the domain name primarily to sell or otherwise transfer it to a Complainant or to a competitor of a Complainant, or any third party, for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name.
- i) Furthermore the Complainant submits that the domain names are not used in connection with a *bona fide* offering of goods or services. The Complainant submits further that the Registrant is intentionally trying to block the registration by the Complainant of the disputed domains, in which the Complainant has rights that predate the registration of the disputed domain names by approximately 20 years.
- j) The Complainant alleges that the Registrant is using the disputed domain names for the Registrant's own commercial gain. It is further alleged that the Registrant is inhibiting the marketing efforts of the Complainant. The Registrant also alleges that the Registrant is also unfairly disrupting the business of the Complainant by infringing the Complainant's ABSA trade mark and by passing-off to members of the public that the disputed domain names and the websites that they resolve to are associated with the Complainant, which is not the case. The Complainant is preventing the Complainant from exercising its rights.
- k) Complainant submits that the above factors in terms of Regulations 4(1)(a)(ii), 4(1)(a)(iii) and 4(1)(a)(iv) of the ADR regulations indicate that the disputed domain names are abusive registrations.

3.2 Registrant

- a) Regulation 18(1)(a) provides that a Registrant must respond to the statements and allegations contained in the Dispute in the form of a Response. In such a Response, the Registrant must detail any grounds to prove the domain name is not an abusive registration.
- b) The Registrant has not responded to the Complaint.
- c) Because the Registrant failed to submit a Response, the Adjudicator must decide the matter on the Dispute (see Regulation 18(3)).
- d) Regulation 28(2) provides that, in the absence of exceptional circumstances, an Adjudicator shall draw such inferences, as it considers appropriate, from the failure of a party to comply with a provision or requirement of the Regulations. The Adjudicator draws the following two inferences:
 - (i) the Registrant does not deny the facts that the Complainant asserts; and
 - (ii) the Registrant does not deny the conclusions that the Complainant draws from these facts.
- e) Notwithstanding these inferences, the Adjudicator has analyzed Complainant's version in order to satisfy herself that the allegations contained in its Complaint are acceptable and probably true (see ZA2007-0010 (Multichoice Subscriber Management v JP Botha) and ZA2012-0117 (Antonie Goosen v SARS)).

4 Discussion and Findings

4.1 Complainant's Rights

- 4.1.1 The Complainant has registered rights in respect of the trade mark ABSA that date back to 1991. Prima facie, the Complainant is the proprietor of validly registered trade marks that comprise of, or

incorporate, the trade mark ABSA.

4.1.2 The Registrants did not dispute the evidence submitted by the Complainant and the Adjudicators find on such evidence that ABSA is indeed a well-known trade mark within the meaning of section 34(1)(c) of the Trade Marks Act.

4.1.3 The disputed domain names at issue are <absacard.co.za>; <absacredit.co.za>, <absafinance.co.za>; <absaprivate.co.za>; <absacreditcard.co.za>; <absalegal.co.za>; <absamobile.co.za>; and <absamoney.co.za>. The Adjudicator finds that neither the words "credit"; "finance"; "private"; "credit and card"; "legal"; "mobile" and "money" nor the suffix .co.za have any influence on the consideration of similarity (see D20020810 (Benetton Group SpA v Azra Khan)).

4.1.4 The Adjudicators find that the disputed domain names are similar to the Complainant's trade mark.

The Complainant has thus established that it has rights in respect of the trade mark ABSA, which is similar to the disputed domain name.

4.2 Abusive Registration

4.2.1 The adjudicator finds that the disputed domain names are similar to the Complainant's mark as contemplated by Regulation 3(1)(a). The question is whether the disputed domain names, in the hands of the Registrant, are abusive registrations.

4.2.2 An abusive registration means a domain name which either:

- (i) Was registered in a manner which, at the time when the registrations took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights; or
- (ii) Has been used in a manner that takes unfair advantage

of, or is unfairly detrimental to the Complainant's rights.

Evidence of an abusive registration, which is deemed relevant to the Dispute, is described in Regulation 4(1)(a)-(b).

Was the disputed domain names registered primarily to sell it to the Complainant for valuable consideration in excess of the Registrant's reasonable out of pocket expenses Regulation 4(1)(a)(i)?

The Registrant offered to sell the disputed domain names to the Complainant (and later to third parties) for more than out of pocket expenses. The Adjudicators find, on a balance of probabilities, that the disputed domain names are abusive registrations in accordance with Regulation 4(1)(a)(i) (see ZA2009 – 0034 (Absa Bank Limited v Digital Orange (aka Joris Kroner)); and ZA2012 – 0107 (Primedia (Pty) Ltd v DMF Industries)).

4.2.3 Was the disputed domain name registered primarily to intentionally block the registration of a name/mark in which the Complainant has rights (Regulation 4(1)(a)(ii))?

The Adjudicator in ZA2007-0003 (Telkom SA Limited v Cool Ideas 1290 CC) held that a blocking registration has two critical features. The first is that it must act against a name or mark in which the Complainant has rights. The second feature relates to an intent or motivation in registering the domain name in order to prevent a Complainant from doing so.

The Registrant must be aware of the well-known ABSA trade marks as they are well known in South Africa. The Registrant is using the disputed domain names for the Registrant's own commercial gain and in relation to financial and banking services. The Adjudicators find, on a balance of probabilities, that the Registrant registered the disputed domain names primarily to block intentionally the registration of a name in which the Complainant has rights.

4.2.4 Was the dhe disputed domain registered primarily to disrupt unfairly the business of the Complainant (Regulation 4(1)(a)(iii))?

ZA2007-0003 (Telkom Sa Limited v Cool Ideas 1290 CC) confirmed that the disruption of the business of a Complainant may be inferred if the Registrant has registered a variation of the Complainant's mark by merely adding a generic word. The Registrant registered the Complainant's mark and added the generic terms that relate to Complainant's business.

Accordingly, the Adjudicators find, on a balance of probabilities, that the Registrant registered the disputed domain name primarily to disrupt unfairly the business of the Complainant.

4.2.5 Was the disputed domain was registered primarily to prevent the Complainant from exercising its rights (Regulation 4(1)(a)(iv))? Two issues must be considered here. First, whether the disputed domain name prevents the Complainant from exercising its rights in the .co.za registry. Secondly, the question arises whether the Registrant had acted in good faith or otherwise in registering the disputed domain name (see ZA2007-0003 (Telkom Sa Limited v Cool Ideas 1290 CC)).

The domain name registration prevents the Complainant from exercising its rights i.e. registering <absamobile.co.za> as its own domain name in the .co.za registry. Was the disputed domain name registered in good or in bad faith? The Registrant warranted, in terms of the UniForum SA terms and conditions (clause 5.1), that when registering the disputed domain name:

" it has the right without restriction to use and register the Domain Name"

"the use or registration of the Domain name by (the Registrant) does not or will not interfere with, nor infringe the right of any third party in any jurisdiction with respect to

trade mark, service mark, trade name, company name, close corporation name, copyright or any other intellectual property right”.

It appears to be undeniable that the Registrant knew that the Complainant holds trade marks rights in the name ABSA. Furthermore, the Registrant registered two of the disputed domain names, namely <absacreditcard.co.za> and <absamoney.co.za> on the day it received the Complainant’s letter of demand and two other disputed domain names, <absalegal.co.za> and <absamobile.co.za>; was registered on month later.

Furthermore, the Registrant's failure to submit a Response is particularly relevant to the issue of whether the Registrant registered the domain name in bad faith (see D2000-0325 Kabushiki Kaisha Toshiba v Shan Computers par 6.4). The Adjudicator concludes that the disputed domain registration was made in bad faith.

The Adjudicators accordingly finds, on a balance of probabilities, that the Registrant registered the disputed domain names primarily to prevent the Complainant from exercising its rights.

- 4.2.6 Are there circumstances indicating the Registrant is using or has registered the disputed domain in a way that leads people to believe that the domain name is registered to, operated to or authorised by, or otherwise connected with the Complainant (Regulation 4(1)(b))?

As the disputed domain names incorporates the Complainant’s trade mark, the registrations lead people or businesses to believe that the disputed domain names are registered to, operated or authorized by, or otherwise connected with the Complainant. The Complainant correctly points out that as it is a bank and financial services provider, if its clients search on-line for mobile banking or credit cards they are likely to search for “ABSA mobile” or “ABSA credit card”.

The Registrant's actions may be characterised as opportunistic bad faith (see Case No. D2003-0985 Société des Bains de Mer et du Cercle des Etrangers à Monaco v Internet Billions Domains Inc).

Accordingly, the Adjudicators find, on a balance of probabilities, that the Registrant has registered the domain name in a way that leads, or will lead, people and businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

5. Decision

- 5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicators order that the disputed domain names <absacard.co.za>; <absacredit.co.za>, <absafinance.co.za>; <absaprivate.co.za>; <absacreditcard.co.za>; <absalegal.co.za>; <absamobile.co.za>; and <absamoney.co.za> be transferred to the Complainant.

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