

Decision

2013-0145

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

ADJUDICATOR DECISION

CASE NUMBER:	2013-0145
DECISION DATE:	2 September 2013
DOMAIN NAME	ccma.co.za
THE DOMAIN NAME REGISTRANT:	Concord Employment Contractors
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Commission for Conciliation, Mediation and Arbitration (CCMA)
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIIPL”) on **10 May 2013**. On **13 May 2013** the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **5 June 2013** UniForum SA confirmed that the domain name had indeed been suspended. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIIPL’s Supplementary Procedure.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **16 May 2013**. In accordance with the Regulations, the due date for the Registrant’s Response was **13 June 2013**. The Registrant requested an extension for filing its Response until **28 June 2013**, to which the Case Administrator agreed. The Registrant submitted its Response on **27 June 2013**, and the SAIIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIIPL’s Supplementary Procedure. The SAIIPL forwarded a copy of the Response to the Complainant on **28 June 2013**.
- c) In accordance with the Regulations the due date for the Complainant’s Reply was **5 July 2013**. The Complainant requested an extension for filing its Reply until **19 July 2013** to which the Case Administrator agreed. The Complainant filed its Reply on **18 July 2013**, and a copy thereof was sent to the Registrant on **22 July 2013**.
- d) The Parties had elected that this Dispute be adjudicated by a panel of 3 (three) adjudicators. Accordingly, the SAIIPL appointed **Mr Gavin Morley SC, Ms Vanessa Lawrance** and **Mr Andre van der Merwe** as the

Adjudicators in this matter on **25 July 2013**. The Adjudicators have submitted the required Statements of Acceptance and Declarations of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

- e) As indicated above, and by way of confirmation, the Parties had agreed to have the Dispute adjudicated by 3 (three) Adjudicators, in accordance with Regulation 20, and that the applicable fees would be shared equally between the Parties.

Regarding the above extensions, the Adjudicators wish to make the following comments:

- i) The Regulations do not make express provision for an extension to be granted to a party for filing of its documents. However, in terms of Clause 11(1) of the SAIPL's Supplementary Procedure, the Case Administrator may, in his/her discretion, allow a limited extension to a party on good cause shown. Clause 11(2) further provides that the Case Administrator shall act strictly in granting any extension, and will remain mindful of the fact that the Regulations are intended to provide an efficient and expeditious means to resolving domain name disputes.
- ii) In respect of the two extensions referred to above, the Adjudicators are satisfied that the Case Administrator has applied his/her mind to the reasons provided for the respective extensions, and had quite correctly allowed both of these limited extensions on good cause shown.
- iii) The Adjudicators are aware that in other disputes, the Case Administrator has allowed an extension to a party on good cause shown. Accordingly there are clear precedents for such extensions

being allowed in domain name disputes. It is also common practice in High Court cases that the parties may agree to extensions *inter se* or that a Judge may grant condonation for late filing of a document where one of the parties does not agree to a requested extension.

- iv) Although the Regulations do not expressly provide for extensions, the Adjudicators believe that express provision should be made in the Regulations for the Case Administrator to allow a limited extension to a party on good cause shown, and/or for an Adjudicator to condone a limited extension allowed to a party on good cause shown, as the case may be. This view is supported by Regulation 24(1) that states: “An Adjudicator must ensure that the parties are treated with equality and that each party is given a fair opportunity to present its case.” Providing a limited extension to a party on good cause shown will, against the above background, maintain a balance with Regulation 24(2) that states: “An Adjudicator must ensure that the dispute is handled as expeditiously as possible.”

2 Factual Background

2.1 The Complainant is the Commission for Conciliation, Mediation and Arbitration, an independent public labour dispute resolution body established in 1996 in terms of the Labour Relations Act, no 66 of 1995. The Complainant’s National office is situated in Johannesburg and it has 18 other (regional) offices situated throughout South Africa in all 9 Provinces.

2.2 The Complainant’s relatively simple and publically funded labour dispute resolution processes, in addition to its other related services, have made it a relatively simple route and forum for labour-based disputes for a large number of persons in South Africa – viz for both employers and employees.

- 2.3 Further to the above, the number of matters that have been referred to the Complainant from 1996 to 2012, amount to just under 2 million.
- 2.4 The Complainant registered the domain name ccma.org.za and launched its website www.ccma.org.za in 1996.
- 2.5 The Complainant's above website receives thousands of visits monthly. During the months of January 2013 to March 2013, the website received over 64 000 visits.
- 2.6 The Complainant's name and trademark CCMA (-the acronym of its name) has always been clearly displayed on its website.
- 2.7 The Registrant is a company duly registered under the company laws of South Africa. Its activities include providing information to members of the public about the Complainant's procedures and statutory services; and/or directing enquirers to service providers, such as specialized labour law attorneys, who offer legal advice and services to employers or employees, as the case may be, needing or wanting to approach the Complainant.
- 2.8 The Registrant registered the disputed domain name ccma.co.za on 2 July 2001.

3 Parties' Contentions

3.1 Complainant

- a) In light of the above paragraphs 2.1 to 2.6, the Complainant contends that it is the proprietor of the well-known name and trademark CCMA in South Africa, which is the acronym of its full name, as set out above.

- b) The Complainant contends that its CCMA trademark has, since 1996, been exclusively associated by members of the public with the Complainant.
- c) The Complainant contends that it has acquired common law rights in and to the trademark CCMA, and that such rights (dating from 1996) predate the registration of the disputed domain name (2 July 2001).
- d) The Complainant contends that the disputed domain name is identical to the Complainant's trademark CCMA.
- e) The Complainant contends that, in terms of Regulation 5(c), because the disputed domain name (not including the first and second level suffixes) is identical to the Complainant's trademark CCMA, without any addition, the burden of proof shifts to the Registrant to show that the disputed domain name is not an abusive registration.
- f) The Complainant contends that the disputed domain name directs internet users to the website at www.ccma.co.za. This website shows: the Complainant's CCMA trademark in a large font and in upper case with "co.za" in lower case below it; the slogan "CCMA Assistance for Everyone" prominently; that the Registrant is using the disputed domain name and trademark CCMA to refer to the Complainant; and that the services offered on the website involve the services offered by the Complainant; and that members of the public in South Africa would be confused and/or deceived into believing that the disputed domain name and website at www.ccma.co.za are operated, or are in some way connected with the Complainant, which is not the case. The Complainant therefore contends that this conduct by the Registrant amounts to passing-off, and the Complainant's

rights to institute passing-off proceedings in the High Court have been reserved.

- g) Following from paragraph (f) above, the Complainant contends that potential users of the Complainant's services would be confused and/or deceived into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. In this regard the disputed domain name offends against the provisions of Regulation 4(1)(b) and hence is an abusive registration.
- h) The Complainant contends that it did not authorise the Registrant to use its CCMA trademark in the course of trade or to register the disputed domain name.
- i) The Complainant contends that, from the actions of the Registrant, the only inference that can be drawn is that the Registrant was aware of the Complainant, its services, and its CCMA name and trademark when the disputed domain name was registered; and that the *modus operandi* of the Registrant was to attract, for commercial gain, internet users to its own website by registering the disputed domain name and using the Complainant's trademark CCMA.
- j) The Complainant contends that, by registering the disputed domain name, the Registrant has blocked the registration by the Complainant of its CCMA name/trademark as a domain name. In this regard the disputed domain name offends against Regulation 4(1)(a)(ii) and hence is an abusive registration.
- k) The Complainant contends that the registration of the disputed domain name is unfairly disrupting the business of the Complainant,

and is preventing the Complainant from exercising its rights and discharging its public duties. In this regard the disputed domain name offends against Regulations 4(1)(a)(iii) and 4(1)(a)(iv) and hence is an abusive registration.

- l) The Complainant contends that the contact details provided by the Registrant in the Whois database are false and incomplete. In this regard the disputed domain name offends against Regulation 4(1)(d) and hence is an abusive registration.
- m) The Complainant contends that the disputed domain name offends against a number of Regulations, as set out above. In terms of Regulation 4(1) these factors may indicate that the disputed domain name is an abusive registration.
- n) Lastly, the Complainant contends that, because the disputed domain name was i) registered in a manner which, at the time when registration took place, took unfair advantage of, or was unfairly detrimental to the Complainant's rights; and ii) has been used in a manner that takes unfair advantage of, and is detrimental to the Complainant's rights, the disputed domain name is an abusive registration (in terms of the definition of an abusive registration in the Regulations).

3.2 Registrant

- a) The Registrant contends, at the outset, that the Adjudicators will have to make a clear ruling on whether the Registrant, in making use of the disputed domain name, is making non-commercial use of the domain name by offering free information to the public relating to the public, or whether it does so solely for commercial gain by referring visitors

- to other sites/services in order to obtain appropriate legal representation.
- b) The Registrant contends, by way of response to the Complainant's contentions in paragraphs 3(1)(a), (b) and (c) above, that the Complainant, as a publicly funded, non-profit entity created by statute, does not enjoy a protectable right to the trademark CCMA; and that the activities performed by the Complainant are prescribed by statute and do not amount to "trading" or "services" for purposes of establishing a protectable right either in terms of the common law of South Africa relating to unfair competition or the SAIPL Regulations.
- c) The Registrant contends that "CCMA" as an abbreviation does not constitute a protectable mark or trademark, due to its general nature or the generic manner of its use. The Registrant also contends that the Complainant is generally known to the public as the Commission for Conciliation, Mediation and Arbitration.
- d) The Registrant contends that the Complainant does not enjoy a protected right to the CCMA mark, whether in terms of the Trade Marks Act 194 of 1993 or in terms of the common law.
- e) The Registrant disputes whether the Complainant has the requisite mandate from its constituents and/or social partners to pursue this complaint because it has submitted no resolution authorising this legal action.
- f) The Registrant further contends that the Complainant is acting outside the scope of its prescribed functions by entering into this dispute; and submits that the Complainant has not shown that it has

- been duly and specifically authorised to expend its public funding for the purpose of this rights dispute.
- g) The Registrant contends that the Complainant is the only option (and not the “preferred” option as contended by the Complainant) which is available to the South African public free of charge in respect of employment disputes.
- h) The Registrant disputes that the disputed domain name is being used in a manner that interferes with the Complainant’s statutory functions and obligations. On the contrary, the Registrant contends that it both aids the Complainant in its functions and obligations and provides valuable information to the public.
- i) The Registrant contends that the common law does not make provision for a statutory body to descend into the marketplace in an attempt to acquire a right which can only be lawfully conferred on it by statute.
- j) The Registrant contends that the Complainant’s dispute management services are not performed for commercial gain but for the benefit and awareness of the public pursuant to its obligations under the Labour Relations Act.
- k) The Registrant contends that, in the light of the evidence submitted by the Complainant in respect of referrals to the Complainant and visits to its website, the Complainant does not seem to be suffering material prejudice.
- l) The Registrant contends that the Complainant has failed to show that it has established an exclusive and/or commercial reputation

specifically in respect of the “CCMA” mark.

- m) The Registrant contends that *bona fide* traders providing (legal) services in connection with the Complainant would, in the course of trade and without improper motive, require the use of the “CCMA” mark in order to distinguish their services. The Registrant’s use of the “CCMA” mark is therefore reasonably necessary in order to describe the information and/or services it makes available using the disputed domain name. Accordingly the Registrant contends that a reasonable member of the public would not be confused or deceived about the nature of such information and/or services.
- n) The Registrant contends that no common law right in respect of the “CCMA” mark accrues to the Complainant; that it does not constitute a trademark; and that it has not been registered as such in terms of the Trade Marks Act. Hence the burden of proof has not shifted to the Registrant [in terms of Regulation 5(c)].
- o) The Registrant contends that it acquired the disputed domain name during the course of January 2012 from the original registrant but that it was aware of the Complainant and its statutory functions at that time.
- p) The Registrant contends that the graphic device (“CCMA.co.za”) used by it bears no resemblance to the logo used by the Complainant, apart from the reasonably necessary use of the “CCMA” abbreviation.
- q) The Registrant further contends that a clear disclaimer is displayed on its website; and that its conduct does not amount to passing off.

- r) The Registrant contends that it is making generic and fair use of the disputed domain name; and that its use amounts to a *bona fide* offering of services incidental to the functions of the Complainant.
- s) The Registrant contends that the case of South African Revenue Services v Antonie Goosen (ZA2012-0117) cited by the Complainant is not relevant to the present dispute.
- t) The Registrant contends that, in the event that the Adjudicators find that the Complainant has some form of protectable right in respect of the “CCMA” mark, such right has been tacitly waived by the Complainant (because it alleges that the Complainant has waited almost 12 years to bring this complaint).
- u) The Registrant contends that the disputed domain name is not blocking the registration of a name or mark by the Complainant because it enjoys no protectable right therein and the Registrant is making *bona fide* and fair use of the disputed domain name.
- v) The Registrant contends that prior to this dispute being lodged, it was not aware that the details of the disputed domain name registration on the Whois database were incomplete and/or incorrect.
- w) The Registrant therefore contends that, in view of the above contentions, the disputed domain name is not an abusive registration.
- x) The Registrant finally contends that the Complainant is using the Regulations in bad faith in order to prevent the Registrant from using the disputed domain name in a way that the Complainant does not approve of. Accordingly this complaint amounts to an attempt to

deprive the Registrant of the disputed domain name. Hence the Registrant contends that the Adjudicators should make a finding of reverse domain name hijacking and hence (also) that the disputed domain name is not an abusive registration.

4 Discussion and Findings

- a) In order to make a finding that the disputed domain name is an abusive registration, the Adjudicators are required to find that the Complainant has proved, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present viz:
- i) the Complainant has rights in respect of a name or mark
 - ii) which is identical or similar to the (disputed) domain name; and
 - iii) in the hands of the Registrant the (disputed) domain name is an abusive registration.

An abusive registration is defined in the definition section viz in Regulation 1, to mean 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.

PROCEDURAL AND OTHER ASPECTS

Before dealing with the substantive elements set out above, the Adjudicators are required to deal with certain procedural aspects of this dispute that were raised by the Registrant, more particularly in respect of the *locus standi* of the Complainant. See paragraphs 3.2(e) and (f) of the Registrant's

Contentions set out above.

- a) The Registrant questions whether the Complainant has the necessary mandate to pursue this complaint because it has submitted no resolution authorising this complaint. In its Reply, the Complainant has explained that it is governed by the Governing Body created in terms of the Labour Relations Act, whose acts are acts of the Commission (viz the Complainant); and that the Governing Body may delegate in writing any of its functions to a Commissioner. In its Reply, the Complainant has accordingly submitted a resolution from the Governing Body, with retrospective effect, confirming and ratifying all steps that have been taken by Mr Eugene Van Zuydam, a Commissioner, in respect of this complaint. Mr van Zuydam has instituted the Dispute and provided both the Dispute Affidavit and the Reply herein on behalf of the Complainant, and has instructed the Complainant's attorneys of record to file and deal with this complaint.
- b) The Registrant contends that the Complainant is acting outside the scope of its prescribed functions by entering into this dispute, and that it has not shown the necessary authority to expend public funds in respect of this dispute.

The Adjudicators, in terms of Regulation 26, and by way of the Case Administrator, requested the Registrant, in addition to its Response, to provide a further statement indicating on what basis it can be contended that a public body has no power or authority to enforce its rights; and to state explicitly the authority on which it relies in contending that a public body is not empowered to take steps to enforce its legal rights.

The Case Administrator allowed the Registrant 3 (three) days to respond to these requests, and the Registrant responded to this

request within 3 (three) days.

The Adjudicator then requested the Complainant, via the Case Administrator, to provide a further statement in reply to the above statement from the Registrant. The Case Administrator likewise allowed the Complainant 3 (three) days to provide this statement. The Complainant pointed out that only paragraph 1 of the Registrant's further statement deals with the two questions put by the Adjudicators; and that the remaining paragraphs 2 to 10 contain "further submissions that are extra procedural."

The Adjudicators are obliged to concur with the Complainant in that only paragraph 1 of the Registrant's further statement deals with the questions put by the Adjudicators to the Registrant; and that paragraphs 2 to 10 are irrelevant and hence must be ignored. More particularly, in paragraph 1 the Registrant submits that a public body (such as the Complainant) has power or authority to enforce its rights; but that, as a creature of statute, its rights, and the enforceability of such rights, are limited to those rights conferred by the relevant statute.

However, it appears from the Registrant's further statement that, in effect, the Registrant contends that the Complainant does not have any rights under common law, and that it is not empowered to enforce such common law rights.

Firstly, the Registrant has not provided any authority for its above contentions, as requested by the Adjudicators. Secondly, the Complainant has explained in its further statement that it was established as an independent juristic person having the same juristic *persona* as a company or corporate entity. In terms of Section 115(4)

of the Labour Relations Act, the Complainant may exercise any other powers conferred on it by or in terms of that Act and is competent to perform any other function entrusted to it by any other law. Therefore there is no reason to conclude that the Complainant's powers and/or functions are limited by that or any other statute, as contended by the Registrant. By the same token, that Act does not include any provision that can be interpreted to include such limitations.

If these limitations existed - these powers would be expressly excluded by the relevant statute (viz the Labour Relations Act), which the Registrant has not been able, or has failed, to show.

Accordingly, in view of the aforementioned, the Adjudicators find that there are no merits in these contentions by the Registrant, and hence these contentions by the Registrant are rejected.

- c) Separately from the aforementioned issues, the Registrant submits that the Adjudicators will have to make a clear ruling on whether the Registrant, in making use of the disputed domain name, does so solely for commercial gain in referring visitors to other sites to obtain appropriate legal advice and/or representation, or whether the Registrant is making non-commercial use of the disputed domain name by offering free information to the public relating to the Complainant. The Adjudicators are not obliged to make a finding in this regard. However, although the Adjudicators believe that such a finding is not relevant to a determination of this dispute, the Adjudicators are of the view that the Registrant, as a labour broker/broking company, is engaged in both of the above activities as part of the overall activities of the group of companies to which it belongs viz the Comco Group of Companies. This view is confirmed by the Registrant itself when it states in paragraph 8.1.2 I.j.(ii): "Although the Registrant's use of the domain is partly non-

commercial and partly commercial, Registrant submits that in either case such use is fair and legitimate.”

SUBSTANTIVE ASPECTS

Turning now to the substantive aspects of this complaint, the Adjudicators have carefully perused the papers filed and fully considered the contentions set out therein.

RIGHTS IN RESPECT OF A NAME OR MARK

In terms of Regulation 1 the term “rights” is widely defined. The regulation states “rights” and “registered rights” include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law but is not limited thereto.

As has been decided by the appeal decisions in www.seido.co.za (ZA2009-0030) and www.xnets.co.za (ZA2011-0077), the notion of “rights” for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. It is a matter of locus standi in order to make sure that the person who complains is someone with a proper interest in the complaint. The threshold in this regard should be fairly low

In the first place, the Adjudicators need to determine whether, as set out above, in terms of Regulation 3(1)(a), the Complainant has rights in respect of the name or mark CCMA. The Complainant claims that it enjoys such rights while the Registrant denies that such rights exist.

A NAME OR MARK?

The first part of the present enquiry is to determine whether the Complainant has locus standi in the sense of a name or mark that is unique or distinctive of it and its activities (and that is not merely descriptive, general or generic,

for example).

It will be seen that this element refers to “a name or mark” (and not necessarily only to a “trademark” in the ordinary sense of the word). Many organisations and businesses (and their products or services) are known by their acronyms viz their abbreviated letters or names such as the UNO, WHO, FIFA, IRB, BMW, FIAT, MG, IBM, KFC – to mention but a few international examples – and ESKOM, IDC, CSIR, UCT, MRC, ARC, SASOL – to mention but a few South African examples. The present tendency in all sectors of society seems to be to use more and more acronyms in place or instead of the full name of an organization or body. It can therefore generally be accepted that the public in any event has a general habit of using an acronym or abbreviation instead of the full and formal name of such an organization or body, for the sake of brevity and convenience.

In the circumstances, it appears that most, if not a substantial number, of members of the public who are familiar with the Complainant and its functions/services, will, instead of using its full and formal name, refer to it, and call it, by its shortened or abbreviated name or acronym - the CCMA. Although the full and formal name of the Complainant is descriptive of its functions and services, CCMA is not a descriptive, general or generic name but is instead a unique combination of letters resulting in a unique name.

Accordingly, the Adjudicators find, on a balance of probabilities, that the secondary and unique name of the Complainant for all practical purposes, and for purposes of this dispute, is CCMA or the CCMA.

As support for the aforementioned reference is made to WIPO case no D2010-2041 (Universidad Autónoma De Neuve León (UANL) v Navigation Catalyst Systems, Inc). Further to the above, it is generally accepted, and there is no doubt that such acronyms can and do, in principle and in practice, act as identifiers or as badges of origin viz trademarks for

organizations or businesses and their goods or services (whether they conduct trade *per se* or not).

The adjudicators accept that the name or mark CCMA acts as a unique identifier or badge of origin for the Complainant and its functions and services (whether it trades in the strict sense or not in respect of those services). CCMA is therefore capable of distinguishing the services of the Complainant from other labour or dispute forums and hence CCMA can serve as a mark and fulfil the functions of a trademark (in the sense of a badge of origin).

Accordingly the Adjudicators find, on a balance of probabilities, that the Complainant has used, and uses, a mark viz CCMA that serves to identify and distinguish its activities and services.

In support of the aforementioned, the Adjudicators refer to WIPO Case No D2005-0214 (National Spiritual Assembly of the Bahá'ís of the United States v 2nd International Bahá'í Council). See also the decision in ZA2007-0007 (FIFA v X Yin).

DOES THE COMPLAINANT HAVE RIGHTS?

The second part of this enquiry is whether the Complainant has rights in respect of the name or mark CCMA. The Complainant factually has no registered rights for CCMA (viz in terms of the Trade Marks Act) so that this aspect can be ignored.

However, the Adjudicators have carefully considered the evidence filed in support of this complaint in respect of the extent of use of the name and mark CCMA by the Complainant and its services. This relates to both the number of years viz from 1996 to 2013 being a considerable period of about 17 years; and the amount of its exposure to members of the South African public. The latter includes the number of persons both natural and juristic

who have been actually involved with labour disputes before the Complainant viz the number of matters referred to the Complainant viz almost 2 million (and with two parties involved with each referral, this amounts to almost 4 million persons). This will also include many persons who have made enquiries with the Complainant but have not proceeded with a formal complaint, and other persons who are aware of the Complainant and its functions such as attorneys, counsel, legal advisors, and HR personnel and managers, for example, and lastly other persons such as employees who have simply heard of the Complainant and its services and activities.

Undeniably the amount of exposure of the name and mark CCMA to the public in South Africa has been extensive and considerable. One can therefore conclude factually and reasonably that the Complainant has developed a considerable repute or reputation in and to its name and mark CCMA. In other words the name or mark CCMA is associated exclusively with the Complainant and its activities.

The Adjudicators wish to comment on the contentions made by the Registrant viz that the Complainant does not enjoy a protectable right to the CCMA mark; that the common law does not make provision for a statutory person such as the Complainant to acquire such rights; or to enter the "marketplace" in a dispute of rights such as this. The Registrant, although enjoying legal representation herein, did not provide any substantiation at all for such contentions. It is well known that statutory bodies often enjoy broad rights of various kinds, including common law rights and the right to conduct business, in order to properly conduct their affairs, and that they often need to litigate based on such rights. Hence these contentions are rejected.

Accordingly the Adjudicators find, on a balance of probabilities, that the Complainant has rights under the common law in the name or mark CCMA

and has the requisite locus standi to make its complaint in these proceedings.

The thrust of the Registrant's case is in effect that the Complainant had to prove a case akin to passing-off, and having regard to the wide definition of "rights", we are of the view that this contention is misplaced.

In further support of the aforementioned, see the decision ZA2012-0117 (South African Revenue Services v Antonie Goosen) in which it was found that the Registrant had, in registering the disputed domain name, sarstax.co.za, acted in contravention of the relevant statute. However, in that decision the Adjudicator also stated *inter alia* in paragraphs 4.1.2 (in respect of common law rights) and 4.1.3 that: "The Adjudicator is of the opinion that the Complainant has acquired a significant goodwill and reputation (common law rights) in this trademark. The Adjudicator finds that the SARS trademark has, through use, become exclusively associated with the Complainant." See also ZA2011-0079 South African Post Office Limited v ZADomain Register in which it was found that the Complainant "has acquired an enforceable reputation and common law rights in THE POST OFFICE, SA POST OFFICE and SOUTH AFRICAN POST OFFICE trademarks."

See the WIPO Case Nos. D2002-0128 (The National Deaf Children's Society and (2) Ndes Ltd v Nude dames, Chat, Sex), and D2005-0214 (uhj.net). See also the decision in ZA2007-0007 (FIFA v X Yin).

NAME OR MARK IDENTICAL OR SIMILAR?

The second element that the Adjudicators need to determine, as set out above, in terms of Regulation 3(1)(a), is whether the name or mark CCMA is identical or similar to the disputed domain name.

In comparing the name or mark CCMA with the disputed domain name ccma.co.za, Regulation 5(c) for example allows the Adjudicators to ignore the first and second level suffixes. In other words the comparison becomes

CCMA v ccma. Other than the difference between upper case and lower case letters, which for all practical reasons can be ignored, these names or marks are in essence, and otherwise, identical.

Accordingly, the Adjudicators find, on a balance of probabilities, that the name or mark CCMA is identical to the disputed domain name.

In support of the aforementioned, reference is made to WIPO Case No 2010-0470 (Burn World-Wide Limited d/b/a BGT Partners v Banta Global turnkey Ltd.

IS THE REGISTRATION ABUSIVE?

The third element that the Adjudicators need to determine as set out above, in terms of Regulation 3(1)(a), is whether the Complainant has proved, on a balance of probabilities, that, in the hands of the Registrant, the disputed domain name is an abusive registration.

This means that the Adjudicators need to determine whether the disputed domain name is an abusive registration as defined in the definition section of the Regulations viz in Regulation 1, and as set out above. According to the definition, and to various Nominet decisions, there are two potential abuses (or two types of abuse) viz:

- a) Registration with an abusive intent; and/or
- b) Use in an abusive manner.

The Adjudicators refer to DRS 02464 (Aldershot Car spares v Gordon); and to DRS 00658 (Chivas Brothers Ltd v David William Plenderleith) in which the expert found that: *“Where a Respondent registered a domain name*

- 1) *which is identical to a name in which the complainant has rights;*
- 2) *where that name is exclusively referable to the complainant;*
- 3) *Where there is no obvious justification for the Respondent having that name for the domain name;*

4) *Where the Respondent has come forward with no (reasonable) explanation for having selected the domain name, it will ordinarily be reasonable for an expert to infer first that the Respondent registered the domain name for a purpose and secondly that such purpose was abusive.”*

See also ZA2007-007 (FIFA v X Yin) in this regard. The Adjudicators concur with the view that the nature of “abusive” in the Regulations does not necessarily require a positive intention to abuse the Complainant’s rights but that such abuse is the effect of the registration or use of the disputed domain name.

Regulations 4 and 5 provide a list of (non-exhaustive) factors which may indicate that the disputed domain name is, or is not, an abusive registration, respectively. These will be discussed in further detail hereunder.

SHIFTING OF BURDEN OF PROOF?

Regulation 5 (c) – Factors that may indicate that the disputed domain name is not an abusive registration, include that the Registrant has demonstrated fair use: Provided that the burden of proof shifts to the Registrant to show that the disputed domain name is not an abusive registration if the disputed domain name is identical to the mark in which the Complainant asserts rights, without addition.

The Registrant has contended that it is making descriptive, generic and fair use of the disputed domain name in its business, and that it is making what amounts to a *bona fide* offering of services incidental to the functions of the Complainant. The Adjudicators confirm that bona fide descriptive use of the name or mark CCMA in the course of the Registrant’s business in referring to the Complainant and its services, is of course perfectly permissible; and that a reasonable person will not be confused or deceived when confronted

with *bona fide* descriptive use. However, the Registrant's use of the disputed domain name, judging from its website, appears not to be descriptive use but rather trademark use. For example, the Registrant's logo is not only a round logo (such as, and similar in appearance to, the Complainant's logo) but it also includes (as does the Complainants' logo) in large capital letters the name and mark of the Complainant viz CCMA. This use is not fair use but trademark use and is usage that copies or imitates the Complainant's usage. In addition, the prominent use of the slogan "CCMA Assistance for Everyone" appears to be trademark usage instead of descriptive usage. Furthermore the Registrant contends that its website displays a "clear" disclaimer and that its use does not amount to passing off. However, the disclaimer is not clearly presented as the Registrant contends and is part of, and is "lost" in, the overall printed body of the website.

The disputed domain name is ccma.co.za that is identical to the name or mark CCMA in which the Complainant alleges rights viz CCMA, and which the Adjudicators find established for purposes of this complaint.

Accordingly, in the opinion of the Adjudicators, it appears that the Registrant's use of the disputed domain name is not descriptive or fair use. In support of the foregoing, the Adjudicators refer to the decision ZA2007-007 in (FIFA v X Yin) in which the Adjudicator quotes with approval from the decision DRS02201 (Viking Office Products Inc v Wenda Sparey) in which the panel states: "Whereas the fact that the complainant has rights in a trademark that is identical to the domain name does not of itself give rise to an assumption of an abusive registration, *the registration of an identical domain name, particularly if unadorned, may raise a presumption that the registration is abusive, because it is impossible to infer that it was chosen for any reason other than to impersonate the complainant.*" See also the leading domain name passing off decision by the UK High Court: British Telecommunications Plc & Others v The One In A Million Limited & Others

[1998] FSR 265.

In any event the Adjudicators proceed to consider the matter on its merits notwithstanding this question of onus.

A BLOCKING REGISTRATION?

Regulation 4(1)(a)(ii) – Was the disputed domain name registered or acquired primarily to block intentionally the registration by the Complainant of a name or mark in which it has rights viz CCMA?

The Registrant contends that the disputed domain name is not blocking the registration of a name or mark by the Complainant because it enjoys no protectable right therein; and because the Registrant is making *bona fide* and fair use of the disputed domain name. The Complainant has been found above to enjoy a protectable right in respect of its name or mark CCMA under the common law. It has also been found that the Registrant's use of the disputed domain name is not *bona fide* and not fair use.

In addition, the Registrant, being a labour broker and being familiar with the Complainant and its services, would or should have known that the disputed domain name would not only infringe the rights of the Complainant but would also block, or be likely to block, the rights of the Complainant.

The Adjudicators refer to the decision ZA2007-0003 (Telkom SA Limited v Cool Ideas 1290 CC) in which the Adjudicator found that a blocking registration has two critical features. The first feature 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 disputed domain name in order to prevent a complainant from doing so. The Registrant knew the Complainant, its name and its services and activities; and knew or must have known that the registration or acquisition of the disputed domain name

would have prevented the Complainant from doing so. See the decisions in DRS00583 and DRS01378.

The Adjudicators finally refer to the “blocking” effect found by the UK High Court in the leading domain name and passing off decision viz British Telecommunications Plc *supra*.

Accordingly, in the opinion of the Adjudicators, it appears that the Registrant had registered or acquired the disputed domain name to primarily block intentionally the registration by the Complainant of CCMA as a domain name, and/or for its own advantage and commercial purposes.

See the WIPO Case Nos. D2001-0301 (telstraonair.co.za) and D2001-0800 (telstra-pccw.net).

UNFAIRLY DISRUPTING COMPLAINANT’S BUSINESS?

Regulation 4 (1)(a)(iii) – Was the disputed domain name acquired primarily to disrupt the business of the Complainant?

To the extent that the disputed domain name and the Registrant’s website are diverting internet traffic from the Complainant that is intended for the Complainant, this is prejudicial to the Complainant and its functions. This will clearly disrupt unfairly the statutory and intended business of the Complainant.

In support of the aforementioned, the Adjudicators point out that various UDRP decisions have found that disruption of a business may be inferred if the Registrant has registered a variant of the Complainant’s mark by adding a generic word. See for example WIPO/D2000-0777, NAF/FA94942, NAF/FA94963, AND NAF/FA95402. This is of course all the more so when the Registrant has registered a word identical to the Complainant’s mark. Accordingly, in the opinion of the Adjudicators, it appears that the Registrant

had registered or acquired the disputed domain name primarily to disrupt unfairly the business of the Complainant.

In support of the aforementioned the Adjudicators refer to the decision ZA2012-0117 (cited above) in which the Adjudicator confirmed that the disruption of the business of the Complainant may be inferred if the Registrant has registered a variant of the Complainant's mark by merely adding a generic word. This will be at least the same or even more so if the disputed domain name is identical to the Complainant's name or mark.

See the WIPO Case Nos. D2005-0604 (proyectoresepson.com) and D2007-0424 (alstom-china.com).

PREVENTING COMPLAINANT FROM EXERCISING ITS RIGHTS?

Regulation 4((1)(a)(iv) – Was the disputed domain name acquired primarily to prevent the Complainant from exercising its rights?

The afore-mentioned diverting of internet traffic from the Complainant also serves to undermine an important part of the regulatory scheme intended by the Labour Relations Act. This prevents the Complainant from exercising its statutory rights and discharging its public obligations and duties.

Besides the factual question of the disputed domain name preventing the Complainant from exercising its rights, this raises the question of whether the Registrant in acquiring the disputed domain name (or its predecessor in title in registering the disputed domain name) had acted in good faith or otherwise. The Registrant's predecessor in title had warranted, when registering the disputed domain name, in terms of the Uniform SA terms and conditions (clause 5.1) that:

"1. It has the right without restriction to use and register the Domain Name."

“2. 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 that the original registrant – and its officers - (at the time of registration) must have known of the Complainant and its name viz CCMA. Clearly therefore the disputed domain name was registered in breach of the above warranty and declaration and hence was registered in bad faith. Such bad faith continues to taint the disputed domain name - even after its acquisition by the (present) Registrant - who has admitted that it was aware of the Complainant (and its name).

Accordingly, in the opinion of the Adjudicators, it appears that the original Registrant had registered, and the present Registrant had acquired, the disputed domain name to prevent the Complainant from exercising its rights. In support of the aforementioned, the Adjudicators refer to the decisions ZA2007-0003 and ZA2012-0117 (cited above). See also the WIPO Case Nos. D2001-0301 (telstraonair.co.za) & D2001-0800 (telstra-pccw.net).

DISPUTED DOMAIN NAME CONNECTED WITH COMPLAINANT?

Regulation 4(1)(b) – Are there circumstances indicating that the Registrant is using, or has registered, the disputed domain name in a way that leads people or businesses to believe that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant? From the Adjudicators’ comments made under the above heading SHIFTING OF BURDEN OF PROOF – Regulation 5(c), because of the Registrant’s use of the (identical) disputed domain name, there is a clear

likelihood that potential users of the Complainant's services will be confused and/or deceived into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. Such unauthorized use of the (identical) disputed domain name by the Registrant, in view of the common law rights claimed or contended by the Complainant, amounts to passing off by the Registrant, in terms of the common law. In this regard, it should also be mentioned that a plaintiff in passing off proceedings does not have to show actual damages suffered but it will be sufficient to show a likelihood of damages or prejudice to its reputation and goodwill. The Complainant has indicated that it reserves its rights to institute High Court proceedings for passing off against the Registrant. The Adjudicators, with respect, therefore cannot agree with the contentions of the Registrant made in this regard.

Accordingly, in the opinion of the Adjudicators, this is a factor indicating that the disputed domain name is an abusive registration.

In support of the above, the Adjudicators refer to the decision ZA2012-0117 (South African Revenue Services v Antonie Goosen) - *supra*. See also the WIPO Case Nos. D2005-0283 (associatedbritishfoods.com) and D2009-0286 (qualitair4u.com).

WHOIS DATABASE DETAILS FALSE AND INCOMPLETE

Regulation 4(1)(d) – False or incomplete details in the Whois database may indicate that the disputed domain name is an abusive registration.

From the Response, it appears that that the Registrant was not the first owner of the disputed domain name, and that it had not registered the disputed domain name in the first instance. Hence the Registrant cannot be held responsible for any incorrect and/or false information being placed on the Whois database at the time of registration. On acquiring the disputed

domain name, the Registrant employed the services of an IT consultant to acquire and to administer the disputed the domain name. Therefore the Registrant submits that it was not aware that the details on the Whois database are incomplete and/or incorrect. It first became aware of this situation when it received the complaint, and it has meanwhile instructed its IT consultant to correct such details.

This explanation by the Registrant is reasonable and acceptable in the circumstances, and hence no adverse inference regarding an abusive registration can be drawn from the incorrect and/or false information of the Whois database as far as the Registrant is concerned.

ALLEGED WAIVER OF RIGHTS?

The Registrant has contended that, in the event that the Adjudicators find that the Complainant enjoys some form of protectable right in respect of the “CCMA” abbreviation of the disputed domain name, such a right has been tacitly waived by the Complainant - in waiting almost 12 years to lodge this complaint. The Complainant has replied to this contention by explaining that it became aware of the existence of the disputed domain name only shortly before the letter of demand was sent to the Registrant. Hence on the facts there does not appear to have been a delay in bringing this complaint.

In any event, our law is quite clear on this question and our courts are generally not inclined to entertain a defence of acquiescence unless there is a clear indication of something more than mere delay (See *Turbek Trading CC v A&D Spitz Ltd* [2010] 2 All SA 284 SCA par [15]).

In further support of this, the Adjudicators refer to *Policansky Brothers v Hermann & Canard* 1910 TPD 1265 in which Wessels J stated at page 1278: “It is a principle of our law that, if a person has once acquired a right, he is entitled at any time to vindicate that right when infringed, provided the

period of prescription has not elapsed.”

The adjudicators also refer to *Collen v Rietfontein Engineering Works* 1948 (1) SA 413 (A) in which Watermeyer CJ stated at page 422: “Quiescence is not necessarily acquiescence” and “conduct to constitute an acceptance, must be an unequivocal indication to the other party of such acceptance.” There has certainly been no unequivocal or any such indication to the Registrant, or to its predecessor in title, so that this contention by the Registrant cannot be entertained.

In addition, reference is made to WIPO Case No D2001-0067 (*Drexel University v David Brouda*), in which was stated that “rights or legitimate interests cannot be created where the user of the domain name at issue would not choose such a name unless he was seeking to create an impression of association with the Complainant”. It has already been found that this must have been the intention of the Registrant.

Accordingly the Adjudicators find, on a balance of probabilities, based both on the facts and on the applicable South African law (including as it relates to Trademark law), that this contention by the Registrant must be rejected.

REVERSE DOMAIN NAME HIJACKING?

The Registrant has submitted that the Complainant is using the Regulations in bad faith in order to prevent the Registrant from using the disputed domain name in a way that the Complainant does not approve of. The Registrant alleges that it is currently making bona fide and fair use of the disputed domain name, and to transfer the disputed domain name to the Complainant would therefore amount to reverse domain name hijacking. The Complainant has dismissed these allegations on the basis that it has proved a bona fide entitlement to the disputed domain name; that it wishes to ensure that members of the public have easy access to its website and

services, without being misled; that the Registrant's allegation of bad faith use of the Regulations by the Complainant is unsubstantiated; and that the Registrant's conduct cannot be described as "bona fide and fair use" of the disputed domain name.

In Regulation 1 (Definitions) "**Reverse domain name hijacking**" is defined as meaning - using these Regulations in bad faith to attempt to deprive a registrant of a domain name.

One circumstance or factor that will indicate that the Complainant is using the Regulations in bad faith will be if it fails to prove that it has rights in a name or mark and/or if such name or mark is not identical or similar to the disputed domain name and/or if the disputed domain name is not an abusive registration. However, this is not the case in the present dispute. Another circumstance or factor will be if the Complainant has exhibited certain conduct that shows that it is acting out of malice or spite, or grossly unreasonably, for example. Such conduct has not been shown in the present dispute, and the allegation of bad faith use of the Regulations by the Registrant is unsupported and unsubstantiated.

Accordingly the Adjudicators find, on a balance of probabilities, that the Complainant has not used the Regulations in bad faith to attempt to deprive the Registrant of the disputed domain name.

In support of the foregoing, the Adjudicators refer to the decision ZA2007-0005 (Appeal Number ZAAP2007-0005) (Telkom v SA Limited v The internet Corporation) in which the Adjudicator Panel, on appeal, suggested that there should be something more shown in the conduct of the Complainant before a finding of bad faith use of the Regulations could be made. More particularly, two members of the Adjudicator Panel had suggested that for example some evidence of unlawful or malicious intent was required such as shown in the High Court decision viz Bress Designs

(Pty) Ltd v GY Lounge Suite Manufacturers (Pty) Ltd 1991 (2) SA 455 W.

4.1 Complainant's Rights

4.1.1 In view of the foregoing, the Adjudicators find, on a balance of probabilities, that the Complainant has rights in respect of a name or mark CCMA which is identical to the disputed domain name.

4.2 Abusive Registration

4.2.1 In view of the foregoing, the Adjudicators find, on a balance of probabilities, that the disputed domain name 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; and/or

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

4.3 Reverse Domain Name Hijacking

4.3.1 In view of the foregoing, the Adjudicators find, on a balance of probabilities, that the Complainant has not used the Regulations in bad faith to attempt to deprive the Registrant of the disputed domain name.

5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator Panel orders that the disputed domain name, ccma.co.za, be transferred to the Complainant.

5.2 For all the foregoing reasons, the Adjudicator Panel finds that the dispute

does not constitute reverse domain name hijacking.

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Mr Gavin Morley SC,

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Ms Vanessa Lawrance,

.....
Mr Andre van der Merwe
SAIIPL SENIOR ADJUDICATORS
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