

## Decision

**ZA2015-0206**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2015-0206</b>
DECISION DATE:	<b>24 August 2015</b>
DOMAIN NAME	<b>bhpbillton.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Avaliani Sergi (a Georgian citizen or resident)</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>BHP BILLITON LIMITED (an Australian corporation)</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Griffith Hack (Australian attorneys, Melbourne – Mr Simon Gapes)</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA )</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **25 June 2015**. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **1 July 2015**. The SAIPL verified that the Dispute, together with the amendment to the Dispute, satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIPL’s Supplementary Procedure. On **1 July 2015** the SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **1 July 2015** ZACR 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 **7 July 2015**. In accordance with the Regulations the due date for the Registrant’s Response was **4 August 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **5 August 2015**. The Registrant failed to submit any Response and the Administrator proceeded with the appointment of an Adjudicator.
- c) The SAIPL appointed **Mr Andre Karel van der Merwe** as the Adjudicator in this matter on **13 August 2015**. The Adjudicator has 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

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- 2.1 The Complainant is the owner of the name and trademark BHP BILLITON. The trademark is registered in various countries around the world such as Australia, China, New Zealand, the United Kingdom, the European Union, the United States of America, and Canada. These foreign registrations date from about 2002 to 2010. In addition, the trademark was registered in South Africa on 19 March 2001 in a number of classes viz classes 1, 2, 4, 6, 7, 8, 9, 11, 14, 16, 17, 19, 21, 25, 35, 36, 37, 38, 39, 40, 41, and 42. The Complainant has submitted copies of registration certificates for these South African registrations which show that these registrations are presently in full force and effect, and are due for renewal by 19 March 2021. *Prima facie* these South African registrations are presumed to be valid until and unless found to be invalid by either the Registrar of Trade Marks or by the High Court of South Africa.
- 2.2 The Complainant has submitted that its business Group is the world's largest diversified resources/mining group, employing more than 40 000 people in more than 100 operations in 25 countries. The core of the Group is a dual listed company comprising the Complainant company viz BHP BILLITON LIMITED and BHP BILLITON Plc. These two entities merged in effect in 2001 but exist as separate companies and operate as a combined group known as BHP BILLITON.
- 2.3 The Complainant's headquarters are located in Melbourne, Australia and the Group operates major offices in London with supporting offices around the world. The Complainant operates a website that is available via various domain names including bhpbilliton.com.
- 2.4 The Complainant's annual turnover for the years 2009, 2010, 2011, 2012 and 2013 amounted to about US\$50,2 billion, US\$52,8 billion, US\$71,7 billion, US\$72.2 billion and US\$65,9 billion, respectively. This indicates that

the Complainant's business, and that of its Group, is worldwide and massive in size and reach. See also below for further details.

- 2.5 The Complainant has submitted documentation to show the variety of its worldwide mining and metallurgical operations for example in respect of petroleum/oil and gas, potash, copper, silver, lead, zinc, iron ore, coal, aluminium, manganese, nickel, and also uranium and gold.
- 2.6 The Complainant's subsidiary South African company, BHP Billiton Innovation (Pty) Limited, had registered the domain name bhpbilliton.co.za on 6 April 2001.
- 2.7 The Complainant and its authorized subsidiary companies have registered and control various other domain names including their name and trademark "bhpbilliton" including bhpbilliton.com, bhpbilliton.net, bhpbilliton.org, bhpbilliton.info, bhpbilliton.biz, bhpbilliton.co.uk, bhpbilliton.org.uk, etc.
- 2.8 The Registrant had registered the disputed domain name bhpbilliton.co.za on 28 May 2015.

### **3 Parties' Contentions**

#### **3.1 Complainant**

- a) The Complainant contends through its submissions that it enjoys statutory rights in and to its name and trademark BHP BILLITON by way of its South African trademark registrations. Through its submissions it has also shown that, by virtue of its widespread and major business activities, both internationally and in South Africa, it has developed an extensive reputation, and hence goodwill, in its name and trademark in terms of the South African common law.

These rights predate the date of registration of the disputed domain name.

- b) The Complainant therefore contends that it has rights in respect of its name and trademark BHP BILLITON that predate the date of registration of the disputed domain name.
- c) The Complainant contends that the only difference between the disputed domain name and the Complainant's registered trademark is that the second letter "i" has been omitted from the disputed domain name. Otherwise the two names are visually and aurally similar.
- d) The Complainant contends that the Registrant has no rights and is not commonly known by the disputed domain name or the term "bhpbillton". The Complainant is unaware of the Registrant holding trademark registrations for "bhpbillton" or having made use of the term as a trademark.
- e) The Complainant contends that the fact that the disputed domain name resembles the Complainant's registered trademark indicates that the Registrant was aware of the Complainant's rights and is using the disputed domain name in bad faith in order to take advantage of the Complainant's reputation. Similarly, it may be inferred from the Registrant's disputed registration of a domain name that is confusingly similar to the Complainant's well-known BHP BILLITON trademark that the disputed domain name was registered in bad faith. Various foreign domain name decisions have been cited by the Complainant to support this contention.
- f) The Complainant contends that the Registrant has not made any

good faith offerings of goods or services under the disputed domain name or made any legitimate non-commercial or fair use of the disputed domain name. Furthermore the Registrant has not made generic or fair use of the disputed domain name.

- g) The Complainant points out that the disputed domain name resolves to a website featuring links to job sites and other business links. The Complainant has not authorized this use or the website, and the Complainant is not affiliated with the aforementioned website page. Hence the Complainant contends that this use of the disputed domain name amounts to circumstances indicating that the Registrant has registered and is using the disputed domain name in a manner that will lead people or businesses to believe that the disputed domain name is registered to, operated or authorized by, or otherwise connected with the Complainant, which is not the case.
- h) The Complainant also contends that the aforementioned misrepresentations may unfairly disrupt the Complainant's business by causing people or businesses to complain to the Complainant if they are misled or deceived by the misrepresentations and also by unfairly depriving the Complainant of business or of visits to its legitimate website.
- i) The Complainant contends that the disputed domain name was selected and registered by the Registrant solely in order to "impersonate" the Complainant and to benefit unfairly from the Complainant's reputation.
- j) Accordingly the Complainant contends that the disputed domain name is an abusive registration.

### 3.2 Registrant

- a) The Registrant did not respond to the Complainant's contentions.

## 4 Discussion and Findings

- a) In order to make a finding that the disputed domain name is an abusive registration, the Adjudicator is 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.

### **SUBSTANTIVE ASPECTS**

Turning to the substantive aspects of this complaint, the Adjudicator has carefully perused the Complaint, as well as all annexed documents, and carefully considered the facts and contentions set out therein. The Registrant has not responded to the Complainant's contentions, and this dispute must therefore be decided on a default basis.

## **RIGHTS IN RESPECT OF A NAME OR MARK**

In terms of Regulation 1 the term “rights” is widely defined. The Regulation states that “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 [seido.co.za](#) (ZA2009-0030) and [xnets.co.za](#) (ZA2011-0077), that 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.

The Adjudicator needs to determine whether, as set out above, in terms of Regulation 3(1)(a), the Complainant has rights in respect of the name and trademark BHP BILLITON. The Complainant claims that it enjoys such rights in this name and trademark.

### **A NAME OR MARK?**

The first part of the present enquiry includes a determination 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).

### **DOES THE COMPLAINANT HAVE RIGHTS?**

The first element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has rights in respect of the name and trademark BHP BILLITON.

In terms of the above facts, the Complainant is the proprietor of various South African trademark registrations for BHP BILLITON, as set out above, that are in full force and effect.

From the above facts and contentions, it also appears clearly that the

Complainant, through its worldwide and extensive South African business activities, also enjoys a very large reputation, as a component of its goodwill, in terms of the common law in respect of its name and trademark BHP BILLITON.

See in this matter regard the textbook South African Law of Trade Marks (4<sup>TH</sup> Edition) by Webster and Page (now Webster and Morley) paragraph 15.10 and *inter alia* the decided case cited here viz Adcock-Ingram Products Limited v Beecham SA (Pty) Limited 1977 4 SA 434 (W) which was approved in Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd [1998] 3 All SA 175 (A).

This common law right can be breached by the wrong known as passing off. See Webster and Page (*supra*) paragraph 15.5 and *inter alia* the decided case cited there viz Capital Estate & General Agencies (Pty) Ltd v Holiday Inns Inc 1977 2 SA 916 (A).

Accordingly the Adjudicator finds, on a balance of probabilities, that the Complainant has both statutory viz registered trademark rights and common law rights in South Africa in respect of its name and trademark BHP BILLITON.

These rights date from 2001 and predate the date of registration of the disputed domain name registration.

This finding also provides the Complainant with the necessary *locus standi* to bring this complaint.

#### **NAME OR MARK IDENTICAL OR SIMILAR TO DOMAIN NAME?**

The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proved that its name and trademark BHP BILLITON, in which it has rights as set out above, is identical or similar to the disputed domain name viz bhpbillton.co.za.

Firstly, the Complainant has contended that the disputed domain name is similar to the Complainant's registered trademark BHP BILLITON.

Secondly, the element "bhpbillton" in the disputed domain name is visually and aurally or audibly similar to the registered trademark since the only difference between the registered trademark and the above element is the removal of the second "i" from the Complainant's trademark, leaving two very similar expressions/terms.

Thirdly, the comparison in effect then becomes BHP BILLITON v BHP BILLTON. In spite of this minor change, and in view of the Adjudicator, the two expressions/terms are certainly very similar. This is how members of the public will without doubt perceive these two expressions/terms.

It is accepted in domain name decisions that the suffix .co.za does not affect the assessment of similarity of a registered trademark and the disputed domain name. See in this regard the decided foreign domain name decision D2002-0810 Benneton Group SA v Azra Khan and the South African domain name decision ZA2008-0015 Luxottica US Holding Corp v Preshal Iyar. The Registrant therefore cannot escape the inevitable conclusion that the Complainant's name and its registered trademark mark BHP BILLITON is similar to the disputed domain name.

Accordingly, the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that both its name and registered trademark BHP BILLITON is similar to the disputed domain name.

### **IS THE DISPUTED DOMAIN NAME AN ABUSIVE REGISTRATION?**

The third element that the Adjudicator needs to establish is whether, on a balance of probabilities, the disputed domain name, in the hands of the Registrant, is an abusive registration. The Complainant asserts

that the disputed domain name is an abusive registration.

The Adjudicator is required 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.

Although not completely on all fours but providing a strong guide-line, the Adjudicator refers 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; and*
- 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 Adjudicator concurs with the view that the nature of “abusive” in the Regulations does not necessarily require a positive intention by the Registrant to abuse the Complainant’s rights but that such abuse can be the effect or consequence of the registration or use of the disputed domain name.

Before dealing with the Regulations, the Adjudicator wishes to deal with the good faith or otherwise of the Registrant herein.

Besides the question of whether the disputed domain name affects the Complainant in the exercising of its rights, the general contention has been raised by the Complainant that the Registrant has acted in bad faith firstly, because the Registrant has no rights in and is not known by the term “bhpbillton” or any similar name or trademark(s); secondly, because the Registrant is not known to hold any trademark registrations for “bhpbillton” or having made use of the term as at trademark; thirdly, because the disputed domain name so resembles the Complainant’s name and registered trademark; and fourthly, because the Registrant was no doubt (*inter alia* for the foregoing reason) aware of the Complainant’s name and trademark viz its rights. Similarly, it may be inferred from the Registrant’s registration of a domain name that is confusingly similar to the Complainant’s well-known BHP BILLITON trademark that the disputed domain name was registered in bad faith.

See in this regard the foreign decided domain name decisions viz WIPO Case No D2000-0037, WIPO Case No 2000-0137-1492, WIPO Case No 2001-1492, and WIPO Case No 2003-0257, in which it was held that bad faith registration may be inferred from the registration of a well-known trademark as part of a domain name.

A further factor in this regard is the non-response by the Registrant. This has also been held in domain decisions to be an indication of bad faith on the part of the Registrant. See in this regard the South African decision ZA2008-0015, in which the WIPO decision D2000-0325 was cited as authority, in which the Registrant’s failure to submit a Response was considered to be particularly relevant to the issue of whether the Registrant registered the disputed domain name in bad faith. See also the various South African Standard Bank decisions, more particularly ZA2007-0006 in which a number viz 12 misspellings

of that bank's name and trademark – generally with one letter omitted - amounting to so-called “typo-piracy”, were considered to be conduct amounting to evidence of bad faith, on the basis of WIPO decisions such as D2000-0680 and D2000-0441.

In spite of the above, the Registrant had proceeded to register and use the disputed domain name for and by himself.

In addition to the above, the Complainant has pointed out that the Registrant has not made any good faith offering of goods or services under the disputed domain name or made any legitimate non-commercial or fair use of the disputed domain name or made generic or fair use of the disputed domain name. These last-mentioned aspects are specified in Regulation 5 which provides a number of factors which may be applicable and which may indicate that a disputed domain name is not an abusive registration. However, these factors clearly do not apply to the present dispute.

Over and above the aforementioned considerations, the Registrant had warranted, when applying to register the disputed domain name, in terms of the ZACR terms and conditions (clause 5.1) that:

- I. “It has the right without restriction to use and register the Domain Name”
- II. “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.”

Clause 5.1.1 of the ZACR terms and conditions state further (-to which the Registrant had agreed): “Applicant (the Registrant) hereby irrevocably represents, warrants, and agrees that its statements

(above) in the Application are accurate and complete.”

It seems undeniable that the Registrant had, at all material times, known of the Complainant and its rights in and to its name and trademark BHP BILLITON.

Hence it appears to the Adjudicator generally, both from the above considerations and directly from the above false statements or warranties by the Registrant, that the Registrant has clearly acted in bad faith and that the disputed domain name was registered and is being used by the Registrant in bad faith. This is a strong indication that the disputed domain name is an abusive registration.

Turning now to Regulation 4, this provides a list of (non-exhaustive) factors which may indicate that a disputed domain name is an abusive registration. More particularly, Regulation 4 lists circumstances that indicate that the Registrant has registered or is using the disputed domain names primarily to achieve certain objectives. The Complainant has asserted or referred to some of these factors or circumstances that will be discussed below viz:

- a) That there are circumstances indicating that the Registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorized by, or otherwise connected with the Complainant**

The Complainant has pointed out that the disputed domain name resolves to a website featuring links to job sites and other business links. The Complainant has not authorized this use or the website, and the Complainant is not affiliated with the aforementioned website page. Hence the Complainant contends that this use of the disputed domain name amounts to circumstances indicating that the Registrant has registered and is using the disputed domain name in a manner that will lead people or

businesses to believe that the disputed domain name is registered to, operated or authorized by, or otherwise connected with the Complainant, which is not the case.

Accordingly the Adjudicator finds that this is a factor or circumstance in the present dispute, and that it indicates that the ongoing use of the disputed domain name is abusive and that the disputed domain name amounts to an abusive registration in the hands of the Registrant.

**b) That there are circumstances indicating that the Registrant has registered the disputed domain name to unfairly disrupt the business of the Complainant**

The Complainant has contended that the aforementioned misrepresentations are likely to unfairly disrupt the Complainant's business by causing people or businesses to complain (to the Complainant) if they are misled or deceived by the misrepresentations and also by unfairly depriving the Complainant of business or of visits to its legitimate website. In addition, the existence of the dispute domain name has the potential to erode the distinctive character of the Complainant. This can, and will, ultimately decrease the value of the Complainant's brand.

Hence the Adjudicator comes to the conclusion that this is a real and present factor in the present dispute, and that it indicates that the ongoing use of the disputed domain name is abusive and amounts to an abusive registration in the hands of the Registrant.

**Further Comments**

The Complainant has further contended that the only apparent reason for the Registrant selecting and registering the disputed domain name was to "impersonate" the Complainant (and its rights)

and hence to benefit unfairly from the Complainant's reputation. In the circumstances this appears to be a valid submission particularly in view of the Registrant's non-response herein. Accordingly the Registrant uses the disputed domain name to attract internet users to his or another website and does so for commercial gain, in the process creating confusion with the Complainant's name and trademark as to its source, affiliation or endorsement of that/those website(s). The disputed domain name has thus been registered and used by the Registrant in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

#### 4.2 Abusive Registration

- 4.2.1 In the circumstances set out above, the Adjudicator concludes 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
- 4.2.2 That the disputed domain name has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.
- 4.2.3 Accordingly, the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that the disputed domain name is an abusive registration.

#### 5. Decision

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

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**A K VAN DER MERWE**  
SAIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)