

## Decision

**ZA2016-0246**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2016-0246</b>
DECISION DATE:	<b>8 December 2016</b>
DOMAIN NAMES	<b>brotheronline.co.za brothersales.co.za</b>
THE DOMAIN NAMES REGISTRANT:	<b>ROBTRADE 6 CC</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None-Self representing</b>
THE COMPLAINANT:	<b>Brother International SA (PTY) LTD</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Vorster &amp; Brandt</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 "SAI IPL") on **4 October 2016**. On **7 October 2016**, the SAI IPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain names at issue, and on **10 October 2016** the ZACR confirmed that the domain names had indeed been suspended. The SAI IPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAI IPL's Supplementary Procedure.
- b) In accordance with the Regulations, the SAI IPL formally notified the Registrant of the commencement of the Dispute on **11 October 2016**. In accordance with the Regulations the due date for the Registrant's Response was **8 November 2016**. The Registrant submitted its affidavit in response on **8 November 2016**. Supporting annexures were submitted on 8 November 2016. The SAI IPL verified that the Response satisfied the formal requirements of the Regulations and the SAI IPL's Supplementary Procedure, and, once the response had been amended to exclude reference to the two domain names that the Registrant had abandoned prior to the institution of the complaint, the SAI IPL forwarded a copy of the Response to the Complainant on **9 November 2016**.
- c) In accordance with the Regulations the due date for the Complainant's Reply was **16 November 2016**. The Complainant submitted its Reply on **16 November 2016**.
- d) The SAI IPL appointed **Vanessa Lawrance** as the Adjudicator in this matter on **21 November 2016**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAI IPL to ensure compliance with the Regulations and Supplementary Procedure.

## 2 Factual Background

- 2.1 The Complainant is a wholly owned subsidiary and representative of Brother Industries, a Japanese Company.
- 2.2 Brother Industries is the proprietor in South Africa of the trade mark BROTHER and various trademarks which incorporate the word BROTHER namely:
  - a. trade mark registration no 1955/00321 **BROTHER** (device) in class 7;
  - b. trade mark registration no 1987/05483 **BROTHER** (device) in class 9;
  - c. trade mark registration no 2004/04912 **BROTHER** in class 9;
  - d. trade mark registration no 1988/00368 **BROTHER** (device) in class 16;
  - e. trade mark registration no 2004/04913 **BROTHER** in class 16;
  - f. trade mark registration no 1988/01103 **BROTHER** in class 42;
  - g. trade mark registration no 2004/04910 **BROTHER** in class 2.
- 2.3 The Complainant, established in 1970, is the authorized importer and distributor of the **BROTHER** range of products in South Africa.
- 2.4 The domain name brother.co.za was registered on 24 April 2001 by Wayne Everton, the managing director of the Complainant, for and on behalf of the Complainant.
- 2.5 The Registrant was incorporated on 11 August 1997.
- 2.6 There are two official resellers of **BROTHER** products, namely Kemtek and Mustek. The Registrant obtains products from them for sale.
- 2.7 The Registrant has abandoned the disputed domain names brother-online.co.za and brother-online.co.za, which has now been registered in the name of the Complainant.

## 3 Parties' Contentions

### 3.1 Complainant

- a) **BROTHER** has become a well known mark all over the world. The Complainant has expended considerable time, money and effort in establishing the **BROTHER** trade mark in South Africa, and has been successful in doing so.
- b) The Complainant has, as a result of its relationship as wholly owned subsidiary of Brother Industries, and as authorised distributor of the owner of the trade marks in South Africa, acquired vested commercial rights in protection of the **BROTHER** mark in South Africa.
- c) The dominant feature of the disputed domain names is the word **BROTHER.**
- d) The use by the Registrant of the disputed domain names is likely to cause confusion and/or deception in the minds of members of the general public.
- e) The conduct of the Registrant, such as displaying the telephone number of the Complainant on the disputed web sites, and displaying the registered trademarks on the disputed web sites, is further evidence of the unlawful competition with and disruption of the business of the Complainant.
- f) The affidavit filed by the Registrant is not properly commissioned.
- g) The deponent to the responding affidavit Ludick is, on the papers, not duly authorized to represent the Registrant.
- h) The disputed domain names in the hands of the Registrant is abusive registrations.

### 3.2 Registrant

- a) The Complainant has no *locus standi* to institute these proceedings, which should have been instituted by Brother Industries, the Japanese company.
- b) The domain name brother.co.za is registered in the name of Wayne Everton, the managing director of the Complainant, and is therefore irrelevant to the dispute.
- c) The Registrant only acts as reseller of **BROTHER** branded goods, and has never stated that it is anything but a reseller of these goods.
- d) There is no likelihood of confusion and/or deception in the minds of members of the general public as a result of the use of the disputed domain names by the Registrant.
- e) The Registrant has at all times acted *bona fide*.
- f) The allegations made by the Complainant is lacking in many respects, as it is not supported by credible evidence.

#### 4 Discussion and Findings

##### a) LOCUS STANDI

1. The Complainant is entitled to pursue the complaint, as it is a wholly owned subsidiary of the company that holds the registered trade marks, has expended considerable time, money and effort in establishing the well known mark **BROTHER** in South Africa, and has clearly done so with the consent of Brother Industries. In addition the registration of the domain name brother.co.za in the name of Wayne Everton, the managing director of the Complainant, is found to be further evidence of the use of and protection by the Complainant of the rights in respect of the **BROTHER** mark. As such it is found that it would be fair to find that the Complainant has the

necessary *locus standi* to institute the complaint.

2. Whilst it is so that the commissioning of the affidavit filed in response does not specify whether a male or female deposed to the affidavit, and Ludick the deponent does not explicitly state that he is authorized to act on behalf of the Registrant, it is clear from a consideration of all the allegations put forward on behalf of the Registrant that Ludick is authorized to act, and that he is a male. The technical issues raised are therefore dismissed, and the matter is considered on the merits.

### **b) THE RIGHTS OF THE COMPLAINANT**

Although the Complainant has no formal trade mark rights to the BROTHER trade mark in South Africa, it has clearly expended considerable funds in the promotion of the mark in this country. It clearly then has an interest in protecting the value of the BROTHER mark in South Africa, and it is fair, therefore, to allow it to protect its business interests. The adjudicator is not bound to find, in matters of this nature, on pure trade mark law. All that must be present is some sort of rights, that are impacted unfairly upon through registration of the disputed domain name.

### **c) THE LIKELIHOOD OF CONFUSION AND/OR DECEPTION.**

1. The dominant feature of the disputed domain names is the word **BROTHER**.
2. The Complainant has registered the domain names brother-online.co.za, and brother-online.co.za that were abandoned by the Registrant.
3. The Registrant has used the registered trademarks **BROTHER** on the disputed web sites, and has listed the telephone number of the Complainant on the web site.
4. The official distributors of **BROTHER** branded products in South Africa, Mustek and Kemtek, make no mention of the word **BROTHER** as part of their trading names and/or domain names.

5. There can be no doubt that in the circumstances the use by the Registrant of the disputed domain names is likely to confuse and/or deceive.

#### **d) THE CONDUCT OF THE REGISTRANT**

1. The Registrant is not authorized to use the registered trademarks **BROTHER**.
2. On the version of the Registrant itself, it is only a reseller of **BROTHER** branded products.

#### **e) FINDING**

In the circumstances it is found that the conduct of the Registrant infringes the recognized common law rights of the Complainant.

#### **4.1 Complainant's Rights**

- 4.1.1 The rights of the Complainant have been discussed above.

#### **4.2 Abusive Registration**

- 4.2.1 For the reasons stated above, it is found that the registration of the domain names brotheronline.co.za and brothersales.co.za by the Registrant are abusive registrations, as they were registered at a time and in a manner that is prejudicial to the rights of the Complainant, and are being used in a manner that takes unfair advantage of the rights of the Complainant.

#### **5. Decision**

- 5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain names brotheronline.co.za and brothersales.co.za be transferred to the Complainant.

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**VANESSA LAWRENCE**  
SAIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)

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**DECISION FORMATTING AND FORWARDING GUIDELINES – TO BE DELETED ONCE YOU HAVE FINALISED YOUR DECISION.**

Please use this Model Decision and follow these guidelines.

**Formatting Guidelines**

- Software: Word (.doc) or Open Office (.odt)
- Font: Nimbus Sans L
- Font size: 11
- Spacing: 1.5
- Paragraph Numbering: automatic paragraph numbering inserted
- Sub-paragraph Numbering: automatic paragraph numbering inserted
- Justification: Full-justified
- Date Format: Day Month (in words), Year (DD/MM/YYYY)
- Other: titles should be followed by a full stop, e.g., Mr., Ms., etc.
- Please always spell Complainant, Registrant, Dispute, Response, Reply and Adjudicator with Capitals.

**Forwarding Procedures: Single Adjudicator**

- Forward a draft of the Decision by e-mail to [admin@domaindisputes.co.za](mailto:admin@domaindisputes.co.za) for a format check by the Administrator. The transmittal e-mail message should clearly indicate that the version being sent is a draft.
- The Administrator will return the Decision fully formatted;
- Download and printout the final version;
- After verifying the text of the Decision, confirm to the Administrator by return e-mail that the Decision is being formally submitted for notification to the parties;
- Send a signed and dated version of the decision to (012 803 4697) by fax or preferably by scanned copy to [admin@domaindisputes.co.za](mailto:admin@domaindisputes.co.za);
- Do not send a signed original hardcopy to the SAIPL, but rather retain this in your own file should the need arise for it later;
- Log into your Adjudicator Panel, click on the relevant case awaiting your Decision and upload the information as requested. Once you hit “Submit” the case will be assigned to the Administrator who will upload further information, including a PDF version of the Decision, after which the Administrator will activate this Decision for public display on [www.domaindisputes.co.za](http://www.domaindisputes.co.za).

**Forwarding Procedures: Three-Member Adjudicator Panel**

- The Presiding Adjudicator should forward a draft of the Decision by e-mail to [admin@domaindisputes.co.za](mailto:admin@domaindisputes.co.za) for a format check by the Administrator. The transmittal e-mail message should clearly indicate that the version being sent is a draft reflecting the views of all three Adjudicators.
- The Administrator will return the Decision fully formatted to each Adjudicator.
- Each Adjudicator should download and printout the final version and after verifying the text of the Decision, the Co-Adjudicators should confirm their assent to the Presiding Adjudicator.
- The Presiding Adjudicator should confirm to the Administrator by e-mail that the Decision is being formally submitted by the Adjudicator Panel for notification to the parties.
- Each Adjudicator should separately send a signed and dated version of the Decision to (012 803 4697) by fax or preferably by scanned copy to [admin@domaindisputes.co.za](mailto:admin@domaindisputes.co.za);
- Do not send a signed original hardcopy to the SAIPL, but rather retain this in your own file should the need arise for it later;
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Decision, after which the Administrator will activate this Decision for public display on [www.domaindisputes.co.za](http://www.domaindisputes.co.za).