

## Decision

[ZA2016-0238]

.ZA ALTERNATE DISPUTE RESOLUTION  
REGULATIONS (GG29405)

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2016-0238</b>
DECISION DATE:	11 July 2016
DOMAIN NAME	<b>domainking.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Hargurnaz Singh</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None - Registrant representing himself</b>
THE COMPLAINANT:	<b>Virtual Dates, Inc.</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Howard Neu, Esq, Law Office of Howard New, P.A.</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 **4 May 2016**. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **5 May 2016**. 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 **9 May 2016** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on the same day, 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 **17 May 2016**. In accordance with the Regulations the due date for the Registrant’s Response was **14 June 2016**. The Registrant submitted its Response on **14 June 2016**, and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL’s Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on **15 June 2016**.
- c) In accordance with the Regulations the due date for the Complainant’s Reply was **24 June 2016**. The Complainant submitted its Reply on **20 June 2016**.
- d) The SAIPL appointed **Mariëtte Du Plessis** as the Senior Adjudicator on **23 June 2016** and **Nishan Singh** as the Trainee Adjudicator in this matter on **27 June 2016**. The Adjudicators have submitted the Statement

of Acceptance and Declaration of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

## 2 Factual Background

2.1 The Complainant is Virtual Dates, Inc., a company of 101 Fort Lauderdale Beach Blvd. The Complainant is the proprietor of the following trade mark registrations:

2.1.1 US registration no. 2773011 DOMAIN KING dated 14 October 2003 in class 42 in relation to “licensing of intellectual property, namely, domain names; and website development services”; and

2.1.2 CTM registration no. 011358471 DOMAIN KING dated 25 March 2013. (A copy of the certificate without details of the goods or services was provided by the Complainant).

2.2 The Complainant is solely owned by Rick Schwartz (“Mr. Schwartz”). The Complainant alleges that Mr. Schwartz has been known throughout the internet as the DOMAIN KING since 1996 and that the trade mark qualifies as an internationally well-known trade mark.

2.3 The Registrant is Hargurnaz Singh of Hannu Internet Corp. Pvt. Ltd of 156 New Jawajar Nagar, Cool Road, Jalandhar. The Registrant filed trade mark application no. 2589128 DOMAINKING logo (depicted below) in class 42 in India on 31 August 2013.



- 2.4 The Registrant is involved in the sale of domain names and website hosting services and it is alleged that the Registrant has used the mark DOMAIN KING logo in relation to such services since 2012 in South Africa. The Registrant is an accredited registrar for .co.za domain names.
- 2.5 The parties agree that there are similarities between the Complainant's DOMAIN KING trade mark and the Domain Name.

### **3 Parties' Contentions**

#### **3.1 Complainant**

- a) The Complainant contends that its sole owner, Mr. Schwartz, has been known by the internet community as the DOMAIN KING since 1996. The Complainant registered the trade mark DOMAIN KING in class 42 in 2003 in the US.
- b) The Complainant further contends the trade mark DOMAIN KING is an internationally well-known trade mark. In support of this contention, the Complainant alleges that a search on the GOOGLE search engine for the mark DOMAIN KING retrieves 7 hits on the first page of the search results for Mr. Schwartz (the actual search results were not provided). The Complainant submitted internet printouts of the Google hits which include Mr. Schwartz's blog and TWITTER profile (which has 12.1K followers), together with an article from the Domain Name Journal dated 3 March 2004, a page from eRealestate.com (which is his own website), an article from Domain Sherpa dated 30 August 2011, an article from The Domains dated 19 May 2015 and an undated WHOAPI article. The Complainant further alleges that Mr Schwartz, "as the Domain King" organised the T.R.A.F.F.I.C. Internet Domain Conferences that were held in the US,

- Canada, Ireland, The Netherlands, Italy and Australia from 2004 to 2014.
- c) The Complainant alleges that the Domain Name is confusingly similar to the Complainant's DOMAIN KING trade mark because it is virtually identical to his trade mark. The Complainant however incorrectly refers to the .za country code as being the code for Zanzibar, instead of South Africa.
  - d) The Complainant alleges that the Registrant registered the Domain Name on 17 May 2011, many years after the Complainant registered the trade mark DOMAIN KING.
  - e) The Complainant contends that the Domain Name is an abusive registration because the Registrant cannot establish legitimate rights or interests in the Domain Name, as the Complainant already owns the trade mark.
  - f) The Complainant further contends that the Registrant's use of the Domain Name unfairly represents that the Registrant's goods and services are associated with the Complainant. The Complainant alleges that the Registrant registered, and has used the Domain Name in bad faith.
  - g) The Complainant also refers to a complaint filed with NIRA against domainkings.ng, also owned by the Registrant.
  - h) In reply to the Registrant's contention that the Complainant does not use the mark DOMAIN KING as a trade mark, but rather as a moniker for Mr. Schwartz, the Complainant refers to a single printout from the Complainant's website of eRealestate.com where there is

use of the mark DOMAIN KING in a logo format.

- i) In reply to the Registrant's contention that he was not aware of the Complainant's trade mark rights, the Complainant contends that the Registrant commenced use of the mark DOMAIN KING in 2011, namely a year after the Complainant held the domain industry conferences in Milan, Italy, Amsterdam, The Netherlands, Dublin, Ireland, Vancouver and Canada, all of which involved the purchase and sale of domain names through the Complainant's DOMAIN KING trade mark. Furthermore, the Complainant contends that the domain name industry is a relatively small one and the Complainant is one of the best known investors and entrepreneurs in the industry.
- j) In reply, the Complainant denies the Registrant's contention that the Complainant is guilty of reverse domain name hijacking. The Complainant states that the domain name complaint before NIRA against the Registrant is still pending.

### 3.2 Registrant

- a) The Registrant contends that the mark DOMAIN KING is generic and a descriptive combination of words which are registered and used in domain names by different entities or individuals worldwide and that the Complainant does not have exclusive rights to use "Domain King" universally.
- b) The Registrant further contends that the Complainant is not using the mark DOMAIN KING as a source identifier for selling goods or services, but its use is rather as a moniker for Mr. Schwartz. The Registrant alleges that the Complainant does not use the mark DOMAIN KING in relation to the *bona fide* offering of goods and/or

services.

- c) Furthermore, the Registrant contends that the Complainant has no trade mark rights in South Africa, India and Nigeria and has not registered the “domainking” domain in these countries in which the Registrant’s organisation is trading.
- d) The Registrant alleges that on the date of registration of the Domain Name, he had no knowledge of the Complainant’s trade mark registration in the United States and no brand results appeared on a GOOGLE search at the time of the Domain Name registration. The Registrant further confirms that the Complainant’s US trade mark and International Trade Mark registered under the Madrid System are not valid in South Africa.
- e) The Registrant alleges that his organisation has been using the mark DOMAINKING since 2012 and that he applied to register the DOMAINKING trade mark in logo format in India on 31 August 2013. The Registrant has a website at [www.domainking.biz](http://www.domainking.biz). The Registrant’s organisation is described on this website as a global domain name registrar and it is accredited as DomainKing with the South Africa Domain Name Registry (ZACR) since 2012.
- f) The Registrant contends that he has a legitimate interest in the Domain Name and that he is using it fairly for his business. The Registrant alleges that he registered the Domain Name to protect his trade mark in South Africa, which resolves to his website at [www.domainking.biz](http://www.domainking.biz). The Registrant is involved in the sale of domain names and website hosting services and he annexed a screenshot from Archive.org as proof that there has been use of the DOMAIN

KING trade mark in South Africa since 2012. The Registrant contends that the Domain Name is relevant as its main business for selling and hosting domains is in South Africa.

- g) It is alleged that the Registrant has over 11 000 clients in South Africa, India, Philippines and Nigeria and that these clients associate the DOMAIN KING mark with the Registrant. The Registrant further contends that, on a GOOGLE search his Nigerian website is ranked first and his .biz website is ranked fourth on the first page of the search results. The Registrant furthermore has a FACEBOOK profile with 715 likes and a TWITTER profile with 167 followers. The Registrant also alleges that he spends USD70 000 annually to market the DOMAIN KING logo trade mark in Africa (including South Africa) and has spent USD40 000 in relation to Registry partnerships in Africa (including South Africa).
- h) The Registrant contends that he is legitimately connected with the Domain Name and that it was not registered in bad faith. He contends that he registered the Domain Name to protect his brand in South Africa and that he has no intention to sell, lease or transfer the Domain Name to the Complainant or its competitors. The Registrant has alleged that he is not competing with the Complainant or using the Domain Name to disrupt the Complainant's business.
- i) The Registrant contends that he is involved in a different industry when compared to the services for which the Complainant has registered its DOMAIN KING trade mark in the United States. The Registrant also alleges that the Complainant may be known in the domain community, but such knowledge relates to the moniker for Mr. Schwartz and not as source identifier for the Complainant's

services.

- j) The Respondent contends that the Complainant is attempting to reverse hijack all his DOMAINKING domain names.

#### **4 Discussion and Findings**

The Complainant's case is based on Regulation 3(1)(a), in that it has alleged rights in respect of a name or mark which is identical or similar to the Domain Name and, in the hands of the Registrant the domain name is an abusive registration. In order to succeed under Regulation 3(1)(a), the Complainant is required to prove on a balance of probabilities, that:

- (i) the Complainant has rights in respect of a name or mark;
- (ii) the name or mark is identical or similar to the Domain Name; and
- (iii) the Domain Name in the hands of the Registrant is an abusive registration.

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

4.1.1 The Regulations define "rights" and "registered rights" to include intellectual property rights protected under South African law, but are not limited thereto.

4.1.2 The Complainant in this Dispute relies on intellectual property rights in the DOMAIN KING trade mark which it has registered in the United States and the European Union. The Complainant has not registered the mark DOMAIN KING in South Africa and it therefore has no statutory trade mark rights which are protected under South Africa law, unless the mark can be regarded as well-known, which aspect will be dealt with below in paragraph 4.1.3.

4.1.3 The Complainant alleges that its sole owner, Mr. Schwartz, has been

known by the internet community as the DOMAIN KING since 1996 and it annexed a few internet printouts in support of this allegation. The Complainant also alleges that the mark DOMAIN KING is an internationally well-known trade mark. However, the Complainant has not adduced a single piece of evidence, nor alleged, that it uses its DOMAIN KING mark in South Africa or has acquired a reputation in the country, or that the trade mark is known by a substantial number of persons in the concerned industry in South Africa, as required for purposes of establishing that a mark is well-known in terms of Section 35 of the Trade Marks Act 194 of 1993. None of the usual spill-over evidence such as international sales and advertising figures or website hits have been submitted.

4.1.4 The Registrant denies that the Complainant has established a trade mark right and the Registrant has adduced evidence in the form of internet printouts which suggest that there is at least one other individual that is referred to, or known as the DOMAIN KING internationally. Furthermore, the Registrant puts forward a compelling argument that it has established rights in the DOMAINKING trade mark in South Africa and supports his argument with client and advertising figures for, amongst others, the South African marketplace.

4.1.5 In the dispute of *Nyama Catering Limited v Francois Wessels* ZA 2011-0092 the adjudicator stated the following at paragraph 4.1.11:

*“The Adjudicator is mindful that the panel of adjudicators in Allstates Global Karate Do, Inc. / Sais Karate (APZA 2009-0030) held that the threshold in establishing the existence of a right in domain name disputes is “fairly low”, but there is a threshold nevertheless. The*

*height of the bar will be influenced by the nature and meaning (if any) of the word or mark relied on and, if it is descriptive of the goods or services, a higher level is appropriate. It is viewed as important by the Adjudicator that long-established principles of trade mark law governing the question of the acquisition of rights in descriptive words be followed and applied consistently in domain name disputes. A dichotomy in approaches in adjudicating trade mark and domain name disputes (in this context) should not develop.”*

- 4.1.6 The right which the Complainant relies on, namely a trade mark right, is subject to the principle of territoriality. Harms JA in the case of *AM Moola Group Limited V the Gap Inc.* 2005 6 SA 568 (SCA) stated the following regarding the principle of territoriality:

*“More recently, in the Barcelona.com case, a US Federal District Court of Appeals dealt with the same underlying principle (per Niemeyer, Circuit Judge):*

*‘The relevant substantive provision in this case is Article 6(3) of the Paris Convention, which implements the doctrine of territoriality by providing that “[a] mark duly registered in a country of the [Paris] Union shall be regarded as independent of marks registered in the other countries of the Union, including the country of origin”.....As one distinguished commentary explains, “the Paris Convention creates nothing that even remotely resembles a ‘world mark’ or an ‘international registration’. Rather, it recognises the principle of the territoriality of trademarks [in the sense that] a mark exists only under the laws of each sovereign nation.” J Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 29:25 (4<sup>th</sup> ed 2002).’*

*It follows from incorporation of the doctrine of territoriality into United States law through Section 44 of the Lanham Act that United States*

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*courts do not entertain actions seeking to enforce trademark rights that exist only under foreign law. See Person's Co, Ltd v Christman, 900 F.2d 1565, 1568-69 (fed Cir 1990) ('The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme')."*

4.1.7 Therefore, even though the Complainant may have registered and used its DOMAIN KING mark in the United States and the European Union, it does not have any trade mark rights that are protectable under South African law. In so far as it is alleged by the Complainant that its DOMAIN KING trade mark is internationally well-known, there is insufficient evidence adduced to the Dispute to make a finding in this regard and the allegation is therefore regarded as inconclusive.

4.1.8 Furthermore, bearing in mind that the mark DOMAIN KING is somewhat laudatory of the services offered by the Complainant and the Registrant, the Adjudicator holds that the Complainant has not overcome the threshold of establishing that the mark DOMAIN KING is exclusively associated with the Complainant in South Africa, for purposes of establishing common law rights in the mark. In fact, no evidence has been submitted to establish that it has any rights in South Africa.

4.1.9 In weighing up all the relevant considerations, the Adjudicator holds that the Complainant has failed to discharge the onus on it of showing, on a balance of probabilities, that it has a right in the mark DOMAIN KING that is enforceable against a third party in South Africa.

## 4.2 Abusive Registration

4.2.1 In light of the finding that the Complainant has failed to establish a protectable right in South Africa in the mark DOMAIN KING, it is not necessary for the Adjudicator to consider whether or not the Domain Name is, in the hands of the Registrant, an abusive registration.

## 5. Decision

5.1 For all the foregoing reasons, the Dispute is refused.

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