

Decision

[ZA2014-0165]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA 2014-0165
DECISION DATE:	23 April 2014
DOMAIN NAME	ezeeweb.co.za
THE DOMAIN NAME REGISTRANT:	MARC KNOTT
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	XNET INTERNET SERVICES (PTY) AND EASYWEB INTERNET (PTY) LTD
COMPLAINANT'S LEGAL COUNSEL:	ADAMS & ADAMS – SOMAYYA KHAN
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **25 February 2014**. On **26 February 2014** the SAIIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **26 February 2014** ZACR 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 **27 February 2014**. In accordance with the Regulations the due date for the Registrant's Response was **28 March 2014**. The Registrant did not submit any response, and accordingly, the SAIIPL notified the Registrant of its default on **31 March 2014**.
- c) The SAIIPL appointed **Mike du Toit** as the Adjudicator in this matter on **7 April 2014**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The First Complainant is Xnet Internet Services (Pty) Ltd. The Second Complainant is Easyweb Internet (Pty) Ltd.
- 2.2 The First Complainant is the proprietor of a number of South African EASYWEB trademark applications which were filed on 24 July 2012. Although not relevant for purposes of proving rights, the trademark

applications are listed in Annex “E2” of the complaint. The First Complainant started trading in 1994 and in 1999 became a registered Internet Service provider.

2.3 The Second Complainant is an associated company of the First Complainant and was registered to take over the EASYWEB division from the First Complainant some time in future. It is the listed registrant of the domain name **eezeweb.co.za** which was registered on 14 March 2008. It is used by the First Complainant and redirects browsers to the main website of the Complainants; www.easyweb.co.za which advertises their business. It is further the registrant of easywireless.co.za, easywebwireless.co.za, easywebtech.co.za and easywebsupport.co.za. It is also the registrant of **easyweb.co.za**, registered in 1998.

2.4 The First Complainant has authorised the Second Complainant to use the mark EASYWEB and to register and maintain the domain name EASYWEB and variant trademarks for the benefit of the First Complainant.

2.5 The First Complainant’s Easyweb Internet Services division operates in wireless internet connectivity and offers services in relation to wireless internet, network security, mail and web hosting, voice over internet protocol and related services.

2.6 The Registrant registered the ezeeweb.co.za domain name on 25 January 2012. The EZEWEBSOLUTIONS business traded in wireless internet and related services until the Registrant took the trading website down. See below.

2.7 The Complainants’ attorneys confronted the use made of the disputed domain name in ezeeweb.co.za and as a result, the Registrant’s website was replaced with a message that read: “Website under construction”.

Despite verbally undertaking to transfer the disputed domain name to the Complainants, the Registrant ultimately refused to do the transfer but undertook to”

“... never again use, register or apply to register in any forum, any name or mark which is identical or confusingly similar to your client’s trademark EASYWEB...”

3 Parties’ Contentions

3.1 Complainant

- a) The First Complainant contends that it has acquired a substantial goodwill and reputation in the mark EASYWEB that is associated with its business. It claims that its Easyweb Internet Services division is a market leader in wireless internet connectivity and offers a variety of products and services in relation to wireless internet, network security mail and web hosting, voip and related services. It claims to have common law protection.
- b) The Second Complainant is the registrant of the following domain names: easywireless.co.za, easywebwireless.co.za, easywebtech.co.za and easywebsupport.co.za. It is also the registrant of easyweb.co.za, registered in 1998.
- c) The Complainants contend that the Registrant’s domain name ezeeweb.co.za is almost identical to the domain name eezeweb.co.za, with minor typographical differences. Their rights in eezeweb.co.za dates back to 2008, prior to the registration of the disputed domain. In addition, the mark ezeeweb as incorporated in ezeeweb.co.za is visually confusingly similar and phonetically identical to the Complainant’s mark EASYWEB incorporated in

easyweb.co.za in 1998.

- d) Visually, ezeeweb.co.za is almost identical to the Complainant's eezeweb.co.za and the dominant element of the Registrant's domain name, EZEWEB is phonetically identical to the Complainant's trademark EASYWEB.
- e) The contention is that there is a direct overlap between the services provided by the Complainants and the Registrant under Ezeeweb Solutions. The Complainants are concerned that the removal of the web content of www.ezeeweb.co.za is not satisfactory as the Registrant would be able to re-activate the website at any time, to the detriment and in conflict with the Complainants' rights.
- f) The Complainants contend that the use and registration of the domain name ezeeweb.co.za was intended to mislead the public into believing that the Registrant is the First Complainant or is associated with the Complainants' business. It is submitted that the registration of the disputed domain and the retention of the domain despite the inactive website is mala fide.
- g) The fact that the Registrant took down the content of the website shows that he is aware of the Complainants' rights.

3.2 Registrant

- a) The Respondent did not reply to the Complainant's contentions.

4 Discussion and Findings

- a) It is trite law that a complainant meets the burden of proof in so far as rights

go for purposes of Regulation 3(1)(a), if he illustrates on a balance of probabilities that he has common law user rights in a mark or a name. The Complainants have done so and have also illustrated rights in domain names of which the dominant elements are the same or identical to the name or mark in which it has proven common law rights.

4.1 Complainant's Rights

4.1.1 The Complainants have proven rights in and to EASYWEB, whether as a mark used in a number of domain names or whether as a trademark in which it holds common law rights. It is unclear when the common law rights were established for the first time as the evidence is silent as to specific dates. It does appear clear and uncontested that it predates the Registrant's earliest claim to rights, i.e. 25 January 2012.

4.1.2 The Complainants contend that the dominant part of the disputed domain name ,i.e. EZEWEB is almost identical to the domain name eezeweb.co.za. In addition, that it is visually confusingly similar and phonetically identical to their trademark EASYWEB. I agree.

4.1.3 This Adjudicator has taken the liberty of conducting a simple search for www.ezeeweb.co.za. The website now opens as NetDirect Wireless Technology a business delivering high speed internet and reliable internet connectivity through technology at an affordable price. The contact email address is info@netdirectcpt.co.za. A simple Whois search revealed that the registrant of netdirectcpt.co.za is Marc Knott, the registrant of the disputed domain name in this matter.

4.1.4 It is clear that the Registrant has since the website was taken down

and since this complaint was lodged, retained the disputed domain name to re-direct traffic to his new website, which appears to be in a business which is in direct competition with the Complainants.

4.2 Abusive Registration

4.2.1 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 Complainants' rights.

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

4.2.3 The conduct of the Registrant is clearly in contravention of clause 4(1) (a)(ii), (iii) and (iv) and clause 4(1)(b).

4.2.4 The use of the disputed domain name is also in clear breach of the Registrant undertaking as provided to the Complainants through his attorneys on 20 February 2014, three days after the Registrant registered netdirectcpt.co.za referred to above. I find that the Registrant was mala fide in its adoption and use of the disputed domain name, whether before or after he took down the content of his first website. It is a clear indication of an abusive registration.

5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name ezeeweb.co.za be transferred to the 2nd Complainant (Easyweb Internet (pty) Ltd).

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[Mike du Toit]

SAIPL SENIOR ADJUDICATOR

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