

## ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2016-0231</b>
DECISION DATE:	<b>13 April 2016</b>
DOMAIN NAME	<b>forevernew.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Malkhaz Kapanadze</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>Forever New Clothing (Pty) Ltd</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Adams &amp; Adams</b>
THE 2 <sup>nd</sup> LEVEL DOMAIN NAME ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA Administrators)</b>

## 1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **11 February 2016**. On **12 February 2016** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **15 February 2016** ZACR confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure.
- b. In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **15 February 2016**. In accordance with the Regulations the due date for the Registrant's Response was **14 March 2016**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **16 March 2016**.
- c. The SAIPL appointed **Janusz F Luterek** as the Adjudicator in this matter on **23 March 2016**. 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

- 1.1. The Complainant is the proprietor in South Africa of trade mark registration nos. 2009/09323-7 FOREVER NEW device in classes 9, 14, 18, 25 and 35.
- 1.2. The Complainant is a fashion clothing and accessories company that was founded in 2006 in Melbourne, Australia. The Complainant now trades in over 250 stores in ten countries globally, including South Africa. Use of the FOREVER NEW trade mark is shown on the Complainant's website at [www.forevernew.com.au](http://www.forevernew.com.au).
- 1.3. Forever New (Pty) Limited was incorporated in South Africa on 12 May 2008 ("FOREVER NEW SOUTH AFRICA") as a joint venture between the Complainant and The House of Busby (Pty) Limited. FOREVER NEW SOUTH AFRICA has been authorised and has been using the Complainant's FOREVER NEW trade mark in South Africa. Currently, there are more than 30 FOREVER NEW retail stores throughout South Africa and the Complainant's products are prominently offered for sale in EDGARS retail stores throughout South Africa.

- 1.4. In addition to its FOREVER NEW trade mark registrations in South Africa, the Complainant has common law rights in its FOREVER NEW trade mark in South Africa as a result of the widespread and extensive use of the FOREVER NEW trade mark in South Africa.

### 3) Parties' Contentions

#### a. Complainant

- i. The Disputed Domain Name, forevernew.co.za, is virtually identical to the Complainant's registered FOREVER NEW trade mark. The Registrant has wholly incorporated the Complainant's FOREVER NEW trade mark in the Disputed Domain Name, without the Complainant's authorisation or consent.
- ii. In terms of Regulation 5(c) the Registrant bears the burden of proof to show that the Disputed Domain Name is not an abusive registration if the domain name is identical to the trade mark in which the Complainant asserts rights. As mentioned above, the Disputed Domain Name is virtually identical to the Complainant's FOREVER NEW trade mark, without additions, so this presumption should apply to this complaint.
- iii. Despite registering the Disputed Domain Name in May 2015, the Registrant has not pointed the domain name to an active website. Interestingly, the parked page to which the domain name points contains links related to clothing, which is the Complainant's field of interest. Accordingly, the Complainant contends that the disputed domain name offends the provisions of Regulation 4(1)(b) and is an abusive registration. In this regard, the Complainant refers to the matter of South African Airways (Pty) Limited v. Ryzhov Volodymyr [ZA2015-0209].
- iv. The Complainant is concerned that the Registrant may elect to sell the Disputed Domain Name to the Complainant for an exorbitant price. In this regard the Complainant refers to the matter of Telkom SA Limited v. Cool Ideas 1290 CC [ZA2007-0003].

- v. The Complainant is concerned that the Registrant may elect to sell the Disputed Domain Name to one of its competitors, thereby causing the Complainant substantial harm. In this regard the Complainant refers to the matters of Telkom SA Limited v. Cool Ideas 1290 CC [ZA2007-0003] and Telkom SA Limited v. Customer Care Solutions (Pty) Ltd [ZA2007-0004].
- vi. Accordingly, the Complainant contends that the disputed domain name offends the provisions of Regulation 4(1)(a)(i) and is an abusive registration.
- vii. The Registrant is inhibiting the marketing and advertising efforts of the Complainant by intentionally blocking the Complainant's registration of the Disputed Domain Name. By virtue of the Registrant's actions, the Complainant is unable to register or use a domain name that corresponds with its FOREVER NEW trade mark. In this regard the Complainant refers to the matter of Federation Internationale de Football Association (FIFA) v. X Yin [ZA2007-0007].
- viii. The Complainant contends accordingly, that the Disputed Domain Name offends the provisions of Regulation 4(1)(a)(ii) and is an abusive registration.
- ix. A letter of demand was sent to the Registrant on 3 December 2015, but despite reminders which were sent to the Registrant, no response has been received to date.
- x. The Complainant requests that the Adjudicator issues a decision for the transfer of the disputed domain name in terms of Regulation 9(a).

**b. Registrant**

- i. The Registrant as Respondent did not reply to the Complainant's contentions.

**4) Discussion and Findings**

**a. Complainant's Rights**

- i. Complainant has rights in respect of a name or mark which is identical or similar to the domain name in dispute.

**b. Abusive Registration**

- i. The disputed domain name in the hands of the Registrant prevents Complainant from using its trade mark and therefore that the disputed domain name prevents the Complainant from exercising its rights in the trade mark.
- ii. The registration of the disputed domain name, which wholly incorporates the Complainant's trade mark, by the Registrant, has the effect that the Complainant is barred from registering or using the disputed domain name for itself. The Adjudicator is in agreement with the WIPO UDRP decision of Red Bull GmbH vs. Harold Gutch where the Panel found that the mere registration of a domain name that contains the well-known mark of another effectively prevents the trade mark owner from reflecting their distinctive and well-known mark in the corresponding domain name.
- iii. The circumstances relating to the registration of the disputed domain name which incorporates the trade mark of the Complainant in the name of the Registrant are unknown and since the Registrant has failed to respond to the Complaint, the only conclusion that can be drawn is that the Registrant was never within his rights to register the disputed domain name in its own name. Thus, in terms of Regulation 5(c) the burden to show that the registration was not abusive shifts to the Registrant, who as stated previously failed to respond and has not discharged that burden.
- v. Thus, under the circumstances there is sufficient evidence indicating that the Registrant has registered or otherwise acquired the domain name in an abusive manner in accordance with Regulation 4(1) as contended by the Complainant.
- vi. Thus, under all the circumstances the registration of the domain forevernew.co.za is held to be abusive.

**c. Offensive Registration**

- i. NOT APPLICABLE

**5) Decision**

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

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**Janusz F Luterek**  
SAIIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)