

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0194
DECISION DATE:	13 May 2015
DOMAIN NAME	iabsa.co.za
THE DOMAIN NAME REGISTRANT:	JACQUES FORTMANN
REGISTRANT'S LEGAL COUNSEL:	Not represented
THE COMPLAINANT:	ABSA BANK LIMITED
COMPLAINANT'S LEGAL COUNSEL:	MARIETTE DU PLESSIS (ADAMS & ADAMS)
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZA Central Registry (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **12 March 2015**. On **13 March 2015** 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 **13 March 2015** 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 **16 March 2015**. In accordance with the Regulations the due date for the Registrant’s Response was **15 April 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **17 April 2015**.
- c. The SAIPL appointed **MIKE DU TOIT** as the Adjudicator in this matter on **22 April 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

- a. The Registrant is Jacques Fortmann, a natural person who according to the relevant 2nd Level Domain Administrator's Whois facility has a postal address in Umtentweni, Port Shepstone, Kwa-Zulu Natal.
- b. The Complainant is the proprietor in South Africa and elsewhere of the trade mark ABSA. The Complainant's business began in 1991 when the Amalgamated Banks of South Africa Limited was formed. In 1997 the name of this company changed to Absa Group Limited.
- c. The Complainant has registered its ABSA trade mark in relation to a wide range of goods and services in South Africa.
- d. In particular, the Complainant is the proprietor in South Africa of, inter alia, the following trade mark registrations:

- no.1991/7473 ABSA BANK in class 36;
- no. 1991/10303 ABSA in class 9;
- no. 1991/10304 ABSA in class 16;
- no. 1991/10305 ABSA in class 36;
- no.1991/10306 ABSA in class 39;
- no.1991/10307 ABSA in class 41;
- no.1991/10308 ABSA in class 42.

- e. The Complainant 's holding company, Barclays Africa Group, has registered, inter alia, the domain names absa.co.za and absa.biz. The Complainant's ABSA trade mark is extensively used on all its letterheads, business cards, advertising and promotional material, as well as online, on its website and social media platforms (including Facebook, Twitter and LinkedIn).
- f. The Complainant's expenditure relating to the promotion of its products and services for the past 9 years under its ABSA trademark exceeded R2 000 000 000.
- g. The Complainant claims to have a protectable reputation and, therefore, common law rights in its ABSA trade mark.

3) Parties' Contentions

a. Complainant

- i. The disputed domain was registered in 2011, some 20 years, after the Complainant adopted its ABSA trade mark.
- ii. The Complainant sent a letter of demand to the Registrant's email address (sales@findfastfree.com) on 26 February 2013.
- iii. The letter contained, inter alia, demands that the Registrant delete the domain name and that it cease using the Complainant's ABSA trade mark in its domain name. The Registrant subsequently contacted the Complainant and offered to sell the domain. The Registrant alleged that numerous parties were interested in purchasing the domain but the Registrant indicated he would prefer to sell it to the Complainant "to prevent fraud".

-
- iv. It is submitted that the Registrant's response does not appear to be truthful, as he only telephonically contacted the Complainant after he received its letter. Furthermore, it is submitted that the Registrant registered the disputed domain with full knowledge of the Complainant's rights in the ABSA trade mark. The Complainant advised the Registrant that it was not prepared to make an offer to purchase the domain name.
 - v. The Registrant refused to comply with the Complainant's demands. The Registrant indicated that he registered the domain name "for a blog site which is an abbreviation for Internet Assistance Book South Africa. This was going to be a blog site that discusses all Internet related problems in RSA where people can discuss and help individuals or companies save money by way of free advice".
 - vi. It is suspected that the Registrant registered the domain name iabsa.co.za primarily to sell the domain name to the Complainant for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name.
 - vii. The disputed domain name wholly incorporates and is confusingly similar to the Complainant's ABSA trade mark with only the addition of the letter "i". It is submitted that the letter "i" is often used as a generic reference to the Internet or information technology.
 - viii. The aforementioned use of the letter "i" is, at least, indicative that the letter "i" has become synonymous with internet/information services or in relation to information technology, including mobile phones/computers.
 - ix. It is submitted that the domain name was registered primarily to intentionally block the registration by the Complainant of the disputed domain name, in which the Complainant has rights that predate the registration of the domain name by 20 years. In view of the Complainant's services offering of online banking, it is submitted that any reasonable person would or should have known that the registration of the disputed domain would not only infringe the rights of the Complainant, but would also act as a blocking registration for the Complainant.

- x. It is submitted that the disputed domain was registered primarily to prevent the Complainant from exercising its rights.
- xi. In light of the Complainant's extensive reputation and common law rights in its ABSA trade mark in South Africa, members of the general public and businesses are likely to be confused and/or deceived into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. The ABSA trade mark is used in conjunction with the prefix letter "i", which adds to the confusion, as this may be indicative of the internet/information services provided by the Complainant

b. Registrant

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

4) Discussion and Findings

a. Complainant's Rights

- i. Complainant has undisputed rights in respect of a name or mark which is identical or similar to the domain name in dispute. The disputed domain name wholly incorporates and is confusingly similar to the Complainant's ABSA trade mark with only the addition of the letter "i".
- ii. The Complainant has proven registered and common law rights in and to the ABSA trademark. These rights are uncontested and accepted.

b. Abusive Registration

- i. 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 which were already established during the previous 20 years.
- ii. The disputed domain was registered primarily to sell or otherwise transfer it to the Complainant or to a competitor of the Complainant, or any third party, for valuable consideration in excess of the Registrant's

reasonable out-of-pocket expenses directly associated with acquiring or using the domain name.

- iii. In view of the confusingly similarity of the domain to the Complainant's ABSA trade mark, the Registrant's conduct falls within the circumstances of Regulation 4(1)(a)(i) of the ADR regulations. It is submitted that the disputed domain name is an abusive registration. The Complainant's reference to Absa Bank Limited v Digital Orange (aka Joris Kroner) [ZA2009 - 00341 and Primedia (Pty) Ltd v DMFI Industries [ZA2012 - 01071 is accepted.
- iv. In light of the Complainant's extensive reputation and common law rights in its ABSA trade mark in South Africa, members of the general public and businesses are likely to be confused and/or deceived into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. The ABSA trade mark is used in conjunction with the prefix the letter "i", and as such, members of the public are likely to believe that the disputed domain website, which remains under construction, is a new facility of the Complainant, which is not the case.
- v. The Registrant's conduct amounts to passing-off (Telkom SA Limited v Cool Ideas1290 CC [ZA2007-0003])

5) Decision

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

.....
Mike du Toit

SAIIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za