

Decision

ZA2015-0224

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0224
DECISION DATE:	25/01/2016
DOMAIN NAME	INVESTMENTSOLUTION.CO.ZA
THE DOMAIN NAME REGISTRANT:	JAMES SAI
REGISTRANT'S LEGAL COUNSEL:	NONE
THE COMPLAINANT:	INVESTMENT SOLUTIONS LIMITED
COMPLAINANT'S LEGAL COUNSEL:	DEBBIE MARRIOTT, ADAMS & ADAMS
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 “SAIPL”) on **27 November 2015**. On **30 November 2015** the SAIPL transmitted by email to ZA Central Registry a request for the registry to suspend the domain name at issue, and on **30 November 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 **3 December 2015**. In accordance with the Regulations the due date for the Registrant’s Response was **5 January 2016**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **6 January 2016**.
- c) The SAIPL appointed **Marthinus Jacobus van der Merwe** as the Adjudicator and **Jeremy Speres** as the Trainee Adjudicator in this matter on **15 January 2016**. The Adjudicator and Trainee Adjudicator have submitted Statements 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 Investment Solutions Limited, a company established in 1997, operating as a provider of multi-manager investment portfolios within South Africa.
- 2.2 The Complainant is the proprietor of trade mark registration no.s 1997/07893 INVESTMENT SOLUTIONS and 1998/23523 INVESTMENT SOLUTIONS device, both in class 36 covering, amongst others, financial, investment and insurance services. Both trade mark registrations appear to have been timeously renewed and remain registered.
- 2.3 In addition to its registered trade marks, the Complainant claims to have developed a considerable reputation in its INVESTMENT SOLUTIONS trade mark as a result of

18 years of extensive, consistent use of its mark in relation to financial advisory, management and investment services, and that as a result, it has acquired rights to protect its mark at common law. The Complainant has, under oath, adduced substantial evidence of use in support of its claim to a reputation, all for periods predating the registration date of the contested domain, including but not limited to significant advertising spend, many examples of print, television and radio advertisements, social media marketing as well as a media coverage report produced by an independent media monitoring agency. Additionally, the Complainant owns the domain name INVESTMENTSOLUTIONS.CO.ZA, which it registered in 1997, and has adduced Internet Archive evidence showing use of that domain in relation to its business since December 2000. All of this evidence is uncontested by the Registrant.

- 2.4 The contested domain name, INVESTMENTSOLUTION.CO.ZA, was registered on **19 December 2013**. This domain appears to be used solely for affiliate or pay-per-click marketing of the investment and financial services of others.
- 2.5 Based on the WHOIS page for the contested domain, the Registrant is James Sai, ostensibly a resident of Kuala Lumpur, Malaysia.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant contends that the contested domain name is confusingly similar to the Complainant's registered and common law trade mark INVESTMENT SOLUTIONS.
- b) The Complainant contends that as a result of its reputation and registered rights in its mark, the registration of the disputed domain constitutes an abusive registration in terms of Regulation 3(1)(a) in that the Registrant has, in terms of Regulation 4(1)(a), registered the domain name primarily to 1) block intentionally the registration of a name or mark in which the complainant has rights; 2) disrupt unfairly the business of the complainant; or 3) prevent the complainant from exercising its rights.

- c) The Complainant contends that the Registrant has registered the contested domain, and has in fact used it, in a manner that is likely to confuse consumers into believing that the associated website is connected to or endorsed by the Complainant. Alternatively, the Complainant contends that the contested domain was deliberately chosen in order to divert traffic to the Registrant's website and then to misdirect that traffic to the websites of those third parties whose services are advertised on the Registrant's website.
- d) The Complainant additionally contends that the contested domain is likely to dilute the distinctiveness of its trade mark.
- e) Finally, the Complainant contends that the Registrant has engaged in a pattern of making abusive registrations in terms of Regulation 4(1)(c). In this regard, the Complainant has directed us to three other domains registered by this Registrant that have previously been found to be abusive registrations. This will be discussed in detail in the findings below.

3.2 Registrant

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

4 Discussion and Findings

4.1 Complainant's Rights

- 4.1.1 The Complainant has chosen a trade mark, being INVESTMENT SOLUTIONS, which is somewhat descriptive and inherently not very distinctive of at least some of the services covered by its registrations as well as those offered through its business. Nevertheless, in light of section 51 of the Act, we are bound to find that the Complainant's registered marks are *prima facie* valid. In any event, we agree with previous decisions by Adjudicators that these proceedings are neither designed nor appropriate for considering the validity of registered trade marks (see the decision in [ZA2011-0075](#) at para 4.9).

4.1.2 The Complainant has adduced significant evidence of use of its marks, which remains uncontested. In our view, the Complainant has tendered evidence sufficient to establish a reputation in its INVESTMENT SOLUTIONS mark and rights to defend such mark at common law.

4.1.3 The disputed domain name differs in one letter, being the final letter “s”, from the Complainant’s mark. We accordingly find that the Complainant has rights in respect of a mark that is confusingly similar to the contested domain name in terms of Regulation 3(1)(a).

4.2 Abusive Registration

4.2.1 The Complainant has directed us to two previous decisions in which the Registrant was found to have made abusive registrations:

<u>Case no.</u>	<u>Domain name(s)</u>	<u>Date of decision</u>
ZA2014-0187	STANARDBANKMOBI.CO.ZA	2 December 2014
ZA2014-0189	SASOLLEARNERSHIP.CO.ZA SASOLCAREER.CO.ZA	23 January 2015

4.2.2 We have independently established that the Registrant has, in addition, been found to have made two further abusive registrations:

<u>Case no.</u>	<u>Domain name(s)</u>	<u>Date of decision</u>
ZA2015-0197	SOWETANJOBS.CO.ZA	23 JUNE 2015
ZA2015-0214	TRANSLUXBUS.CO.ZA	22 October 2015

4.2.3 Adjudicators are permitted to undertake limited factual research into matters of public record, especially if this is in the interests of justice (see the decision in [ZA2015-0193](#) at para 4.2.9).

4.2.4 This dispute was filed on 27 November 2015 and all four of the decisions referred to above in which the Registrant was found to have made abusive registrations were decided within the 12 months preceding the date that this dispute was filed. Accordingly, we find that Regulation 4(3) is applicable and that a rebuttable presumption that the contested domain is an abusive registration applies. Given that the Registrant has not responded to the complaint, the presumption has not been rebutted and that the contested

domain name must be found to be an abusive registration on this basis. Nevertheless, in case we are incorrect, we will proceed to consider the merits of the matter.

4.2.5 An abusive registration means a domain name which either:

- 1) 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; or
- 2) Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

4.2.6 The Registrant uses the domain name to advertise the services of third parties which are identical to those offered by the Complainant and which no doubt compete with the Complainant. In addition, the contested domain name is virtually identical to the Complainant's reputed trade mark as well as the Complainant's own domain name, differing in only one letter, being the last letter. In light of the tendency of internet users to misspell the ends of domain names being entered by them into their browsers, the contested domain name is likely to lead to internet users viewing the Registrant's website when they in fact intended to view that of the Complainant.

4.2.7 In WIPO decision [D2010-1502](#) it was found that altering a trade mark by one letter is not enough to avoid a decision of confusing similarity or the impression that the designation is connected to the trade mark of the complainant. Given the repute of the Complainant's mark, the fact that the contested domain has simply been "parked" and used exclusively for "pay-per-click" advertising for competing services, as well as the Registrant's history of making abusive registrations, we find that it is likely that the registration and use of the contested domain name amounts to "typo squatting". In WIPO decision [D2010-1118](#) it was held that "typo squatting" occurs when: "*a respondent purposefully includes typographical errors in the mark portion of a disputed domain name to divert Internet users who make those typographical errors.*" In numerous local and international domain name decisions, typo squatting has been found to warrant a decision in the complainant's favour (see the decision in [ZA2007-0006](#) and the

WIPO decisions referred to above).

- 4.2.8 That the registration of this domain amounts to typo squatting is further supported by the fact that the Registrant has chosen to register the domain name in the singular form, being INVESTMENTSOLUTION, but has proceeded to use the domain name to advertise multiple third party investment offerings instead of just one, as the domain's singular form implies. This clearly suggests that the Registrant was seeking a domain as close to that of the Complainant's mark as possible.
- 4.2.9 This typo squatting is likely to lead to a disruption of the Complainant's business as well as preventing the Complainant from exercising its rights to enjoy, unhindered, the goodwill associated with its trade mark in terms of Regulation 4(1)(a)(iii) and (iv).
- 4.2.10 In light of the Registrant's history of abusive registrants, we find that the factor listed at Regulation 4(1)(c) is also applicable and that it is proper to take the Registrant's history of abusive registrations into account in this matter.
- 4.2.11 Given that the contested domain name has been put to some limited use, we need to consider whether Regulation 5(a)(i) applies and whether the Registrant can be said to have used the domain in connection with a good faith offering of goods or services. In numerous local and foreign domain name decisions it has been held that use of a domain name that conflicts with a complainant's trade mark purely for the purposes of providing pay-per-click advertisements to third party businesses that compete with the complainant does not amount to a good faith offering of goods or services. See WIPO decisions [D2007-1499](#), [D2010-1652](#) and the local decision in [ZA2015-0209](#). We respectfully agree with these decisions and find the principle to be equally applicable here, especially given the repute of the Complainant's mark in this case. If the general principle were otherwise, then it would be open to nefarious registrants to adopt the trade marks of others as domain names, use them for competing services and profit handsomely from the exercise.

4.2.12 In the circumstances, we find that the contested domain name is an abusive registration.

5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, we order that the disputed domain name, INVESTMENTSOLUTION.CO.ZA, be transferred to the Complainant.

.....
MARTHINUS JACOBUS VAN DER MERWE
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za

.....
JEREMY SPERES
SAIPL TRAINEE ADJUDICATOR
www.DomainDisputes.co.za