

ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-0159
DECISION DATE:	12 March 2014
DOMAIN NAME	KONFTELSA.CO.ZA
THE DOMAIN NAME REGISTRANT:	PHONATICS (PROPRIETARY) LIMITED
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	AVAYA INC and KONFTEL AB
COMPLAINANT'S LEGAL COUNSEL:	Spoor & Fisher
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZA Central Registry (CO.ZA Administrators)

1 Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **14 January 2014**. On **15 January 2014** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **15 January 2014** 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.
- 1.2 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **16 January 2014**. In accordance with the Regulations the due date for the Registrant's Response was **13 February 2014**. The Registrant submitted no Response by **13 February 2014**. The SAIPL notified the Registrant of its default on **14 February 2014**. The SAIPL accordingly considered the Registrant to be in default and proceeded with appointing the Adjudicator.
- 1.3 The SAIPL appointed **Janusz F Luterek** as the Adjudicator in this matter on **25 February 2014** after another attempt to appoint another adjudicator came to nought. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence on **25 February 2014**, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The domain was registered on 24 October 2012 by Phonatics (Pty) Ltd with FJ van Dyk as the administrative contact.
- 2.2 The following facts are undisputed and, their not being palpably implausible, the Adjudicator accepts them for the purposes of this adjudication.
- 2.3 The Complainants are AVAYA INC and KONFTEL AB jointly. Konftel AB is based in Sweden and is a wholly owned subsidiary of Avaya Inc. Avaya Inc as the principal company is the registered proprietor of the trade mark KONFTEL. On its turn,

Konftel AB as wholly owned subsidiary of Avaya Inc, is the permitted user of the trade mark KONFTEL. The Complainants are thus cited in their capacities as enterprises within the same group of companies, Avaya Inc. being the proprietor of the KONFTEL mark and Konftel AB being the actual user thereof.

- 2.4. The Complainant, Konftel AB, a Swedish company and wholly owned subsidiary of Avaya Inc., has been using the trade mark KONFTEL in connection with conference and loud speaking telephones since 28 November 1988. Konftel AB was acquired by Avaya Inc. in January 2011.
- 2.5. It is alleged by the Complainants that Konftel AB is a leading company and the world's fastest growing brand within audio conferencing solutions. Since 1988 it has assisted people around the world to conduct meetings despite distances. It delivers reliable audio conferencing solutions where the client's meeting experience is put first. The conference solutions are developed with the user in focus in order to provide easy to use products with excellent and clever design. The Complainants' Konftel solutions are sold globally under the KONFTEL brand, with headquarters based in Sweden.
- 2.6. The Complainants' KONFTEL goods were first imported in South Africa and sold locally during November 2006 through authorised distributors which deal with the KONFTEL goods in the South African market.
- 2.7. Previously, the Complainants became aware that the Registrant had registered the domain name *konftel.co.za* and a formal domain name complaint was filed in respect thereof. That complaint was allocated case no. ZA2012-0115 with judgment being handed down on 22 October 2012. It was held that the domain name registration *konftel.co.za* in the hands of the Registrant to be an abusive registration ordering the transfer of the domain to the Complainants.

3 Parties' Contentions

3.1 Complainant

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- 3.1.1 Konftel AB is a leading company and the world's fastest growing brand within audio conferencing solutions. Since 1988 it has assisted people around the world to conduct meetings despite distances. It delivers reliable audio conferencing solutions where the client's meeting experience is put first. The conference solutions are developed with the user in focus in order to provide easy to use products with excellent and clever design. The Complainants' Konftel solutions are sold globally under the KONFTEL brand, with headquarters based in Sweden.
- 3.1.2 Konftel AB, is a wholly owned subsidiary of Avaya Inc., has been internationally using the trade mark KONFTEL in connection with conference and loud speaking telephones since 28 November 1988. Konftel AB was acquired by Avaya Inc. in January 2011.
- 3.1.3 In the light of Domain Dispute 2012-0115 in respect of www.konftel.co.za and the decision therein, the Registrant could not have been unaware of the existence of the Complainants' rights in the KONFTEL trade mark when it registered the corresponding domain name www.konftelsa.co.za on 24 October 2012.
- 3.1.4 The Complainant, Avaya Inc, has applied for registration in South Africa of its KONFTEL trade mark under application number 2012/28981, on 25 October 2012, which application has now been accepted but at the time of the filing of this complaint had not yet been registered.
- 3.1.5 In addition to the above trade mark application, the Complainants claim common law rights in the trade mark KONFTEL and this is supported by marketing data as well as the findings of the adjudicator in Domain Dispute 2012-0115 in which it was stated that the Complainants had acquired "rights" in the KONFTEL mark (at a stage prior to the filing of its trade mark no. 2012/28981).
- 3.1.6 The Registrant's use of the domain name in question infringes Complainant's rights in the "KONFTEL" trade mark because combination of the trade mark "KONFTEL" with the postscript "SA" creates a domain name that cannot be anything but confusingly similar to the Complainant's "KONFTEL" trade mark. In addition, the goods offered for sale by the Registrant on the website at www.konftelsa.co.za include products of the Complainants and competitors of the

Complainants. As a result of the above, the Complainant submits that there is a substantial likelihood that Internet users and consumers will be confused into believing that there is some affiliation or connection between the Complainant and the Respondent, when in fact, there is no such relationship. The Complainant therefore contends that the disputed domain name is confusingly similar to the Complainant's KONFTEL trade mark.

- 3.1.7. A number of Domain Disputes.co.za judgments have held that the mere addition of the letters S A to a name in which a Complainant has rights, such as the situation in the present matter, does not serve to overcome the domain being an abusive registration. Such cases include case no. ZA2013-00148 *olympicssa.co.za*, ZA2013-00134 *carfindsa.co.za*, ZA2013-00128 *inetsa.co.za*, ZA2011-0068 *singersa.co.za*.
- 3.1.8. The Complainant thus contends Registrant's conduct falls within the ambit of Regulation 4(1) in that there is evidence supporting that the registration of the disputed domain name is abusive.
- 3.1.9. The Complainants further contend that the Registrant is engaged in a pattern of making abusive registrations as referred to in Section 4(1)(c) of the Alternative Dispute Resolution Regulations (Regulation 1166 of 22 November 2006) under the Electronic Communications and Transactions Act, 2002.

3.2 Registrant

- 3.2.1 The Registrant failed to respond to the complaint.

4 Discussion and Findings

- 4.1 The Adjudicator concurs with the adjudicator in case 2012-0115 and finds that the Complainant has common law rights in respect of the trade mark "KONFTEL" as contemplated by Regulation 3(1)(a). The question is whether the domain in question is abusive in the hands of the Registrant.
- 4.2 An abusive registration denotes a domain which either:-
 - 4.2.1 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
 - 4.2.2 has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.
- 4.3 The Complainant is required by Regulation 3(2) to prove that the foresaid elements are present to support a finding that the disputed domain registration is abusive.
- 4.4 The Registrant has not proffered cogent reasons, or any reasons at all, why he chose to register the disputed domain name, nor has he given any reason why he registered the domain name at the time he did. The Adjudicator is therefore entitled to hold that the domain name www.konftelsa.co.za is an abusive domain registration in the hands of the Registrant.
- 4.5 The Adjudicator finds the domain registration www.konftelsa.co.za to be abusive. Consequently, the Adjudicator upholds the Complainant's complaint.

5 Decision

- 5.1 For the above reasons, in accordance with Regulation 9(a), the Adjudicator orders that the domain name, konftelsa.co.za be transferred to Avaya Inc.

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JANUSZ F LUTEREK
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za