

Decision

[ZA2016-0230]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2016-0230
DECISION DATE:	24 March 2016
DOMAIN NAME	pnpexpress.co.za
THE DOMAIN NAME REGISTRANT:	BP RAISETHORPE SERVICE STATION CC
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	PICK 'N PAY RETAILERS (PTY) LTD
COMPLAINANT'S LEGAL COUNSEL:	ADAMS & ADAMS
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry

1 Procedural History

- a) The domain in this complaint is **pnexpress.co.za**, which was registered on **9 November 2008**. The Registrant is BP RAISETHORPE SERVICES STATION CC.
- b) The Complainant is **Pick N Pay Retailers (Pty) Ltd**, whose principal place of business is at Pick n Pay Centre, Corner Main and Campground Roads, Claremont, Cape Town.
- c) This dispute was filed with the South African Institute of Intellectual Property Law (“SAIIPL”), on **5 January 2016**. On the same day SAIPL emailed a request to ZA Central Registry for the registry to suspend the domain name, on **6 January 2016** the Registry confirmed the suspension.
- d) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **6 January 2016**. The due date for the Registrant’s Response was **3 February 2016**. The Registrant did not submit a Response, and notification of his default was posted on **4 February 2016**.
- e) The SAIPL appointed **Reinard Michau** as the Adjudicator in this matter on **12 February 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

- 2.1 The Complainant is Pick ‘n Pay Retailers (Pty) Ltd.
- 2.2 The Complainant is the proprietor in South Africa of the trade marks:
 - PICK N PAY and PNP. The PICK N PAY trade mark was first used by the Complainant in South Africa in 1967 and in 2007 it commenced use of the trade mark PNP, such use in respect of retail stores.
- 2.3 In 2008 the Complainant commenced making use of the trade mark PICK N PAY EXPRESS, also in respect of retail stores.

- 2.4 The Complainant has various trade marks in South Africa and, in particular, no. 2007/27241 PNP (special form) in class 35 registered in respect of, *inter alia*, “*offering for sale and the sale of goods in the retail and wholesale trade*”, 2010/00714 PNP (special form) in class 43 in respect of “*services for providing food and drink*”, 2008/21231 PICK N PAY EXPRESS in class 35 for, *inter alia*, “*offering for sale and the sale of goods in the retail and wholesale trade*” and 2008/21232 PICK N PAY EXPRESS in class 43 in respect of, *inter alia*, “*services for providing food and drink*”.
- 2.5 The Complainant has various domain names which incorporate the trade mark PNP and, according to the papers, (see annexe “4”) in excess of 20.
- 2.6 The Complainant operates some 1200 stores across all formats in South Africa and employs close to 50 000 persons (excluding its franchisors). The Complainant has various stores called PICK N PAY EXPRESS which is operated in collaboration with the well-known service station BP, which were first opened in 2008 and it currently has a total of 46 such stores.
- 2.7 The Complainant has used the trade mark PNP extensively and since 2011 it has had, in respect of the use of this trade mark, a turnover in excess of R50 Billion, annually.
- 2.8 In addition, the Complainant has advertised its trade marks extensively.
- 2.9 The Complainant has 1 Million Facebook followers and in the past year had 790 Million customer interactions.

3 Parties’ Contentions

3.1 Complainant

- a) The Complainant contends that, as a result of its extensive use it has gained an extensive reputation in the trade marks PNP and PICK N PAY EXPRESS.

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- b) It contends because the disputed domain name “*pnpress.co.za*” wholly incorporates the well-known PNP trade mark, there will be a likelihood of deception or confusion given that the word “*express*” “*does not serve to distinguish the disputed domain name from the Complainant’s well-known PNP trade mark*” (presumably because the term “*express*” is of a non-distinctive nature). As such, it contends that the disputed domain name will cause deception or confusion.
- c) The Complainant also contends that the domain name is an abuse of the registration in the hands of the Registrant.
- d) The Registrant, although it has a BP service station, has no PICK N PAY EXPRESS store operated from such service station. The sole member of the registrant is a certain Mr Moodley, a person who is not a franchisee of the Complainant. That notwithstanding, he has, in his personal name, registered the domain name “*picknpayexpress.co.za*” and in respect of which a separate complaint is lodged.
- e) Following a request from the Complainant’s attorneys, the Registrant’s attorneys responded indicating that they would consider transferring the domain name to the Complainant for a figure to be agreed upon.
- f) The Complainant also contends that the use of the domain name will constitute an infringement of the registered trade marks of the Complainant (as referred to earlier).
- g) In summary, the Complainant contends that the reasons that the disputed domain name is abusive is because:
- i) the Registrant has no legitimate claim to the domain name;
 - ii) the disputed domain name has the effect that the Complainant is barred from registering an identical domain name;
 - iii) it will amount to an unfair disruption of the Complainant’s business because it will mislead consumers and as a result divert consumers to the Registrant’s website;
 - iv) the Registrant is preventing the Complainant from exercising its rights in

its PNP and PICK N PAY EXPRESS trade marks.

3.2 Registrant's contentions no response

The Registrant filed no response and therefore has made no submissions. The contentions stand uncontested.

4 Discussion and Findings

4.1 Complainant's Rights

4.1.1 Complainants' Rights, Regulation 1 defines "*rights*" to include intellectual property rights.

4.1.2 The above definition is broad and "*rights*" is not restricted to rights founded on the principles of trade mark law, but recognises rights going beyond those in terms of the Trade Marks Act 294 of 1993 ("*the Act*") or the requirements at common law for passing-off. Such rights must, however, find recognition in law. See ZA2007-008 (privatesale.co.za).

4.1.3 The Complainant is the proprietor of various trade mark registrations for PNP and PICK N PAY EXPRESS. As a result of the undisputed evidence set out earlier, there is no doubt that there is an enormous reputation and goodwill in the aforesaid trade marks. They are protected by the Act as well as at common law.

4.2 Abusive Registration

4.2.1 "*Abusive Registration*" is defined in the Regulations to mean, *inter alia*, a domain name which was registered in a manner which, at the time the registration took place, took unfair advantage of or is unfairly detrimental to the Complainant's rights.

4.2.2 The disputed domain name includes the Complainant's mark PNP in its entirety and, of course, the term "*express*" in the trade mark PICK N PAY EXPRESS. The phrase PNP, because of the aforesaid extensive use, is a well-known acronym for the trade mark PICK N PAY.

- 4.2.3 The incorporation of the generic word “*express*” does not assist to distinguish the disputed domain name from the PNP trade mark. Reference is made to a similar case in the South African Domain Dispute Matter of ZA2007/000, where it was found that the domain name telkommedia.co.za was identical or confusingly similar to the well-known trade mark TELKOM.
- 4.2.4 In the foreign decision of Wipo / D2002-0367, the Panel concluded that: *“The disputed domain name contains Complainant’s EXPERIAN trade mark in its entirety. The addition of the generic term ‘automotive’ does not distinguish the Respondent’s domain name from the Complainant’s mark”.*
- 4.2.5 Reference is also made to foreign case Wipo / D2000-1598 in which NIKETRAVEL and NIKESPORTSTRAVEL were found to be similar to NIKE. DRS04601 in which NIKESTORE was found to be similar to NIKE and DRS01493 in which NOKIA-RING-TONES was found to be similar to NOKIA.
- 4.2.6 The Adjudicator accordingly finds that the domain name pnpexpress.co.za is a domain name which will lead to deception and confusion and will unfairly disrupt the business of the Complainant. It also takes unfair advantage thereof. There is no doubt that the public would associate it with the Complainant. The contentions of the Complainant as set out in paragraph 3.1 above carry considerable weight and the Adjudicator finds those contentions to have been proved. They are incorporated in the Adjudicator’s findings.

5. Decision

- 5.1 For the foregoing reasons the complaint is upheld and the Registrant is ordered that the disputed domain name is to be transferred to the Complainant.

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R MICHAU SC
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za