

Decision

[ZAAP2015-0203]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0203
APPEAL NUMBER:	ZAAP2015-0203
DECISION DATE:	11 January 2016
DOMAIN NAME	propuk.co.za
THE DOMAIN NAME REGISTRANT:	Carina Bester
REGISTRANT'S LEGAL COUNSEL:	Spoor & Fisher
THE COMPLAINANT:	North-West University
COMPLAINANT'S LEGAL COUNSEL:	Kisch-IP
2 nd LEVEL ADMINISTRATOR:	ZACR (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (“the SAIPL”) on **18 June 2015**. On **22 June 2015** the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name at issue, and on **23 June 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 **25 June 2015**. In accordance with the Regulations the due date for the Registrant’s Response was **23 July 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **27 July 2015**.
- c) The SAIPL appointed **Mr Deon Bower** as the Adjudicator in this matter on **03 August 2015**. The Adjudicator 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.
- d) On **11 August 2015**, Spoor & Fisher advised the administrator that it had been instructed belatedly to respond to the Complaint, and undertook to lodge the Response by **14 August 2015**. The Registrant was allowed, by the Adjudicator, to submit its Response, which it did on **17 August 2015**, and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL’s Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant. The Complainant’s Reply was submitted on **27 August 2015**.
- e) The Adjudicator’s decision was forwarded to the parties on **22 September 2015**. On **29 September 2015** the Complainant lodged its Notice of Intention to Appeal, and paid the requisite fees. On **1 October 2015**, in accordance with the Regulations, the administrator advised the Complainant that its Appeal Notice Deadline was **22 October 2015**. The Appeal Notice was duly submitted on **22 October 2015**.
- f) In accordance with the Regulations, the SAIPL formally notified the Registrant of

the Appeal Notice on **22 October 2015**. In accordance with the Regulations the due date for the Registrant's Appeal Notice Response was **5 November 2015**.

- g) The Registrant did not submit any Appeal Notice Response, and accordingly, the SAIPL notified the Registrant of its default on **6 November 2015**.
- h) The SAIPL appointed **Vanessa Lawrance, Mike du Toit, and Tana Pistorius** as the Panel of Adjudicators in this matter on **16 November 2015**. The Adjudicators have submitted their Statements of Acceptance and Declarations of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The facts appear from the decision of the Adjudicator in the decision in the first instance. The Complainant, previously known as, amongst others, the Potchefstroom University College and the Potchefstroom University for Christian Higher Education, has been using the names PUK or PUKKE, and other similar names, extensively, for many decades. The Complainant alleges that the name PUK is well known.
- 2.2 The Complainant has established an extensive reputation, not only in the distinctive name PUK, but also variants of the name, such as PUKKE, PUKKIE and NWU-PUK, and enjoys a reputation in the aforementioned names, and, as such, enjoys extensive common law rights, at least in the name, PUK.
- 2.3 The Complainant is further the registered proprietor of various trade mark registrations for the trademarks PUK, PUKKE, PUKKIE and PUKKI, which trade mark registrations are in full force and effect.
- 2.4 The Disputed Domain Name is registered in the name of Ms Carina Bester, an employee of Solidarity. The Registrant's postal address is that of Solidarity.

3 Decision under Appeal

- 3.1 The Adjudicator held that in the absence of confirmatory evidence, the submissions made by Solidarity are hearsay and inadmissible and must, as such, be rejected. The Adjudicator accordingly held that Solidarity has no *locus standi* as it is not the Registrant of the Disputed Domain Name. The Adjudicator declined to consider Solidarity's Response and consequently the Complainant's Reply was also not considered.
- 3.2 The Adjudicator held that the Complainant has established statutory rights in respect of its PUK and PUKKE trade marks and that the Disputed Domain Name is similar to the Complainant's trade marks in terms of Regulation 3(a).
- 3.3 The Adjudicator held that the Disputed Domain Name was not registered primarily to "block intentionally the registration of a name or mark in which the Complainant has rights". The Adjudicator held that the aforementioned becomes clear, especially, if the evidence which the Complainant submitted which illustrates the intentions of and the manner in which the Disputed Domain Name is used in a non-commercial manner by the Registrant or the "Pro-Puk 'Groep'", is considered.
- 3.4 The Adjudicator noted that although it will be difficult to dispute the "facts" which the Complainant makes reference to, it is quite conceivable that the Disputed Domain Name was registered for the purpose of "protecting" Afrikaans, as the evidence suggests, and not otherwise. The Adjudicator held that in the absence of any evidence to the contrary, the Complainant's submissions alone do not constitute proof, on a balance of probabilities, that the Disputed Domain Name was registered primarily to "prevent the complainant from exercising his, her or its rights".
- 3.5 The Adjudicator held that there is no evidence, which, on a balance of probabilities, proves that the Registrant, or its predecessor, had registered or acquired the Disputed Domain Name primarily to disrupt the business of the Complainant. To the contrary, the manner in which the Disputed Domain Name is used, suggests that the Registrant is not, primarily, seeking to disrupt the business of the Complainant, but rather to promote certain objectives, clearly, not associated with or linked to "disrupting" the

business of the Complainant.

- 3.6 The Adjudicator held that it is unlikely that people will be confused or deceived into believing the Disputed Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, as it will be, immediately, apparent to persons accessing the website www.propuk.co.za that the website is associated, operated, authorised by a group which is connected with the Complainant. The Adjudicator held that the evidence therefore does not, on a balance of probabilities, prove that “The Registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”.
- 3.7 The Adjudicator held that the evidence confirms that the Complainant holds extensive trade mark rights in the various PUK trade marks, the Disputed Domain Name is similar to the Complainant’s PUK trade marks and, also, that the Disputed Domain Name is used for non-commercial purposes.
- 3.8 The Adjudicator held that the evidence does not, on a balance of probabilities, support the allegations of bad faith i.e. that 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 or has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant’s rights. The Adjudicator accordingly dismissed the Complaint.

4. The Parties’ Submissions on Appeal

4.1 Complainant

- a) Succinctly put the Complainant alleges that the Adjudicator correctly excluded the Response to the Complaint, which means that the Reply was also correctly excluded from consideration.
- b) The Adjudicator erred in holding that the use of the Disputed Domain Name was “non-commercial” or for purposes of “non-commercial criticism”. The Complainant avers that: (i) Solidarity is a trade-union movement but it is

also clearly involved in creating or organizing the Pro-Puk Group (“the Group”) and orchestrating its activities and use of the Disputed Domain Name; (ii) Solidarity’s activities are business-related and it behaves like a business; and (iii) Solidarity’s purposes and activities herein, and that of the Group, which are part of Solidarity’s business, are in fact, at the very least or partly, commercial in nature. The Complainant alleges that the Adjudicator, erred in referring to D2008-0430 and the UDRP requirement of “legitimate non-commercial or fair use of the domain name”. The Adjudicator referred to it as: “... as long as the use if (sic – is) fair and non-commercial”.

- c) The Adjudicator should have held that the evidence submitted by Solidarity was inadmissible *in toto*, and not partly inadmissible.

- d) The Adjudicator erred in rejecting the Complainant’s first ground of objection, that the Disputed Domain Name is a blocking registration. The Complainant submits that the statement in its letter of request to the Pro-Puk Group dated 9 April 2015 (Annexure “DK23”) to the effect that “its adoption of the Pro-Puk name by the Group was possibly in good faith”, must be seen against the background of the entire letter that was written in an amicable spirit and belief (and not as the usual letter of demand). Secondly, the Registrant and Solidarity/the Group have acted in bad faith because they were well aware of the Complainant’s names/trade mark e.g. PUK. Thirdly neither the Registrant nor Solidarity has demonstrated any fair use, which may include websites operated solely in tribute to or fair criticism of a person or business – as is required by Regulation 5(c) - which may be a factor indicating that the domain name is not an abusive registration. However, this factor is in any event inadmissible and hence not available, to the Registrant (or to Solidarity, for that matter) in its defence. Fourthly, the Registrant clearly cannot deny that she was fully aware, as is Solidarity and the Group that PUK is a trade mark of the Complainant. In that sense, the adoption by the Registrant, and subsequent use by Solidarity or the Group, of the Disputed Domain Name, is not bona fide and hence not fair use. The Complainant refers to local and international decisions in support of its contention that it is the effect of the Disputed Domain Name,

above all other considerations, that results in a blocking registration.

- e) The Complainant avers that the Adjudicator erred in rejecting the Complainant's claim that Disputed Domain Name factually prevents the Complainant from exercising its rights in South Africa viz by not being able to register PROPUK.CO.ZA for itself. The Registrant's warranty that the registration of the Disputed Domain Name does not infringe third parties' intellectual property rights was false. This shows bad faith by the (initial and present) Registrant, and Solidarity and the Group, who have acted initially in registering and subsequently in using the Disputed Domain Name, respectively.
- f) The Adjudicator erred in holding that there is no evidence demonstrating how the use of the Disputed Domain Name disrupts or unfairly disrupts the Complainant's business. The Complainant avers that Solidarity and the Group have been involved in using the Disputed Domain Name to influence persons as to its business and possible changes thereto. This activity has primarily been the reason for registering and using the Disputed Domain Name, and this has been unfairly disruptive to the Complainant's business. The Complainant then attempts to introduce new evidence (reference to the Vice-Chancellor's media statement dated 13 August 2015) and claims that it is disruptive to its business as these activities have been based on rumour and untruths and hence are based on bad faith.
- g) The last ground of appeal is that the Adjudicator erred in holding that there is no evidence to support the Complainant's claim that the Registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant notes that it has submitted examples of actual confusion from persons connected with the NWU, thinking that the Disputed Domain Name is associated with the NWU. The Complainant refers to the fact that the NWU Logo, the capital letters NWU and PUKKE is depicted on the

PROPUK webpage and on its Facebook and Twitter accounts. The Complainant's well-known (old) Main Building of NWU is also depicted on these sites. The Adjudicator erroneously reasoned that, because the PUK trademark is used in various instances in combination with the NWU trademark, this does not support the Complainant's submissions. However, the Complainant submits that, whether PUK is used on its own or in combination with NWU, the Complainant remains effectively the same body/university. Hence this reasoning by the Adjudicator is not valid. Secondly, the Adjudicator erroneously held that "...as it will be, immediately, apparent to persons accessing the website www.propuk.co.za that the website is associated, operated, authorised by a group which is connected with the Complainant". The Complainant notes that there are two problems with this statement – firstly, the Group is NOT connected with the Complainant; and secondly, the Adjudicator has found that there is a connection with the Complainant – albeit an indirect connection – which is at odds with his finding in respect of this factor.

4.2 Registrant

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

5. Discussions and Findings

- 5.1 Solidarity is a trade union that has political aspirations and agendas. It is a business and in the wider concept of "business" as referred to in the textbook Webster and Page: South African Law of Trade Marks, 4th Edition, page 15-26 and the British and South African cases/authorities cited there, its activities are not non-commercial. It clearly stated in DK19 that the Pro-Puk Group operates in close co-operation with Solidarity and that it also supports the efforts to establish AKADEMIA, the new Afrikaans community university. The Adjudicator referred to the use made of the Disputed Domain Name "by the Registrant or the "Pro-Puk 'Groep"". In reality the first web page was created on 2 March 2014 to criticise a series of articles in the Beeld newspaper regarding the hazing of first year students at North-West University. The post was signed by Flip Buys, Executive Chairperson, Solidarity Movement (see <https://web.archive.org>). This evidences the fact that Solidarity has been the user of

the domain name *ab initio*. There is also enough evidence in the Complaint to support this fact. For the purposes of this appeal the actions of Solidarity should be seen as that of the Registrant. The panel holds that Solidarity is the user of the Disputed Domain Name. For purposes of this decision the panel will refer to Solidarity and the Group as “the Registrant”. The panel therefore agrees with the Complainant that the activities of the Registrant are for commercial purposes. If the panel allows the decision of the Adjudicator to stand on this point, it would lead to an untenable precedent which would open the door for the registration of abusive registrations by politically motivated registrants, hiding behind a so called “non-commercial” defence.

- 5.2 The Complainant’s registered trade mark PUK is long established and the panel holds that the Complainant submitted sufficient evidence to establish that it is well known. Previous WIPO UDRP decisions have held that the unauthorised registration of a well-known trade mark as a domain name is a clear indication of bad faith in itself, even without considering other elements (see *Veuve Clicquot Ponsardin Maison Fondée en 1772 v The Polygenix Group Co* WIPO Case No D2000-0163; *PepsiCo Inc v “null”, aka Alexander Zhavoronkov* WIPO Case No D2002-0562; *Pepsico Inc v Domain Admin*, WIPO Case No. D2006-0435). The Registrant did not adopt a non-distinctive word as part of their domain name; they adopted the Complainant’s trade mark and used the Disputed Domain Name to address several sensitive political issues that have a direct impact on the business of the Complainant. The panel agrees with the Complainant’s submission and holds that the Disputed Domain Name was registered in bad faith.
- 5.3 The Disputed Domain Name was registered in bad faith. The panel finds, on a balance of probabilities, that the Registrant registered the disputed domain name primarily to block intentionally the registration of a name in which the Complainant has rights.
- 5.4 The Complainant’s attempt to introduce new evidence to demonstrate the unfair disruption of its business (the Complainant refers to the Vice-Chancellor’s media statement dated 13 August 2015) is rejected. The panel is nevertheless in agreement that the use of the Disputed Domain Name unfairly disrupts the Complainant’s business. The Disputed Domain Name and its associated social media applications

are spearheaded to rally against decisions of the management of the North West University. In the current volatile tertiary educational environment this is disruptive of the business of the Complainant.

5.5 The Complainant avers that the Adjudicator erred in rejecting the Complainant's claim that Disputed Domain Name factually prevents the Complainant from exercising its rights in South Africa. Two issues must be considered here. First, whether the Disputed Domain Name prevents the Complainant from exercising its rights i.e. registering propuk as its own domain name in the .co.za registry. Secondly, the question arises whether the Registrant had acted in good faith or otherwise in registering the disputed domain name (see ZA2007-0003 (Telkom Sa Limited v Cool Ideas 1290 CC). The domain name registration prevents the Complainant from exercising its rights i.e. registering propuk.co.ca as its own domain name in the .co.za registry. The panel has already ruled on bad faith above and therefor this ground of appeal is upheld.

5.6 The last ground of appeal is that the Adjudicator erred in rejecting the Complainant's claim that the Registrant is using, or has registered, the Disputed Domain Name in a way that leads people or businesses to believe that it is registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant notes that it has submitted examples of actual confusion from persons connected with the NWU, thinking that the Disputed Domain Name is associated with the NWU. The examples of actual confusion from persons connected with the NWU have not been placed before the panel. However, the Disputed Domain Name resolves to a website depicting the Complainant's logo and an iconic landmark. The Complainant's logo is amended to include the words PRO-PUK. The web site displays the information of members of staff of the Complainant (for example the contact details of an alumni officer) and routinely refers to the statements made by the current Vice Chancellor. The Disputed Domain Name is certainly used to strengthen the Registrant's cause and to influence the Complainant's alumni. The mere fact that the Disputed Domain Name in itself alludes to a website or organisation that is on the face of it, "pro" the Complainant, and actually turns out to be "anti" the Complainant, is fatal for the Registrant. The panel agrees that the Disputed Domain Name is used in a manner that leads people or businesses to believe that it is operated or authorised by, or otherwise connected with the Complainant.

6 Dissenting decision by Ms Vanessa Lawrance

- 6.1 The dissenting Adjudicator has read the judgment of her co-panellists Prof. T Pistorius and Mr Mike du Toit. The conclusion to which she has come is different from theirs. As required by Regulation 29(5) read with Regulation 32(1) the dissentient view is to accompany the concluding decision and is set out hereunder.
- 6.2 The evidence put forward by the Complainant does not show that the disputed domain name was registered to intentionally prevent the Complainant from registering a mark or name in which the Complainant has rights, as no evidence to prove bad faith in the registration of the disputed domain name was put forward. The mere fact that the registration of the disputed domain name has the effect of barring the Complainant from registering a similar domain name, and the probable knowledge of the Registrant of the rights of the Complainant set out above prior to registration, is not enough to prove by way of inference that the disputed domain name was registered in bad faith.
- 6.3 For the same reasons the Complainant has not proved that the registration of the disputed domain name has in any way prevented the Complainant from exercising its rights.
- 6.4 The Complainant in the third instance argues that the mere fact that the Complainant is unable to register a domain name similar to the disputed domain name means that the business of the Complainant is unfairly disrupted. No evidence of the intention to register such a domain name was put forward, nor was any evidence adduced to show the nature and extent of the disruption.
- 6.5 The web site accessed when using the disputed domain name, when accessed by any reasonable reader, will clearly not confuse or deceive such a reader to think that the web site is operated with or in association with the Complainant. The contents of the web site in fact clearly show that the web site is not associated, operated or authorized by the Complainant. The mere fact that symbols associated with the Complainant appears on the web site does not detract from the content of the web site, which clearly show that the web site is not authorized, operated or associated with the Complainant. The Complainant has in addition furnished no proof of actual confusion by any person or business.

6.6 In the result it is found that the Complainant has not discharged the onus resting on it, and the appeal against the decision of the Adjudicator dated 21 September 2015 is dismissed.

7. Decision

7.1 For all the foregoing reasons, the Appeal is upheld.

.....
VANESSA LAWRENCE
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za

.....
TANA PISTORIUS
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za

.....
MIKE DU TOIT
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za