

## Decision

**ZA2014-0184**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2014-0184</b>
DECISION DATE:	<b>16 October 2014</b>
DOMAIN NAME	<b>standardbanklifeinsurance.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Mr Jacques Henning</b>
REGISTRANT'S LEGAL COUNSEL:	<b>N/A</b>
THE COMPLAINANT:	<b>The Standard Bank of South Africa Limited</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Adams &amp; Adams, Pretoria</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA )</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **2 June 2014**. On **13 August 2014** the SAIPL transmitted by email to ZA Central Registry a request for the registry to suspend the domain name(s) at issue, and on **14 August 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.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **15 August 2014**. In accordance with the Regulations the due date for the Registrant's Response was **12 September 2014**. The Registrant did not submit any response.
- c) In the absence of a response from the Registrant, the Complainant did not submit any Reply.
- d) The SAIPL appointed **Andre van der Merwe** as the Adjudicator in this matter on **8 October 2014**. 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.
- e) After the Complaint had been lodged by the Complainant, the Registrant advised the Administrator on **19 August 2014** that he had notified the Complainant of the "termination" of the disputed domain name registration. The Administrator thereafter advised the parties on **27 August 2014** of a possible settlement of the dispute. However, on **5 September 2014** the Complainant's legal counsel advised the Administrator that "the parties are

not involved in direct settlement negotiations with one another”. Accordingly the formal procedure of the dispute was continued.

Although the Administrator routinely notifies a registrant that the due date for its response has passed, in this case the Administrator, assuming that the parties could arrive at a settlement of this dispute and/or because of the Registrant’s abovementioned “termination” of the disputed domain name registration and its attitude herein, accordingly did not notify the Registrant of its default in this regard.

## 2 Factual Background

- 2.1 The Complainant was established during 1862 as a limited liability company, and has become one of South Africa’s well-known and leading banks. It is presently a subsidiary of Standard Bank Group limited (“the Group”) being the largest South African banking group. The Group has a presence in 18 African countries and in 12 countries outside of the African continent. The Group is listed on the Johannesburg Stock Exchange and on the Namibia Stock Exchange.
- 2.2 The Group and the Complainant have registered various trademarks worldwide and in South Africa, more particularly its name STANDARD BANK and STANDARD and its FLAG & SHIELD LOGO in respect of its services including insurance and financial services of all kinds. These registrations in the name of the Complainant date from 1978 and are presently in full force and effect on the official South African Register of Trademarks.
- 2.3 In addition to its above-mentioned statutory rights, the Group, and hence the Complainant, have developed substantial common law rights viz a repute or reputation, and hence goodwill, through many years and extensive use and

promotion of the name and trademark STANDARD BANK in South Africa. The Complainant has further submitted that its name and the trademark STANDARD BANK have become well known in South Africa in respect of the above-mentioned services.

- 2.4 The Registrant is apparently a South African citizen/resident conducting business from Metropolitan Building, 7 Coen Steytler Avenue, Cape Town. His business or other interests are unknown because no response was filed herein by him.

### **3 Parties' Contentions**

#### **3.1 Complainant**

- a) The Complainant contends that it has both statutory and common law rights in the name and trademark STANDARD BANK from a date well before the registration of the disputed domain name viz 20 March 2013.
- b) The Complainant contends that the dominant and memorable element of the disputed domain name is the first element viz STANDARDBANK. This is phonetically identical and visually similar to the name and registered trademark STANDARD BANK.
- c) The Complainant contends that the phrase "lifeinsurance" is wholly descriptive of a type of insurance that the Complainant itself offers to the public under the name and trademark STANDARD BANK. It is not sufficient to distinguish the disputed domain name from the Complainant's name and trademark STANDARD BANK.
- d) The Complainant contends that the disputed domain name is

confusingly similar to the Complainant's well known name and trademark STANDARD BANK. Hence there is a substantial likelihood that internet users and consumers will be misled into thinking that there is some association between the Complainant (or the Group), on the one hand, and the Registrant, on the other hand, when, in fact, there is no such relationship. For example, it is likely that a consumer will be misled into thinking that the disputed domain name is a dedicated domain name aimed at promoting the Complainant's life insurance products.

- e) Accordingly the Complainant contends that the disputed domain name is an abusive registration and cites circumstances that indicate that the Registrant has registered or otherwise acquired the disputed domain name to block intentionally the registration of a name or mark in which the Complainant has rights; and/or to disrupt unfairly the business of the Complainant; and/or to prevent the Complainant from exercising its rights.
- f) The Complainant contends that the Registrant has not provided any reasons for choosing or adopting the disputed domain name; and has failed to rebut the presumption that the disputed domain name is an abusive domain registration.
- g) Lastly the Complainant contends that the existence of the disputed domain name has the potential to erode the distinctive character of the name and trademark STANDARD BANK.

### 3.2 Registrant

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

## 4 Discussion and Findings

a) In order to make a finding that the disputed domain name is an abusive registration, the Adjudicator is required to find that the Complainant has proved, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present viz:

- i) the Complainant has rights in respect of a name or mark;
- ii) which is identical or similar to the (disputed) domain name; and
- iii) in the hands of the Registrant the (disputed) domain name is an abusive registration.

An abusive registration is defined in the definition section viz in Regulation 1, to mean a domain name which either –

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

### **SUBSTANTIVE ASPECTS**

Turning to the substantive aspects of this complaint, the Adjudicator has carefully perused the Complaint filed herein and fully considered the facts and contentions set out therein (as well as the lack of response from the Registrant).

### **RIGHTS IN RESPECT OF A NAME OR MARK**

In terms of Regulation 1 the term "rights" is widely defined. The Regulation states that "rights" and "registered rights" include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law but is not limited thereto.

As has been decided by the appeal decisions in [www.seido.co.za](http://www.seido.co.za) (ZA2009-0030) and [www.xnets.co.za](http://www.xnets.co.za) (ZA2011-0077), the notion of “rights” for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. It is a matter of *locus standi* in order to make sure that the person who complains is someone with a proper interest in the complaint. The threshold in this regard should be fairly low.

In the first place, the Adjudicator needs to determine whether, as set out above, in terms of Regulation 3(1)(a), the Complainant has rights in respect of the name or trademark STANDARD BANK. The Complainant claims that it enjoys such rights in this name and mark.

#### **A NAME OR MARK?**

The first part of the present enquiry is to determine whether the Complainant has *locus standi* in the sense of a name or mark that is unique or distinctive of it and its activities (and that is not merely descriptive, general or generic, for example).

#### **DOES THE COMPLAINANT HAVE RIGHTS?**

The first element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has rights in respect of the name or trademark STANDARD BANK. The Complainant asserts that it has rights in and to this name and mark.

Firstly, under statute law, the Complainant has shown, as set out above, that it is the proprietor of registered rights in respect of the name and trademark STANDARD BANK in South Africa that date back to 1978. This trademark was registered prior to the disputed domain name registration, and such trademark registrations are in force and are *prima facie* valid and enforceable. This clearly provides the Complainant with rights in terms of section 34 of the Trade Marks Act no 194 of 1993. Infringement would take place in terms of that section if a person used a mark, without authority,

which is identical or similar to the registered trademark STANDARD BANK in respect of the services for which the trademark is registered, such as insurance and financial services of all kinds. Hence the Complainant has validly claimed the aforementioned registered rights in South Africa.

In support of the above see the textbook Webster and Page: South African Law of Trade Marks, Fourth Edition, paragraphs 12.5 and 12.6, and the South African and foreign decided cases cited therein.

Secondly, under the common law in South Africa, the Complainant asserts that, by virtue of extensive use and promotion of its name and trademark STANDARD BANK in South Africa, it has developed a considerable repute or reputation therein, as an asset of its business in South Africa. In fact it claims that its name and trademark STANDARD BANK is well known in South Africa.

Such reputation, or more particularly goodwill stemming from that reputation, in respect of its name or trademark STANDARD BANK, could be damaged by means of unlawful competition, or more specifically passing off, under the common law by another party wrongly representing that it is, or is associated with, or part of, the Complainant and its business.

It was pointed out in ZA2007-0003 that the registration and adoption of a domain name being a name or mark that enjoys a reputation, of another person, could readily amount to passing off under the common law.

The Complainant therefore claims to have justifiable and justiciable rights under the common law in respect of its name and trademark STANDARD BANK viz rights that can be enforced against others who infringe or would be likely to damage such rights.

In support of the above, see ZA2007-0003 at page 9; and the textbook Webster and Page *op cit*, at paragraphs 15.5 and 15.7, and the South African and foreign decided cases cited therein.

In further support of the above, the Adjudicator refers to the South

African decisions regarding the domain names <standerdbank.co.za> (ZA2007-0006) and <standardbanks.co.za> (ZA2011-0073) in which it was earlier established that the Complainant has rights in and to the STANDARD BANK name and trademark.

The Adjudicator therefore finds that the Complainant has proved, on a balance of probabilities, that it has both registered trademark rights and unregistered rights viz common law rights in respect of the name and trademark STANDARD BANK. Hence the Complainant has also established that it has the necessary *locus standi* to bring this complaint or dispute.

#### **NAME OR MARK IDENTICAL OR SIMILAR TO DOMAIN NAME?**

The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proved that its name or mark, in which it has rights as set out above, is identical or similar to the (disputed) domain name. The Complainant asserts that the disputed domain name is identical or similar to its name and mark STANDARD BANK.

The Complainant's name or mark (in which it has rights) is STANDARD BANK, while the disputed domain name is `standardbanklifeinsurance.co.za`. Ignoring the first and second level suffixes, in terms of Regulation 5(c), the comparison becomes STANDARD BANK v `standardbanklifeinsurance`.

The disputed domain name contains the Complainant's name and mark STANDARD BANK in its entirety. This is undeniably the distinctive, dominant and memorable element of the domain name, and this is the feature that is known (and even well-known) to a substantial number of members of the public. The Registrant has merely added a descriptive (or generic term) viz "life insurance" to the distinctive STANDARD BANK name/mark. The Registrant cannot escape the inevitable conclusion that the Complainant's name and mark STANDARD BANK is essentially identical, or certainly

similar, to the disputed domain name.

In support of the above, see the following foreign domain name decisions - In NAF/FA141825 it was held that: "It is also well-established under the policy that a domain name composed of a trademark coupled with a generic term still is confusingly similar to the trademark."

In WIPO/D2002-0367 the Panel concluded that: "The disputed domain name contains Complainant's EXPERIAN trademark in its entirety. The addition of the generic term "automotive" does not distinguish Respondent's domain name from Complainant's mark."

See also for example the decisions 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-ringtones was found to be similar to NOKIA.

See also the following South African domain name decisions – in ZA2007-0003 telkommedia was found to be similar to TELKOM; in ZA2007-0010 mwebsearch was found to be similar to MWEB; in ZA2008-0025 suncityshuttle was found to be similar to SUN CITY; in ZA2009-0034 absapremiership was found to be similar to ABSA; in ZA2010-0048 etravelmag was found to be similar to ETRAVEL; and in ZA2013-00149 autotraderauction was found to be similar to AUTOTRADER.

Accordingly the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that its name and mark STANDARD BANK is identical or similar to the disputed domain name.

### **IS THE DOMAIN NAME AN ABUSIVE REGISTRATION?**

The third element that the Adjudicator needs to establish is whether, on a balance of probabilities, the disputed domain name, in the hands of the Registrant, is an abusive registration. The Complainant asserts that the disputed domain name is an abusive registration.

The Adjudicator is required to determine whether the disputed domain name

is an abusive registration as defined in the definition section of the Regulations viz in Regulation 1, and as set out above. According to the definition, and to various Nominet decisions, there are two potential abuses (or two types of abuse) viz:

- a) Registration with an abusive intent; and/or
- b) Use in an abusive manner.

The Adjudicator refers to DRS 02464 (Aldershot Car spares v Gordon); and to DRS 00658 (Chivas Brothers Ltd v David William Plenderleith) in which the Expert found that: *“Where a Respondent registered a domain name*

- 1) which is identical to a name in which the complainant has rights;*
- 2) where that name is exclusively referable to the complainant;*
- 3) Where there is no obvious justification for the Respondent having that name for the domain name; and*
- 4) Where the Respondent has come forward with no (reasonable) explanation for having selected the domain name; it will ordinarily be reasonable for an expert to infer first that the Respondent registered the domain name for a purpose and secondly that such purpose was abusive.”*

See also ZA2007-007 (FIFA v X Yin) in this regard. The Adjudicator concurs with the view that the nature of “abusive” in the Regulations does not necessarily require a positive intention to abuse the Complainant’s rights but that such abuse is the effect or consequence of the registration or use of the disputed domain name.

Regulations 4 and 5 provide a list of (non-exhaustive) factors which may indicate that a disputed domain name is, or is not, an abusive registration, respectively. More particularly, Regulation 4 lists circumstances that indicate that the Registrant has registered the disputed domain names primarily to

achieve certain objectives. The Complainant has asserted or referred to some of these factors or circumstances that will be discussed below viz:

- a) **That the Registrant has registered the disputed domain name primarily to block intentionally the registration of a name or mark in which the Complainant has rights.**

The Complainant has clearly established that it has rights in and to the name or mark STANDARD BANK. The Registrant was, or should have been, aware of such rights and has not at any time, or in any way, disputed such rights of the Complainant. In fact the Registrant has confirmed that the Complainant has such rights in its communications with the Administrator.

Although the Regulations (and definitions) are silent on what a “blocking registration” is or involves, it is clear both in general terms and from various Nominet decisions that a blocking registration appears to have two critical features. The first is that it must act against a name or mark in which the Complainant has rights. The second is intent or motivation and suggests some knowledge and hence a purpose in registering a domain name to prevent the Complainant from doing so. See DRS00583 and DRS01378.

The disputed domain name undeniably prevents the Complainant from registering this domain name, or its name or marks in these forms, for itself whether through the intent of the Registrant and/or as an unintended consequence of the disputed domain name registration.

Failure by the Registrant to reply to the letter of demand dated 27 November 2013 from the Complainant also appears to indicate the Registrant’s bad faith herein.

The Adjudicator is obliged to conclude that the registration of the disputed domain name has the simple consequence of barring the Complainant from using and registering the disputed domain name for itself, as the owner of rights to the relevant name or trademark.

In support of the above, see WIPO/D2000-0545; and the leading United Kingdom authority dealing with domain names and their “blocking” effect viz British Telecommunications plc v One in a Million Ltd [1999] FSR 1 (CA). In this case, the Court of Appeal held that the disputed domain name registrations were unlawful on the grounds of both trademark infringement and passing off, and interdicted One in a Million Ltd and those who controlled it from such conduct, and ordered them to transfer the disputed domain name registrations to the companies that in reality traded under those names.

In support of the above, see also the foreign decision WIPO/D2000-0766 (Red Bull GmbH v Harold Gutch) which is cited in the South African decision ZA2008-0014 (Automobiles Citroen v Mark Garrod).

Accordingly the Adjudicator comes to the conclusion that this factor applies in the present dispute, that this factor indicates that the disputed domain name is an abusive registration.

**b) That the Registrant has registered the disputed domain name primarily to prevent the Complainant from exercising its rights.**

The Complainant contends that the disputed domain name blocks it from registering its own domain name, as set out above; and hence the disputed domain name prevents the Complainant from exercising its legitimate rights in South Africa by registering its own .co.za domain name.

Besides the factual question of the disputed domain name preventing the Complainant from exercising its rights ie by registering its own domain name, this raises the question of whether the Registrant had acted in good faith or otherwise in registering the disputed domain name, as also set out above. The Registrant had warranted, when applying to register the disputed domain names, in terms of the Uniform SA terms and conditions (clause

5.1) that:

- I. "It has the right without restriction to use and register the Domain Name"
- II. "The use or registration of the Domain Name (by the Registrant) does not or will not interfere with, nor infringe the right of any third party in any jurisdiction with respect to trade mark, service mark, trade name, company name, close corporation name, copyright, or any other intellectual property right."

Clause 5.1.1 of the Uniform SA terms and conditions state further (-to which the Registrant had agreed): "Applicant (the Registrant) hereby irrevocably represents, warrants, and agrees that its statements in the Application are accurate and complete."

It appears undeniable that the Registrant had, at all material times, known of the Complainant and its rights in and to its name and trademark STANDARD BANK, and hence it appears both from this knowledge and directly from the above false statements or warranties by the Registrant that the disputed domain name was registered in bad faith.

Accordingly the Adjudicator comes to the conclusion that this factor also applies in the present dispute, and that it indicates that the disputed domain name is an abusive registration.

- c) That there are circumstances indicating that the Registrant has registered the disputed domain name to disrupt unfairly the business of the Complainant**

The disputed domain name has the effect that the Complainant is barred from registering or using the disputed domain name, which it may well reasonably be required to do because it offers its own life insurance services and products. In addition, the existence of the dispute domain

name has the potential to erode the distinctive character of the name and trademark STANDARD BANK. This can, or will, ultimately decrease the value of the brand. In this way, the disputed domain name unfairly disrupts the business of the Complainant and the Group.

In support of the above, the Adjudicator points out that various foreign decisions have found that disruption of a business may be inferred in situations when the Registrant has registered a domain name containing the Complainant's name or mark plus a generic term – such as in the present case. See for example the foreign decisions in WIPO/D2000-0777, NAF/FA94942, NAF/FA94963, NAF/FA95402; and the above cited NIKE and NOKIA decisions. See also the WIPO cases d2005-0604 and D2007-0424.

The Adjudicator also refers to the South African decision ZA2012-0117 in which the Adjudicator confirmed that the disruption of a business may be inferred if the Registrant has registered a variant of the Complainant's mark by merely adding a generic word. This can be more so if the disputed domain name is identical to the Complainant's name or (house) mark.

Hence the Adjudicator comes to the conclusion that this is a real and present factor in the present dispute, and that it indicates that the disputed domain name is an abusive registration.

The Adjudicator has two final comments to make herein. Firstly there are various indications, as set out above, that the Registrant has acted in bad faith in registering the disputed domain name. In the decision in <movingfroward.co.za> (ZA2010-0050) regarding the Group's MOVING FORWARD trademark, the Panelist found that the registrant had not offered any cogent reasons for choosing to register that disputed domain name, nor had he given any reason for registering the domain name at the time he did, or why he had failed to make legitimate use of the domain name. In the circumstances the Panelist found that the registrant had failed to rebut the presumption that that disputed domain name was an abusive

registration. The reasoning in that decision can be applied similarly to the present dispute.

Secondly, the Adjudicator wishes to point out that, in addition to the decisions referred to above that have involved the present Complainant, there have been a number of other decisions involving the Complainant and its name and/or trademarks viz ZA2010-0051; ZA20011-0074; ZA2011-0075; ZA2011-0095; ZA2012-00119; and ZA2013-00156. Apparently the Complainant and its business have a high public profile that attracts the (unwanted) attention of persons who wish to adopt and register domain name registrations that include the Complainant's name and/or trademarks, or variations thereof. However, the aforementioned decisions have invariably resulted in a transfer of such disputed registrations to the Complainant.

#### **4.2 Abusive Registration**

4.2.1 In view of the above, the Adjudicator concludes that the disputed domain name was registered in a manner which, at the time when the registration took place, took unfair advantage of, or was unfairly detrimental to, the Complainant's rights.

4.2.2 Accordingly the Adjudicator finds, on a balance of probabilities, that the disputed domain name, in the hands of the Registrant, is an abusive registration.

### **5. Decision**

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

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**ANDRE VAN DER MERWE**  
SAIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)