

Decision

ZA2016-0250

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2016-0250
DECISION DATE:	1 December 2016
DOMAIN NAME	sundaytimeslive.co.za
THE DOMAIN NAME REGISTRANT:	James Sai
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Times Media (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	Moore Attorneys
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 **17 October 2016**. On **18 October 2016** the SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **18 October 2016** 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 **19 October 2016**. In accordance with the Regulations the due date for the Registrant's Response was **16 November 2016**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **17 November 2016**.
- c) The SAIPL appointed **Victor Williams** as the Adjudicator in this matter on **28 November 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 a JSE Listed company. The Complainant established its Sunday newspaper SUNDAY TIMES in February 1906, and distributed same since then throughout the Republic of South Africa and neighbouring countries.
- 2.2 SUNDAY TIMES is the biggest selling Sunday newspaper in South Africa, and is distributed online and through many retail outlets.

- 2.3 The Complainant utilizes the following websites: www.sundaytimes.co.za; www.timeslive.co.za and www.timesmedia.co.za.
- 2.4 The Complainant is the proprietor in South Africa of the following trade marks:
- a. No 1985/03771 SUNDAY TIMES in class 16
 - b. No 1985/05949 SUNDAY TIMES in class 41
 - c. No 1998/11237 SUNDAY TIMES LIFESTYLE in class 16
 - d. No 1998/11238 SUNDAY TIMES LIFESTYLE in class 38
 - e. No 1998/11239 SUNDAY TIMES LIFESTYLE in class 41
 - f. No 2004/14085 SUNDAY TIMES TOP BRANDS in class 35
 - g. No 2004/14086 SUNDAY TIMES TOP BRANDS in class 42
 - h. No 2005/02141 SUNDAY TIMES TOP 100 BRANDS in class 16
 - i. No 2005/02142 SUNDAY TIMES TOP 100 COMPANIES in class 16
 - j. No 2005/02731 SUNDAY TIMES in class 38
 - k. No 2005/02732 SUNDAY TIMES TOP 100 BRANDS in class 38
 - l. No 200502733 SUNDAY TIMES TOP 100 COMPANIES in class 38
 - m.No 2006/28344 SUNDAY TIMES MARKETING EXCELLENCE in class 09
 - n. No 2006/28345 SUNDAY TIMES MARKETING EXCELLENCE in class 16
 - o. No 2006/28346 SUNDAY TIMES MARKETING EXCELLENCE in class 35
 - p. No 2006/28347 SUNDAY TIMES MARKETING EXCELLENCE in class 38
 - q. No 2007/05944 SUNDAY TIMES MARKETING EXCELLENCE in class 41
 - r. No 2008/22298 SUNDAY TIMES GOOD VALUE in class 09
 - s. No 2008/22299 SUNDAY TIMES GOOD VALUE in class 16
 - t. No 2008/22300 SUNDAY TIMES GOOD VALUE in class 35
 - u. No 2008/22301 SUNDAY TIMES GOOD VALUE in class 38
 - v. No 2009/04653 SUNDAY TIMES PRIME in class 09
 - w. No 2009/04654 SUNDAY TIMES PRIME in class 16
 - x. No 2009/04655 SUNDAY TIMES PRIME in class 38
 - y. No 2011/26170 SUNDAY TIMES TRAVELLERS CLUB in class 39
 - z. No 2011/26729 SUNDAY TIMES TRAVELLERS CLUB in class 38
 - aa. No 2013/12043 SUNDAY TIMES BRAND VOICE in class 09
 - bb. No 2013/12044 SUNDAY TIMES BRAND VOICE in class 16

- cc. No 2013/12045 SUNDAY TIMES BRAND VOICE in class 35
- dd. No 2013/12046 SUNDAY TIMES BRAND VOICE in class 38
- ee. No 2016/14535 SUNDAY TIMES PLATINUM PLUS in class 35

2.5 The domain name sundaytimes.co.za was registered on 10 August 1998.

2.6 The disputed domain name was registered on 19 December 2013.

3 Parties' Contentions

3.1 Complainant

- a) The disputed domain name is identical or similar to a mark in which the Complainant has rights, both in respect of registered trademarks and in terms of the common law.
- b) The trademarks of the Complainant have due to its extensive marketing and exposure become a well-known brand in South Africa.
- c) The purpose of the disputed domain name is to generate hits, and the disputed domain name is likely to create deception and/or confusion in the minds of members of the general public.
- d) The Disputed domain name incorporates the words SUNDAY TIMES wholly, which words is the dominant and memorable part of the domain name.
- e) The Registrant has been a Defendant in several domain name complaints, mostly filed by big brand owners.

3.2 Registrant

- a) The Registrant is in default, and has filed no papers.

4 Discussion and Findings

- a) 1. The Complainant has extensive rights in the words SUNDAY TIMES, as a result of the protection afforded by the Trade Marks Act, 194 of 1993, and also in terms of the common law.
2. SUNDAY TIMES is a well known brand in South Africa.
3. The Complainant has domain name rights in sundaytimes.co.za, the registration of which predates the registration of the disputed domain name.
4. The disputed domain name is similar to the domain names of the Complainant, and the registered trademarks of the Complainant.
5. The addition of the word LIVE in the disputed domain name is insufficient to distinguish the domain name, and is likely to cause confusion and/or deception in the minds of the members of the general public. This addition in fact in the media and publishing industry serves only to bring the disputed domain name closer to the trademarks and domain names of the Complainant.

4.1 Complainant's Rights

- 4.1.1 The rights of the Complainant in the words SUNDAY TIMES have been fully set out and discussed above.

4.2 Abusive Registration

- 4.2.1 In the light of the proven facts, the disputed domain name is an abusive registration, as
- 4.2.2 It was registered at a time and in a manner that took unfair advantage of the registered and common law rights of the Complainant, and
- 4.2.3 Is likely to cause confusion and/or deception in the minds of the members of the general public, and

4.2.4 It was registered to prevent the Complainant from registering a similar domain name, and to prevent the Complainant from exercising its registered and common law rights.

5. Decision

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

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VICTOR WILLIAMS
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za