

Decision

ZA2015-0213

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0213
DECISION DATE:	30 October 2015
DOMAIN NAME	THAWTE.CO.ZA
THE DOMAIN NAME REGISTRANT:	MR DIJON/DEON VENTER
REGISTRANT'S LEGAL COUNSEL:	NONE
THE COMPLAINANT:	SYMANTEC INTERNATIONAL (an Irish Company)
COMPLAINANT'S LEGAL COUNSEL:	Von Seidels Attorneys (Mr Hugo Prinsloo)
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 **14 August 2015**. On **17 August 2015** the SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **17 August 2015** the 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 **18 August 2015**. In accordance with the Regulations the due date for the Registrant’s Response was **15 September 2015**. The Registrant submitted its (uncommissioned) Response on **15 September 2015**, and the SAIPL notified the Registrant on **16 September 2015** that its Response did not satisfy the formal requirements of Regulation 18, as it was not commissioned.
- c) The Complainant did not submit a Reply to the deficient Response filed by the Registrant.
- d) The SAIPL appointed **Mr Andre Karel van der Merwe** as the Adjudicator in this matter on **28 September 2015**. 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 a considerable exchange of correspondence between the Registrant and the Administrator arising from its deficient Response, the Adjudicator, in the circumstances, and in order to give each party a fair opportunity to present its case, on **9 October 2015** granted the Registrant a 5 day period (extension) to re-submit a commissioned Response to comply with Regulation 18, and granted the Complainant a similar period (extension) thereafter to submit a Reply (if it wished to do so). In granting such an

extension to each party, the Adjudicator had indicated clearly that, in the absence of a timely and compliant Response from the Registrant, the dispute would be decided on a default basis viz on the basis of the Complaint documents only.

The Registrant thereafter filed a Response within the extension granted, that had been commissioned by a commissioner for oaths in the Republic of Ireland. Although the Response did not comply with the provisions of Regulation 16(2)(b), the Adjudicator has decided to overlook such formality shortcomings, in view of the discretion provided in SAIPL's supplementary procedure, and in order to concentrate on the substantive issues raised herein. The Complainant then requested an extension of 3 days for filing its Reply (until 30 October 2015), which was granted by the Adjudicator to ensure that each party was treated with equality and that each party was given a fair opportunity to present its case. The Complainant duly filed its Reply on **28 October 2015** (without requiring the full extension granted).

2 Factual Background

- 2.1 The Complainant is the proprietor of various foreign trademark registrations for THAWTE, predating the date of registration of the disputed domain name (2006). Copies of these registration certificates and some renewal certificates have been submitted by the Complainant. These registrations are in force and hence are *prima facie* valid and enforceable.
- 2.2 The Complainant is also the proprietor of a number of South African trademark registrations for THAWTE, dating from 1998 and 2004, which also predate the date of registration of the disputed domain name. Copies of these registration certificates and renewal certificates have been submitted by the Complainant. These registrations are likewise in force and hence are *prima facie* valid and enforceable.
- 2.3 By way of background, Thawte was a South African company founded in 1995 by the well-known Mark Shuttleworth, which had specialized in digital (SSL) certificates and internet security. Thawte was the first company outside the USA to issue SSL certificates and by 1999 it had accounted for

about 40% of the global SSL market. In 1999 Thawte was acquired by Verisign, Inc. and in 2010 the Complainant acquired Thawte.

- 2.4 The Complainant, its parent company, and its predecessors-in-title have expended considerable money, time and effort in the use and promotion of the THAWTE trademarks worldwide, and in South Africa where the Complainant currently has over 800 customers that use its software and services. Hence it enjoys a considerable reputation and goodwill *inter alia* in South Africa iro the name and trademark THAWTE.
- 2.5 Through its global reach, the Complainant had operated through its <thawte.com> domain name which became operational and accessible to South African users in 1996.
- 2.6 The thawte.co.za domain name was initially registered by the Complainant's predecessors-in-title in 1998 but this registration was allowed to lapse at the end of 2000 through non-renewal of the registration.
- 2.7 The disputed domain name was registered by the Registrant on 30 August 2006.
- 2.8 On 22 May 2015, the Complainant's attorneys sent a letter of demand to the Registrant, requiring him to transfer the domain name to the Complainant, failing which the Complainant would institute proceedings against the Registrant. After correspondence between the Registrant and the Complainant's attorneys, this demand was confirmed in a further letter to the Registrant dated 24 June 2015.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant contends that it has both statutory rights in its trademark registrations for THAWTE in South Africa, and common law rights iro this name and trademark based on its reputation and the goodwill in its business in South Africa; and that these rights

predate the date of registration of the disputed domain name.

- b) The Complainant contends that the disputed domain name is identical or (at least) similar to THAWTE in which it has rights, as set out above.
- c) The Complainant contends that in March 2015, it became aware that the Registrant was selling competitors' SSL certificates on the website to which the disputed domain leads users.
- d) The Complainant contends that it was not aware that the Registrant had operated as a legitimate reseller, partner or affiliate of the Complainant's products or services; until recently, and, that it had recently become aware that the Registrant was selling a competing product on its website viz the "Comodo" product.
- e) The Complainant contends that the disputed domain name currently re-directs a user to a website offering competing but identical products and services offered by the Complainant (viz as specified in the Complainant's registered trademarks in South Africa). This is unauthorized use and is likely to deceive or confuse members of the public, and this amounts to trademark infringement in terms of the Trade Marks Act [section 34(1)(a)].
- f) The Complainant contends that such unauthorized use is also likely to lead to members of the public to associate the disputed domain name with the Complainant, leading to harm or damage to the reputation and goodwill of the Complainant in its business and its THAWTE trademark. This amounts to passing off under the common law.
- g) In the circumstances, the Complainant contends that the disputed domain name is, in terms of Regulation 4, respectively, a blocking registration; that it prevents the Complainant from exercising its rights; and that it disrupts the business of the Complainant unfairly.

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- h) The Complainant contends (in its Reply *inter alia*) that its reseller agreement, to which resellers must agree (as the Registrant has recently done viz in June 2015), in order to sell Thawte certificates, expressly prohibits the registration of a domain name that incorporates the Complainant's trademark(s).
- i) The Complainant contends that the Registrant appears to have been selling Thawte certificates from or about 2013 by working through ResellerClub.com (now known as Directi), a domain registrar and an authorized reseller of Thawte certificates. Hence the Complainant had no direct contact with, or knowledge of, the Registrant.
- j) The Complainant contends that it was unaware of a letter of demand sent to the Registrant in 2009 (and raised by the Registrant in its Response) because this letter was apparently not transferred to it after the sale of the business to the Complainant.
- k) The Complainant contends that, once the Registrant learned that the trademark THAWTE was owned by the Complainant, he corresponded with the Complainant (in 2011) in an attempt to extort money from the Complainant in exchange for transfer of the disputed domain name.
- l) In the circumstances, the Complainant contends that the disputed domain name, as registered and used by the Registrant, is an abusive registration.
- m) The Complainant finally contends (pre-emptively) that, in the circumstances, any delay on its part in submitting this complaint does not affect its rights in its THAWTE trademarks, nor does it constitute a waiver of such rights or bar it from bringing this complaint to request a transfer of the disputed domain name.

3.2 Registrant

- a) The Registrant contends that the present ADR system is "impartial

- (*sic*) and systematically biased” against the Registrant; that it is an “impartial (*sic*), unjust process”; that “it is *mala fide*”; that “the Regulations are clearly deficient here resulting in a discriminatory and pro-complainant process”; that it is a “unilateral process”; and that “It is incumbent on the Adjudicator to refer this matter to another court.” His further contention is that “I am being forced into the unjust, impartial (*sic*) ADR process” and that “this dispute be withdrawn from or escalated, at least to a 3 man panel, if not another authority.”
- b) The Registrant contends that the disputed domain name “was and is NOT an abusive registration”; and “Therefore the trademark was actually protected and defended by my registration of the domain, in as much as was my capacity to do so. It was not abused.”; and that the trademark was “even promoted” by him and thereby “justifying my ‘defensive’ registration of the domain.”
- c) The Registrant contends that the Complainant’s dispute should be rejected out of hand because the Complainant has allowed third parties in other countries, like himself, to register “thawte” domains and to use their trademark to operate websites to sell “thawte” certificates which the Complainant then issued.
- d) The Registrant contends that he had been a “partner” (- or a reseller or agent) of the Complainant for some years, for example from 2013 to date, during which he had sold certificates which the Complainant issued to the Registrant’s customers. He therefore questions the Complainant’s competency *inter alia* because they do not appear to have been aware of his business relationship with them (as a reseller).
- e) The Registrant contends that, because the Complainant operates in the internet security business, they should be held to a higher standard than normal trademark holders.
- f) The Registrant contends that this Complaint is a reverse domain name hijacking attempt.

- g) The Registrant contends that he had made an offer to the Complainant's predecessor-in-title to release the disputed domain name to them "if they made a substantial donation to an agreed charity" but that this offer was not accepted.
- h) The Registrant finally contends that the Complainant "... knew I was in Europe, yet chose to fabricate a dispute in South Africa."

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:
"The registrant must submit to proceedings under the Rules (emphasis by the Adjudicator) if a complainant asserts, in accordance with the procedure, that -
 - 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." (-the Adjudicator's underlining)

In other words, it will be seen from the above that a Registrant is obliged, in terms of the Regulations issued under the ECT Act, viz in terms of South African law, to submit to this procedure in respect of a .co.za domain dispute. This deals with the Registrant's criticism regarding the jurisdiction and the authority of the system and the organizations and persons appointed and accredited to deal with domain disputes in South Africa.

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.

It will therefore be seen from Regulation 3(1)(a) quoted above that the Registrant had agreed to the ZACR's terms and conditions, and is bound to submit to these proceedings, both according to those terms and conditions, and in terms of the above-quoted law, relating to the registration of the disputed domain name.

PROCEDURAL AND SUBSTANTIVE ASPECTS OF THIS DISPUTE

Turning to the procedural and substantive aspects of this complaint, the Adjudicator has perused the documents filed herein, as well as the annexed documents, and carefully considered the facts and contentions set out therein.

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 [seido.co.za](#) (ZA2009-0030) and [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 *inter alia* 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.

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 and trademark THAWTE. The Complainant contends that it enjoys such rights in this name and trademark.

A NAME OR MARK?

The first part of the present enquiry includes a determination 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 and trademark THAWTE. In terms of the facts set out above, it will be seen that the Complainant is the proprietor of various (foreign and) South African trademark registrations for THAWTE, as set out above, that are in full force and effect viz it has statutory/registered rights that date from 1998 that it can enforce in an infringement situation viz where a third party uses the trademark THAWTE in an unauthorized manner in terms of the Trade Marks Act [section 34(1)(a)]. These rights predate the date of registration of the disputed domain name.

From the above facts and contentions, it also appears clearly that the Complainant, through its worldwide and extensive South African business activities, also enjoys a large reputation, as a component of its goodwill, in terms of the common law in respect of its name and trademark THAWTE.

See in this regard the textbook South African Law of Trade Marks (4TH Edition) by Webster and Page (now Webster and Morley) paragraph 15.10 and *inter alia* the decided case cited here viz Adcock-Ingram Products Limited v Beecham SA (Pty) Limited 1977 4 SA 434 (W) which was approved in Caterham Car Sales & Coachworks Ltd v Birkin Cars (Pty) Ltd [1998] 3 All SA 175 (A).

These common law rights can be breached by the wrong known as passing off. See Webster and Page (*supra*) paragraph 15.5 and *inter alia* the decided case cited there viz Capital Estate & General Agencies (Pty) Ltd v Holiday Inns Inc 1977 2 SA 916 (A).

Accordingly the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that it has both statutory viz registered trademark rights, and common law rights, in South Africa in respect of its name and trademark THAWTE, that can be breached by unauthorized use by a third party.

The trademark THAWTE also appears to be a well-known trademark in the

relevant sector of the public viz this trade and business in South Africa.

These rights date from about 1998 and predate the date of registration of the disputed domain name registration (viz 2006).

This finding also provides the Complainant with the necessary *locus standi* to bring this complaint.

NAME OR MARK IDENTICAL OR SIMILAR TO DOMAIN NAME?

The second element that the Adjudicator needs to establish is whether the Complainant has proved, on a balance of probabilities, that its name and trademark THAWTE, in which it has rights as set out above, is identical or similar to the disputed domain name viz THAWTE.CO.ZA.

The Complainant has contended that the disputed domain name is identical, or (at least) similar, to the Complainant's registered trademark THAWTE.

It is accepted in domain name decisions that the suffix .co.za does not affect the assessment of similarity of a registered trademark and the disputed domain name. In support thereof, the adjudicator refers to the foreign domain name decision D2002-0810 Benneton Group SA v Azra Khan; and the South African domain name decision ZA2008-0015 Luxottica US Holding Corp v Preshal Iyar.

Accordingly, the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that its name and (registered) trademark THAWTE is identical to the disputed domain name.

IS THE DISPUTED DOMAIN NAME AN ABUSIVE REGISTRATION?

The third element that the Adjudicator needs to establish is whether, the Complainant has proved, on a balance of probabilities, that 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 the foreign decisions DRS 02464 (Aldershot Car spares v Gordon); and 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 the South African decision 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 by the Registrant to abuse the Complainant’s rights but that such abuse can be the effect or consequence of the registration or use of the disputed domain name.

Before dealing with the Regulations, the Adjudicator wishes to deal with the good faith or otherwise of the Registrant herein.

Besides the question of whether the disputed domain name affects the Complainant in the exercising of its rights, the general contention has been raised by the Complainant that the Registrant has acted in bad faith, firstly, because the Registrant has no rights in and is not known by the term “thawte” or any similar name or trademark(s); secondly, because the Registrant does not hold any trademark registrations for “thawte” or has not made use of the term as a trademark; thirdly, because the disputed domain name is identical to the Complainant’s name and registered trademark; and

fourthly, because the Registrant was no doubt aware of the Complainant's well-known name and trademark THAWTE and its rights therein.

Accordingly it may be inferred from the Registrant's registration of a domain name that is identical to the Complainant's well-known THAWTE trademark that the disputed domain name was registered in bad faith.

See in this regard the foreign decided domain name decisions viz WIPO Case No D2000-0037, WIPO Case No 2000-0137-1492, WIPO Case No 2001-1492, and WIPO Case No 2003-0257, in which it was held that bad faith may be inferred from the registration of a well-known trademark as part of a domain name.

In spite of the above, the Registrant had proceeded to register and use the disputed domain name for and by himself.

Over and above the aforementioned considerations, the Registrant had warranted, when applying to register the disputed domain name, in terms of the ZACR 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 ZACR terms and conditions state further (to which the Registrant had agreed): "Applicant (the Registrant) hereby irrevocably represents, warrants, and agrees that its statements (above) in the Application are accurate and complete."

It seems undeniable that the Registrant had, at all material times, known of the Complainant and its rights in and to its name and trademark THAWTE. Hence it appears to the Adjudicator generally, both from the above considerations and directly from the above false statements or warranties by the Registrant, that the Registrant has clearly acted in bad faith and that the disputed domain name was registered and is being used by the Registrant in

bad faith. This is usually a strong indication that the disputed domain name is an abusive registration.

Turning now to Regulation 4, this provides a list of (non-exhaustive) factors which may indicate that a disputed domain name is an abusive registration. More particularly, Regulation 4 lists circumstances that indicate that the Registrant has registered or is using the disputed domain names primarily to achieve certain objectives. The Complainant has asserted 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 trademark THAWTE. 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 (at least indirectly) confirmed that the Complainant has such rights in its communications with the Complainant's attorneys.

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 the foreign decisions DRS00583 and DRS01378.

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

As indicated above, the Registrant's actions herein appear to indicate the Registrant's bad faith in dealing with the disputed domain name.

Although the Registrant has offered reasons for registering the disputed

domain name such as protecting and defending (and even promoting) the trademark of the Complainant, the Adjudicator is obliged to conclude that the registration of the disputed domain name has the simple consequence of barring, and hence blocking, the Complainant from using and registering this domain name for itself, as the legitimate owner of rights to the relevant name and trademark THAWTE. The Adjudicator is also obliged to conclude that it was the primary purpose of the Registrant to intentionally block the registration of a name or trademark in which the Complainant has rights so that the Registrant could use the disputed domain name for himself (and for his own business purposes).

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 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 further 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, and that this factor may indicate 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 viz by registering its own THAWTE.CO.ZA domain name that it should be entitled to do but is prevented from doing by the disputed 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 begs the question of whether the Registrant had acted in good faith or otherwise in registering the disputed domain name, as also set out above. From the above explanation of the Registrant's actions in registering and using the disputed domain name and the false statements made by the Registrant when registering the disputed domain name, it appears that the Registrant had in effect not acted in good faith but had in fact acted in bad faith

In support of this proposition, 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 THAWTE. 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 *inter alia* primarily to prevent the Complainant from exercising its rights.

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

- c) **That there are circumstances indicating that the Registrant has registered the disputed domain name primarily 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 THAWTE.CO.ZA, which it is reasonably required to do because it offers digital (SSL) certification and internet security services and products. This presents a disruption to the Complainant's business.

In addition, the existence (ie the registration and ongoing use) of the disputed domain name has the potential to erode the distinctive character of its well-known name and trademark THAWTE. This can, or will, ultimately decrease the value of the brand, and the Complainant's business, unless stopped. It appears that the recent use (from or about March 2015) of the disputed domain name points users to a website where

the Registrant offers the products of the Complainant's competitors. This amounts to so-called "baiting and switching" which is a well-known business practice that conflicts with public policy, and is *contra bonos mores*, and that falls within the ambit of unlawful competition as part of the common law. This has the effect of unfairly disrupting the business of the Complainant and damaging its reputation. In support hereof see paragraph 15.2 of Webster and Page cited above.

In this way, the disputed domain name unfairly disrupts the business of the Complainant, and the Registrant must have been aware of this effect on the business of the Complainant.

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 is especially the case if the disputed domain name is identical to the Complainant's name or trademark, which applies in the present case.

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

Further Comments

To the extent that the Registrant's major contentions have not been dealt with above, the balance thereof are dealt with hereunder –

Firstly, the Registrant contended that the Complainant had waived its rights to take steps against the Registrant by waiting for some years after

becoming aware of the disputed domain name being registered in the name of the Registrant. The history of the Complainant and its predecessors-in-title as well as the Registrant's interaction with these parties and his activities *vis-a-vis* the registration and use of the disputed domain name are quite complex. However, the Complainant contended, in turn, that it was not aware of the letter of demand sent to the Registrant in 2009 on behalf of VeriSign, Inc because that letter had not been handed to the Complainant after it had bought the Thawte business from VeriSign, Inc. In addition, the Complainant contends that the Registrant had since 2013 been working via an intermediary viz ResellerClub.com so that he had no direct contact with the Complainant. Hence the Complainant contends that it was not aware of him and his (indirect) business relationship with them. Consequently, there appeared to be no indication to the Complainant that the Registrant was selling SSL certificates or otherwise using the disputed domain name in relation to any infringing activity. Therefore such a contention of waiver by the Registrant cannot be upheld (unless, for example, it has clearly waived its rights, which has nowhere been shown by the Registrant to be the case). In respect of this Complaint, infringement of the Complainant's rights appear to have started relatively recently, viz from March 2015, as set out in paragraph 3.1(c) above. In principle, if infringement of a complainant's rights is ongoing, a complainant can decide at any time to take legal steps in respect of such ongoing or continuing infringement. In other words, waiver or estoppel does not apply in the above circumstances.

Secondly, the Registrant has contended that the disputed domain name is not an abusive registration, and that it had, for example, "protected" and "defended" the Complainant's trademark. This is strange logic on the part of the Registrant. In the experience and opinion of the Adjudicator, it is highly unlikely that any trademark owner will agree with this logic or reasoning. In addition, this logic flies in the face of the provisions of the .co.za Regulations which are squarely based on other international domain name dispute ADR systems such as the WIPO UDRP system, the UK Nominet system, and the USA domain name ADR system. It therefore appears to the Adjudicator that, although claiming to act as "a good Samaritan", the Registrant had no justifiable, *bona fide* or legitimate business or other interest in registering or

using the disputed domain name.

Thirdly the Registrant has contended that he (and other third parties for example in France and the Netherlands) had been “partners” or agents/resellers for some years of the Complainant’s products and had registered and used the thawte domain name in the relevant countries. Accordingly the Registrant contends that the Complainant was negligent in allowing these actions by third parties. However, the Complainant has explained in its papers that the French and Netherlands domains are licensed for use via Networking4 All, and that such foreign registration and use (which is properly regulated by written agreement) is therefore quite irrelevant to the present dispute. Secondly, in addition to what is set out above regarding the Registrant’s use of the disputed domain name formerly via an intermediary, the Complainant’s “Certificate Reseller Agreement” – that was apparently recently signed and agreed to by the Registrant, expressly prohibits registration of the disputed domain name. Thirdly, however, what is of overall significance is that, assuming that the Registrant is correct, then, on his own version of events as a partner/reseller/agent of the Complainant, he would have known the Complainant’s business and its product thoroughly – and this would have placed the Registrant in a position of knowledge and trust. As an partner/agent/reseller of the Complainant’s product, the Registrant therefore took unfair advantage of his position both in registering, and subsequently in using, the disputed domain name, for his own benefit and advantage – and to the disadvantage and detriment of the Complainant. Accordingly, the above contention by the Registrant is dismissed. However, in the second and third aspects discussed above, it appears that the Registrant has breached the above mentioned term of its “Certificate Reseller Agreement” with the Complainant, and has taken advantage of his position of trust, thereby acting in bad faith.

Fourthly, the Registrant has contended that the Complainant must be held to some higher standard than other trademark owners in caring for its trademarks and domain names. To the knowledge of the Adjudicator no country in the world has any requirement for enhanced care by a trademark owner in respect of its trademarks and trademark rights, depending on the

nature of its business. Accordingly, this contention does not bear scrutiny. Fifthly, the Registrant had, in contacting the Complainant in 2011, threatened to publicize what he thought was a scandalous expose about the Complainant having allowed the disputed domain name to lapse. Based on such lapsing of the thawte.co.za domain name by the Complainant's predecessor-in-title in 2000, and the Registrant's registration of the disputed domain name, the Registrant had, during 2011, contacted an official of the Complainant, (see Annex I to the Complaint) saying: "My ex-wife sent me this article as she is threatening to warn the public, unless I provide for her and our children. Can we help each other out here?" and further (see Annex J to the Complaint) saying: "...my ex-wife ...wants to sell this story to the newspapers as we are struggling financially and she needs money to provide for our kids. ... I am certain at any rate that this is not a story you would want splashed about, but rather have it seen as an example of proactive protection of consumers of your products. ... I do hope that we can have a constructive discussion on how to make this happen." However, the Complainant had ignored these suggestions or offers, and hence nothing had come of this. However, the Adjudicator points out that Regulation 4(1)(a)(i) cites a (further) factor that may indicate that the disputed domain name is an abusive registration viz if the Registrant had registered the disputed domain name primarily to transfer the domain name to a third party for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring or using/maintaining this domain name. The Registrant comes very close to breaching this Regulation. Although these offers, in the opinion of the Adjudicator amount to attempts at extortion by the Registrant, it is not clear that this was his primary intention in registering the disputed domain name, although it may have been one of his intentions when, in 2006, he registered the dispute domain name. Accordingly, the Adjudicator makes no finding in this regard although such offers made by the Registrant generally indicate bad faith on the part of the Registrant.

Lastly, the Registrant has contended that the Complainant is guilty of so-called "reverse domain name hijacking". This concept is defined in the Regulations as "using the Regulations in bad faith to attempt to deprive a

registrant of a domain name.” From its prior rights in and to the name and trademark THAWTE that have been proved by the Complainant, on a balance of probabilities, and to the satisfaction of the Adjudicator, as set out above, the Complainant has clearly not used the Regulations in bad faith, in bringing this Complaint and acting to protect its rights. Hence this contention by the Registrant is dismissed.

Overall therefore the contentions made by the Registrant cannot be upheld, and therefore cannot function as any kind of defence to, or justification of, its actions in registering and using the disputed domain name.

4.1 Complainant's Rights

4.1.1 In summary therefore, the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that it has rights in respect of the name and trademark THAWTE which is identical to the disputed domain name.

4.2 Abusive Registration

4.2.1 The Adjudicator also finds that the Complainant has proved, on a balance of probabilities, 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; and

4.2.2 Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

4.2.3 Accordingly the Adjudicator comes to the overall decision that the Complainant has proved, 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, THAWTE.CO.ZA, be transferred to the Complainant.

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A K VAN DER MERWE
SAIPL SENIOR ADJUDICATOR
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