

Decision

[ZA2014-0185]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-0185
DECISION DATE:	10 November 2014
DOMAIN NAME	weebly.co.za
THE DOMAIN NAME REGISTRANT:	Domains 2us
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Weebly, Inc.
COMPLAINANT'S LEGAL COUNSEL:	Hugo Prinsloo – Von Seidels
2 nd LEVEL ADMINISTRATOR:	ZA CENTRAL REGISTRY

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **5 September 2014**. On **15 September 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 **16 September 2014** ZA Central Registry confirmed that the domain name had indeed been suspended. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **12 September 2014**. The SAIPL verified that the Dispute [together with the amendment to 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 **17 September 2014**. In accordance with the Regulations the due date for the Registrant’s Response was **15 October 2014**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **16 October 2014**.
- c) The SAIPL appointed **Mike du Toit** as the Adjudicator in this matter on **22 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.

2 Factual Background

- 2.1 The Complainant is the proprietor in South Africa of the trade mark WEEBLY, registered under registration number 2012/05553 in cl 42 with the

following specification of services:

Providing temporary use of online non-downloadable software for designing, creating, hosting, customizing, modifying, maintaining and updating websites and web pages for others on a global computer network, mobile devices and social media sites and applications; application services provider (ASP) featuring software for use in designing, creating, hosting, customizing, modifying, maintaining and updating websites and web pages of others on a global computer network, mobile devices and social media sites and applications; cloud computing featuring software for use by others in designing, creating, customizing, modifying, maintaining and updating websites and web pages on a global computer network, mobile devices and social media sites and applications; computer services, namely, cloud hosting provider services; providing virtual computer systems and virtual computer environments through cloud computing; consulting services in the field of cloud computing; developing and hosting a server on a global computer network for the purpose of facilitating e-commerce transactions; providing on-line non-downloadable software for supporting and managing the creation and sending of bulk electronic mail which customers can use to design and send email advertising and promotional campaigns and to manage such campaigns.

- 2.2 In addition to being registered in South Africa, the Complainant's WEEBLY trademark is also registered in the European Union, Hong Kong, India, Indonesia, Israel, Japan, Malaysia, Mexico, New Zealand, Norway, Philippines, Russia, South Korea, Switzerland, Taiwan, Thailand and the United States of America.
- 2.3 The registration in the United States of America dates back to 2008 and the Complainant is the owner of weebly.com, registered in 2006.

- 2.4 WEEBLY is a free online website creator, which inter alia automatically generates a mobile version of each website and supports basic features for blogging and e-Commerce. As of August 2014, WEEBLY hosts 24 million sites, with a monthly rate of more than 140 million visitors.
- 2.5 The Registrant registered the disputed weebly.co.za domain name on 2 March 2011.
- 2.6 In addition to statutory rights in its WEEBLY trademark in South Africa, the Complainant claims to have acquired common law rights in the trademark WEEBLY in this country. The Complainant has expended considerable time, money and effort in the promotion and advertisement of its WEEBLY trademark in South Africa. As a result of its extensive and widespread use of its WEEBLY trademark, the Complainant claims to have acquired a reputation and goodwill in South Africa.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant submits that the Registrant registered the disputed domain name primarily to:
- Intentionally block the registration of the domain name by the Complainant;
 - Unfairly disrupt the business of the Complainant;
 - Sell or otherwise transfer the domain name to the Complainant or to a competitor of the Complainant, or any third party, for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name;

-
- Prevent the Complainant from exercising its rights in that the Complainant is prevented from registered its identical trade mark as a domain name and operating its website from such domain name; and
/ or
- Lead people to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- b) The Registrant applied to join the Complainant's affiliate program before applying to register the disputed domain name. The Complainant's affiliate program offers online marketers (including webmasters, bloggers, newsletters etc.) an opportunity to promote WEEBLY and to refer customers to the Complainant's website, www.weebly.com. Affiliates earn commission for every qualifying sale. The Registrant's affiliate application was declined.
- c) The Registrant subsequently registered the disputed domain name, well aware of the Complainant's rights. Not only did the Registrant register the disputed domain name in bad faith, but thereafter had it re-direct to the website of one of the Complainant's direct and biggest competitors, Wix (www.wix.com). Wix also provides a free online web development platform.
- d) After the Complainant's Legal Department contacted the Registrant on 22 July 2014, the Registrant demanded either (1) that his affiliate application be approved or (2) payment of USD 5000 to purchase the domain name, in order to have the domain name re-directed to the Complainant's website.
- e) The registration was not only made with abusive intent, but the

Registrant's ongoing use thereof is also abusive. Re-direction of the domain name to one of the Complainant's direct competitors is causing, or is likely to cause, substantial harm to the Complainant.

- f) The Registrant is inhibiting the marketing and advertising efforts of the Complainant by intentionally blocking the Complainant's registration of the domain name in question.
- g) The disputed domain name registration will not only prevent the Complainant from registering its identical trade mark as a domain name, but will also prevent the Complainant from operating a website from such domain name, or from directing the domain name to its current website. This will disrupt the business of the Complainant unfairly.
- h) The disputed domain name is identical to the Complainant's WEEBLY trademark. The disputed domain name currently re-directs to a website offering the identical services covered by the Complainant's registered WEEBLY trademark. This amounts to trade mark infringement in terms of section 34(1)(a) of the Trade Marks Act.

The Registrant is making unauthorised use of an identical mark, in the course of trade, in relation to the identical services covered by the Complainant's registered WEEBLY trade mark, which will likely deceive or cause confusion amongst members of the public. While the Complainant's WEEBLY trademark may post-date the registration of the disputed domain name, the Complainant's date of first use of its WEEBLY trademark in South Africa pre-dates the registration of the disputed domain name.

There is no obvious or legitimate justification for the Registrant's

adoption of the disputed domain name or for the ongoing use thereof. The disputed domain name was registered in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's rights. The disputed domain name is currently also being used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

3.2 Registrant

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

4 Discussion and Findings

- a) An indication is given in the Regulations as to what could be considered an abusive registration. In terms of Section 4(1), such factors include:-

“(a) Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to –

(i) Sell, rent or otherwise transfer the domain name to a complainant or to a competitor of the complainant, or any third party, for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name;

(ii) Block intentionally the registration of a name or mark in which the complainant has rights;

(iii) Disrupt unfairly the business of the complainant; or

(iv) Prevent the complainant from exercising his, her or its rights;

(b) Circumstances indicating 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 authorized by, or otherwise connected with the complainant;

(c) evidence, in combination with other circumstances indicating that the domain name in dispute is an abusive registration, that the registrant is engaged in a pattern of making abusive registrations;

(d) false or incomplete contact details provided by the registrant in the Whois database; or

(e) the circumstances that the domain name was registered as a result of a relationship between the complainant and the registrant, and the

complainant has –

*(i) been using the domain name registration exclusively; and
(ii) paid for the registration or renewal of the domain name registration.”*

To succeed in this complaint the Complainant has to prove, on a balance of probabilities, the following:-

- It has rights in respect of a name or mark which is identical or similar to the domain name; and
- The domain name, in the hands of the Respondent, is an abusive registration as defined.

4.1 Complainant's Rights

4.1.1 The Adjudicator finds that the Complainant has proven rights in the trademark WEEBLY. This is evidenced by the numerous trademark certificates annexed as evidence. The Complainant also has a domain name weebly.com that pre-dates the registration of the Registrant's disputed domain name. The only issue to be determined is whether the fact that the Registrant's disputed domain name predates the Complainant's trademark rights in South Africa, makes any difference. The disputed domain name was registered on 2 March 2011 while the Complainant's trademarks were registered in South Africa on 2 March 2012. In this regard the Adjudicator relies on the fact that the Complainant has proven registered trademark rights that predate the date of registration of the disputed domain name in the OHIM Office – (5 April 2010) and the registration certificates in the USA recorded that the trademark had been in use since 2006. These rights clearly pre-date the date of registration of the disputed domain name. The same goes for the common law rights, which the Complainant has proven. The Complainant has proven its rights in respect of a name or mark, which is identical to the domain name in dispute.

4.2 Abusive Registration

-
- 4.2.1 The question therefore to be decided is whether the domain name in question 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.
- 4.2.2 The Complainant submitted evidence of email exchanges between itself and the Registrant. It is clear that the Registrant was aware of the Complainant's business and WEEBLY trademark at the time when weebly.co.za was registered. The Registrant applied to join the Complainant's affiliate program before applying to register the disputed domain name. Only once its application was declined, did the Registrant register the domain name and had it re-directed to one of the Complainant's biggest and direct competitors. It has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.
- 4.2.3 After the Complainant's Legal Department contacted the Registrant on 22 July 2014, the Registrant demanded that his affiliate application be approved or demanded payment of USD 5000 to purchase the domain name in order to have the domain name re-directed to the Complainant's website.
- 4.2.4 The Adjudicator finds that the registration was not only made with abusive intent, but that the Registrant's ongoing use thereof is also abusive. The Complainant referred to the matter of Fédération Internationale de Football Association (FIFA) v. X Yin [ZA2007-0007]. Re-direction of the domain name to one of the Complainant's direct competitors is causing, or is likely to cause, substantial harm to the Complainant. The matters of Telkom SA Limited v. Cool Ideas 1290 CC [ZA2007-0003], Thomas Cook UK Limited v. Whitley Bay

Uncovered [NOMINET UK Decision DRS00583] and Akamai Technologies, Inc. v. Mr Alex Goldstein [NOMINET UK Decision DRS01378], all deal with blocking registrations.

5. Decision

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

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