

Decision

[ZA2015-0220]

.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0220
DECISION DATE:	26 January 2016
DOMAIN NAMES:	wetransfer.co.za
THE DOMAIN NAME REGISTRANT:	Priven Reddy
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	WeTransfer B.V and WeRock B.V
COMPLAINANT'S LEGAL COUNSEL:	DM Kisch Inc.
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry (co.za)

1. Procedural History

- 1.1 The domain in this complaint is <wetransfer.co.za>, which was registered on 30 October 2012. The Registrant is Priven Reddy, of 59 Silver Avenue, Morningside, Durban, KwaZulu Natal.
- 1.2 The Complainants are WeTransfer B.V and WeRock B.V, each a company whose principal place of business is at Nieuwe Prinsengracht 33, 1018 EG Amsterdam, The Netherlands. The two are hereinafter compendiously referred to as “the Complainants”.
- 1.3 This dispute was filed with the South African Institute of Intellectual Property Law (“SAIIPL”), on **12 November 2015**. On **13 November 2015** SAIPL emailed a request to ZA Central Registry for the registry to suspend the domain name, and on the same day it confirmed the suspension.
- 1.4 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **23 November 2015**. The due date for the Registrant’s Response was **22 December 2015**. The Registrant did not submit its Response by **22 December 2015**, and notification of his default was posted on **24 December 2015**.
- 1.5 The SAIPL appointed **Adv Owen Salmon SC** as the Adjudicator in this matter on **11 January 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 The Facts

- 2.1 The First Complainant is the registrant of the domain name <wetransfer.com>. This domain was created on 14 December 2007. The First Complainant offers an online free file-transferring platform that allows

anyone in the world to send large files (up to 2 GB per transfer) through a simple user-friendly platform. Its net worth is currently over 100 billion US Dollars.

2.2 The Second Complainant is the sole shareholder of the First Complainant. It is the proprietor of the following trade marks:-

2.2.1 Community Trademark (CTM) registration no. 12836921
WETRANSFER in classes 9, 35, 38 41 and 42;

2.2.2 Community Trademark (CTM) registration no. 11633047
WETRANSFER in classes 9, 35 and 38;

2.2.3 US Federal trade mark registration no. 4661724 WETRANSFER in
classes 9, 35 and 38;

2.3 From 1 January 2015 to 21 September 2015 the number of unique users of the Complainant's website, <wetransfer.com> was over one hundred and forty million. The number of users from South Africa, in one month alone, was 125 761. This gives an indication of the public awareness (i.e. reputation) of the Complainants' business under the mark WETRANSFER.

2.4 Although the Registrant has not responded to the dispute, in a prior email he recorded:-

“We have already responded to this a few weeks ago when we mentioned that the domain does not belong to us it was simply purchased by us for a client. The client however wishes to remain anonymous.”

2.5 In responding to a demand from the Complainants' attorneys, on 3 July 2015, Mr Reddy wrote:-

“We have informed the client. They will be moving this site to a new domain soon and consider selling wetransfer.co.za to your client. Our client is seeking R60 000 for the domain.”

2.6 Later on 9 July 2015, Mr Reddy wrote:-

“The client has reverted that he does not want to sell the domain nor did he ever want to as he had not purchased it with the intent to ever resell it. The intent to sell it was a misinterpretation and clear misunderstanding from a staff member as the clients staff member had only suggested this as a way to amicably resolve the domain dispute.” (sic.)

2.7 Nothing further has been heard from him.

3 **The Complainant’s contentions**

3.1 The disputed domain name <wetransfer.co.za> wholly incorporates the Complainant’s trade mark and is therefore identical to the Complainants’ trade mark. Therefore the use by the Registrant of the domain name would lead to deception and confusion and mislead members of the public to assume the domain name was registered or operated by the Complainants. In addition, the Registrant, by adopting a similar layout and design for its website (at www.wetransfer.co.za) is deliberately trading off the goodwill that the Complainants have developed in their WETRANSFER trade marks and WETRANSFER website and services. The adoption and registration of the domain name wetransfer.co.za therefore amounts to passing off under common law.

3.2 In the foreign decisions DRS 02464 (Aldershot Car Spares v Gordon) and DRS 00658 (Chivas Brothers v David William Plenderleith), as cited in the South African domain decision ZA2014-0188 (Life Healthcare Group (Pty) Limited v Webmail International (Pty) Ltd, the presiding adjudicators 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 that the Respondent registered the domain name for a purpose and secondly that such purpose was abusive.”

In this regard reference is also made to South African domain decision ZA2007-0007 (FIFA v X Yin).

- 3.3 The Complainants have clearly established that they have a right in and to the WETRANSFER marks and logos, and that the Complainants are known as WETRANSFER and referred to by this name. The Complainants have further established that the disputed domain name wetransfer.co.za is identical to the Complainant’s domain name wetransfer.com.
- 3.4 The disputed domain name clearly prevents the Complainants from registering their domain name as the Complainant’s domain name is identical to the disputed domain name.
- 3.5 It is submitted by the Complainants that the Registrant acted intentionally and the following is the basis of this submission. Firstly, it is highly unlikely that the Registrant did not know of the Complainant’s domain when registering the disputed domain name. This is evident by the disputed domain making use of the similar website design and the WETRANSFER logos. The Registrant initially proposes to sell the domain to the First Complainant for R60 000 and later retracted this offer by stating that there

was a misunderstanding and the Registrant never had the intention to sell the domain name.

3.6 In addition, the Complainants' domain and the disputed domain are confusingly similar and therefore likely to lead consumers to mistakenly believe that there is a connection between the two domains, where there is no such connection. By its action the Registrant is taking unfair advantage of the Complainant's rights and the reputation attaching to these marks by attracting custom to its domain and away from the Complainants' domain and deliberately trading off the Complainants' goodwill.

3.7 Furthermore, the Complainants' reputation in its WETRANSFER marks may be damaged by the existence of the disputed domain registration, as the Complainants have no control over the use of this domain and the experience of the users of this domain. Where users are likely to be confused that there is a connection between the two domain names, and where there is a bad user experience, the Complainants' reputation will be harmed, potentially causing irreparable damage to the Complainants' business.

3.8 The disputed domain name further offers similar goods and services to those of the complainants. The use and registration of the disputed domain name therefore suggests a connection between the parties, where no such connection exists. This is likely to mislead persons in thinking that there is a connection between the parties, which is untrue.

4 The Registrant's contentions

4.1 The Registrant did not file a reply to the Complainants' contentions.

5 Discussion and Findings

- 5.1 The Complainants clearly have rights in the mark WETRANSFER.
- 5.2 This mark is identical to the domain name in question, and given the provisions to Regulation 5, there is an onus on the Registrant to show that the domain name is not abusive. Seeing that he has not responded to the Dispute, he cannot discharge the onus.

6 Decision

- 6.1 For the foregoing reasons the Adjudicator finds that the domain name is abusive. In accordance with Regulation 9 the Adjudicator orders that the domain name <wetransfer.co.za> be transferred to the First Complainant.

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ADV OWEN SALMON SC
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za