

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-00286
DECISION DATE:	4 December 2017
DOMAIN NAME	absa-barclays.co.za
THE DOMAIN NAME REGISTRANT:	Whois Agent
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	ABSA Bank Limited
COMPLAINANT'S LEGAL COUNSEL:	Moore Attorneys (Muhammad Patel)
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZA Central Registry (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **2 October 2017**. On **9 October 2017** SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **9 October 2017** ZACR confirmed that the domain name had indeed been suspended. SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and SAIPL's Supplementary Procedure.
- b. In accordance with the Regulations, SAIPL formally notified the Registrant of the commencement of the Dispute on **11 October 2017**. In accordance with the Regulations the due date for the Registrant's Response was **8 November 2017**. The Registrant did not submit any response, and accordingly, SAIPL notified the Registrant of its default on **9 November 2017**.
- c. The Complainant did not need to submit any Reply.
- d. SAIPL appointed **Christiaan J Steyn** as the Adjudicator in this matter on **27 November 2017**. On **27 November 2017** the Adjudicator submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2) Factual Background

- a. The Complainant is ABSA Bank Limited, a company duly incorporated according to the laws of the Republic of South Africa, having its principle place of business at 7th Floor, Barclays Towers West, 15 Troye Street, Johannesburg, South Africa, being listed on the Johannesburg Stock Exchange. The Complainant offers various financial services, which includes personal and business banking, credit cards, corporate and investment banking, wealth and investment management and insurance. The Complainant has provided sufficient proof hereof.
- b. The Complainant formally started trading as a registered company (under registration number 1986/004794/06) in 1986, and was formally founded in 1991, known as "ABSA Bank" (or "ABSA"). The Complainant currently has 42000 employees, 1251 branches with 10378 ATMs and 9.4 million clients throughout South Africa. The Complainant boasts several other accolades, which further indicates its reputation in the South African banking industry and establishes its common law rights. The Complainant has also provided sufficient proof hereof.
- c. The Complainant has registered the name **ABSA** as a trade mark in various classes in South Africa, including classes 9, 16, 35, 36, 38, 39, 41 and 42, the dates of these registrations being **22 February 1991, 5 December 1991** and **13 January 1999** respectively. The Complainant has provided proof of these trade mark registrations.
- d. Although the Complainant did not provide complete details of the registered trade mark **BARCLAYS**, owned by an affiliated company of which the Complainant is a subsidiary, the Adjudicator wishes to make reference thereto in its relevance to this matter. **BARCLAYS** has been registered as a trade mark in various classes in South Africa, including 16, 35 and 36, the dates of these registrations being **14 August 1980** and **8 November 1991** respectively. These registrations are registered in the name of Barclays Bank PLC, who is a shareholder of Barclays Africa Group, of which the Complainant is a subsidiary.

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- e. The Complainant further registered the domain name *absa.co.za*, which include its **ABSA** trade mark, and has hosted its official website on this domain, and made use of its **ABSA** trade mark thereon, since **1 January 1995**. The Complainant has provided proof of this use and domain registration.
 - f. In **February 2017**, the Complainant became aware of the disputed domain name registration *absa-barclays.co.za*, owned and registered by the Registrant on **2 February 2017**.
 - g. On **15 February 2017**, the Complainant, through its representative, addressed a letter of demand based on the Complainant's rights, to the Registrant, *inter alia* demanding that the disputed domain name be transferred to the Complainant on the basis that the disputed domain name are abusive registrations, and putting them on notice that formal proceedings would be initiated if the demands were not met.
 - h. No response was received hereon from the Registrant and the Registrant therefore failed to comply with the Complainant's demands.
 - i. The Complainant sent a further letter to the Registrant on **26 April 2017**, again demanding compliance with its demands.
 - j. No response was received hereon from the Registrant and the Registrant therefore again failed to comply with the Complainant's demands.
 - k. This Complaint was thereafter filed with the Administrator on **2 October 2017**.

3) Parties' Contentions

a. Complainant

- i. 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 proven, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present:

1. that the Complainant has rights in respect of a name(s) or mark(s);
 2. that is identical or similar to the disputed domain name; and
 3. that, in the hands of the Registrant, the disputed domain name is an abusive registration.
- ii. An abusive registration is defined in the definitions of Regulation 1, to mean a domain name(s) which either:
1. 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
 2. has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

b. Substantive Aspects

- i. Turning to the substantive aspects of this Complaint, the Adjudicator has carefully perused the Complaint, and has fully considered the facts and contentions set out therein.

c. Rights in Respect of Name(s) or Mark(s)

- i. 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.
- ii. As has been decided in the South African appeal decisions of *seido.co.za* (ZA2009-00030) and *xnets.co.za* (ZA2011-00077), the notion of "rights" for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. The threshold in this regard should be fairly low.
- iii. It is also a matter of *locus standi* in order to make sure that the person who lodges the Complaint is someone with a proper

interest in that Complaint. The threshold in this regard should also be fairly low.

d. Does the Complainant have Rights

- i. The first element that the Adjudicator needs to establish is whether, as set out above, and in terms of Regulation 3(1)(a), on a balance of probabilities, the Complainant has rights in respect of the name(s) or trade mark(s) **ABSA**. This will also determine whether the Complainant has the necessary *locus standi* to bring this Complaint. The Complainant contends that it has rights in and to the name(s) or trade mark(s) **ABSA**, and, as not response was lodged by the Registrant, the Registrant does not contest this.
- ii. The Complainant has shown that it has registered its name or trade mark **ABSA** in various classes in South Africa, from as early as 1991. These trade mark registrations are shown to be in force and are considered by the Adjudicator to be *prima facie* valid. Although the Adjudicator takes note of the existence of the registered name and trade mark **BARCLAYS** owned by a proprietor of which the Complainant is a subsidiary, for the sake of this dispute, the Adjudicator will focus on the Complainant's **ABSA** name and trade mark.
- iii. The South African trade mark registrations and the rights flowing from these registrations could be enforced by the Complainant against an infringer who, without authority, was to use the name or trade mark **ABSA** or a confusingly similar trade mark, in the course of trade.
- iv. In support of the above mentioned, the Adjudicator refers to the South African Law of Trade Marks by Webster and Page, Fourth Edition, paragraph 12.5 *et seq* (hereafter "Webster and Page"), and the foreign and South African decided cases cited therein.

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- v. These rights could also be used against a third party who was to attempt to register such a trade mark, in order to oppose such a trade mark application.
 - vi. In support of the above mentioned, the Adjudicator refers to Webster and Page, paragraph 8.30 *et seq*, and the decided cases cited therein.
 - vii. The Complainant has also registered a domain name in South Africa, which include its name or trade mark **ABSA**. This provides the Complainant with rights in terms of the Regulations to object to a disputed domain name in the event that their name or trade mark **ABSA** is identical or similar to a disputed domain name.
 - viii. The Complainant states that it has spent considerable resources on marketing and promoting its **ABSA** name and/or trade mark, which have become known to, and associated by, a substantial number of the public with the Complainant. Accordingly, the Complainant contends that, by virtue of its aforementioned activities, it has developed a substantial repute or reputation in South Africa, and hence goodwill, in terms of the common law.
 - ix. Such reputation, as forming part of the goodwill, stemming from that reputation, in respect of its name or trade mark **ABSA**, could be damaged by means of unlawful competition (or more particularly 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.
 - x. It was pointed out in the South African domain name decision ZA2007-00003 (*telkommedia.co.za*) that the registration, adoption and use 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 or trade mark **ABSA** rights that can be enforced

against others who infringe or would be likely to damage such rights.

- xi. In support of the above, the Adjudicator refers to the above-mentioned South African domain name decisions ZA2017-00272, ZA2017-00265, ZA2007-00003; and Webster and Page, at paragraphs 15.5 and 15.7, including the decisions cited therein. See also ZA2017-00265 and ZA2017-00285.
- xii. The Registrant, by virtue of omission, does not dispute that the Complainant has registered trade mark(s) in respect of **ABSA**, and furthermore, the Registrant does not dispute or challenge the above-mentioned rights as claimed by the Complainant.
- xiii. Considering the above factors, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that it has both registered and unregistered (common law) rights in respect of the name and trade mark **ABSA**. The Complainant has thereby also established that it has the necessary *locus standi* to bring this Complaint.

e. Name(s) or Mark(s) Identical or Similar to the Disputed Domain name

- i. The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proven that its name or trade mark **ABSA**, in which it has rights, is identical or similar to the disputed domain name. The Complainant contends that its name or trade mark **ABSA** is similar to the disputed domain name, which was, by omission, not contested by the Registrant.
- ii. The Complainant's name and trade mark (in which it has rights) is **ABSA**, while the disputed domain name is **asba-barclays.co.za**. Ignoring the first and second level suffixes, in terms of Regulation 5(c), the comparison becomes a comparison of **ABSA**, against **ABSA-BARCLAYS**.

- iii. Herein, the Registrant has simply combined the Complainant's name and trade mark **ABSA** with another name and trade mark **BARCLAYS**. Furthermore, as set out in this decision above, the **BARCLAYS** name and trade mark is associated with the Complainant. It is therefore evident that the disputed domain name is not only similar to the Complainant's name and trade mark **ABSA**, but also similar to the name and trade mark of a proprietor of which the Complainant is a subsidiary, being **BARCLAYS**.
- iv. Furthermore the disputed domain name contains the Complainant's name and trade mark **ABSA** in its entirety. In support hereof, in ZA2017-00285 the domain name *capitech.co.za* was found to be confusingly similar to CAPITEC. Also see ZA2016-00247, ZA2017-00248, ZA2016-00250, ZA2016-00254, ZA2017-00272, ZA2017-00265 and WIPO/D2002-00367 herein.
- v. Subsequently, the Adjudicator is of the view that a reasonable person will inevitably come to the conclusion that the Complainant's name and trade mark **ABSA** is similar to the disputed domain name.
- vi. Furthermore, the Adjudicator takes note that the disputed domain name is also similar to the Complainant's domain name *absa.co.za*, used by the Complainant for its official website.
- vii. The Adjudicator also wishes to point out that the test herein is not "confusing similarity" but merely "similarity", which involves a lower standard of comparison. In support hereof, see ZA2017-00272, ZA2017-00265 and ZA2017/00285.
- viii. Accordingly, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that the name and trade mark **ASBA** is similar to the disputed domain name.

f. Is the Disputed Domain Name an Abusive Registration

- i. 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.
- ii. The Complainant contends that the disputed domain name is, in the hands of the Registrant, an abusive registration, while the Registrant omitted to respond. The Complainant herein submitted that, in terms of Regulation 4, the Registrant has registered the domain name primarily to:
 1. Intentionally block the registration of the domain name *asba-barclays.co.za* in which the Complainant has rights;
 2. Unfairly disrupt the business of the Complainant;
 3. Prevent the Complainant from exercising its rights in and to the domain name *absa-barclays.co.za*;
 4. Lead people or business to believe that the domain name is registered by, operated or authorised by, or otherwise connected to the Complainant; and
 5. Be used in a manner that takes unfair advantage of, or is ungainly detrimental to, the Complainant's rights.
- iii. The Adjudicator is subsequently required to determine whether the disputed domain name is an abusive registration as defined by Regulation 1, and as set out above.
- iv. According to the definition, and to various Nominet decisions, there are two potential abuses (or two types of abuse), being:
 1. Registration with an abusive intent; and/or
 2. Use in an abusive manner.
- v. The Adjudicator herein refers to the foreign decisions DRS02464 (Aldershot Car spares v Gordon), DRS00658 (Chivas Brothers Ltd v David William Plenderleith), and the South African decisions ZA2007-00007 (FIFA v X Yin), as referred to in ZA2017-00272, ZA2017-00265 and ZA2017-00285. Against the background of the

aforementioned decisions, the Adjudicator agrees 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 can be the result, effect or consequence of the registration and/or use of the disputed domain name.

vi. As contended above by the Complainant, Regulation 4 lists factors or circumstances which indicate that the Registrant has registered the disputed domain name for various stated reasons. The Adjudicator will now focus on the most pertinent aspects, in its view, which *inter alia* include:

1. **Regulation 4(1)(a)(ii):**

- a. Although the Regulations are silent on what a “blocking registration” is, 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 herein.
- b. The disputed domain name undeniably prevents the Complainant from registering this domain name, or its name or trade mark in this form, for itself, whether through the intent of the Registrant or as an unintended consequence of the disputed domain name registration.

- c. The Registrant, by omission to lodge a Response, offered no reason for registering the disputed domain name.
- d. In support of the above, see WIPO/D2000-0545 (*bancolumbia.com*); and *British Telecommunications plc v One in a Million Ltd* [1999] FSR 1, as well as the South African decisions ZA2008-0014, referring to WIPO/D2000-0766, and the more recent ZA2017-00265.

2. Regulation 4(1)(b):

- a. The Complainant has clearly established that it has rights in the name and trade mark **ABSA**, and that the Complainant's name and trade mark **ABSA** is similar to the disputed domain name.
- b. Therefore, based on above, there exists a likelihood that the public will be confused or deceived into thinking that the Registrant is related to, or associated with, the Complainant.
- c. Although the Registrant did not make actual use of the disputed domain name, the above Regulation requires either registration OR use. Various foreign decisions have found that actual use is not a hard and fast requirement. Therefore, the mere registration of the disputed domain name by the Registrant is sufficient herein. See WIPO/D2016-2310, WIPO/D2000-0545, NAF/FA91359, NAF/FA95464 and NAF/FA95498, as well as ZA2017-00265 and ZA2017-00285 herein.
- d. Actual confusion is furthermore not necessary, and the potential or (reasonable) likelihood for

confusion is sufficient. See WIPO/D2000-0777, WIPO/D2000-0878, NAF/FA95033 and NAF/FA95402, as well as ZA2007-0003, ZA2016-00254, ZA2017-00265, ZA2017-00272 and ZA2017-00285 herein.

- vii. Accordingly, the Adjudicator concludes that *inter alia* the above circumstances apply in the present dispute, and that these factors indicate that the disputed domain name is an abusive registration.

g. Registrant

- i. The Respondent did not reply to the Complainant's contentions.

4) Discussion and Findings

a. Abusive Registration

- i. The Adjudicator concludes that the disputed domain name was registered 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. Therefore, the Adjudicator finds that the disputed domain name, in the hands of the Registrant, is an abusive registration.

5) Decision

- a. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, *absa-barclays.co.za*, be transferred to the Complainant.

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CHRISTIAAN J STEYN

SAIPL ADJUDICATOR

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