

Decision

[ZA2011-0075]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0075
DECISION DATE:	22 July 2011
DOMAIN NAMES:	accessfinance.co.za axisfinance.co.za
THE DOMAIN NAME REGISTRANT:	DirectAxis Pty Ltd
REGISTRANT'S LEGAL COUNSEL:	Ron Wheeldon Attorneys
THE COMPLAINANT:	The Standard Bank of South Africa Limited
COMPLAINANT'S LEGAL COUNSEL:	Bowman Gilfillan Inc.
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA)

1. Procedural history

- 1.1. There are two domains in issue, both in the name of Direct Axis (Pty) Ltd. The first, <axisfinance.co.za> was registered (by a predecessor in-title¹) on 6 October 2009. The other, <accessfinance.co.za> was registered on 23 February 2010.
- 1.2. This dispute was filed with the South African Institute of Intellectual Property Law (“SAIPL”) on 12 May 2011. On 13 May 2011 the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain names, and on 16 May 2011 UniForum SA confirmed that the names had indeed been suspended.
- 1.3. In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on 19 May 2011. In accordance with the Regulations the due date for the Registrant’s Response was 17 June 2011.
- 1.4. The Registrant submitted its Response on 17 June 2011, and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL’s Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on 20 June 2011.
- 1.5. In accordance with the Regulations the due date for the Complainant’s Reply was 27 June 2011. The Complainant submitted its Reply on 27 June 2011.
- 1.6. The SAIPL appointed Adv Owen Salmon as the Adjudicator in this matter on 4 July 2011. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as

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See paragraph 2.12 below.

required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2. Factual Background

- 2.1 There being no dispute about the facts set out in what follows, the Adjudicator accepts them as established for the purposes of this adjudication.
- 2.2 The Complainant is The Standard Bank of South Africa Limited, a company duly incorporated in accordance with the laws of the Republic of South Africa. The Complainant is one of the largest banks in South Africa and is considered to be a leader in banking products and services in South Africa. It needs no further introduction.
- 2.3 In 1995 the Complainant registered the mark ACCESSFINANCE as a trade mark in South Africa, under number 1995/12182. This registration is in class 36, in respect of “financial, insurance and banking services; monetary affairs; real estate affairs”.
- 2.4 In addition, the Complainant has registered the trade mark ACCESSFINANCE in Botswana, Lesotho, Malawi, Mozambique, Namibia, Zambia and Zimbabwe.
- 2.5 The Complainant applies the mark ACCESSFINANCE to a financing product available to the public, which links a Standard Bank Vehicle and Asset Finance credit agreement to a current account. Customers are able to deposit any surplus funds they may have into this account. The customer derives benefit when these funds are used to calculate the earnings reduction on their Standard Bank Vehicle and Asset Finance credit agreement.

- 2.6 Since 1995, the Complainant has spent a considerable amount of time, money, and effort promoting its services under the ACCESSFINANCE trade mark. It has generated revenue in excess of R3 million, annually, from these services.
- 2.7 The Complainant alleges that it has amassed a considerable reputation in and to its ACCESSFINANCE trade mark, and that, accordingly, it has strong common law rights in and to the ACCESSFINANCE trade mark in respect of the provision of financial services. It submits that, due to the considerable reputation of the ACCESSFINANCE trade mark, and the services promoted under it, the trade mark is exclusively associated with the Complainant. There are facts and contentions raised by the Registrant in this regard, and these will be traversed later in this judgement.
- 2.8 The Registrant² is a registered financial service provider, and has traded under the brand DIRECT AXIS, since January 1995, as an innovative supplier of direct access to a range of financial products such as unsecured personal loans, secured loans and car finance. Additionally it provides insurance services such as medical aid, car insurance, life insurance and burial plans. It claims that it has used the words “direct access” to describe what it has constantly offered since the business started.
- 2.9 It has been a successful business, and over the last 16 years has granted more than one million personal loans and more than half a million insurance policies. Due to the direct nature of the services,

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The Registrant’s Response states that it was “*incorporated as Direct Axis SA (Pty) Ltd under company registration number 1995/06077/07*”. Nothing is mentioned about a change of name, or other explanation proffered to immaterialise a difference, if there is, between this company and the Registrant. However, in view of the conclusion reached by the Adjudicator, nothing turns on this.

direct marketing techniques are used and the Registrant has become v
ery well-known in the South African market.

2.10 The Registrant claims that it is the proprietor³ of the trade mark DIRECT
AXIS, which it has registered under number 1996/11940 in class 36 in
respect of “insurance, financial affairs, monetary affairs, real estate
services.”

2.11 However, there are some fifty other additional registered trade marks in
class 36 for the same or overlapping services which consist of or
incorporate the word “direct”. Thus there is registered, for example,
ABSA DIRECT, GO DIRECT, INVESTEC DIRECT, BOE MONEY
DIRECT, METBOARD DIRECT and, simply, DIRECT. Consequently,
asserts the Registrant, the main distinguishing feature of its company
name and its primary trade mark is the element AXIS; this word has
no particular meaning in relation to Registrant’s services and so is
arbitrary, and thus inherently highly distinctive.

2.12 The Registrant was concerned when, in 2010, customers who thought
they were dealing with it found that they were dealing with an “Axis
Finance” not related to the Registrant. This led it to discover that the
domain <axisfinance.co.za> had been registered⁴ by one Dudley
Computers CC of Ashwood, KwaZulu Natal. Upon further
investigation, the Registrant ascertained that the domain was being
used, by a business in Umhlanga Rocks, to sell financial services. This
led to the Registrant sending a demand letter based on alleged

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A copy of the certificate of registration is annexed to the Registrant’s
Response. It reflects that the proprietor is Direct Axis (South Africa) (Pty) Ltd.
See the comment in footnote 2 above.

⁴

On 6 October 2009 – see paragraph 1.1 above.

statutory trade mark infringement. This letter is dated 19 April 2010. As a result, Dudley Computers CC transferred the domain to the Registrant – the WHOIS register reflects this to have been on or about 14 July 2010.

2.13 Having discovered that the presence of AXIS, alone, in a domain name caused consumers to suppose a connection with the Registrant, it applied for registration of the trade mark AXIS in class 36 on 20th April 2010. This application was accepted by the Registrar of Trade Marks, but the Complainant has threatened opposition. According to the Registrant, it believed that this was being resolved by negotiation, until the present dispute was lodged.

2.14 On 23 February 2010, the Registrant secured the domain <accessfinance.co.za>. It states the following in this regard:-

“If Complainant wished to claim the domain name accessfinance.co.za it certainly could have done so within the 15 years after it registered the alleged trade mark, because it was still available when registrant claimed it in February 2010. This was done, not to trade on any reputation of Standard Bank, but to secure the generic accessfinance to complement the trade mark based domain name axisfinance.co.za. This is in keeping with the Registrant’s constant use of generic terms incorporating “access” over its entire existence including:-

<u>Phrase Used</u>	<u>Date First Used</u>
Instant Access to Cash	Jan 98

Your Access to Instant Cash	Sept 98
Immediate Access to Cash	Sept 01
Quick Access to Cash	Nov 03”

2.15 The statement is interesting for a number of reasons. First, an awkwardness arises from the chronology. According to the Registrant, it was alerted to the domain <axisfinance.co.za> when instances of confusion came to its attention; otherwise, one must presume, it would not have become aware of the domain. It was, thus, in April 2010 that the demand was sent. But, in February 2010, the Registrant had claimed the domain <accessfinance.co.za> - not a domain which reflects its name DIRECT AXIS (or AXIS anything). Moreover, the Registrant’s assertion that a domain named <accessfinance.co.za> would “*complement the trade mark based domain name axisfinance.co.za*” seems somewhat discordant in light of the contention (dealt with below) that ‘accessfinance’ is entirely generic and bears no relation to the distinctive mark “axis finance”.

2.16 In addition, “accessfinance” (*qua* domain name) is not entirely “*in keeping with ... use of generic terms incorporating “access”...*” First, there is no suggestion that the “generic terms” that were used gave rise to their own domain names. Moreover, the terms all relate to instant *cash* – and this is, *prima facie* at least, different from *finance*. The Registrant does not say whether it has also “claimed” a domain named “accesscash.co.za”, for example, which one may be tempted to think is better so “in keeping”.⁵

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A search of the ‘WHOIS’ Register reveals that a domain with this name has not been registered.

2.17 In the result, this explanation leaves room for doubt. The importance of this will be addressed later in this judgement.

3. Parties' Contention

3.1 The Complainant's Contentions

- 3.1.1 The essence of the Complaint can be reduced to the following.
- 3.1.2 The domain name <accessfinance.co.za> is identical to the Complainant's registered trade mark, and is being used in respect of identical services.
- 3.1.3 The domain name <axisfinance.co.za> is, conceptually and aurally, similar to the Complainant's ACCESSFINANCE trade mark.
- 3.1.4 There is a substantial likelihood that internet users and consumers will be confused into believing that there is some affiliation, connection, sponsorship, approval or association between the Complainant and the Registrant, when in fact, there is no such relationship.
- 3.1.5 At the time the disputed domain names were registered, the Registrant was not commonly known to third parties by the name "access finance" or "accessfinance" or "axis finance". The Registrant has never made use of the disputed domain names in connection with a good faith offering of goods or services either now or in the past, nor is the Registrant making legitimate non-commercial or fair use of the disputed domain names, either now or in the past. As a result of its extensive marketing activities from November 1995 onwards, the Complainant is the exclusive owner of the ACCESSFINANCE trade mark and all common law rights in and to the ACCESSFINANCE trade mark.

- 3.1.6 The use of the word “axis”, instead of “access”, does not distinguish the domain name from the Complainant’s ACCESSFINANCE trade mark. In this case the change is so *de minimis* that the likely purpose would be to cause, and opportunistically exploit, inevitable user confusion.⁶ Such confusion is further compounded in that the Complainant and Registrant are competitors in the financial services industry.
- 3.1.7 Further reliance is placed upon the WIPO UDRP decision of <reuters.com> (D2002-0441) for the contention that, when determining whether the registration of a domain name in a typo- squatting matter was identical or confusingly similar, it is helpful to consider the context in which the domain names are being used, as well as the aural and visual similarity between the domain names and the complainant’s trade mark.
- 3.1.8 The Registrant uses the domain names for the purpose of unfairly disrupting the business of the Complainant and has tarnished the ACCESSFINANCE trade mark in the process. In that respect, the Complainant refers to the fact that there is no disclaimer to indicate that the site is not approved, endorsed or otherwise connected to the Complainant.
- 3.1.9 Furthermore, the Registrant is using the website associated with the disputed domain names to promote the goods and services of companies competing with the Complainant.
- 3.1.10 Given the repute and renown of the Complainant’s ACCESSFINANCE trade mark, the Registrant must have been aware of the Complainant’s rights to the mark, and the Registrant intentionally adopted this name in

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Reliance is placed upon the WIPO UDRP decision of <phizer.com> (D2002-0410).

order to ride on the coat-tails of the Complainant's success and reputation.

- 3.1.11 The registration of the disputed domain names has the effect that the Complainant is barred from registering and using the disputed domain names.
- 3.1.12 On the basis of the reasoning set out in British Telecommunications plc v One in a Million Ltd [1999] ETMR 61, the Complainant submits that the Registrant has intentionally attempted to attract internet users, for the purpose of unfairly disrupting the business of the Complainant by creating a likelihood of confusion with the Complainant's ACCESSFINANCE trade mark.
- 3.1.13 The Registrant's lack of legitimate interest in the ACCESSFINANCE name indicates that the Registrant registered the domain name in bad faith primarily to unfairly disrupt the Complainant's business.
- 3.1.14 Therefore, the disrupted domain names are abusive registrations in the hands of the Registrant.

3.2 The Registrant's Contentions

- 3.2.1 It is helpful to address the Registrant's contentions separately in regard to the different domain registrations. The Adjudicator deals firstly with <axisfinance.co.za>.
- 3.2.2 The word "access" and the word "axis" are not equivalent. The latter is distinctive and a key part of Registrant's trade mark. The former is directly descriptive of the sort of services both the Complainant and Registrant offer, and no person should have any form of monopoly in it.

- 3.2.3 In light of the Registrant's explanation as to its acquisition of the domain, it follows that selection of the domain <axisfinance.co.za> was entirely unrelated to Complainant and does not rationally involve any right of Complainant's. On the contrary, it is based on Registrant's own trade mark and company name and is not, therefore, "abusive".
- 3.2.4 With regard to <accessfinance.co.za> the Registrant's contentions are different and can be summarized as follows.
- 3.2.5 Complainant uses the word "access" descriptively, as does Registrant and the rest of the financial services industry. It is not used alone as a trade mark by Complainant, nor is it used as a trade mark in combination with "finance" (itself a wholly descriptive term in the context of financial services) or other descriptors.
- 3.2.6 On the contrary, the Registrant uses it descriptively, and in relation primarily to "access bonds". Thus, the Complainant's 'access bond' permits secured bond borrowers to "access" funds in the bond when required, and pay the money back later. This is in fact commonplace. Similar access bond facilities are offered by most, if not all, major banks in South Africa. People refer to bonds which offer the facility to access funds within them as "access bonds".
- 3.2.7 That the word ACCESS is presently generic in class 36 is borne out by the fact the Trade Marks Registry has allowed a number of registrations in the class which incorporate the word ACCESS but which are not in the name of Complainant. This has apparently been without objection by Complainant. Examples are:-
- 3.2.7.1 1987/05488 CAMS CORPORATE ACCESS MANAGEMENT SYSTEM in class 36 in the name of First Rand Bank Ltd (in

which the entire term “corporate access management system” is disclaimed);

3.2.7.2 2008/15152 NEOACCESS in class 36 in the name of Neotel (Pty) Ltd (in which “access” is disclaimed);

3.2.7.3 2003/14834 INVESTEC GLOBAL ACCESS in class 36 in the name of Investec Bank Ltd;

3.2.7.4 2001/18844 SINGLE POINT ACCESS TO MULTIPLE QUOTES in class 36 (in which the phrase “single point access” is disclaimed) in the name of Nettle treasury Services (Pty) Ltd; and

3.2.7.5 2008/10191 VAB VEHICLE ACCESS BENEFIT in class 36 in the name of Mocking Bull Holdings (Pty) Ltd.

3.2.8 The Complainant has realized and accepted that the word “access” was generic for financial services. While it had and continues to hold a number of registrations for trade marks incorporating the term, it did not object to third party use or registration. One would expect that there would be strenuous efforts to ensure that it is always used as trade mark, rather than a descriptor, and that action would have been taken against the range of sites using it as a descriptor to persuade their holders that the term is a trade mark and not a descriptor. There is no evidence of any such action. The evidence, on the contrary, is that an “access bond” is a type of bond one might buy from a number of sources, including STANDARD BANK. It is only once the words STANDARD BANK are used, that there is any connection with Complainant as a source.

- 3.2.9 The same is true of ACCESSFINANCE. This is the main component of the close corporation name Access Finance and Business Consultations CC (registration number 1989/017681/23) and is echoed in the names Access Financial Services CC (registration number 1993/015495/23), Access Key Financial Services (Pty) Ltd (2006/034570/07) and Access Home Loans (Pty) Ltd (1996/006561/07). A search on enterprise names incorporating “access” disclosed 740 such enterprises.
- 3.2.10 The use of the term “access finance” is common place on the internet and a Google search of “accessfinance South Africa” does not disclose any reference on the top page to Complainant. All uses are entirely generic. The result is the same if the search is for “access finance South Africa”. On the Trade Mark Register, in most cases the word “access” is disclaimed.
- 3.2.11 In regard to the existence of the Complainant’s trade mark registration for the mark ACCESSFINANCE, the Registrant maintains that it has not challenged the registration because it *bona fide* believed that the dispute would be settled. Discussions led to a draft settlement agreement, which was with the Registrant for consideration when the present dispute was launched by the Complainant (through different attorneys). It is contended that it was open to the Registrant to seek expungement of the registration ACCESSFINANCE and if the Adjudicator follows the view that the registration must be given effect, he should suspend a decision in this matter until the Registrant has had an opportunity to bring an expungement application. Otherwise, it is submitted that the registrations of ACCESS and ACCESSFINANCE should be treated as generic, dead registrations, which remain on the register but which are devoid of any enforceable right.

3.2.12 That aside, the Registrant contends that there is nothing in the Regulations that constrains an adjudicator from going beyond the *prima facie* position, as it is submitted ought to happen. This is because there are some words it is not possible to register validly as a mark. These include a “laudatory epithet”, the name of the product, a word common to trade or a word appropriate to describe some attribute to the product. And, so the contention proceeds, ‘accessfinance’ is in the same category; it cannot be validly registered, and so the state of the Trade Marks Register should be ignored in the assessment.

3.2.13 Although domains can consist of non-distinctive words, it is (thus) contended that mere “ownership” of a “trade mark” that is generic, cannot make another person’s earlier claim to that mark as a domain name abusive.

3.2.14 However, the Registrant further submits, in the final analysis a domain name is not a trade mark, and something that cannot be registered as a trade mark may serve quite effectively as a domain name. In fact, it asserts, the most valuable domains are those which are the least apt to distinguish.⁷

3.2.15 In the end, the Registrant contends, the rational way of determining whether the Registrant’s registration is abusive is to ask whether the term “access finance”, standing alone, means “Standard Bank” to the average person. If it does not, and it is submitted that it plainly does not have that meaning, it must follow that the Registrant’s registration is not abusive.

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A number of examples are cited where such domains have been sold for huge sums of money.

4. Discussions and Findings

- 4.1 The ACCESSFINANCE mark is registered in the name of the Complainant. *Prima facie*, this mark is validly registered.⁸ The Adjudicator therefore finds that the Complainant has established rights as contemplated by Regulation 3(1)(a) read with Regulation 3(2).
- 4.2 The Adjudicator further finds that the domain <accessfinance.co.za> is identical to the Complainant's ACCESSFINANCE as contemplated by Regulation 3(1)(a). The Adjudicator finds that the name <axisfinance.co.za> is not identical or similar to the Complainant's mark, for the reasons discussed below. Therefore, the only question is whether the registration for <accessfinance.co.za> in the hands of the Registrant is an abusive registration.
- 4.3 Why is <axisfinance.co.za> not identical or similar? Only audially is there any similarity. However, this is insufficient to create similarity of the sort contemplated - one must have a holistic approach to the assessment.⁹ Semantically, the two marks have no relationship to each other. Visually, and (a not insignificant consideration in address-bar denominated user) they are typographically quite dissimilar.
- 4.4 Thus, the Adjudicator cannot find support for the Complainant's contentions about the name <axisfinance.co.za>. To accede to the submission, that it impinges upon the rights of the Complainant, would

⁸ cf. Section 51 of the Trade Marks Act 194/1993 - *"In all legal proceedings relating to a registered trade mark ... the fact that a person is registered as the proprietor of the trade mark shall be prima facie evidence of the validity of the original registration ..."*

⁹ Cf Bata Ltd v Face Fashions CC and Another 2001 (1) SA 844 (SCA) at paragraph [9].

afford the latter a monopoly (or, even, an extent of protection) not warranted. This would probably be so even if the mark 'accessfinance' was, inherently and factually, distinctive of the Complainant; yet, nevertheless, states of affairs which cannot be found on the present facts.

4.5 It follows that, insofar as the Complaint against <axisfinance.co.za> is concerned, it fails at the starting, and the requested transfer will be refused. With regard to <accessfinance.co.za> the considerations are different.

4.6 An abusive registration means 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.

4.7 The Registrant is required to prove on a balance of probabilities that the domain name is not an abusive registration.¹⁰

4.8 In terms of Regulation 4(1)(a), factors which may indicate that the domain name is an abusive registration include circumstances indicating that the registration was primarily to:-

4.8.1 transfer the domain name to a complainant for valuable consideration in excess of the Registrant's reasonable out-of-

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Regulation 5(c).

pocket expenses directly associated with acquiring the domain name;

4.8.2 block intentionally the registration of a name or mark in which the Complainant has rights;

4.8.3 disrupt unfairly the business of a Complainant;

4.8.4 prevent the Complainant from exercising its rights.

4.9 Here, the domain name is identical to the mark in which the Complainant has rights. The present proceedings are neither designed nor appropriate to settle disputes about trade mark rights, and issues in that regard,¹¹ and the Adjudicator declines the invitation by the Registrant to regard as *pro non scripto* the entry in the Trade Marks Register, and the import thereof. Indeed, to do so would be contrary to the provisions of Section 51 of the Trade Marks Act. In any event, the Registrant's contention runs contrary to the following dictum of Plewman JA in Luster Products:-¹²

“Neither in counsels’ written heads of argument nor in the judgment is there any discussion of the effect of the grant. In my view, a clear understanding of this is of fundamental importance.

In terms of the 1963 Act (‘the Act’ for the purposes of this judgment) a ‘trade mark’

¹¹

See ZA2009-0030 <seido.co.za> (Appeal Panel decision) at paragraphs 5.12 and 5.13.

¹²

Luster Products Inc. v Magic Style Sales CC 1997 (3) SA 13 (A) at 19 E. That the previous Trade Marks Act was under consideration is of no moment.

‘... means a mark used or proposed to be used in relation to goods or services for the purposes of –

- (a) indicating a connection in the course of trade between the goods or services and some person having the right, either as proprietor or as a registered user, to use the mark, whether with or without any indication of the identity of that person; and
- (b) distinguishing the goods or services in relation to which the mark is used or proposed to be used, from the same kind of goods or services connected in the course of trade with any other person.’

A registered mark must also satisfy the requirements of Section 10 and Section 12 of the Act and it is accordingly also necessary to quote the relevant portions of Section 10 and Section 12. In terms of Section 10, in order to be registrable in part A of the register, a trade mark –

‘... shall contain or consist of a distinctive mark.’

In terms of Section 12(1) ‘distinctive’ means

‘adapted, in relation to the goods ... in respect of which a trade mark is registered ..., to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods ... in the case of which no such connection

subsists, either generally or, where the trade mark is registered ... subject to limitations, in relation to use within those limitations.

- (1) In determining whether a trade mark is distinctive as aforesaid, regard may be had to the extent to which –
 - (a) the trade mark is inherently adapted to distinguish; and
 - (b) by reason of the use of the trade mark or of any other circumstance the trade mark is or has become adapted to distinguish.’

The mark then is the mark as depicted – that is the large or bold stylised alphabetical letter S in combination with the word ‘curl’ in capital letters. It is a ‘goods mark’. The mark must also be accepted as meeting the requirements of Section 10 and Section 12 – in particular as distinguishing the goods upon which it is used from the goods of other persons and as indicating a connection in the course of trade with appellant. It conferred on the appellant the right to restrain infringement of the mark under the provisions of Section 44(1)(a) and (b) of the Act (to which I will presently refer more fully.”

- 4.10 Until set aside, by expungement or revocation, the registration –and, therefore, the Complainant’s rights – stand.

4.11 The Adjudicator also does not accede to the request to stay a decision “until the Registrant has had an opportunity to bring an expungement application.” Van Dijkhorst, J stated the following in the Reliance matter¹³ in a similar regard:-

“I accept that I have a discretion to stay these proceedings pending the respondents’ application in terms of s14 of the Act, but at best for the respondents this discretion is to be exercised sparingly and in exceptional circumstances. *Fisheries Development Corporation of SA Ltd v Forgensen and Another; Fisheries Development Corporation of SA Ltd v AWF Investments (Pty) Ltd and Others 1979 (3) SA 1331 (W) at 1340 D – 1341 A*. There are no exceptional circumstances in this case. The law of trade marks will fall into desuetude should every infringer be allowed to defend himself by saying: I know that I am acting unlawfully, but bear with me; there is a possibility that my actions may become lawful. The proper course for such infringer would be to comply with the law and desist from infringing until the application to legalise such use is successful. I refuse a stay of proceedings.”

4.12 Clearly, the domain will block the registration by the Complainant of a domain bearing the name of its registered trade mark, although there is something to be said for the perspective that this consideration should not weigh that heavily when the Complainant has not sought to do so

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Abdulhay M Mayet Group (Pty) Ltd v Renasa Insurance Co. Ltd 1999 (4) SA 1039 (T) at 1048 H. The learned Judge’s reliance on the Fisheries Development Corporation case for the fact that a discretion exists was subject to discussion in Clipsal Australia (Pty) Ltd and Others v Gap Distributors and Others 2010 (2) SA 289 (SCA) at paragraphs [18] and [19], although the questions arising do not affect the principle.

for almost fifteen years. Nevertheless, *prima facie*, use of the domain is an infringement of the Applicant's statutory rights.

- 4.13 The Adjudicator's view is that the Registrant's explanation of its 'adoption' of the name for the domain raises unanswered questions. Why would the Registrant, a long-time participant in a very similar, if not the same field as the Complainant register a domain with the competitor's mark (distinctive or otherwise) before it has registered a domain with its own established name? And why "accessfinance", not "accesscash" or "accesstofinance" or "directaxisfinance"? Why has not one of the 740 enterprises with "access" in their names chosen "accessfinance" as a domain? Yet the Registrant, which does not have "access" in its name, has. Why would "accessfinance" be chosen, "*to complement the trade mark based domain name axisfinance*" when the Registrant's name is not "Access Finance" but Direct Axis?
- 4.14 Of course, the adjudication does not depend on satisfactory answers to all questions that may be so postulated, but the Complainant raises challenges about the Registration's intentions, and all of these may well be that type of question that "falls to be asked and answered."¹⁴
- 4.15 Furthermore, the fact that the mark "accessfinance" may (or may not; it does not require determination) be generic falls away as a consideration given the Registrant's own averment that effective domains can and do exist with non-distinctive names.
- 4.16 Given the papers before the Adjudicator, these aspects of the matter leave the Adjudicator with doubts about the Registrant's motive.

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cf Blue Lion Manufacturing (Pty) Ltd v National Brands Ltd 2001 (3) 884 (SCA) at paragraph [13], per Schutz JA.

- 4.17 The preponderance of these doubts is such that the Registrant does not, in the Adjudicator's view, discharge the onus. Consequently, it is found that the domain <accessfinance.co.za> is abusive as contemplated by the Regulations.

5. Decision

- 5.1 For the foregoing reasons the Adjudicator orders that the domain name <accessfinance.co.za> be transferred to the Complainant. The request for transfer in respect of <axisfinance.co.za> is refused.

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ADV OWEN SALMON

SAIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za