

## Decision

**[ZA2011-0078]**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2011-0078</b>
DECISION DATE:	<b>26 July 2011</b>
DOMAIN NAME	<b>foodnetwork.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>My Guys Family Trust/Mr Graham Johnson</b>
REGISTRANT'S LEGAL COUNSEL:	<b>Rademeyer Attorneys</b>
THE COMPLAINANT:	<b>Television Food Network, G.P. d/b/a "Food Network"</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Spoor &amp; Fisher</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>UniForum SA (CO.ZA )</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **31 May 2011**. On **01 June 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **01 June 2011** UniForum SA 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 **02 June 2011** In accordance with the Regulations the due date for the Registrant's Response was **04 July 2011**. The Complainant lodged a Supplementary Complaint on **23 June 2011**. The SAIPL formally notified the Registrant of the Supplementary Complaint on **27 June 2011**. The Registrant was asked whether an extension of the term for the Response was required The Registrant submitted its Response on **28 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 **29 June 2011**. In response to the Supplementary Complaint, the Registrant filed a Supplementary Response on **1 July 2011**. In response to a notification by the SAIPL that the Supplementary Response was administratively deficient, the Registrant filed an amended Supplementary Response to the dispute on **5 July 2011**. The SAIPL verified that the Supplementary Response satisfied the formal requirements of the Regulations and the SAIPL's Supplementary Procedure. The SAIPL forwarded a copy of the Supplementary Response to the Complainant on **5 July 2011**.
- c) In accordance with the Regulations the due date for the Complainant's Reply to the Primary Response was **6 July 2011**. The due date for its Reply

to the Supplementary Response was **8 July 2011**. The Complainant submitted its Reply on **6 July 2011**. It submitted its Supplementary Reply on **8 July 2011**.

- d) The SAIPL appointed Victor Williams as the Adjudicator in this matter on **14 July 2011**. 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

- a) The Complainant is Television Food Network, G. P. d/b/a “Food Network”, the general partnership organised under the State of Delaware, United States.
- b) The Registrant in these proceedings is My Guys Family Trust, Mr. Graham Johnson. The Registrant registered the domain name foodnetwork.co.za on 12 September 2006. At the date of filing the dispute, this domain name pointed to the website attached to the domain name cookbook.co.za, which provides recipes.
- c) The Complainant has, for over 10 years, been engaged in the business of creating products and services in the cooking and culinary arts industry, including cable television broadcasting services and the provision of culinary arts information online through its website, linked to the domain name foodnetwork.com.
- d) The Complainant made its television airing debut in 1993 under the trade mark “TV Food Network”. In 1996, the “TV” was dropped from the mark, and the channel was referred to as “Food Network”.
- e) The Complainant has expanded its services internationally. It has been licensed for airing in 138 territories. It has registered trade marks incorporating and consisting of “Food Network” in the United States, Canada and Europe. Its repute has been recognised, inter alia, by the WIPO

Arbitration Centre.

- f) The Registrant ads its television channel in South Africa through DSTV, a cable provider in South Africa, since 2010.

### 3 Parties' Contentions

#### 3.1 Complainant

- a) The Complainant submits that it, its partners, licensed affiliates, subsidiaries and related companies, have, for in excess of 14 years, created products and services in the cooking and culinary arts industry. These include broadcasting services through cable television and the provision of culinary arts information on-line, through a website hosted at [www.foodnetwork.com](http://www.foodnetwork.com).
- b) The Complainant's television airing debut was in 1993, at which time it was called "TV Food Network". By 1996, the "TV" was dropped from the mark, and the channel was advertised as "Food Network".
- c) Food Network branded programming is licensed for airing in 138 territories (including South Africa). It is one of the largest television networks devoted to cooking and culinary arts in the world.
- d) Food Network is a well known mark. Indeed, the Complainant submits that consumers the world around associate the trade mark "Food Network" solely and exclusively with television food network products.
- e) The Complainant is the proprietor of various trade mark registrations, comprising or incorporating "FOOD NETWORK", in Europe, America and Canada.
- f) The Complainant submits that the Respondent has no legitimate interest in the domain name foodnetwork.co.za. The Respondent is unrelated to the Complainant and its sole purpose in registering the

domain name was to unfairly disrupt the business of the Complainant and prevent the Complainant from exercising its rights in its registered trade mark as a domain name.

- g) The Complainant, in addition, mentions that the Registrant was willing to sell the domain name to an agent that was instructed to approach it on the Complainant's behalf.

### 3.2 Registrant

- a) The Registrant submits that the Complainant's television channel first aired in South Africa in 2010, and that FOOD NETWORK was not a household name in South Africa before that time. Indeed, that the average South African consumer knew nothing of Food Network before that date.
- b) The Registrant submits that the Complainant has no trade mark applications or registrations in South Africa. It had no right in South Africa prior, possibly, to 2010.
- c) The Registrant submits that, when it registered its domain name in 2006, it had a bona fide intention to create a food network (a central website that would provide links to other web pages, each pertaining to a particular food type). At the time, Mr. Johnson/the Registrant had no knowledge of the Complainant.
- d) As a result of a lack of funding, the Registrant was unable to launch the proposed electronic food network, but it had the intention to do so in the future. In the interim, it directed traffic from the domain name foodnetwork.co.za to the website linked to another of its domain names, cookbook.co.za, on which one can access recipes.
- e) When the Registrant was contacted to enquire about the possible purchase of the domain name foodnetwork.co.za, on 3 May 2011, Mr Johnson advised the party making enquiries that foodnetwork.co.za

was intended for future development and was not for sale. He had responded to the effect that the domain name was for sale when he received similar enquiries in March 2011.

- f) The Registrant denies that the foodnetwork.co.za domain name is abusive. He denies that the registration was made in bad faith and denies that the domain name was acquired with the purpose of selling it to the Complainant later at an exorbitant price.

#### 4 Discussion and Findings

- a) In terms of the Regulations, in order to succeed, a Complainant must prove, on a balance of probabilities, that the Complainant has rights in respect of a name or mark which is identical or similar to the domain name and, that the domain name is an abusive registration in the hands of the Registrant.
- b) The Complainant acknowledges that it had no statutory rights in its Food Network trade mark in South Africa at the time that the Registrant registered the domain name complained of.
- c) The Complainant submits that this is not fatal to its argument as the regulations that guide the findings in this type of matter provide 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”. (the Adjudicator’s emphasis). It accordingly submits that the reputation of its FOOD NETWORK trade marks and registered rights that it holds in the trade mark in other countries are sufficient to qualify as rights upon which it may lodge the complaint.
- d) Reference is made, by the Complainant, to the WIPO decision DN2000-1840 (First American Funds, Inc v Ult.Search, Inc), in which, inter alia, it was stated that a “gTLD name serves as an address and is not limited either with respect to geography of (sic) field of use”. A gTLD is a generic Top Level Domain. These TLDs are not country specific and can be registered internationally. gTLDs include .com, .net, .org, .gov, .mil, .edu, .biz, .info,

.name, .pro, .museum, .aero and .coop. It is a TLD with three or more characters that does not correspond to any country code. The findings in this matter are, accordingly, in the Adjudicator's view, irrelevant in a matter where ownership of a .co.za domain name is in dispute. A .co.za domain name is country specific, and one is obliged to take into account the rights and legal framework in that country when assessing disputes in the .co.za domain space.

- e) The question is thus what rights did the claimant have in the trade mark FOOD NETWORK in South Africa in 2006, when the domain name was registered? It is common cause that there were no statutory trade mark rights. The Claimant claims it had made extensive use of the trade mark FOOD NETWORK in many other jurisdictions by that date, but has provided no evidence of any of that reputation reaching the shores of South Africa. No evidence of any advertising in this country has been presented. The Complainant has given no evidence of numbers of "hits" on its foodnetwork.com website by South African users prior to the date of registration of the domain name foodnetwork.co.za. The Complainant does not claim to have any other type of rights. The Adjudicator's view is therefore, that the answer to that question must be that the Complainant did not have any rights in South Africa at the date of registration of the domain name.
- f) The Complainant submits that not even that fact is fatal to its case. It submits that the definition of an abusive registration includes a domain name that may not have been abusive at the time of registration, but has been used in a manner that takes unfair advantage of or is unfairly detrimental to the Complainant's rights. The Adjudicator agrees with this interpretation.
- g) The Registrant claims to have registered the domain name foodnetwork.co.za with the view to using it in relation to a site that contains links to a number of other web pages, each pertaining to a particular food type. It ran into financial difficulties and so had to put the project on hold. The Registrant claims that it never lost interest in the idea of using the

domain name to create a network of different recipes of different types of foods, so merely directed traffic through the domain name foodnetwork.co.za to the site linked to another of its domain names, cookbook.co.za.

- h) The Respondent's argument seems plausible. There is nothing on the website to which foodnetwork.co.za traffic is directed that suggests any affiliation to the Complainant. The domain name FOOD NETWORK is descriptive, although, admittedly, the Complainant has established secondary rights therein through extensive use, advertising and promotion. It is, however, not unthinkable that a party that is unaware of the Complainant's use may stumble upon the mark Food Network unaided by any knowledge of the Complainant and its reputation.
- i) Domain names in the .co.za domain space are registered on a "first-come-first-served" basis. Accordingly, prima facie, when the Registrant registered the domain name foodnetwork.co.za in 2006, it acquired ownership rights in an asset (the domain name).
- j) The Complainant submits that the Respondent's response to an email enquiry to the effect that the domain name is for sale is an indication that the domain name has been used in an abusive manner. The Adjudicator's attention was drawn to the decision in the matter General Machine Products Company, Inc. v Prime Domains (a/k/a Telepathy, Inc.), Forum File FA0001000092531, in which it was found that the fact that the Registrant did not seek to sell the domain name to the Complainant, but where the Registrant was approached by an agent soliciting an attempt to sell, the offer to sell does not indicate bad faith on the part of the Registrant. The Adjudicator agrees with this finding; and may the Adjudicator be so bold as to say that all things are for sale if a high enough price is offered therefor. It is also not unusual for a seller to increase the price of an item as he becomes aware of the value that that item holds.
- k) The Adjudicator finds, for the reasons set out above, that the Complainant

has failed in its task to prove that it held rights in its FOOD NETWORK trade mark in South Africa prior to 2010, and also failed to prove that the Registrant is using the domain name foodnetwork.co.za in a manner that has become abusive.

**5. Decision**

- a) For the foregoing reasons, the Dispute is refused.

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**VICTOR WILLIAMS**  
SAIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)