

Decision

ZA2011 - 0081

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011 - 0081
DECISION DATE:	05 August 2011
DOMAIN NAME	hipoo.co.za
THE DOMAIN NAME REGISTRANT:	Dominic Fisser
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Telesure Investment Holdings (Pty) Limited
COMPLAINANT'S LEGAL COUNSEL:	Tyrone Walker, Moore Attorneys
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **8 June 2011**. On **8 June 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **10 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 **10 June 2011**. In accordance with the Regulations, the due date for the Registrant’s Response was **12 July 2011**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **13 July 2011**.
- c) The SAIPL appointed **Gérard du Plessis** as the Adjudicator in this matter on **21 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 following factual allegations are undisputed and, as these allegations do not appear to be implausible for any reason, the Adjudicator accepts them for the purposes of this adjudication.
- b) The Complainant is Telesure Investment Holdings (Pty) Limited and is part of an international financial services group that houses leading insurance brands in South Africa.
- c) The Complainant is the proprietor of various trade marks incorporating the mark HIPPO. Copies of the registration certificates for these marks were attached to the Complaint.
- d) The Complainant also registered the domain name hippo.co.za and operates the website situated at www.hippo.co.za . This website provides an electronic

platform that facilitates the aggregation of short-term domestic insurance quotes from various insurers and insurance brokers. This allows consumers to compare insurance premiums.

- e) The Complainant became aware of the disputed domain name, hipoo.co.za, on 31 January 2011. The domain name resolved to a website that advertised similar products and services to those of the Complainant.
- f) The Complainant then instructed its attorneys to address a letter of demand to the Registrant, demanding the transfer of the domain name to the Complainant's subsidiary, Upstream Advertising (Pty) Limited.
- g) The letter of demand, dated 11 February 2011, was sent to the Registrant's postal address and e-mail address, as provided in the WHOIS records for the relevant domain name.
- h) The Complainant received no response to this letter and various follow-up e-mails were sent to the Registrant. The Complainant did not receive any response to the subsequent communications.
- i) On 30 March 2011, the Complainant became aware that the disputed domain name was redirected to a pornographic website situated at www.xnxx.com.
- j) Thereafter the Complainant lodged the present complaint.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant is the proprietor in South Africa of trade mark registrations incorporating the mark HIPPO. These include trade mark registrations nos. 2008/29259-60 HIPPO in classes 36 and 38 and 2008/29261 HIPPO device in class 38. The Complainant also filed trade mark applications nos. 2008/29262-3 HIPPO logo in classes 36 and 38.
- b) The Complainant contends that it enjoys extensive common law rights in its HIPPO trade marks as a result of extensive advertising and promotion.

- c) In addition, the Complainant submits that its domain name hippo.co.za is also well-known in the market place due to the extensive exposure it has received as a result of advertising.
- d) The Complainant further submits that the disputed domain name, hipoo.co.za, is visually and phonetically similar to the Complainant's registered trade marks and its hippo.co.za and hipo.co.za domain names.
- e) It is also submitted that the use of the domain name hipoo.co.za amounts to typo squatting.
- f) The Complainant contends that the registration and use of the disputed domain name by the Registrant amounts to an abusive registration. In support of the above contention the Complainant relies on the following factors:
- the disputed domain name was registered primarily to block the registration of a name or mark in which the Complainant has rights;
 - the disputed domain name was registered or otherwise acquired in a manner which, at the time that the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights;
 - the Registrant has registered and used the disputed domain name to trade off the goodwill and reputation of the Complainant's trade marks and domain name;
 - the disputed domain name has been used in a manner that is unfairly detrimental to the Complainant's rights as it is similar to the Complainant's trade marks;
 - the disputed domain name was registered primarily to sell, rent or otherwise transfer the domain name to a third party, for

valuable consideration in excess of the Registrant's out-of-pocket expenses directly associated with acquiring or using the domain name;

- the registration of the disputed domain name unfairly disrupts the business of the Complainant;
- the registration of the disputed domain name prevents the Complainant from exercising its rights in its HIPPO trade marks, in that the Complainant is prevented from registering the offending domain name;
- the Registrant has registered the disputed domain name in a manner that leads people to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant;
- the domain name resolves to a pornographic website that has no HIPPO branding and is detrimental to the Complainant.

3.2 Registrant

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

4 Discussion and Findings

4.1 Complainant's Rights

- a) The Adjudicator is of the view that the Complainant has indeed shown that it owns rights in respect of the trade mark HIPPO. The Complainant has registered rights in its HIPPO trade marks. The Complainant also submitted that its HIPPO trade marks are well-known and the Adjudicator has no reason to question this assertion.
- b) The Complainant further submitted that the registration of the disputed domain name amounts to typo squatting. In the WIPO decision D2010 – 1502 (La Touraine, Inc. d/b/a Naughty America v Texas International Property Associates) it was found that altering a mark by one letter

(adding or removing a letter) is not enough to escape a finding of similarity and it does not change the impression that designation is connected to the trade mark of the Complainant. The Adjudicator agrees with this approach.

- c) In this instance, the Respondent registered a domain name in which the Complainant's HIPPO trade mark was amended merely by the substitution of the letter "P" with the letter "O". The Adjudicator also took note of the fact that, on a standard QWERTY keyboard, the letters "O" and "P" are located right next to each other. In the circumstances, the Adjudicator finds that the disputed domain name hipoo.co.za is confusingly similar to the Complainant's HIPPO trade marks and that the Respondent's conduct amounts to typo squatting.
- d) The Complainant has, therefore, established that it has rights in respect of the trade mark HIPPO and that the offending domain name is similar to the Complainant's HIPPO trade marks.

4.2 Abusive Registration

- a) The registration of the disputed domain name is a form of typo squatting. The effect (see D2010 – 1502 referred to above) is that users looking for the Complainant's website can easily mistype the domain name and be diverted to the website of the Registrant. This allows the Registrant to capitalise on the Complainant's established HIPPO trade marks and hipoo.co.za domain name.
- b) The disputed domain name is similar to the registered trade marks of the Complainant and the Adjudicator finds that the disputed domain name is capable of creating the impression that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- c) The Complainant further submitted that the disputed domain name initially resolved to a website that advertised similar products and services to those of the Complainant. In the absence of any evidence, to

the contrary, the Adjudicator accepts that this was indeed the case.

- d) The disputed domain name can be regarded as a variation of the Complainant's registered trade marks. In various foreign (see NA/FA 95402, *ESPN, Inc v Players Sportsbook & Casino*) and local decisions (see ZA2008 – 0022, *Samsung Electronics Co. Ltd v Sean Elseworth*) it has been accepted that a disruption of the Complainant's business may be inferred if the disputed domain name is a variation of the Complainant's mark. In the circumstances, the Adjudicator finds that the registration of the disputed domain name will unfairly disrupt the Complainant's business and interfere with the exercise of its rights.
- e) The disputed domain name presently resolves to a pornographic website. This was seemingly done after the Complainant's attorneys sent a letter of demand and various follow-up e-mails to the Registrant. In FA 95261 (*Mick Jagger v Denny Hammerton*) it was found, with reference to FA 94243 (*Youtv, Inc v Almedar*), that the Registrant acted in bad faith by registering a domain name that was identical to the Complainant's mark and linking that domain name to a pornographic website, which was in no way associated with the Complainant. The Adjudicator finds that the same can be said of the Respondent in this instance.
- f) In the circumstances, the Adjudicator finds that the Registrant is presently using the disputed domain name in bad faith by linking it to a pornographic website that is not associated or affiliated with the Complainant.
- g) There is also no explanation why the disputed domain name was chosen and why it is now linked to the website situated at www.xnxx.com
- h) Accordingly, the Adjudicator finds that the registration, in the hands of the Registrant is abusive. The disputed domain name was registered in a manner, which at the time the registration took place, took unfair advantage of the Complainant's rights. The disputed domain name is

also used in a manner that takes unfair advantage of the Complainant's rights, and it is unfairly detrimental to its rights.

- i) The Complainant alleged that the domain name hipoo.co.za was registered primarily to sell, rent or otherwise transfer the domain name to a third party, for valuable consideration in excess of the Registrant's out-of-pocket expenses directly associated with acquiring or using the domain name. No evidence of such intention on the part of the Respondent has been produced and the Adjudicator cannot find that the domain name was registered for this purpose. However, in light of the earlier findings of the Adjudicator, a finding on this aspect of the matter is not necessary.

5. Decision

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

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GÉRARD DU PLESSIS
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za