

Decision

[ZA2017-0287]

.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0287
DECISION DATE:	4 December 2017
DOMAIN NAME	krazidoors.co.za
THE DOMAIN NAME REGISTRANT:	Mrs Yvonne Els
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	Dorhold (Pty) Ltd –First Complainant Krazi Door (Pty) Ltd – Second Complainant
COMPLAINANT'S LEGAL COUNSEL:	Moore Attorneys (Tyrone Walker)
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry (CO.ZA)

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** the 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. 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 **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, the SAIPL notified the Registrant of its default on **9 November 2017**.
- c) Given that the Registrant did not submit any response, the Complainants did not need to submit any Reply.
- d) The SAIPL appointed **Kelly Thompson** as the Adjudicator and **Nicole Smalberger** as the trainee adjudicator in this matter on **14 November 2017**. The Adjudicators have submitted the Statements 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

- 2.1 This Complaint is in respect of the domain name **krazidoors.co.za**. The domain name was registered on 1 November 2013. The First Complainant is described in paragraph 3.1.1 of the Complaint as Dorhold (Pty) Ltd, a company incorporated according to the company laws of the Republic of South Africa and having its principal place of business at 655 Old Main

Pretoria Road, Wynberg, Johannesburg. The Second Complainant is described in paragraph 3.1.2 of the Complaint as Krazi Door (Pty) Ltd, a company duly incorporated according to the company laws of the Republic of South Africa and having its principal place of business at No. 20 1st Avenue, Dunvegan, 1609. The Second Complainant is a sister company of the First Complainant and is licensed and authorised by the First Complainant to use the KRAZI DOORS trade marks.

- 2.2 The First Complainant is the registered proprietor of the trade mark KRAZI DOORS in classes 6, 19, 35 and 37 in South Africa.
- 2.3 The Second Complainant was incorporated in 1996, but has been in the business of manufacturing and distributing garage doors and related products for over 30 years. The First Complainant registered the domain name *krazidoor.co.za* in 2008. The Second Complainant has hosted its website at this domain, and made use of the marks KRAZI DOOR and KRAZI DOORS on its website, for almost ten years.
- 2.4 The Second Complainant describes itself as a leader in the garage door industry. It has expended both time and money in the promotion of its business under the KRAZI DOORS trade mark. It relies upon marketing expenditure between 2014 and 2017, which it claims has been in the region of R470 000.00, as evidence of this.
- 2.5 In January 2017, the Complainants became aware of the disputed domain name. The Complainants do not mention any correspondence having been entered into with the Registrant, or what transpired between their learning of the disputed domain name and the filing of the subject complaint. They do state, however, that on a review of the Registrant's website, it was ascertained that the Registrant provides competing services, identical to those of interest to the Complainants. The Complainants have provided printouts from the Registrant's website as evidence of this and this evidence is uncontested.

3 Parties' Contentions

3.1 Complainant

The contentions set out in the founding evidence of the Complainants can be summarised as follows:

3.1.1 The First Complainant, through its sister company, the Second Complainant, has promoted, manufactured and sold its KRAZI DOORS products and provided related services for many years. Indeed, the Second Complainant contends that it has been involved in the manufacture and distribution of garage doors and related goods for over 30 years.

3.1.2 The Second Complainant claims to be a leader in the garage door industry and to have promoted the KRAZI DOORS brand by way of various advertising initiatives, social media platforms, print media and radio.

3.1.3 The Complainants contend that the contested domain name incorporates the KRAZI DOORS trade mark, that the Registrant, apparently a direct competitor of the Complainants, could not have been unaware of the Complainants' KRAZI DOORS name and marks at the time of registering the contested domain name, and that the contested domain name has been registered in bad faith and with the intention of infringing the KRAZI DOORS trade mark for financial gain.

3.1.4 Regulation 4 sets out a (non-exhaustive) list of circumstances which may indicate that a domain name is abusive. The Complainants have relied upon Regulation 4 in making the contention that the Registrant has registered the contested domain name primarily to:

- block intentionally the registration of a name or mark, in this case, the domain name ***krazidoors.co.za***, in which the

Complainants contend they have rights;

- disrupt unfairly the business of the Complainants;
- prevent the Complainants from exercising rights in and to the domain name **krazidoors.co.za**;
- lead people or business to believe that the contested domain name is registered to, operated or authorised by, or otherwise connected to the Complainants;
- attract internet users to the contested domain name for financial gain; and
- be used in a manner which takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

3.1.5 The Complainants' contentions are therefore, with reliance on Regulation 3(1)(a), that the contested domain name **krazidoors.co.za** is identical or similar to a name or mark in which they have rights and that the domain name **krazidoors.co.za** is an abusive registration in the hands of the Registrant. These contentions are discussed more fully below.

3.2 Registrant

- a) The Respondent did not file a response and therefore did not reply to the Complainants' contentions.

4 Discussion and Findings

- a) In order to succeed under Regulation 3(1)(a), the Complainants are required to prove, on a balance of probabilities, that:
 - they have rights in respect of a name or mark;
 - the name or mark is identical or similar to the contested domain name; and
 - the domain name in the hands of the Registrant is an abusive registration.

For the reasons set out below, it is the Adjudicator's view that the contested domain name is contrary to the proven rights of the Complainants and amounts to an abusive registration in the hands of the Registrant.

4.1 Complainant's Rights

4.1.1 The term "rights" is broadly defined in Regulation 1. "Rights" and "registered rights" are stated to include, *inter alia*, intellectual property rights and commercial rights.

4.1.2 The First Complainant is the proprietor of trade mark registrations nos2010/27047-50 KRAZI DOORS in classes 6, 19, 35 and 37. It relies upon extracts from the Register of Trade Marks as evidence of these registrations, which the Adjudicator accepts as *prima facie* evidence of its registered trade mark rights. It also enjoys rights in the domain name, krazidoor.co.za, which it registered in 2008, and which it can rely upon in terms of the Regulations to object to the contested.

4.1.3 The Second Complainant enjoys rights in the company name Krazi Doors (Pty) Ltd, and the trading name(s) Krazi Door(s), which it has used for many years.

4.1.4 The Complainants have put forward evidence in support of the abovementioned rights, which evidence has not been disputed by the Registrant. Insofar as the Second Complainant's marketing spend is concerned, reliance is strangely made upon an email from a candidate attorney at an attorney's firm, with no stated or apparent personal knowledge of the Second Complainant's business or the figures in question. However, even without this evidence, the Adjudicator is satisfied that the evidence shows, *prima facie*, that the Complainants own and enjoy both registered and common law rights in the KRAZI DOORS name and mark and that they therefore also have the necessary *locus standi* to bring this complaint.

4.1.5 The contested domain name is identical to the First Complainant's KRAZI DOORS trade mark. The Second Complainant, as mentioned above, relies upon its use of the name and marks KRAZI DOOR and KRAZI DOORS, for many years. The contested domain name is also almost identical to the First Complainant's domain name, *krazidoor.co.za*, but for the addition of an "s". There are many precedents to the effect that domain names which wholly incorporate a trade mark, with the addition of other non-distinctive matter, such as the letter "s" *in casu*, are identical or similar to the trade mark. In this regard, the Adjudicator refers to South African domain name matter no. **ZA2016-00248**, which is of particular relevance, and in which the domain name *timeslives.co.za* was held to be confusingly similar to TIMES LIVE. The addition of an "s" does not distinguish *krazidoors* and *krazidoor*. The contested domain name, *krazidoors.co.za*, is identical to the registered trade mark KRAZI DOORS. The Adjudicator is, in the circumstances, satisfied that the contested domain name is identical and/or similar to marks and names in which the Complainants enjoy rights.

4.2 Abusive Registration

4.2.1 An abusive registration means a domain name which either:

- was registered or otherwise acquired in a manner which, at the time when the registration took place, took unfair advantage or, was unfairly detrimental to, the Complainant's rights; or
- has been used in a manner which takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

4.2.2 Regulation 5(c) states:

"The burden of proof shifts to the Registrant to show that the domain name is not an abusive registration if the domain name (not including first and second level suffixes) is identical to the mark in which the

Complainant asserts rights, without any addition.”

Although the above provision is stated within the context of Regulation 5(c), it was accepted in South African domain name matter no. **ZA2007-0007**, which dealt with the domain name *fifa.co.za*, that the apparent meaning is to operate as shifting the overall burden of proof to the Registrant in instances where the contested domain name is identical to the Complainant’s mark.

The name forming the contested domain name is the mark KRAZI DOORS which is identical to the First Complainant’s trade mark registration. The Adjudicator has accepted that, when the Registrant registered the contested domain name in 2013, the Complainants had already registered and used the identical name and trade mark KRAZI DOORS for many years. The shifting of the burden of proof disposes of this matter since the Registrant has not responded to this complaint. Nevertheless, the Adjudicator has considered the matter on its merits, irrespective of the shift in onus.

4.2.3 There are various decisions which make it clear that a “positive intention” to abuse the rights of the Complainant is not necessarily required. Rather, the abuse can be an effect or consequence of the registration of the contested domain name. South African domain name matter no. **ZA2007-0007** is again referred to in this regard. Nevertheless, the Complainants allege that there has indeed been a positive intention on the part of the Registrant to abuse their rights in registering the contested domain name.

4.2.4 The Complainants have provided evidence that the Registrant has used the domain name **krazidoors.co.za** in relation to the very goods and services of interest to the Complainants and that her business is therefore a competitor of the Complainants. The Registrant has not responded to these allegations and there is no evidence to the contrary before the Adjudicator.

4.2.5 It is not a far-fetched notion that an internet user, seeking to view the Complainants' website at www.krazidoor.co.za, may by way of a typing error, or mistaken belief that the Complainants' website is hosted at www.krazidoors.co.za, given the Complainants' use of the KRAZI DOORS trade mark, access the Registrant's website instead and unwittingly take their business to the Registrant when they had intended to engage the Complainants. The circumstances suggest that the Registrant may very well have had a positive intention to use its domain name abusively in order to syphon business away from her competitors, the Complainants, or to ride off the Complainants' goodwill and thereby draw business to herself. It also goes without saying that the Complainants cannot, as they have contended, register or exercise any rights in the domain name ***krazidoors.co.za*** while it is registered in the name of the Registrant. This limits the Complainants' use of the registered KRAZI DOORS trade mark. The detriment to the Complainants' rights is clear. The Adjudicator is, in light of the above, satisfied that the contested domain name, in the hands of the Registrant, amounts to an abusive registration.

4.3 **Offensive Registration**

4.3.1 Not applicable.

5. **Decision**

5.1 The Adjudicator finds that the Complainants have shown, on a balance of probabilities, that they have rights in trade marks and names identical or similar to the contested domain name, and that the contested domain name is an abusive registration in the hands of the Registrant. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, ***krazidoors.co.za*** be transferred. Since the Complainants have not indicated to which of them they would prefer the domain name to be transferred, the Adjudicator orders that the domain

name be transferred to the First Complainant, being the owner of the registered trade mark and prior domain name.

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