

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0283
DECISION DATE:	15 November 2017
DOMAIN NAME	mandela100.co.za
THE DOMAIN NAME REGISTRANT:	Ken Msuku
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	The Trustees for the time being of the Nelson Mandela Foundation Trust
COMPLAINANT'S LEGAL COUNSEL:	ENS Africa – Delene Bertaso
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 "SAIPL") on **18 September 2017**. On **20 September 2017** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the mandela100.co.za ("Disputed Domain Name") at issue, and on **20 September 2017** ZACR confirmed that the Disputed 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 **21 September 2017**. In accordance with the Regulations the due date for the Registrant's Response was **20 October 2017**.
- c. On **22 September 2017** Mr Harry Chakhala ("Mr Chakhala") addressed a letter to the Administrator advising, amongst others, that:
 - He was the legal custodian of the Disputed Domain Name;
 - The Dispute is totally vexatious and not worth any attention;
 - The Disputed Domain Name is neither linked to the late Mr Nelson Mandela ("Mr Mandela"), his trademark, nor associated to the Nelson Mandela Foundation activities/records/information/events;
 - There were approaches, including from the Complainant, to transfer the Disputed Domain Name to it against payment ranging from R5,000.00 to a R1,000,000.00. The offers were all rejected;
 - The Disputed Domain Name was registered with a view to it being used by a family member;
 - To associate the word "Mandela" with the late Mr Mandela or the Complainant is unjust and frivolous; and
 - Denying the allegations contained in the Dispute.

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- d. On **22 September 2017** the Administrator advised Mr Chakhala that in order to respond to the Dispute filed against the Registrant, it is necessary to submit a Domain Dispute Response ("Response") document as *per* regulation 18 of the Alternative Dispute Resolution Regulations ("Regulations"). The Administrator also provided Mr Chakhala with website links to the Regulations and guidelines on how to file a response.
- e. Mr Chakhala, on **3 October 2017**, identified himself as a "*family representative*" and advised the Administrator *inter alia* that:
- "*As a family, we have identified a person to assist respond to the allegations made by the Complainant regarding our domain mandela100.co.za*";
 - "*Our position is that the complaint is self-created and it does not deserve any honour*";
 - "*We do not have money to formalise the appointment for legal assistance*"; and
 - "*We have received a quotation of R15000.00 for initial legal fees. We have a family gathering end of this October and once the money is gathered, we shall proceed to advise due date of our submissions in response to this unwarranted and unjust complaint. While we are raising the funds, it's important that the matter is not adjudicated until our formal response is properly served*".
- f. On **9 October 2017** the Administrator informed Mr Chakhala that should he require an extension of the response deadline, it will be necessary to submit a formal request.
- g. On **10 October 2017** Mr Chakhala requested the Administrator to explain what a formal request is and to provide him with a sample of such a request. Mr. Chakhala also advised that "*Unless SAIPL is able to assist with funds...then you can demand our commitment. Other than this, once our counsel is appointed, he/she will formally submit to SAIPL processes*".
- h. On **10 October 2017** the Administrator advised Mr Chakhala as follows:

"A formal request would be an email that specifies the new date you would like the response deadline to be extended to. It should also include the reasons for requesting for an extension. Please also note that we will evaluate your requested date first and approve accordingly.

With regards to funds assistance please go to "<http://www.domaindisputes.co.za/content.php?tag=17>", check number 4."

- i. On **23 October 2017** the Administrator issued a notice to all parties confirming that in the absence of a Response from the Registrant, as required by the provisions of Regulation 18, the Registrant is in Default and an Adjudicator will be appointed to adjudicate the Dispute. The Administrator also invited the Registrant to, in the event that a Response had, indeed, been submitted, to contact the Administrator, immediately.
- j. On **30 October 2017** Mr Chakhala addressed a letter to the Administrator in which Mr. Chakhala, advised, amongst others, as follows:
 - *"It seems you are been pressurised to fast track this matter without waiting for our detailed response";*
 - *"You have not respond to two of my emails requesting you to forward a sample of an official application for extension";*
 - *"You were informed of our position to raise funds in order to hire a legal counsel to represent this contention of non-existence dispute";*
 - Accusing the Administrator of denying "us" from their right to legal representation;
 - *"We have hired Adams & Adams and are awaiting allocation of a legal counsel to attend to this matter";* and
 - Demanding that the process be stopped immediately.
- k. On **31 October 2017**, the Administrator advised Mr. Chakhala, amongst others, that the SAIPL was in the process of appointing an adjudicator and will request the Adjudicator to make a ruling on the request for the extension within which to file a Response.

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- l. The SAIPL appointed **Deon Boucher** as the Adjudicator, also on **31 October 2017**, and instructed the Adjudicator to also consider the request for an extension the period within which to file a Response. The Adjudicator has submitted a Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.
- m. On **3 November 2017** the Adjudicator confirmed to the Administrator that he will be considering the request for an extension even though there is merely an informal request to hold the matter over. The Adjudicator, in an attempt to ensure that each party was given a fair opportunity to present its case, instructed the Administrator to enquire from the Registrant if he wishes to put facts before the Adjudicator to support the extension request, including until when an extension is required, and if so, to submit such facts by no later than close of business on **8 November 2017**.
- n. On **3 November 2017** the Administrator advised the Parties accordingly and advised Mr. Chakhala that, should he wish to proceed further with the matter, to advise on what basis he is entitled to respond to the Dispute on behalf of the Registrant.
- o. On **5 November 2017** Mr Chakhala addressed a letter to the Adjudicator in which he, amongst others, advised that:
- *"He has a legal right to represent our Stokvel as the present Chairman";*
 - *"The domain was obtained in 2013 and is reserved for our family stokvel which has been in existence over 15 years";*
 - *"Our legal counsel will provide evidence to that effect during response to the complaint by the 30 November 2017";* and
 - *"We are a family stokvel of 100 under privileged members with limited resources for funeral and family culture activities".*

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- p. On **6 November 2017** the Adjudicator requested the Complainant to respond to the response received from Mr Chakhala dated **5 November 2017** before close of business on **9 November 2017**.
- q. On **9 November 2017** the Complainant submitted a comprehensive response in which it advised *inter alia* as follows:
- *"It is important to note that the domain name complaint was filed on 18 September 2017, whereafter and on 21 September 2017 the registrant was duly notified of the complaint by the Domain Name Administrator, which notification clearly indicated that the deadline for the registrant's response was 20 October 2017";*
 - The e-mails originating from the Administrator could not have been clearer and, unequivocally, stated what the Registrant had to do to obtain an extension;
 - The Registrant or his representative failed to submit a formal request for an extension, timeously;
 - The Registrant has flagrantly disregarded for the domain name complaint process;
 - The submission by Mr Chakhala that Adams & Adams have been retained but that he is waiting allocation of a legal counsel to attend to this matter is particularly strange given that Adams & Adams, being undoubtedly familiar with domain name complaints and the deadlines involved in the process, would act fairly swiftly in the process and, also, that Adams & Adams is the legal representative for some of the trustees for the time being of the Nelson Mandela Children's Intellectual Property matters;
 - The aforementioned casts dispersions on the *bona fides* of the Registrant and Mr Chakhala, and the time lapses between e-mails from the Domain Name Administrator and Mr Chakhala's responses, is indicative of the Registrant's intention to deliberately and unduly delay this matter to the extent that he is obstructing the due process in this matter;

- Mr Chakhala's e-mail of 5 November 2017 is devoid of any reason/s, whatsoever, to support the grant of the extension. There are no valid and cogent reasons advanced in the e-mail for granting the extension requested until 30 November 2017. The Registrant also failed to take the Adjudicator into his confidence and indicate what exact steps he has taken towards preparing a response so far and what progress has been made in appointing legal representation.
 - Mr Chakhala's e-mail of **5 November 2017** also fails to set out a *prima facie* defence to the domain name complaint but rather provides unsubstantiated allegations, which allegations, even if they were substantiated, are without any merit, but simply comprise of disparaging comments concerning the Complainant which the Complainant submits are unnecessary and unwarranted; and
 - Requested that the extension be denied.
- r. On **12 November 2017** it appeared from correspondence sent by Mr Chakhala to the Domain Registrar, Hetzner (Pty) Ltd, in which correspondence the Adjudicator, as well as the Complainant's legal advisor, was copied, that Mr Chakhala had, on 3 November 2017, requested the Domain Registrar to transfer the Disputed Domain Name, as well as various other domain names, such as vodaapp.com, telkomapp.com, mtnapp.co.za, vodaapp.co.za, telkomapp.co.za, yomtn.com, yoneotel.co.za and mandela100.com from the Registrant to Mr Chakhala, ostensibly, as a representative of a company, YO4NE (Pty) Ltd.

Locus Standi

- s. Regulation 18 of the Regulations provides that:
- "Within 20 days of the date of commencement of the dispute the registrant must submit a response in paper format, in triplicate and in electronic format to the provider"* (emphasis added).

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- t. It is therefore necessary for Mr Chakhala to prove that he is, in fact, the Registrant, alternatively, that he is authorised by the Registrant to file a response.
- u. It is common cause that the 2nd Level Domain Administrator's Whois facility lists the Registrant as Mr Msuku.
- v. Mr Chakhala claims that he is a "*family representative*", the "*legal custodian*" of the Disputed Domain Name and "*have (a) legal right to represent our Stokvel as the present Chairman*".
- w. In making the above, and other, submissions, Mr Chakhala appears to argue not only that Mr Msuku is not the true Registrant but also that he represents a third party, presumably, an association/ stokvel ("association"), who is the true proprietor of the Disputed Domain Name.
- x. However, Mr Chakhala elects not to submit any evidence, on oath or otherwise, from either Mr Msuku, whom responded to the Complainant's initial objection, or the "association" confirming, or, at least, supporting, his allegations.
- y. In the absence of confirmatory evidence, of any kind, the submissions made by Mr Chakhala are hearsay and inadmissible.
- z. Furthermore, Mr Chakhala's attempt to have the Disputed Domain Name transferred to himself, alternatively, YO4NE (Pty) Ltd and, similarly, his earlier statement that the Disputed Domain Name was registered for use by a "*family member*", in the absence of any evidence to the contrary, contradict his claim that the true proprietor of the Disputed Domain Name, is the "association" and that he is "*authorised*" to present the "*association*".
- aa. Mr Chakhala's evidence must therefore be rejected and the Adjudicator finds that Mr Chakhala has no *locus standi* to bring an application for an extension of the period within which to submit a Response, as he is not the Registrant and also holds no authority to file a Response for or to act on behalf of the Registrant.

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- bb. In view of the above, it is not necessary to deal further with Mr Chakhala's demands that the matter be held over until **30 November 2017**. The Adjudicator nevertheless deems it appropriate, for the sake of good order, to deal with the submissions made by Mr Chakhala in support of his demand that the matter be held over.
- cc. The Supplementary Procedure of the SAIIPL provides in clause 11 for limited extensions upon good cause being shown. Clause 11 also makes provision for the Case Administrator, who, in practice, refers such requests to the Adjudicator, in her discretion, to grant a limited extension to a party, on good cause shown. However, clause 11(2) provides that the Case Administrator, in practice, the Adjudicator, shall act strictly in granting any extension, and will remain mindful of the fact that the Regulations are intended to provide an efficient and expeditious means to resolving domain name disputes.
- dd. The submissions made by Mr Chakhala do not provide any reason for the delay in providing a response herein by or on behalf of the Registrant, other than a reference to having appointed a legal representative as long ago as 26 October 2017. Mr Chakhala's submission that a legal representative and, specifically, Adams & Adams, has been appointed seems unlikely, especially, as it is unlikely that a law firm would have failed to, at least, record themselves as representatives of the Registrant, or any other party, in the circumstances.
- ee. Clause 11(1) also requires a party to show good cause i.e. plausible or credible reason(s) for the delay and hence for the extension sought. If no reason whatsoever is provided, then it is submitted that good cause has not been shown, and hence that the party has not made out a case for an extension. In any event, and in addition, the abovementioned clause 11(2) requires the Adjudicator to act strictly in considering and granting any extension - in order not to delay the entire dispute.
- ff. Taking all the above considerations into account, as well as the fact that Mr Chakhala has failed to provide any defence in opposing the Dispute,

the Adjudicator finds that Mr Chakhala has not discharged the onus that rest on the Registrant. The extension request is accordingly denied.

2) Factual Background

- a. The Complainant is a non-profit organisation founded by the late Mr Mandela in 1999 and embarks on numerous projects with the goal of furthering and promoting the vision and work of its founder.
- b. The Complainant is tasked *inter alia* with the protection of the legacy of the late Mr Mandela, all over the globe.
- c. The Complainant is the proprietor of several trade mark registrations for the MANDELA trade mark in South Africa, including trade mark registration numbers 2004/17458 - 61 in classes 16, 35, 36 and 41. The aforementioned registrations are enforce and predate the registration of the Disputed Domain Name by almost ten years.
- d. In addition to the above statutory rights, the Complainant submit that it has also acquired an extensive reputation, with accompanying goodwill, in the trade mark and name MANDELA by virtue of the extensive and widespread use of the name. This name is undeniably synonymous with the late Mr Mandela.
- e. The Complainant is also the proprietor of various domain name registrations that incorporate or comprise of the name and trade mark MANDELA and predate the Disputed Domain Name, including mandelamemorial.co.za, mandela.za.com and mandela.co.za.
- f. The Complainant further submits that the name and trade mark MANDELA is well-known, not only in South Africa but worldwide and is most certainly a trade mark that is protected in terms of the relevant well-known provisions of the Trade Marks Act 194 of 1993 ("Trade Marks Act") as well as in terms of the Paris Convention.
- g. In and during February 2017, the Complainant instructed its attorneys to register several domain names incorporating the trade mark MANDELA,

including the mandela100.co.za domain name, particularly with a view to the centenary of the late Mr Mandela's birth in 2018. Due to the prior registration of the Disputed Domain Name, the Complainant was not able to register the domain name mandela100.co.za.

- h. The Complainant subsequently requested the Registrant to transfer the Disputed Domain Name to it. On **22 May 2017**, the Registrant, Mr Msuku, responded and stated that he is of the view that the Disputed Domain Name does not infringe on the rights of the Complainant.
- i. The Registrant's refusal to adhere to the Complainant's demand led to the Dispute.

3) Parties' Contentions

3.1 Complainant

- a. Based on the factual background, the Complainant submits that it is the proprietor of the MANDELA trade mark, holds extensive common law trade mark rights in the MANDELA trade mark and also, that the MANDELA trade mark is well-known.
- b. The Complainant further submits that the Disputed Domain Name is confusingly similar to the MANDELA trade mark, resulting from the Disputed Domain Name, wholly, incorporating the trade mark MANDELA, the word MANDELA being the dominant, distinctive and therefore, the most memorable portion of the Disputed Domain Name and reference to the name MANDELA in the Disputed Domain Name being a clear reference to the late Mr Mandela.
- c. The Complainant also submits that the numeral "100", as featured in the Disputed Domain Name, is descriptive and generic and, therefore, does not distinguish the Disputed Domain Name from the name and trade mark MANDELA.
- d. In support of its submissions the Complainant relies on the WIPO UDRP decision of 4microsoft2000.com [D2000-1493] where it was held, amongst

others, that a user of a mark will not avoid likely confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it. The aforementioned principles were also confirmed in other WIPO decisions, including *mynutella.com*. [D2000-1534], *wwwamctv.com* [D2003-0273], and *buylantus.com* [D2005-0037], as well as in the SAIPL decision ZA 2007/ 003 Telkom SA Limited VS Coolideas 1290 CC.

- e. The Complainant further submits that it is an established legal principle that a domain name that comprises a trade mark coupled with a generic term, or for that matter, a numeral, is still confusingly similar to the trade mark. In the circumstances, and given the incorporation of the MANDELA mark in the Disputed Domain Name, the Complainant submits that the Disputed Domain Name is virtually identical to, and therefore confusingly and / or deceptively similar to the name and trade mark MANDELA.
- f. In support of its submissions that the Disputed Domain Name constitutes and abusive registration, the Complainant further submits, amongst others, that:
 - i. The registration of the Disputed Domain Name by the Registrant precludes the Complainant from registering and using the domain name, therefore preventing it from exercising its legitimate rights in the name and trade mark MANDELA, which, given the rights that it holds, it should be entitled to do, especially, given the centenary of the late Mr Mandela's birth in 2018;
 - ii. Given the iconic status of the late Mr Mandela, the Registrant must have known of the late Mr Mandela and therefore must, undoubtedly, have been familiar with his surname "Mandela". There is no apparent justification for the Registrant's registration of the Disputed Domain Name, which is indicative of the Registrant's lack of *bona fides* in registering this name. The renown of the Mandela name dispels any legitimate reason for the registration of the Disputed Domain Name by the Registrant;

- iii. The Disputed Domain Name blocks the registration of a name and mark in which the Complainant has rights and, unfairly, disrupts the business and goals of the Complainant, particularly those which it has for the centenary of the late Mr Mandela's birth in 2018;
- iv. As and when the Registrant commences use of the Disputed Domain Name, such use will undoubtedly divert internet users away from the Complainant's website and its endeavours, and will inevitably mislead internet users to believe that the Registrant's site is associated with, affiliated to, or operated by the Complainant, which will not be the case. This will undoubtedly unfairly disrupt the Complainant's business and its endeavours; and
- v. Given the renown attaching to the name and trade mark MANDELA, the Registrant did not act in good faith in registering the Disputed Domain Name.

3.2 Registrant

- a. The Registrant did not respond to the Complainant's contentions.

4) Discussion and Findings

- a. Regulation 3(1)(a) requires that a Complainant proves each of the following elements in order for the Disputed Domain Name to be transferred on the basis that it constitutes an abusive registration, namely that:
 - i) The Complainant has established rights in respect of a name or mark;
 - ii) The name or mark is identical or similar to the Disputed Domain Name; and
 - iii) In the hands of the Registrant, the Disputed Domain Name is an abusive registration.

- b. The Adjudicator will draw such inferences from the Registrant's default as he considers appropriate. This will include the acceptance of plausible evidence of the Complainant, which has not been disputed.

4.1 Complainant's Rights

- a) Regulation 1 defines "*rights*" to include intellectual property rights, commercial, cultural, religious and personal rights protected under South African law, but are not limited thereto.
- b) The above definition is broad and "*rights*" is not restricted to rights founded on the principles of trade mark law, but recognises rights going beyond those in terms of the Trade Marks Act or the requirements at common law for passing off. Such rights must, however, find recognition in law. See ZA2007-0008 (privatesale.co.za).
- c) The Complainant is the proprietor of trade mark registrations for the MANDELA trade mark and, also, holds domain registrations consisting of the word MANDELA only.
- d) The Adjudicator therefore finds that the Complainant has discharged the onus in showing that it has established suitable rights in respect of, particularly, the MANDELA trade mark, at least under the Trade Marks Act.
- e) The Disputed Domain Name not only includes the Complainant's mark MANDELA in its entirety, but the MANDELA trade mark is also the dominant feature of the Disputed Domain Name.
- f) The incorporation of the numeral "100" does not assist the Registrant in escaping the aforesaid finding and reference is made to a similar case in the South African domain dispute matter ZA2007/0003, where it was found that the domain name telkommedia.co.za was identical or confusingly similar to the well-known trade mark TELKOM.

- g) The Adjudicator accordingly, also, finds that the Disputed Domain Name is similar to the Complainant's MANDELA trade mark as required in terms of Regulation 3(a).

4.2 Abusive Registration

- a) "Abusive Registration" is defined in the Regulations to mean a domain name which either -
- 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
 - has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the complainant's rights.
- b) Regulation 4(1) provides for a number of grounds (non-exhaustive) which may indicate that the Disputed Domain Name is an abusive registration, namely:
- "(a) *Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to -*
- (i) sell, rent or otherwise transfer the domain name to a complainant or to a competitor of the complainant, or any third party, for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name;*
 - (ii) block intentionally the registration of a name or mark in which*
 - (iii) disrupt unfairly the business of the complainant; or*
 - (iv) prevent the complainant from exercising his, her or its rights;*

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- (b) *circumstances indicating that the registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the complainant;*
- (c) *evidence, in combination with other circumstances indicating that the domain name in dispute is an abusive registration, that the registrant is engaged in a pattern of making abusive registrations;*
- (d) *false or incomplete contact details provided by the registrant in the whois database; or*
- (e) *the circumstance that the domain name was registered as a result of a relationship between the complainant and the registrant, and the complainant has -*
- (i) been using the domain name registration exclusively; and*
- (ii) registration paid for.” (emphasis added)*
- c) For purposes of this dispute, the Complainant relies on Regulations 4(1)(a)(ii) - (iv) and 4(1)(b).
- d) In the absence of an explanation by the Registrant as to why he holds a *bona fide* interest in the Disputed Domain Name which incorporates, in its entirety, the MANDELA trade mark, in which the Complainant holds rights, there can be no doubt that, as the Complainant submits, the Registrant registered the Disputed Domain Name either to: -
- intentionally block the registration of a name in relation to which the Complainant holds rights to; or
 - take unfair advantage of the Complainant’s rights; or
 - unfairly, disrupt the business of the Complainant; or

- confuse members of the public into believing that the Disputed Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

5) Decision

For all the foregoing reasons, the Adjudicator finds that the Disputed Domain Name is an abusive registration and, in accordance with Regulation 9, orders that the domain name mandela100.co.za be transferred to the Complainant.

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DEON BOUWER
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za