

Decision

[ZA2011-0074]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0074
DECISION DATE:	25 July 2011
DOMAIN NAME	mi-money.co.za
THE DOMAIN NAME REGISTRANT:	Grandwebs
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	The Standard Bank of South Africa Limited
COMPLAINANT'S LEGAL COUNSEL:	Alicia Louw Bowman Gilfillian Inc
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 **06 May 2011**. On **09 May 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **09 May 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 **12 May 2011**. In accordance with the Regulations the due date for the Registrant's Response was **14 June 2011**. The Registrant did not submit any Response.
- c) The SAIPL appointed **Tana Pistorius** as the Adjudicator in this matter on **20 June 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.
- d) The decision was due on the **08 July 2011**. The Adjudicator requested an extension due to personal reasons on **13 July 2011**.

2 Factual Background

- a) The trade mark MIMONEY has been used by the Complainant in connection with a new financial product, namely a payment method for online purchases. Marketing for MiMoney commenced in 2008 and the product was launched in 2009.
- b) The marketing material and various articles about the product is evidenced by various publications as illustrated in Annexure C, Annexure D, Annexure

E and Annexure F.

- c) According to the relevant 2nd Level Domain Administrator's Whois facility, the Registrant in these proceedings is Grandwebs of 87A Adam Tas Avenue 7441.
- d) The Complainant became aware of this domain name registration in February 2011 and demanded that the Registrant transfer the domain name to the complainant (see Annexure H1).

3 Parties' Contentions

3.1 Complainant

- a) The Complainant states that it is one of the leading banks in Southern Africa. It is listed on several stock exchanges.
- b) The Complainant aptly illustrates the importance of trade marks and branding to banking institutions in Annexure A. It also states that the protection of its goodwill and its rights associated with its various marks are deemed to be of strategic importance.
- c) Complainant states that it is the proprietor of various South African trade-mark registrations consisting of the MIMONEY mark. Complainant has attached a sheet (Annexure G) containing a summary of its registered MIMONEY marks as well as related marks and device marks it applied. On this sheet and in the complaint itself the trade marks 2008/29316, 2009/29317, 2009/29318, 2009/29319 and 2009/29320 in respect of classes 09, 35, 36, 38 and 42 are listed as registered. The word mark MIMONEY WALLET is registered under numbers 2009/01852, 2009/01853 and 2009/01854 in classes 09, 36, 38 and 42.

The Complainant also claims to be the proprietor of trade-mark applications for the MIMONEY device mark under trade mark

application numbers 2008/23860-2008/23864 in classes 09, 35, 36, 38 and 42. According to the Complainant these applications were lodged in October 2008 and they are still pending. The MIMONEY WALLET logo has been applied for under 20009/03843-2009/03848 in classes 09, 35, 36, 38 and 42 in March 2009 and these registrations are pending.

In the take-down of a web site notification for the web site related to the disputed domain name (see Annexure H2) the Complainant's legal representative avered that additional MIMONEY marks, namely trade-marks 2009/16574, 2009/16575, 2009/16577 and 2009/16578 are registered in respect classes 09, 35, 36, 38 and 42.

The trade mark registration certificates of all the alleged trade-mark registrations were not attached as evidence.

- d) Complainant claims to enjoy extensive common-law rights in the MIMONEY mark due to substantial use of the mark in relation to its services as reported in several on-line publications, including www.itweb.co.za, www.imod.co.za, www.mobilemoneyafrica.co.za and others. These publications inter alia report that important on-line retailers, namely Kalahari.net, Ster-Kinekor, exactMobile, Mr Delivery and MXit accept the MiMoney payment mechanism as settlement for purchases. The Complainant also attached its own advertising material displayed on its own web site (www.mimoney.co.za).
- e) The Complainant notes that the disputed domain name was registered more than two years after the Complainant launched its service and that the Registrant must have been aware of Complainant's rights in the name MIMONEY.
- f) The Complainant avers that the disputed domain name is virtually identical to the Complainant's trade mark and a substantial likelihood exists that users will be confused and will believe that some

affiliation, connection or sponsorship exists between the Complainant and Registrant.

- g) The Complainant asserts that the domain name is abusive because it is a blocking registration, it unfairly disrupts the business of the Complainant and the registration prevents the Complainant from exercising its rights.
- h) The Complainant asserts that the disputed domain was registered primarily to intentionally block the registration of a name/mark in which the Complainant has rights.
- i) The Complainant asserts that the disputed domain was registered primarily to disrupt unfairly the business of the Complainant because given the repute of the mark the Registrant must have been aware of the Complainant's rights. The Registrant intends to be involved in the financial services industry. The only plausible explanation is that the Registrant registered the disputed domain name to attract Complainant's customers by virtue of misleading association. The Complainant also asserts that the disputed domain name is likely to create confusion and that the Registrant will benefit commercially from the traffic (web visitors) to the web site associated with the disputed domain name.
- j) The Complainant asserts that the disputed domain was registered primarily to prevent the Complainant from exercising its rights because the registration of the disputed domain name effectively bars the Complainant from registering and using the disputed domain name.
- k) The Complainant notes that the Registrant has not been licensed or authorised to use the disputed domain name and that the Registrant has pre-empted the Complainant's exclusive right to use the MIMONEY trade mark.

- l) The Complainant also asserts in paragraphs 30 and 31 of the complaint that the trade mark MIMONEY is a well-known mark and that the registration of the disputed domain name suggests opportunistic bad faith on the part of the Registrant.

3.2 Registrant

- a) The Registrant did not reply to the Complainant's contentions.
- b) Regulation 18(1)(a) provides that a Registrant must respond to the statements and allegations contained in the Dispute in the form of a Response. In such a Response, the Registrant must detail any grounds to prove the domain name is not an abusive registration.
- c) Because the Registrant failed to submit a Response, the Adjudicator must decide the matter on the Dispute (see Regulation 18(3)).
- d) Regulation 28(2) provides that, in the absence of exceptional circumstances, an Adjudicator shall draw such inferences, as it considers appropriate, from the failure of a party to comply with a provision or requirement of the Regulations.
- e) The Adjudicator draws the following two inferences: (i) the Registrant does not deny the facts that the Complainant asserts, and (ii) the Registrant does not deny the conclusions that the Complainant draws from these facts.

Notwithstanding these inferences, the Adjudicator has analysed Complainant's version in order to satisfy herself that the allegations contained in its Complaint are acceptable and probably true (see ZA2007-0010 (Multichoice Subscriber Management v JP Botha)).

4 Discussion and Findings

- a) Regulation 3 provides that a Complainant is required to prove, on a balance

of probabilities, that the following three elements are present in order to succeed in a domain name Dispute based on an alleged abusive registration:

- i) That the Complainant has rights in respect of a name or mark;
- ii) that the name or mark is identical or similar to the domain name; and
- iii) That the domain name, in the hands of the Registrant, is an abusive registration.

4.1 Complainant's Rights

- a) The cornerstone of the Complainant's case is proof on a balance of probabilities that it had rights in the trade mark MIMONEY at the time of the registration of the domain name, and that this trade mark is identical to the domain name. The Adjudicator does not regard the mere assertion or list of registered marks as adequate evidence of Complainant's trade-mark rights. Indeed, it has no official value, as Complainant or its legal representative prepared it. As a rule, only copies of official applications or certificates of registration issued by registration authorities are apt to demonstrate trade mark rights (see D2001-0709 Red Bull GmbH v Ian Andrew).
- b) The Complainant submitted evidence of use of the trade mark since 2008, as noted above. The one article was accessed by over 5000 subscribers. The 12 million MXit users were made aware of the MIMONEY service. The Adjudicator finds on such evidence put forward by the Complainant that the Complainant has at least established that it has common-law rights in the MIMONEY trade mark. The evidence is not sufficient to indicate that the mark is well-known.
- c) The domain name at issue is <mi-money.co.za>. The Adjudicator finds that the differences are minor that the domain name mi-money.co.za is, if not identical, at least similar to the Complainant's trade mark (see D2002-0810 Benetton Group SpA v Azra Khan).

- d) The Complainant has thus established that it has rights in respect of the trade mark MIMONEY, which is identical to the disputed domain name.

4.2 Abusive Registration

- a) An abusive registration is defined as a domain name, which (a) when the Registrant registered the domain name took unfair advantage of or was unfairly detrimental to the Complainant's rights or (b) a domain name that is being used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

The Registrant has not used the disputed domain name, and the consideration therefore falls to be mainly determined under sub paragraph (a) of the definition of an abusive registration, save for a discussion of bad faith relating to passive use infra. Evidence of an abusive registration, which is deemed relevant to the Dispute, is described in Regulation 4(1)(a)-(b).

- b) A domain name is abusive if the disputed domain was registered primarily to disrupt unfairly the business of the Complainant (Regulation 4(1)(a)(iii)). ZA2007-0003 (Telkom Sa Limited v Cool Ideas 1290 CC) confirmed that the disruption of the business of a Complainant may be inferred if the registrant has registered a variation of the Complainant's mark by merely adding a generic word. It appears to be undeniable that the Registrant knew of the Complainant's trade mark MIMONEY when he registered the domain name, as the trade mark was widely used in relation to banking services. The only plausible explanation is that the Registrant registered the disputed domain name to attract Complainant's customers by virtue of misleading association.

Accordingly, the Adjudicator finds, on a balance of probabilities, that

the Registrant registered the disputed domain name primarily to disrupt unfairly the business of the Complainant.

- c) The disputed domain was registered primarily to prevent the Complainant from exercising its rights because the registration of the disputed domain name effectively bars the Complainant from registering and using the disputed domain name.

The Adjudicator finds, on a balance of probabilities, that the Registrant registered the disputed domain name to prevent the Complainant from exercising its rights.

- d) A domain name is abusive if circumstances indicate that the Registrant has registered the disputed domain in a way that leads people to believe that the domain name is registered to, operated to or authorised by, or otherwise connected with the Complainant (regulation 4(1)(b)).

The domain name mi-money.co.za creates an impression of association between the Registrant, the Complainant and its trade mark MIMONEY (see D2002-0810 Benetton Group SpA v Azra Khan). This will not only lead people or businesses to believe that the domain name is registered to, authorized by, or otherwise connected with the Complainant but may also be characterised as opportunistic bad faith (see Case No. D2003-0985 Société des Bains de Mer et du Cercle des Etrangers à Monaco v Internet Billions Domains Inc).

Accordingly, the Adjudicator finds, on a balance of probabilities that the Registrant is using the disputed domain name in a way that leads, or will lead, people and businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

- e) The disputed domain name mi-money.co.za resolved to a parking

web site. The www.prepaidwizard.co.za web site (that was the subject of a take-down notification) stated that the www.mi-money.co.za web site was under construction. (It should be noted that the Take Down Notification had no practical effect. The Pre Pay Wizard blog is currently still active. This web site links to a new blog, "Our MONEY" (<http://mi-money.blogspot.com/>).

Other panels have held non-use may amount to bad faith where the Registrant failed to respond to the Complaint (see D2000-0325 *Kabushiki Kaisha Toshiba v Shan Computers* par 6.4) and where it is impossible to conceive a good faith use of the domain name (see D2000-0574 *Jupiters Limited v Aaron Hall*; D2002-0131 *Ladbroke Group Plc v Sonoma International LDC*).

The Registrant's failure to submit a Response is particularly relevant. It is, in the Adjudicator's view, impossible to conceive a good faith use of the domain name mi-money.co.za by the Registrant. The Adjudicator finds, on a balance of probabilities that the Registrant's passive use of the disputed domain name amounts to use in bad faith.

5 Decision

- 5.1 For the foregoing reasons the Adjudicator finds on a balance of probabilities that the disputed domain name is an abusive registration.
- In accordance with Regulation 9, the Adjudicator orders that the domain name mi-money.co.za be transferred to the Complainant.

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TANA PISTORIUS

SAIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za