



## Reverse Domain Name Highjacking in .co.za

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## Overview



- Domaining
- Introduction of the facts of the case
- Analysis of initial Decision for Reverse Hijacking.
- Reasons for reversal of Reverse Hijacking
- Authority created by Appeal Decision and
- Examples of International decisions.
- Best practices

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## Telkom

- Abusive registration of phonebook.co.za & whitepages.co.za
- Rights:
  - Registered trade mark THE PHONE BOOK logo in various classes, including class 38
  - TDS common law mark in phone book & white pages – telephone directories




## Telkom

- Registrant's registration
  - Confusingly similar/ identical to marks & abusive:
    - Registered intentionally block registration of domain names in which Complainant has rights
    - Disruption of business – cannot use the domain names
    - Prevents Complainant from exercising its rights

## Disclaimer

- *"Registration of this trade mark shall give no right to the exclusive use of the word PHONE, or of the word FOONBOEK, or of the word BOOK, each separately and apart from the mark. The trade mark is shown in the English and Afrikaans versions, being two of the official languages, in which it is or will be used, the two versions represented having equivalent meanings. In practise, both versions of the trade mark will be used either separately or together, but when used together they will not necessarily be in close approximation one to the other."*

## Marks confusingly similar or identical to domain name?

- Comparison: mark as registered: 
- Stylised & non-distinctive disclaimed features not helpful
  - D2001-0964 (Cream Holdings Limited)
  - D2003-0645 (Meat and Livestock Commission)
- Not confusingly similar



[www.phonebook.co.za](http://www.phonebook.co.za)



- Common-law rights
- Evidence phone book: distribution figures of directories for 2001 (not prior)
- White pages: Annexure D: use in descriptive manner



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## Conclusion



» Not confusingly similar to phonebook.co.za



» No common law rights proved for phone book & white pages

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## Reverse DN Hijacking

- using these Regulations in bad faith to attempt to deprive a registrant of a domain name.



## Requirements

- Complainant knew:
  - of the Registrant's legitimate interests in the disputed domain name or
  - Clear lack of bad faith registration and use
- Nevertheless brought the Complaint in bad faith

## Legitimate Interest

- Use a generic word to describe his product or business.
- Generic use of the word must be without the intent to take advantage of a Complainant's rights in that word
- Registrant provided ample evidence of generic nature of phone book & white pages & no intention to take advantage: no rights

## 2 Alternative requirements for RDNH

- Complainant knew:
  - of the Registrant's legitimate interests in the disputed domain name ☺ or
  - Clear lack of bad faith registration and use

## Clear lack of bad faith registration and use

- [www.whitepages.co.za](http://www.whitepages.co.za) Bona fide offering goods & services
- **White Pages Scrapbooking Club**  
White Pages? Let us fill them with your memories!  
The site for Scrapbooking in South Africa



Bery welcome to my  
scrapBOOKING page

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**I look forward to hearing all of your ideas,  
Love,  
Romy**



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## Lack of bad faith registration and use

- Lack of bad faith registration and use
  - Registered more than 5 years ago – started preparatory steps after notice of complaint
  - Passive use may amount to bad faith
  - Incomplete whois information
- Balance of probabilities – cannot substantiate lack of bad faith registration & use

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## Decision



- Phonebook.co.za
  - May have misunderstood scope of rights
  - Failed to prove bona fide use of domain name
  - May have existed reasonable scope for suspicion –
- Unduly harsh to characterise as RDNH



- No basis for claim no rights or legitimate interest in [whitepages.co.za](http://whitepages.co.za)
- No proper objection & knew this as was professionally advised = aware of weakness of case
- abuse of proceedings i.e. reverse domain name high jacking

## privatesale.co.za

- No RDNH
  - Bona fide attempt to obtain a domain name
  - Did not undermine privatesale.co.za
- privatesale.co.za no abuse of proceedings -  
Complaint not brought in bad faith
- Abuse of proceedings: Bike&leisuretrader  
ZA2008.0018

## Appeal RDNH

- Confirmed no rights
- Incorrect issue must not have been addressed - Bad faith must infringe a competing right
  - was done ito RDNH 2<sup>nd</sup> requirement

## Appeals Panel

- Aim & scope of RDNH
  - = unclear; Legislative intervention
- Litigants free to launch proceedings
- Evidence of bad faith = Unlawful intent as in *Bress Designs* case

## *Bress Designs*



- Advancement of one's own interest = legitimate; BUT act dominant purpose infliction of harm for harm's sake = unlawful
- RDNH – use of proceedings with intent to inflict harm for harm's sake
- Contrast with bad faith – passive holding; incorrect contact details?

## .za Position

- Generic name; No tm rights;
- No basis for Complaint:
  - no RDNH (requires malice)

## International RDNH

- **Aim & Purpose:** Reinforces UDRP
  - Limit proceedings to cybersquatting
  - Narrow type of conflicts
- **Scope: Unjustified complaints**
  - Complainant's knowledge legitimate interest / lack of bad faith
  - Brought Complaint in bad faith
- **Bad faith**
  - Not only Registrants

## Legitimate interest in the use of a domain name

- Two requirements:
  - the Registrant must registered use a **generic word** to describe his product or business; and
  - the generic use of the word must be **without the intent to take advantage** of a Complainant's rights in that word

## Legitimate Interests/ Lack of bad faith

- Lack of bad faith registration:
  - No knowledge of mark; without intent to take advantage of Complainant's rights;
- Lack of bad faith use: bona fide offering of goods or service
  - Complete lack of evidence that the DN – generic term – related in any way to Complainant's mark (*Kiwi European Holdings B.V. v. Future Media Architects, Inc kiwi polish v kiwi search engines*)



## G. A. Modefine S.A. v. A.R. Mani Case No. D2001-0537

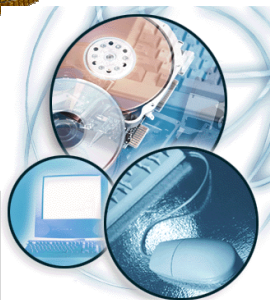
- "ARMANI" "GIORGIO ARMANI" "EMPORIO ARMANI"
- Anand Ramnath Mani is the Respondent's real name
- No evidence that Registrant used domain name to take advantage /no evidence of confusion
- No basis to peruse Complaint
- Facts not disclosed

- [http://marketing.blogs.ie.edu/archives/2007/09/armani\\_goes\\_onl.php](http://marketing.blogs.ie.edu/archives/2007/09/armani_goes_onl.php)



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## Knowing disregard of likelihood of success



- *Goldline International* D2000-1151
- knew rights limited
- Knew dn bona fide registration & use
- Reasonable investigation; also notified by Registrant
- = RDNH

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## Proto Software v Vertical Axis D2006-0905

- Complainant knew it could not prove domain name was registered in bad faith
- Complainant's knowledge before filing
  - Dn registered 3 years prior
  - Knew of the domain name before use made of tm
- Bad faith:
  - Onus on Respondent – mere lack of success on sufficient
- Little prospect of success
  - Proceedings: expenditure of time, costs
  - Must have reasonable & credible belief in case



## Cardpoint plc v Riga Ind DRS 00538

- Bad faith = objective & subjective
- Objective – no reasonable grounds to succeed
- Subjective – Complainant lack of honest belief in legitimacy
  - Set out no grounds for abusive registration – “rightly ours”
  - Dn registered 2 years prior to tm application
  - Complaint brought out of frustration – Respondent would not negotiate for transfer

## NOT RDNH

- Petit-Chêne et Heidi-Shop v. Gerard Praplan (Case No. D2003-0672)

[www.heidi.com](http://www.heidi.com)



- Likelihood of success:
  - Trade mark was registered before use of dn in relation to Heidi T-shirts etc.
  - National court allow tm infringement (bad faith not requirement) similar goods & service
  - Respondent did not reply

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## Effect of RDNH



- UDRP: none
- Nominet Procedure 16(d): 3 x in 2: 2



- <http://www.marlerblog.com/2007/04/>
- .za: Uncertain right & none

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## Comparison

.za	International decisions
No tm rights: malicious intent	Weak tm rights: Reckless disregard, dishonesty
Legal representation: negative	Legal representation: positive
SA tm holders: broad dn holders: restrictive	.com dn: attempt balance...

## Conclusions

- Reverse domain name hijacking: clarity from international precedent
- Important: Balance of rights
- Legislative intervention?
  - Effect – 3 x 2y = no complaint for 2 years
  - Nominet approach of objective & subjective
  - Burden of proof

UNISA: thank you



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