

ADR - Trends and cases

No of cases opposed: 10 (67%)
No of cases unopposed: 5 (33%)

Successful disputes: 11 (73%)
Unsuccessful disputes: 4 (27%)

Opposed cases

Leading to a transfer: 5 (50%)

Leading to a refusal: 5 (50%)

Unopposed cases

Leading to a transfer: 5 (100%)

Leading to a refusal: 0

Legal Counsel

Cases with Legal Counsel for Complainant: 15 (79%)

Cases with Legal Counsel for Registrant: 6 (32%)

- 5 in which both represented
- 2 in which neither represented
- 5 in which there was no response
- 3 in which Complainant only was represented.

↓
2 transferred (66.6%); 1 refused (33.3%)

Requirements for success

The Complainant must prove:

- 1. rights in the name/trade mark;
- 2. that the trade mark/name is similar/identical to the domain name; and
- 3. that the domain name in the hands of the Registrant is an abusive registration
 - a) registered/acquired in a manner that (at the time) took unfair advantage of or was unfairly detrimental to the Complainant's rights
 - b) used in a manner that was unfairly detrimental or took unfair advantage of the Complainant's rights

mrplastic.co.za

Mr Plastic CC v Mr Plastic Mining & Promotional Goods CC

1. Has Complainant shown sufficient rights?

Complainant and Registrant are in the same trade and both use a highly descriptive name in which neither can claim exclusive rights.

telkommedia.co.za

Telkom SA Ltd v Cool Ideas 1920 CC

1. Who may lodge a dispute?

Only requirement is that the Complainant must have rights (Reg 3)- no requirement to be an interested/affected/aggrieved person

2. A domain name comprising a trade mark together with a generic term is still confusingly similar to the trade mark.

3. Requirements for a "blocking registration"

a) acts against a name/trade mark in which the Complainant has rights

b) intent & motive. Suggests some knowledge and hence the purpose of registering a domain name to prevent the rights holder from doing so

4. Disruption of business of Complainant

May be inferred when a domain name is used that comprises the Complainant's trade mark with a generic term.

5. Registration and use in a manner that indicated a connection with the Complainant

Regulation requires "use". Nominet decisions found that site "under construction" may cause confusion. Use of a trade mark + generic term.

6. Incomplete or incorrect information on WHOIS

WIPO decisions found that this indicates bad faith.

7. Is Complainant obliged to make a reasonable attempt to reclaim the domain name before initiating ADR proceedings?

No requirement in Regulations

telkombusiness.co.za
telkom-business.co.za
telkomcorporate.co.za
telkom-corporate.co.za
telkom-internet.co.za

Telkom SA Ltd v Customer Care Solutions (Pty) Ltd

1. Are the Regulations applicable to domain names registered before they came into effect?

Assumption: that legislation doesn't act retrospectively
BUT: intention of legislature in promulgating ECT (Electronic Communication Act) was clearly to regulate the .za domain space in its entirety and not from a specific date only

2. Is ADR Arbitration?

The regulations provide for "alternative dispute resolution" – not arbitration

Differences :

A domain name Registrant is compelled to submit to the ADR procedure

The ADR findings bind a 3rd party (the 2nd level domain name administrator – Uniform)

Therefore the Arbitration Act is not applicable

3. What about the agreement reached between the parties?

Letter didn't look like a settlement.

3 domain names registered after "agreement"; they are not subject to alleged agreement.

phonebook.co.za whitepages.co.za

Telkom SA Ltd & TDS Directory Operations v The Internet Corporation

1. Regulations not binding on earlier domain names

In registering, the Registrant enters a contractual relationship with Uniforum.

Terms of the agreement provide:

- a) they may be changed (to include reference to ADR);
- b) Registrants bound by any dispute resolution procedure introduced by law

2. Is the domain name similar to the trade mark/name in which the complainant has rights?

2 important factors in deciding:

- a) does the mark comprise a logo/device?
- b) does the mark contained disclaimed features?

Words contained in the trade marks is descriptive (logo)

Disclaimer: "... separately and apart from the mark".

THE PHONEBOOK logo is dissimilar to phonebook.co.za

Complainant failed to prove secondary meaning.

3. Reverse domain name hijacking?

Reverse domain name hijacking: using the policy in bad faith to deprive someone of a domain name

Required to prove that Complainant knew of Registrant's legitimate interests or its clear lack of bad faith and nevertheless brought complaint in bad faith

Legitimate interest has 2 requirements

- a) Registrant must use a generic name to describe his product /business
- b) generic name used without intent to take advantage of Complainant's rights.

Registrant has rights being the first to register

Non-use for a specific period (eg 2 years) not necessarily indicative of bad faith.

4. Blocking registrations

2 features of blocking registrations:

- a) acts against mark in which Complainant has rights
- b) interrupts Complainant's business

phonebook.co.za
whitepages.co.za- appeal

Telkom SA Ltd & TDS Directory Operations v The Internet Corporation

1. Nature of Appeal

The Appeal panel looks at the matter afresh. Initial judgement not assumed correct.

2. Comparison of marks

Use a "global appreciation" (visual, conceptual or aural similarity) based on overall impression.

3. Effect of disclaimer

The whole word "phonebook"/"foonboek" disclaimed.

4. Bad Faith

Requires a violation of a competing right/claim.

5. Reverse Domain name Hijacking

Scope and concept unclear and also the onus that must be discharged to succeed in such a claim.

standerbank.co.za, standarbank.co.za
wwwstandardbank.co.za
standerdank.co.za
standardank.co.za
stanardbank.co.za
standardban.co.za
standadbank.co.za
standardbak.co.za
stndardbank.co.za
stadardbank.co.za
sandardbank.co.za

Standard Bank of South Africa Ltd v Daniel Cox

1. **“Typo squatting”**

2. **“Typo-piracy”**

Addition of the letters “www” before the domain name.
Domain name is confusingly similar to trade mark.

fifa.co.za

FIFA v X Yin

1. **What is meant by “fairness”**

Cannot infer that there was the intention to block FIFA or disrupt its business or prevent it from exercising its rights.

Possible indicators of unfairness:

- a) offer to selling name
- b) pattern of making abusive registrations
- c) relationship between parties

Given the infinite proportions of access to a website and the possibilities of use, the likelihood of substantial economic detriment cannot be the sole standard for assessing fairness.

Intention to use domain name to avail himself of benefit through use of the trade mark FIFA in a domain name.

privatesale.co.za

Homefront Trading 272 CC v Ian Ward

1. What is unfair use?

No right to be protected- domain name is descriptive/generic and the Complainant has shown no secondary meaning
Although Registrant's actions were questionable, there were no rights to protect

2. Reverse domain name hijacking

No conduct aimed at undermining domain name privatesale.co.za

oxycell.co.za

Holistic remedies (Pty) Ltd & Amka Pharmaceuticals (Pty)Ltd v Oxygen for Life (Pty) Ltd

1. Onus of Proof

Not that the Complainant would be successful in a passing off case BUT that, on the balance of probabilities, it has the goodwill and reputation protectable by way of a passing off action.

mwebsearch.co.za

Multichoice Subscriber Management v JP Botha

1. Trade Mark + generic term in domain name

Still in fringes the trade mark

2. No response from the Registrant

Complainant is still required to make a persuasive case

vcbet.co.za

Newcote International Limited & Victor Chandler
(International) Ltd v iLogic (Pty) Ltd

1. Domain name= trade mark + generic term
2. Used in relation to services loosely akin to those in respect of which rights have been acquired

citroen.co.za

Automobiles Citroën v Mark Garrod

1. Indications of unfairness:

- a) registration made with the intention to sell
- b) pattern of abusive registrations
- c) non compliant data on WHOIS
- d) relationship between parties
- e) use in an attempt to create the impression that there is a connection

2. The problem is the conflict between the legitimacy of a tribute site and the rights of the Complainant in its trade mark.

The intellectual property of one was appropriated by another.

Principle: when a mark is appropriated , it must be in a manner that cannot leave doubt but that it is wholly descriptive and truthful.

- could have registered ilovecitroën.co.za
- could have asked for Citroëns approval before registering

sunglasshut.co.za

Luxottica U.S. Holding Corp v Preshal Iyar

1. **Impression of connection created**
Through registration of a domain name identical to registered trade mark
2. **Passive use may indicate bad faith**
International presedent has found that positive action and also inaction are sufficient "use".
3. **Attempt to sell name**
Indicates bad faith if price payable is in excess of out-of-pocket expenses.

mares.co.za
dacor.co.za

Aqua Divers International (Pty) Ltd v Divetek (Pty) Ltd

1. Trade Mark Rights

Complainant has no proprietary rights in the mark- its rights are commercial.

Commercial rights are acquired contractually- cannot bind 3rd parties.

Commercial rights holder cannot prevent fair and honest use of the trade mark that is not calculated to mislead the public.

Is the Registrant acting contra bonos mores?

2. Fair use

Principle: first come, first served

No indication that the Registrant was obliged to cease use of trade marks when contract was terminated.

No evidence of confusion created that there is a connection between the parties.

Website linked to domain name used to promote genuine products.

capepointostrichfarm.co.za

Cape Point Ostrichfarm (Pty) Ltd v Punta Di Kappa

1. Where allegation of reputation and goodwill was made and not disputed, it was accepted that common law rights exists, even though the name may arguably be descriptive.

bikeandleisure.co.za

The Car Trader (Pty) Ltd v Junk Mail Publishing (Pty) Ltd

- 1. Requirements for a "blocking registration"**
 - a) designed to prevent the legitimate owner of right from registering and using the associated domain name
 - b) Registrant is unable to demonstrate a prima facie right in the name or valid reason for the registration