

Decision

2013-0153

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

ADJUDICATOR DECISION

CASE NUMBER:	2013-0153
DECISION DATE:	13 December 2013
DOMAIN NAME	virginpoker.co.za
THE DOMAIN NAME REGISTRANT:	Geoff
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Virgin Enterprises Limited
COMPLAINANT'S LEGAL COUNSEL	DMR Attorneys (Mr R Richardson)
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIIPL”) on **16 October 2013**. On **17 October 2013** the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **17 October 2013** UniForum SA confirmed that the domain name had been suspended. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIIPL’s Supplementary Procedure.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **30 October 2013**. In accordance with the Regulations, the due date for the Registrant’s Response was **27 November 2013**. No response was filed by the Registrant.
- c) In accordance with the Regulations the Case Administrator sent a notification of default to the parties on **28 November 2013** viz that no Response had been received from the Registrant.
- d) The Complainant had elected that this Dispute be adjudicated by a single adjudicator. Accordingly, the SAIIPL appointed **Mr Andre van der Merwe** as the Adjudicator in this matter on **6 December 2013**. The Adjudicator has submitted the required Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Complainant is Virgin Enterprises Limited, a British company, of The School House, 50 Brook Green, W6 8RR, London, England, United Kingdom. This company is part of the Virgin group of companies that includes about two hundred companies world-wide (“the Virgin Group”). The Virgin Group has traded under the name VIRGIN since 1970 and continues

to do so.

- 2.2 The Complainant is responsible for the ownership, management and protection of all trademarks and intellectual property in and to the name VIRGIN. As such the Complainant is the registered proprietor of all the VRIGIN trademarks owned or used by companies in the Virgin Group.
- 2.3 The Complainant is currently the proprietor of a portfolio of over 2 500 trademark applications and registrations incorporating the VIRGIN trademark in over 125 countries around the world. These applications and registrations cover a wide range of goods and services that reflect the diversity of the Virgin Group's world-wide business interests and activities.
- 2.4 More particularly, the Complainant is the proprietor of about 171 trademark registrations and applications in South Africa, most of which trademarks relate to, or include VIRGIN in one form or another. The oldest of these registrations date from 1975 and 1980.
- 2.5 The Complainant is the registrant of over 4 500 domain names, the majority of which include the VIRGIN name. These include about 99.co.za domain names incorporating the VIRGIN name.
- 2.6 The Complainant is also responsible for licensing the VIRGIN trademarks in respect of various goods and services to companies both within and outside the Virgin Group on a world-wide basis. These entities vary greatly in terms of their business activities including for example telecommunications, travel and transport, entertainment, retail, leisure, and lifestyle sectors.
- 2.7 The Complainant operates an on-line gaming business called VIRGIN Games. Details thereof can be obtained from the website located at virgingames.co.za.
- 2.8 The Registrant is Geoff (further names and surname unknown and not shown in the WHOIS details). The Registrant's address details are also not known except for a billing mail address given in the WHOIS details as g_man_billy@yahoo.com.

2.9 The Registrant registered the disputed domain name virginpoker.co.za on 10 May 2009.

2.10 Various attempts by the Complainant to contact the Registrant both directly and through the Registrar have failed to produce any response.

3 Parties' Contentions

3.1 Complainant

- a) In light of the above paragraphs, the Complainant contends that it is the proprietor of the name and trademark VIRGIN in South Africa and in many countries world-wide.
- b) More particularly, the Complainant contends that it is the proprietor of the following relevant South African trademark registrations viz nos 1988/03598 virgin IN CLASS 41; 1988/03602 virgin LOGO IN CLASS 41; 1995/10036 VIRGIN in class 41; 2001/01849 VIRGIN ACTIVE in class 41; and 2008/11158 VIRGIN in class 36.
- c) The Complainant also contends that it has acquired extensive common law rights in and to the trademark VIRGIN, and that such rights predate the registration of the disputed domain name. The Complainant further contends that its name and trademark VIRGIN has become famous (viz well-known) through extensive use and promotion thereof world-wide and in South Africa.
- d) The Complainant contends that the disputed domain name had pointed to the website www.silversandscasino.com. Accordingly the Registrant was attempting to take advantage of the VIRGIN name and trademark by diverting on-line traffic to the business of an alternative gambling site. Subsequent to sending a letter of demand to the Registrant, the redirecting of the website to www.silversands.com has ceased.

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- e) The Complainant contends that the distinctive, dominant and memorable element of the disputed domain name is the word VIRGIN. This is likely to be associated with the Complainant. This will cause confusion among members of the public, and such use will amount to infringement of the Complainant's registered rights.
- f) The Complainant contends that its registered rights cover financial, gaming, casino and gambling services. These are the services for which the disputed domain name has been used in the past (and is the only manner in which this sort of name is likely to be used).
- g) In support of the above, the Complainant contends that potential users of the Complainant's services would be confused and/or deceived into believing that the disputed domain name is associated with the Complainant. This contention is based on the common law rights that the Complainant enjoys in the name and trademark VIRGIN, and hence that use of the disputed domain name by the Registrant amounts to passing off under the common law.
- h) The Complainant contends that the adoption of the VRIGIN name and trademark by the Registrant gives the Registrant an unfair advantage which it would not have had if it had adopted an alternative, original and distinguishable name. More particularly, the Complainant contends that it is clear that until recently, the disputed domain name has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights by the practice of pointing to the website www.silversands.com.
- i) The Complainant contends that by using the disputed domain name as a conduit to alternative websites and pages, the Registrant seeks unfairly to disrupt the business of the Complainant.
- j) The Complainant contends that, by reason of the repute and fame of the VIRGIN name and trademark, it is highly likely that people and/or businesses will believe that the disputed domain name is registered

to, operated or authorised by, or otherwise connected with the Complainant.

- k) The Complainant contends that the contact details provided by the Registrant in the WHOIS database are false or incomplete. This is alleged to be a clear indication of devious intent, and hence the disputed domain name should be taken out of the hands of the Registrant.
- l) The Complainant contends overall that, because of the reasons set out above, the disputed domain name is an abusive domain name and should be transferred to the Complainant.

3.2 Registrant

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

4 Discussion and Findings

4.1.2 In order to make a finding that the disputed domain name is an abusive registration, the Adjudicator is required to find that the Complainant has proved, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present viz:

- i) the Complainant has rights in respect of a name or mark;
- ii) which 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.

An abusive registration is defined in the definition section viz in Regulation 1, to mean a domain name which either –

- a) 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

- b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

SUBSTANTIVE ASPECTS

Turning now to the substantive aspects of this complaint, the Adjudicator has carefully perused the complaint filed herein and fully considered the facts and contentions set out therein.

RIGHTS IN RESPECT OF A NAME OR MARK

In terms of Regulation 1 the term "rights" is widely defined. The regulation states that "rights" and "registered rights" include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law but is not limited thereto.

As has been decided by the appeal decisions in www.seido.co.za (ZA2009-0030) and www.xnets.co.za (ZA2011-0077), the notion of "rights" for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. It is a matter of *locus standi* in order to make sure that the person who complains is someone with a proper interest in the complaint. The threshold in this regard should be fairly low.

In the first place, the Adjudicators need to determine whether, as set out above, in terms of Regulation 3(1)(a), the Complainant has rights in respect of the name or mark VIRGIN. The Complainant claims that it enjoys such rights in this name or mark.

A NAME OR MARK?

The first part of the present enquiry is to determine whether the Complainant has *locus standi* in the sense of a name or mark that is unique or distinctive of it and its activities (and that is not merely descriptive, general or generic, for example).

DOES THE COMPLAINANT HAVE RIGHTS?

The first element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has rights in respect of the name or mark VIRGIN. The Complainant asserts that it has rights in and to the name and mark VIRGIN.

Under statute law, the Complainant has shown that it is the proprietor of registered rights in respect of the name and trademark VIRGIN in South Africa that date back to 1975 and 1980. The trademark VIRGIN was registered prior to the disputed domain name registration, and such trade mark registrations are *prima facie* valid and enforceable. This clearly provides the Complainant with rights in terms of section 34 of the Trade Marks Act no 194 of 1993. Infringement would take place in terms of that section if a person used a mark which is identical or similar to the registered trademark VIRGIN in respect of the services for which the trademark is registered, such as casino or gaming services, for example. Hence the Complainant has the aforementioned registered rights in South Africa. See the textbook Webster and Page: South African Law of Trade Marks, Fourth Edition, paragraphs 12.5 and 12.6 and the South African and foreign decided South African and foreign cases cited there.

Under common law, the Complainant asserts that, by virtue of extensive use and promotion of its name and trademark VIRGIN, it has developed a considerable repute or reputation therein, and hence goodwill as an asset of its business in South Africa. In fact it claims that its name and trademark is famous (or well-known to use the term recognized in the Trade Marks Act). Such goodwill, or more particularly reputation, could be damaged by means of unlawful competition or specifically passing off under the common law by another party wrongly representing that it is, or is associated with, the Complainant. It was pointed out in ZA2007-0003 that the registration and adoption of a domain name being a name or mark that enjoys a reputation, of another person, could readily amount to passing off under the common law. The Complainant therefore claims to have

justifiable and justiciable rights under the common law in respect of its name and trademark VIRGIN viz rights that can be enforced against others who infringe such rights. See ZA2007-0003 at page 9; and the textbook Webster and Page op cit, at paragraphs 15.5 and 15.7 and the decided South African and foreign cases cited there. The Adjudicator therefore finds that the Complainant has proved, on a balance of probabilities, that it has both registered and unregistered rights viz common law rights in the name or mark VIRGIN.

4.1.3 NAME OR MARK IDENTICAL OR SIMILAR TO DOMAIN NAME

The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proved that its name or mark, in which it has rights as set out above, is identical or similar to the (disputed) domain name. The Complainant asserts that the disputed domain name is confusingly similar to its name and mark VIRGIN.

The Complainant's name or mark (in which it has rights) is VIRGIN, while the disputed domain name is virginpoker.co.za. Ignoring the first and second level suffixes, in terms of Regulation 5(c), the comparison becomes virginpoker v VIRGIN.

The disputed domain name contains the Complainant's name and mark VIRGIN in its entirety. This word is undeniably the distinctive, dominant and memorable element of the domain name, and this is the feature that is known (or even well-known) to members of the public. The Registrant has merely added a descriptive (or generic term in gambling parlance) viz "poker" to the distinctive VIRGIN name/mark. The Registrant cannot escape the inevitable conclusion that the Complainant's name and mark VIRGIN is similar to the disputed domain name.

In support of the above, see the following foreign domain name decisions - In NAF/FA141825 it was held that: "It is also well-established under the policy that a domain name composed of a

trademark coupled with a generic term still is confusingly similar to the trademark.”

In WIPO/D2002-0367 the Panel concluded that: ”The disputed domain name contains Complainant’s EXPERIAN trademark in its entirety. The addition of the generic term “automotive” does not distinguish Respondent’s domain name from Complainant’s mark.”

See also for example the decisions WIPO/D2000-1598 in which niketravel and nikesportstravel were found to be similar to NIKE; DRS04601 in which nikestore was found to be similar to NIKE; and DRS01493 in which nokia-ringtones was found to be similar to NOKIA.

See also the following South African domain name decisions – in ZA2007-0003 telkommedia was found to be similar to TELKOM; in ZA2007-0010 mwebsearch was found to be similar to MWEB; in ZA2008-0025 suncityshuttle was found to be similar to SUN CITY; in ZA2009-0034 absapremiership was found to be similar to ABSA; in ZA2010-0048 etravelmag was found to be similar to ETRAVEL; and in ZA2013-00149 autotraderauction was found to be similar to AUTOTRADER.

Accordingly the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that its name and mark VIRGIN is similar to the disputed domain name.

4.1.4 IS THE DOMAIN NAME AN ABUSIVE REGISTRATION?

The third element that the Adjudicator needs to establish is whether, on a balance of probabilities, the domain name, in the hands of the Registrant, is an abusive registration. The Complainant asserts that the disputed domain name is an abusive registration.

This means that the Adjudicator needs to determine whether the disputed domain name is an abusive registration as defined in the definition section of the Regulations viz in Regulation 1, and as set out above. According to the definition, and to various Nominet

decisions, there are two potential abuses (or two types of abuse) viz:

- a) Registration with an abusive intent; and/or
- b) Use in an abusive manner.

The Adjudicator refers to DRS 02464 (Aldershot Car Spares v Gordon); and to DRS 00658 (Chivas Brothers Ltd v David William Plenderleith) in which the Expert found that: *“Where a Respondent registered a domain name*

- 1) which is identical to a name in which the complainant has rights;*
- 2) where that name is exclusively referable to the complainant;*
- 3) Where there is no obvious justification for the Respondent having that name for the domain name;*
- 4) Where the Respondent has come forward with no (reasonable) explanation for having selected the domain name; it will ordinarily be reasonable for an expert to infer first that the Respondent registered the domain name for a purpose and secondly that such purpose was abusive.”*

See also ZA2007-007 (FIFA v X Yin) in this regard.

The Adjudicator concurs with the view that the nature of “abusive” in the Regulations does not necessarily require a positive intention to abuse the Complainant’s rights but that such abuse is the effect of the registration or use of the disputed domain name.

Regulations 4 and 5 provide a list of (non-exhaustive) factors which may indicate that the disputed domain name is, or is not, an abusive registration, respectively. The Complainant has asserted some of these factors that will be discussed below viz:

- a) That the Registrant has registered the disputed domain name primarily to disrupt unfairly the business of the Complainant**

The Complainant discovered that the domain name was pointing to the website of www.silversands.com. Accordingly the Registrant was

attempting to take unfair advantage of the VIRGIN trademark by driving on-line traffic to the business of an alternative gambling website. The dominant part of the domain name is VIRGIN, and it is likely that members of the public will be confused and will associate the domain name with the Virgin Group, more particularly because the Complainant's trademark VIRGIN is registered and used in respect of financial, gaming, casino and gambling services. Adoption by the Registrant of the name and trademark VIRGIN therefore gives an unfair advantage to the Respondent, and use, as set out above, of the domain name will take away business from the Complainant, which should legitimately have come to the Complainant. In addition, it is known that the above practice in the industry provides a consideration for the Registrant for referrals or so-called "click-throughs." This was, so it is asserted by the Complainant, the intention of the Registrant.

To the extent that the disputed domain name and the Registrant's website were diverting internet traffic from the Complainant that was intended for the Complainant, this is prejudicial to the Complainant and its functions. This will clearly disrupt unfairly the business activities of the Complainant.

In support of the aforementioned, the Adjudicator points out that various UDRP decisions have found that disruption of a business may be inferred if the Registrant has registered a variant of the Complainant's mark by adding a generic word. See for example WIPO/D2000-0777, NAF/FA94942, NAF/FA94963, AND NAF/FA95402. See also the WIPO Case Nos. D2005-0604 (proyectorsepson.com) and D2007-0424 (alstom-china.com).

In support of the aforementioned the Adjudicator also refers to the decision ZA2012-0117 South African Revenue Services v Antonie Goosen (sarstax.co.za) in which the Adjudicator confirmed that the disruption of the business of the Complainant may be inferred if the Registrant has registered a variant of the Complainant's mark by merely adding a generic word.

Accordingly the Adjudicator comes to the conclusion that this factor applies in the present dispute, and that indicates that the domain name is an abusive registration.

b) That there are circumstances indicating that the Registrant is using, or has registered, the domain name in a way that leads people and/or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected to the Complainant

The Complainant asserts that, because of the extensive reputation of the name and trademark VIRGIN, it is highly likely that people and/or business will be confused and will believe that the disputed domain name is somehow associated or linked with the Complainant.

Such unauthorized use of the (similar) disputed domain name by the Registrant, in view of the statutory and common law rights of the Complainant, amounts respectively to trademark infringement and to passing off (under the common law) by the Registrant. In this regard, it should also be mentioned that a plaintiff in passing off proceedings does not have to show actual damages suffered but it will be sufficient to show a likelihood of damages or prejudice to its goodwill or reputation. See Webster and Page *supra*.

See for example the decisions in the foreign cases WIPO/D2000-0545, NAF/FA95319, NAF/FA95464, and NAF/FA95498. See also the decisions in the foreign cases WIPO/D2000-0777, WIPO/D2000-878, NAF/FA95033, and NAF/FA95402, WIPO/D2005-0283 and WIPO/D2009-0286; and the above cited NIKE and NOKIA decisions.

See also the decision in the South African case ZA2012-0117 cited above. Hence the Adjudicator comes to the conclusion that this is a

real and present factor in the present dispute, and that indicates that the domain name is an abusive registration.

c) That the Registrant has provided false or incomplete information in the WHOIS database

The Complainant has shown that the Registrant, in the WHOIS details, has not provided his full names or his surname; and that he has not provided any ordinary contact address (other than an e-mail address).

Clause 5.1.1 of the Uniform SA terms and conditions states: "Applicant (the Registrant herein) hereby irrevocably represents, warrants and agrees that its statements in the Application are accurate and complete." The WHOIS details clearly indicate that the Registrant has not complied with the aforementioned terms and conditions; and that he has in fact breached such terms and conditions. The Complainant alleges that this action by the Registrant is a clear indication of devious intent (and has made communication with the Registrant impossible). Accordingly the Complainant asserts that the domain name should be taken out of the hands of the Registrant.

In various WIPO and NAF decisions, it has been found that incomplete or inaccurate information indicates bad faith on the part of the Registrant. See for example WIPO/D2000-0501 and NAF/FA92016. See also the South African decision in ZA2007-0003. Accordingly, the Adjudicator comes to the conclusion that this is a factor in the present dispute, and that indicates that the domain name an abusive registration.

4.2 Abusive Registration

4.2.1 Hence the Adjudicator finds, on a balance of probabilities, that the disputed domain name 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; and

4.2.2 The Adjudicator likewise finds, on a balance of probabilities, that the disputed domain name has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

4.2.3 Accordingly, taking all the above factors into account, the Adjudicator finds, on a balance of probabilities, that the disputed domain name is an abusive registration.

5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, virginpoker.co.za, be transferred to the Complainant.

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ANDRE VAN DER MERWE
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za