

2014-0182

.ZA ALTERNATE DISPUTE RESOLUTION REGULATIONS
(GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	2014-0182
DECISION DATE:	3 October 2014
DOMAIN NAME	EMPOWERDEX-SA.CO.ZA
THE DOMAIN NAME REGISTRANT:	Tsakisi Mathebula
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Empowerdex (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
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 **26 June 2014**. On **30 June 2014** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **30 June 2014** ZA Central Registry confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute [together with the amendment to 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 **3 July 2014**. In accordance with the Regulations the due date for the Registrant's Response was **31 July 2014**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **1 August 2014**.
- c. The SAIPL appointed **Janusz F Luterek** as the Adjudicator in this matter on **15 September 2014**. 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.

2) Factual Background

- a. Complainant has registered a slew of trade marks, including 2005/17988 for EMPOWERDEX in class 41 applied for on 31 August 2005.
- b. The Complainant's statutory trade mark rights are valid, enforceable and predate the registration of the offending domain name by more than seven years.
- c. The Complainant further owns the domain name <empowerdex.co.za>, which incorporates its EMPOWERDEX trade mark. The Complainant's

services are offered and promoted to the public at the corresponding website at www.empowerdex.co.za. This website has been in use since its registration in 2002.

3) Parties' Contentions

a. Complainant

- i. The dominant and memorable element of the disputed domain is the first element, EMPOWERDEX. The dominant element of the disputed domain name is phonetically identical and visually similar to the Complainant's registered EMPOWERDEX trade mark.
- ii. The word "-sa" is wholly descriptive and is indicative of the country, namely South Africa, where the Registrant probably intends to work/ where the Complainant conducts its business and has registered statutory rights, and which relates to the country specific second level domain name. The addition of the hyphen and these two letters is not sufficient to distinguish the disputed domain name from the Complainant's EMPOWERDEX trade mark.
- iii. The Complainant submits that there is a substantial likelihood that internet users and consumers will be confused into believing that there is some affiliation, connection, sponsorship, approval or association between the Group and the Registrant when, in fact, there is no such relationship. For example, it is very likely that a consumer will be misled into thinking that the disputed domain is a dedicated domain name aimed at promoting the Complainant's services.
- iv. The Complainant alleges that the continued use and registration of the disputed domain name is abusive at least in that circumstances exist 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.

v. The Complainant submits that the Registrant has no legitimate interest in the domain name and his motives for registering the domain name are at the very minimum, suspicious. It is difficult to infer that the domain name was chosen for any reason other than to be able to imitate the Complainant. As discussed above, the Complainant has significant rights in its EMPOWERDEX trade marks. These well-established and widely known rights suggest that the Registrant must have known of the Complainant's rights prior to the registration of the disputed domain name, especially given the Complainant's use of this trade mark for more than 12 (twelve) years.

b. Registrant

- i. The Registrant as Respondent did not reply to the Complainant's contentions.

4) Discussion and Findings

a. Complainant's Rights

- i. Complainant's has rights in respect of a name or mark which is identical or similar to the domain name in dispute, for example, 2005/17988 for EMPOWERDEX in class 41 applied for on 31 August 2005 and granted on 26 January 2010.
- ii. In AB Electrolux AB vs. Johan van Zyl (ZA2013 - 0135) it was held that "it is a well-established legal principle that a domain name that comprises a trade mark coupled with a generic term is still confusingly similar to the trade mark". The Complainant submits that this reasoning applies equally in this matter and the Adjudicator agrees with this submission. The combination of the trade mark EMPOWERDEX with the addition of "-sa" creates a domain name that can only be regarded as confusingly similar to the Complainant's prior registered EMPOWERDEX trade mark.

b. Abusive Registration

- i. 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.
- ii. Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.
- iii. The word EMPOWERDEX is not one that appears in any dictionary, as it is a word that was created by the Complainant to serve as its distinctive name and trade mark. It is entirely implausible that the Registrant could have independently come up with the same name without reference to the Complainant. Its registration of the domain name wholly incorporating the Complainant's trade mark was therefore clearly in bad faith.
- iv. The registration of the disputed domain name, which is so similar to the EMPOWERDEX trade mark, by the Registrant, has the effect that the Complainant is barred from registering or using the disputed domain name for itself. The Adjudicator is in agreement with the WIPO UDRP decision of Red Bull GmbH vs. Harold Gutch (02000-0766), cited by the Complainant, where the Panel list in casu found that the mere registration of a domain name that contains the well-known mark of another effectively prevents the trade mark owner from reflecting their distinctive and well-known mark in the corresponding domain name.
- v. The Registrant registered the disputed domain name on 17 March 2014, more than six years after the Complainant obtained registration of its EMPOWERDEX trade mark in South Africa. The Registrant is not offering any goods or services on the website associated with the disputed domain name. There is simply a "park page" at www.empowerdex-sa.co.za. However, the Registrant is using the domain for its email addresses and has sent emails to

third parties, including the Complainant, which on the face of it appear to pose as being related to the Complainant.

vi. Thus, under the circumstances there is sufficient evidence indicating that the Registrant has registered or otherwise acquired the domain name in an abusive manner in accordance with Regulation 4(1):

1. to block intentionally the registration of a name or mark in which the Complainant has rights;
2. to disrupt unfairly the business of the Complainant; or
3. to prevent the Complainant from exercising his, her or its rights.

vii. Circumstances also exist 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.

viii. Thus, under all the circumstances the registration of the domain EMPOWERDEX-SA.CO.ZA is held to be abusive.

c. Offensive Registration

- i. NOT APPLICABLE

5) Decision

a. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, EMPOWERDEX-SA.CO.ZA be transferred to the Complainant.

Janusz F Luterek

SAIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za