

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0257
DECISION DATE:	3 April 2017
DOMAIN NAME	nationalyellowpages.co.za
THE DOMAIN NAME REGISTRANT:	LENNY MUNSAM
REGISTRANT' S LEGAL COUNSEL:	None
THE COMPLAINANT:	TELKOM SA SOC Limited
COMPLAINANT' S LEGAL COUNSEL:	Adams & Adams
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZACR (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **30 January 2017**. On **30 January 2017** the SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **30 January 2017** the ZACR 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 **31 January 2017**. In accordance with the Regulations the due date for the Registrant’ s Response was **28 February 2017**. From the record, it appears that the Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **01 March 2017**.
- c. The SAIPL appointed **Janusz F Luterek** as the Adjudicator in this matter on **14 March 2017**. 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

- 2.1 The Complainant, is the proprietor in South Africa of trade mark registrations for the mark **YELLOW PAGES** and trade marks fully incorporating **YELLOW PAGES**. In particular, *inter alia*, **YELLOW PAGES** is registered in class 16 under registration number no. B72/4382 and class 35 under registration 86/4489.
- 2.2 The Complainant (formerly known as Telkom S.A. Limited), is a South African state owned company and a fixed and wireless telecommunications provider in South Africa, and operates in more than 38 countries across the African continent. The Complainant owns registered rights in South Africa in respect

of its **YELLOW PAGES** marks, dating back to 1972. The Complainant has also, through its subsidiary and licensee, Trudon (Pty) Limited, and Trudon (Pty) Limited's predecessors in title, made use of its **YELLOW PAGES** mark in South Africa since 1992.

2.3 Trudon (Pty) Limited, with the consent of the Complainant, uses the mark **YELLOW PAGES** in the domain name yellowpages.co.za and prints telephone directories under the mark **YELLOW PAGES** and distributes these **YELLOW PAGES** directories in 19 geographical areas throughout South Africa.

3) Parties' Contentions

a. Complainant

- i. The Complainant has made extensive and widespread use of its trade mark **YELLOW PAGES**, in South Africa. The Complainant has, in addition to its statutory rights acquired substantial common law rights in its trade mark **YELLOW PAGES**. The complainant has submitted that the mark **YELLOW PAGES** has acquired a substantial reputation and qualifies as a well-known trade mark in terms of the Trade Marks Act no 194 of 1993.
- ii. The Disputed Domain Name, nationallyyellowpages.co.za, incorporates the Complainant's well-known and registered **YELLOW PAGES** trade mark. The addition of the descriptive word "national" does not distinguish the Registrant's mark from that of the Complainant. Accordingly, the marks **YELLOW PAGES** and **NATIONAL YELLOW PAGES** are visually, phonetically and conceptually identical or, alternatively, confusingly similar.
- iii. In light of the above, the Complainant submits that the mark **NATIONAL YELLOW PAGES** is likely to appear to the public as the alternative description for **YELLOW PAGES** and does not distinguish the Disputed Domain Name from the Complainant's trade mark **YELLOW PAGES**. After all, the Complainant uses its **YELLOW PAGES** trade mark on a national basis, i.e. across the entire South Africa. As a result, the Disputed Domain Name is

likely to deceive or confuse members of the public into believing that it is somehow associated with the Complainant. The Complainant thus submits that the Registrant has incorporated a confusingly similar mark to the Complainant's YELLOW PAGES trade mark in the Disputed Domain Name, without the Complainant's authorisation or consent.

- iv. In addition to the above, the Complainant provided evidence that a website previously linked to the Disputed Domain Name, which was situated at www.nationalyellowpages.co.za, referred directly to the mark YELLOW PAGES. It was submitted by the Complainant that the mark NATIONAL YELLOW PAGES was purposely derived from the Complainant's mark YELLOW PAGES and is, accordingly, aimed directly at bringing the Complainant's mark to mind or, at the least, creating an association with the Complainant's YELLOW PAGES mark.
- v. The Complainant further submits that although the domain name does not currently resolve to an active website, however, at one stage, the Disputed Domain Name resolved to a website promoting the exact services offered by the Complainant, through its subsidiary, Trudon (Pty) Limited. The Registrant used the Disputed Domain Name in relation to services covered by the Complainant's trade mark registrations. The Registrant, therefore, infringed the Complainant's rights in its YELLOW PAGES trade mark in terms of Section 34(1) (a) of the Trade Marks Act.
- vi. In light of the above, it is also submitted by the Complainant that the past use of the Disputed Domain Name by the Registrant took unfair advantage of, or has been detrimental to, the distinctive character or repute of the Complainant's well-known YELLOW PAGES trade mark. Such use, therefore, amounted to trade mark infringement in terms of Section 34(1)(c) of the Trade Marks Act.
- vii. The Complainant submits that in terms of Regulation 5(c) the Registrant bears the burden of proof to show that the Disputed Domain Name is not an abusive registration if the domain name is

identical to the trade mark in which the Complainant asserts rights. As submitted above, the Complainant submits that the Disputed Domain Name is confusingly similar to the Complainant's **YELLOW PAGES** trade mark and, in addition, the Disputed Domain Name previously resolved to a website that used the Complainant's identical **YELLOW PAGES** mark in relation to the exact services covered by the Complainant's trade mark registrations. It is, therefore, submitted that this presumption should apply to this complaint.

- viii. The Complainant further submits that as a result of the Complainant's long-standing use of its **YELLOW PAGES** trade mark and the fact that the Registrant's website referred to the Complainant's trademark **YELLOW PAGES**, it is submitted that the Registrant registered the Disputed Domain Name with full knowledge of the Complainant's trade mark rights in the mark **YELLOW PAGES**. There is no other reasonable explanation for the incorporation of the Complainant's well-known **YELLOW PAGES** trade mark in the Disputed Domain Name, in relation to the exact same services for which the Complainant's **YELLOW PAGES** mark is well-known, other than that the Registrant intended to take unfair advantage of the goodwill and reputation which vest in the **YELLOW PAGES** trade mark.
- ix. In light of the above, it is submitted by Complainant that the Disputed Domain Name can be regarded as a variation of the Complainant's registered trade mark. In *Samsung Electronics Co. Ltd v Sean Elseworth* [ZA2008 - 0022] it has been accepted that a disruption of the Complainant's business may be inferred if the Disputed Domain Name is a variation of the Complainant's mark.
- x. On 2 June 2016, after becoming aware of the Disputed Domain Name, the Complainant sent a letter to the Registrant calling upon the Registrant to desist in any use of the **YELLOW PAGES** or confusingly similar trademarks, and to cancel the Disputed Domain Name. On 14 June 2016, the Registrant sent an e-mail to the Complainant's attorneys indicating that he will refrain from trading

as National Yellow Pages and will refrain from using the mark **YELLOW PAGES**.

- xi. Notwithstanding the above undertaking by the Registrant, he refuses to cancel his registration of the offending domain name and has, to date, not cancelled his registration of the domain name nationallyellowpages.co.za. He is, accordingly, continuing to make unauthorised use of the Complainant's registered trade mark in his domain name. Such use is in breach of the undertaking given by the Registrant to the Complainant. In addition, by maintaining his registration of his offending domain, he is also able to use the mark NATIONAL YELLOW PAGES in his e-mail addresses, viz. marketing@nationallyellowpages.co.za; sales@nationallyellowpages.co.za; info@nationallyellowpages.co.za; hello@nationallyellowpages.co.za.
- xii. The Complainant submits that the Disputed Domain Name is not registered to, operated or authorised by, or otherwise connected with the Complainant. Accordingly, the Disputed Domain Name offends the provisions of Regulation 4(1)(b) and is an abusive registration. In this regard, the Complainant refers to the matter of South African Airways (Pty) Limited v. Ryzhov Volodymyr [ZA2015-0209].
- xiii. The Complainant requests that for the reasons submitted, the Adjudicator issues a decision for the transfer of the disputed domain name in terms of Regulation 9(a).

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 has rights in respect of a name or mark which is identical or similar to the domain name in dispute, for example, YELLOW PAGES is registered in class 16 under registration number no. B72/4382 and class 35 under registration 86/4489.
- ii. In the UDRP case of Red Bull GmbH vs Harold Gutch (02000/0766), the panel also found that the registration of a domain name which incorporates the well-known trade mark of another effectively prevents the trade mark owner from using its distinctive and well-known trade mark in the corresponding domain name. In Samsung Electronics Co. Ltd v Sean Elseworth [ZA2008 - 0022] it has been accepted that a disruption of the Complainant's business may be inferred if the Disputed Domain Name is a variation of the Complainant's mark. It is the Adjudicator's view in the present matter that the disputed domain name in this case similarly prevents Complainant from using its YELLOW PAGES trade mark and therefore that the disputed domain name prevents the Complainant from exercising its rights in the YELLOW PAGES trade mark.

b. Abusive Registration

- i. The Registrant's conduct amounts to an unfair disruption of the business of the Complainant's licensees. As a direct result of the registration of the domain name, potential customers interested in the goods and services of the Complainant's licensees, may be redirected to the disputed domain name. It is submitted that internet traffic that should reach the Complainant and its licensees will be diverted as a result and to the prejudice of the Complainant and its licensees. In Telkom SA Limited v Cool Ideas 1290 CC [ZA2007 -0003] it was 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, such as the case with the disputed domain name nationallyellowpages.co.za.

-
- ii. The registration and use of the disputed domain name would lead people and/or businesses to believe that the domain name is registered to, operated by, authorised by and/or associated in some way to the Complainant, when this is not the case. The disputed domain name, therefore, creates the impression that the Registrant is in some way associated and/or connected to the Complainant, due to the similarity between the disputed domain name and the Complainant's well-known YELLOW PAGES trade mark. This finds support in *Telkom SA Limited v Cool Ideas 1290 CC [ZA2007 -0003]*.
- iii. The circumstances relating to the registration of the disputed domain name in the name of the Registrant are unknown and since the Registrant has agreed to cease using the disputed domain and subsequently failed to respond to the Complaint, the only conclusion that can be drawn is that the Registrant was never within his rights to register the disputed domain name in its own name. Thus, in terms of Regulation 5(c) the burden to show that the registration was not abusive shifts to the Registrant, who as stated previously failed to respond and has not discharged that burden.
- iv. 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.
- v. Thus, under all the circumstances the registration of the domain `nationallyellowpages.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, nationalyellowpages.co.za be transferred to the Complainant.

.....

Janusz F Luterek
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za