

## **ADJUDICATOR DECISION**

CASE NUMBER:	<b>ZA2017-00272</b>
DECISION DATE:	<b>31 August 2017</b>
DOMAIN NAME	<b>heraldonline.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Corp Terramonte</b>
REGISTRANT'S LEGAL COUNSEL:	<b>n/a</b>
THE COMPLAINANT:	<b>Times Media (Pty) Ltd</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Tyrone Walker, Moore Attorneys Inc, Fourways, RSA</b>
THE 2 <sup>nd</sup> LEVEL DOMAIN NAME ADMINISTRATOR:	<b>ZACR (co.za Administrators)</b>

## 1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **6 July 2017**. On **6 July 2017** SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **7 July 2017** ZACR confirmed that the domain name had indeed been suspended. SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and SAIPL's Supplementary Procedure.
- b. In accordance with the Regulations, SAIPL formally notified the Registrant of the commencement of the Dispute on **12 July 2017**. In accordance with the Regulations the due date for the Registrant's Response was **10 August 2017**. The Registrant did not submit any response, and accordingly, SAIPL notified the Registrant of its default on **14 August 2017**.
- c. The Complainant did not need to submit any Reply.
- d. SAIPL appointed **Christiaan Steyn** as the Adjudicator in this matter on **16 August 2017**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

## 2) Factual Background

- a. The Complainant is Times Media (Pty) Ltd, a company duly incorporated according to the laws of the Republic of South Africa, having its principle place of business at 4 Biermann Avenue, Rosebank, Johannesburg, South Africa, being listed on the Johannesburg Stock Exchange. The Complainant offers media services, which includes information, education, entertainment and social services. The Complainant further owns several "brands", including its HERALD brand, used for newspaper publication services. The Complainant has provided sufficient proof hereof.

- b. The Complainant's HERALD Newspaper was first published on 7 May 1845, and is regarded as one of the oldest existing newspaper publications in South Africa. The physical (hard-copy) edition of the HERALD Newspaper is distributed in the Eastern Cape Province, with its main area being in Port Elizabeth, South Africa. The HERALD Newspaper has a circulation of 23 372 (twenty three thousand, three hundred and seventy two) and a readership of 257 000 (two hundred and seven thousand). An electronic version of the HERALD Newspaper is also available through electronic means throughout South Africa, through the domain names *heraldline.co.za* and *herald.newspaperdirect.com*. The Complainant has also provided sufficient proof hereof.
- c. The Complainant has registered the name(s) and trade mark(s) ('brand'), **HERALD (THE)** and **HERALD TRAVELLER'S CLUB (THE)**, in various classes in South Africa, the dates of these being 26 November 2007 and 13 October 2011 respectively. The Complainant has provided proof of these trade mark registrations.
- d. The Complainant further registered various domain names which include its "**HERALD**" mark(s), including *theherald.co.za*, *theheraldonline.co.za* and *heraldlive.co.za*. The Complainant has hosted its website on these domains, and made use of its **HERALD** marks thereon, since 2001. The Complainant has provided proof of this use.
- e. In August 2016, the Complainant became aware of the disputed domain name registration ***heraldonline.co.za***, owned and registered by the Registrant on 17 March 2010.
- f. On 10 August 2016, the Complainant, through its representative, addressed a letter of demand based on the Complainant's rights, to the Registrant, *inter alia* demanding that the disputed domain name be transferred to the Complainant on the basis that the disputed domain name are abusive registrations, and putting them on notice that formal proceedings would be initiated if the demands were not met.

- g. No response was received hereon from the Registrant and the Registrant failed to comply with the Complainant's demands. This Complaint was thereafter filed with the Administrator on 6 July 2017.

### **3) Parties' Contentions**

#### **a. Complainant**

- i. 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 proven, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present:
1. that the Complainant has rights in respect of a name(s) or mark(s);
  2. that is identical or similar to the disputed domain name; and
  3. that, in the hands of the Registrant, the disputed domain name is an abusive registration.
- ii. An abusive registration is defined in the definitions of Regulation 1, to mean a domain name(s) which either:
1. 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
  2. has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

#### **b. Substantive Aspects**

- i. Turning to the substantive aspects of this Complaint, the Adjudicator has carefully perused the Complaint, and has fully considered the facts and contentions set out therein.

#### **c. Rights in Respect of Names or Marks**

- i. 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.
- ii. As has been decided in the South African appeal decisions of *seido.co.za* (ZA2009-00030) and *xnets.co.za* (ZA2011-00077), the notion of "rights" for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. The threshold in this regard should be fairly low.
- iii. It is also a matter of *locus standi* in order to make sure that the person who lodges the Complaint is someone with a proper interest in that Complaint. The threshold in this regard should also be fairly low.

#### **d. Does the Complainant have Rights**

- i. The first element that the Adjudicator needs to establish is whether, as set out above, and in terms of Regulation 3(1)(a), on a balance of probabilities, the Complainant has rights in respect of the name(s) or trade mark(s) **HERALD (THE)** and **HERALD TRAVELLER'S CLUB (THE)**. This will also determine whether the Complainant has the necessary *locus standi* to bring this Complaint. The Complainant contends that it has rights in and to the name(s) or trade mark(s) **HERALD (THE)** and **HERALD TRAVELLER'S CLUB (THE)**, and, as no response was lodged by the Registrant, the Registrant does not contest this.
- ii. The Complainant has shown that it has registered its names or trade marks **HERALD (THE)** and **HERALD TRAVELLER'S CLUB (THE)** in various classes in South Africa, from as early as 2007. These trade mark registrations are shown to be in force and are considered by the Adjudicator to be *prima facie* valid. For the sake

of this dispute, the Adjudicator will focus on the Complainant's **HERALD (THE)** name and trade mark.

- iii. The South African trade mark registrations and the rights flowing from these registrations could be enforced by the Complainant against an infringer who without authority was to use the name or trade mark **HERALD (THE)** or a confusingly similar trade mark, in the course of trade.
- iv. In support of the abovementioned, the Adjudicator refers to the South African Law of Trade Marks by Webster and Page, Fourth Edition, paragraph 12.5 *et seq* (hereafter "Webster and Page"), and the foreign and South African decided cases cited therein.
- v. These rights could also be used against a third party who was to attempt to register such a trade mark, in order to oppose such a trade mark application.
- vi. In support of the abovementioned, the Adjudicator refers to Webster and Page, paragraph 8.30 *et seq*, and the decided cases cited therein.
- vii. The Complainant has also registered various domain names in South Africa and in other countries, which include its name or trade mark **HERALD (THE)**. This provides the Complainant with rights in terms of the Regulations to object to a disputed domain name in the event that their name or trade mark **HERALD (THE)** is identical or similar to a disputed domain name.
- viii. The Complainant states that it has spent considerable resources on marketing and promoting its **HERALD** brand(s), which have become known to, and associated by, a substantial number of the public with the Complainant. Accordingly, the Complainant contends that, by virtue of its aforementioned activities, it has developed a substantial repute or reputation in South Africa, and hence goodwill, in terms of the common law.

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- ix. Such reputation, as forming part of the goodwill, stemming from that reputation, in respect of its name or trade mark **HERALD (THE)**, could be damaged by means of unlawful competition (or more particularly passing-off) under the common law by another party wrongly representing that it is, or is associated with, or part of, the Complainant and its business.
- x. It was pointed out in the South African domain name decision ZA2007-0003 (*telkommedia.co.za*) that the registration, adoption and use 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 or trade mark **HERALD (THE)** rights that can be enforced against others who infringe or would be likely to damage such rights.
- xi. In support of the above, the Adjudicator refers to the above-mentioned South African domain name decisions ZA2017-00265, ZA2007-00003; and Webster and Page, at paragraphs 15.5 and 15.7, including the decisions cited therein.
- xii. The Registrant, by virtue of omission, does not dispute that the Complainant has registered trade marks in respect of **HERALD (THE)** and **HERALD TRAVELLER'S CLUB (THE)**, and furthermore, the Registrant does not dispute or challenge the above-mentioned rights as claimed by the Complainant.
- xiii. Considering the above factors, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that it has both registered and unregistered (common law) rights in respect of the name and trade mark **HERALD (THE)**. The Complainant has thereby also established that it has the necessary *locus standi* to bring this Complaint.

**e. Names or Marks Identical or Similar to the Disputed Domain name**

- i. The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proven that its name or trade mark **HERALD (THE)**, in which it has rights, are identical or similar to the disputed domain name. The Complainant contends that its name or trade mark **HERALD (THE)** is similar to the disputed domain name, which was, by omission, not contested by the Registrant.
- ii. The Complainant's names and trade marks (in which it has rights) are **HERALD (THE)** and **HERALD TRAVELLER'S CLUB (THE)**, while the disputed domain name is *heraldonline.co.za*. Ignoring the first and second level suffixes, in terms of Regulation 5(c), the comparison becomes a comparison of **HERALD (THE)**, against **HERALDONLINE**.
- iii. Herein, firstly, the Registrant has simply added the generic word 'ONLINE' and removed the space between the words 'HERALD' and 'ONLINE'. Furthermore, considering the services offered by the Complainant under its name and trade mark **HERALD (THE)**, it is evident that the word 'ONLINE' is purely generic and descriptive. It is therefore evident that the disputed domain name is similar to the Complainant's name and trade mark **HERALD (THE)**. In support hereof, in ZA2016-00247 the domain name *rememberingmadiba.co.za* was found to be similar to MADIBA, in ZA2016-00250 the domain name *sundaytimeslive.co.za* was found to be similar to SUNDAY TIMES, and in ZA2017-00265 the domain names *reedexpo.co.za* and *reedexhibitions.co.za* were found to be similar to REED.
- iv. Furthermore, disregarding the 'THE' element of the Complainant's name and trade mark **HERALD (THE)**, the disputed domain name contains the Complainant's name and trade mark **HERALD (THE)**



in its entirety. In support hereof, in ZA2016-00248, the domain name *timeslives.co.za* was found to be confusingly similar to TIMES LIVE, and similarly, in ZA2016-00254, the domain name *anglogoldashantiafrica.co.za* was found to be confusingly similar to ANGLOGOLD and ANGLOGOLD ASHANTI. Also see ZA2016-00247, ZA2016-00250 and WIPO/D2002-00367 herein.

- v. Subsequent, the Adjudicator is of the view that a reasonable person will inevitably come to the conclusion that the Complainant's name and trade mark **HERALD (THE)** is similar to the disputed domain name.
- vi. Furthermore, the Adjudicator takes note that the disputed domain name is also similar to the Complainant's domain names *theherald.co.za*, *theherladonline.co.za* and *heraldlive.co.za*, used by the Complainant for its official website(s).
- vii. The Adjudicator also wishes to point out that the test herein is not "confusing similarity" but merely "similarity", which involves a lower standard of comparison. In support hereof, see ZA2017-00265.
- viii. Accordingly, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that the name and trade mark **HERALD (THE)** is similar to the disputed domain name.

**f. Are the Disputed Domain name Abusive Registrations**

- i. The third element that the Adjudicator needs to establish is whether, on a balance of probabilities, the disputed domain name, in the hands of the Registrant, is an abusive registration.
- ii. The Complainant contends that the disputed domain name is, in the hands of the Registrant, an abusive registration, while the Registrant omitted to respond. The Complainant herein submitted that, in terms of Regulation 4, the Registrant has registered the domain name primarily to:

1. Intentionally block the registration of the domain name *heraldonline.co.za* in which the Complainant has rights;
  2. Unfairly disrupt the business of the Complainant;
  3. Prevent the Complainant from exercising its rights in and to the domain name *heraldonline.co.za*;
  4. Lead people or business to believe that the domain name is registered by, operated or authorised by, or otherwise connected to the Complainant;
  5. Attract internet users to the disputed domain name and does so for commercial gains, as is evident by the fact that the Registrant is willing to sell the domain name; and
  6. Be used in a manner that takes unfair advantage of, or is ungainly detrimental to, the Complainant's rights.
- iii. The Adjudicator is subsequently required to determine whether the disputed domain name is an abusive registration as defined by Regulation 1, and as set out above.
- iv. According to the definition, and to various Nominet decisions, there are two potential abuses (or two types of abuse), being:
1. Registration with an abusive intent; and/or
  2. Use in an abusive manner.
- v. The Adjudicator herein refers to the foreign decisions DRS02464 (Aldershot Car spares v Gordon), DRS00658 (Chivas Brothers Ltd v David William Plenderleith), and the South African decisions ZA2007-0007 (FIFA v X Yin), as referred to in 2017-00265. Against the background of the aforementioned decisions, the Adjudicator agrees 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 can be the result, effect or consequence of the registration and/or use of the disputed domain name.

vi. As contended above by the Complainant, Regulation 4 lists factors or circumstances which indicate that the Registrant has registered the disputed domain name for various stated reasons. The Adjudicator will now focus on the most pertinent aspects, in its view, which *inter alia* include:

**1. Regulation 4(1)(a)(i):**

- a. It is clear from the provided evidence that the Registrant offers the disputed domain name *heraldonline.co.za* for sale, stating on its website used under the disputed domain name: *"...heraldonline.co.za is for sale..."*
- b. It is reasonable to assume that the Registrant registered the disputed domain name to sell such domain name, which would lead to out-of-pocket expenses on the side of the Complainant to obtain such. This public offer for sale of the disputed domain name may further be regarded as a factor for abusiveness. See the decisions in ZA2015/00208 herein.
- c. The Registrant, by omission to lodge a Response, has offered no reason for this conduct.
- d. Accordingly, the Adjudicator concludes that this circumstance applies in the present dispute, and that this factor indicates that the disputed domain name may be an abusive registration. See ZA2017-00256, ZA2015-00208 herein.

**2. Regulation 4(1)(b):**

- a. The Complainant has clearly established that it has rights in the names and trade marks **HERALD (THE)** and **HERALD TRAVELLER'S CLUB (THE)**, and that the Complainant's name and trade mark

**HERLAD (THE)** is similar to the disputed domain name.

- b. Furthermore, the Registrant also makes unauthorised use of the Complainant's names and trade marks (in which it has rights) on its website being used under the disputed domain name.
  - c. Therefore, based on above, there exists a likelihood that the public will be confused or deceived into thinking that the Registrant is related to, or associated with, the Complainant.
  - d. Actual confusion is furthermore not necessary, and the potential or (reasonable) likelihood for confusion is sufficient. See foreign decisions WIPO/D2000-0777, WIPO/D2000-0878, NAF/FA95033 and NAF/FA95402, as well as the South African decision ZA2007-0003, ZA2016-00254 and ZA2017-00265 herein.
- vii. Accordingly, the Adjudicator concludes that *inter alia* the above circumstances apply in the present dispute, and that these factors indicate that the disputed domain name is an abusive registration.

**g. Registrant**

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

**4) Discussion and Findings**

**a. Abusive Registration**

- i. The Adjudicator concludes that the disputed domain name was registered 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. Therefore, the Adjudicator finds that the disputed domain name, in the hands of the Registrant, is an abusive registration.

## 5) Decision

- a. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, *heraldonline.co.za*, be transferred to the Complainant.

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**CHRISTIAAN STEYN**

SAIPL ADJUDICATOR

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