

## ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2007-0003</b>
DECISION DATE:	<b>13 JULY 2007</b>
DOMAIN NAME	<b>telkommedia.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Cool Ideas 1290 CC 25 SIDONIA AVENUE, NORWOOD, JOHANNESBURG, GAUTENG</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>TELKOM SA LIMITED TELKOM TOWERS NORTH 152 PROES STREET PRETORIA, GAUTENG</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Buys Inc.</b>
THE 2 <sup>nd</sup> LEVEL DOMAIN NAME ADMINISTRATOR:	<b>UniForum SA (CO.ZA Administrators)</b>

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## 1. Procedural History

This Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on 24 May 2007. On 28 May 2007, the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on 28 May 2007 UniForum SA confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations") and the SAIPL'S Supplementary Procedure.

In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on 28 May 2007. In accordance with the Regulations the due date for the Registrant's response was 25 June 2007. The Registrant submitted its Response on 22 June 2007, and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL's Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on 22 June 2007.

In accordance with the Regulations, the due date for the Complainant's reply was 29 June 2007. The Complainant submitted its reply on 25 June 2007.

The SAIPL appointed Mr Andre van der Merwe as the Adjudicator in this Dispute on 26 June 2007. The Adjudicator has submitted a 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

On 30<sup>th</sup> September 1991 the Complainant was registered and incorporated as a public company in terms of the Companies Act of 1973 under registration no. 1991/005476/06. Since that date the Complainant has been offering a range of telecommunications-related goods and services in the South African market,

including fixed line telephone infrastructure, Internet access and ADSL broadband connectivity.

On 6 February 2006 the Complainant registered the company Telkom Media (Pty) Limited in terms of the Companies Act of 1973 under registration 2006/003303/07, as a subsidiary company of the Complainant. The Complainant intends, through this company, to focus on the provision of pay-television services over the Internet. The Complainant owns 66% of the shares of Telkom Media (Pty) Limited.

The Complainant announced its intentions in respect of Telkom Media (Pty) Limited during August 2006, and on 31 August 2006 Telkom Media (Pty) Limited applied for a satellite television subscription broadcasting license from the Independent Communications Authority of South Africa (ICASA). This received wide media attention at that time.

Telkom Media (Pty) Limited plans to invest R7 billion in "setting up a subscription television service aimed at the mass market, as well as several multi-platform technologies such as IP TV and video on demand". This was announced in Business Day on 20 April 2007.

The Registrant was registered as a Close Corporation on 19 June 2003 in terms of the Close Corporations Act of 1984 under registration no. 2003/050363/23. On 4 September 2006, the Registrant registered the disputed domain name telkommedia.co.za. This registration has been updated three times namely on 16 November 2006, 29 December 2006 and 10 January 2007. The domain name currently links to a temporary and incomplete website that states: "This Web site is coming soon".

When the Complainant, acting through its subsidiary, Telkom Media (Pty) Limited, wanted to register the domain name telkommedia.co.za during January 2007, it noticed that the Registrant had already registered this domain name on 4 September 2006. Accordingly, the Complainant through its attorneys, Buys Inc., sent a letter of demand to the Registrant on 16 January 2007, pointing out the

Complainant's rights and infringement thereof by the Registrant, and claiming transfer of the domain name to the Complainant.

The Registrant responded in a letter dated 23 January 2007, disputing the Complainant's contention that use by it of the domain name telkommedia.co.za will confuse the public, and stating inter alia that they do not believe that use of this domain infringes the Complainant's trade mark. The Registrant further stated that any legal action (taken) would be defended, and that they believe they are well within their rights to make use of the disputed domain. They indicated that they could not accept the Complainant's demands, as these will disadvantage the Registrant.

On 5 April 2007, the Complainant's attorneys sent a final letter of demand to the Registrant. This letter by Buys Inc rejected the contents of the Registrant's letter, and indicated that they would activate a domain name update request at noon on 11 April 2007 in order to transfer the domain name to the Complainant. They indicated further that the Registrant's failure to confirm the update would be regarded as a final failure to settle this matter amicably. In such case, a formal complaint/Dispute would be lodged in terms of the Regulations. The Registrant refused to allow the update to proceed, and the lodging of the present Dispute has therefore followed.

### **3. The Parties' Contentions**

#### **a) Complainant**

The Complainant has made the following contentions, namely that:

- i. It has registered trade mark rights. It has listed 10 (ten) trade mark registrations in South Africa dating from 1991 for the trade mark TELKOM and TELKOM & KEYPAD logo in various classes including class 38 that relates to telecommunication services. In addition the Complainant is the proprietor of a further 105 (one hundred and five) trade mark registrations incorporating the

TELKOM name and mark. Further the Complainant is the applicant for an additional 33 (thirty three) trade mark applications incorporating the TELKOM name and mark.

- ii. It enjoys common law rights. More particularly, it contends that its name and trade mark TELKOM is one of South Africa's most recognized brands. In support of this contention, it quotes from the 1998 Sunday Times/Markinor Top Brands Survey to show that Telkom was (at that time) the "most recognized brand" in South Africa". The 2005 Sunday Times/Markinor Top Brands Survey showed that Telkom still featured in the national top ten brand list. On the strength of this, the Complainant contends that TELKOM is a well-known brand in South Africa.
- iii. It has rights in respect of the name TELKOM flowing from its company registration; and in respect of the name TELKOM MEDIA flowing from the company registration of its subsidiary, Telkom Media (Pty) Limited.
- iv. It has domain name rights based on the (earlier) registration of its telkom.co.za domain name that was registered on 18 December 1995.
- v. The disputed domain name telkommedia.co.za is similar to the TELKOM name and trade mark since its merely adds a generic i.e. descriptive word MEDIA to the TELKOM name; and the disputed domain name is identical to the name of its subsidiary company Telkom Media (Pty) Limited.
- vi. The disputed domain name, in the hands of the Registrant, is an Abusive registration. In support of this contention, the Complainant has submitted that, in terms of Regulation 4, the Registrant has registered the domain name primarily to:
  - block intentionally the registration of a name or mark i.e. telkommedia.co.za in which the Complainant has rights;

- disrupt unfairly the business of the Complainant and its subsidiary company, Telkom Media (Pty) Limited;
- prevent the Complainant from exercising its rights in that the Complainant is prevented from registering the name of its subsidiary company, Telkom Media (Pty) Limited as a domain name and operating its website from such domain name.

In further support of this contention, the Complainant also submits that, in terms of Regulation 4, the Registrant has registered the domain name in a way that leads people to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant; and lastly the Complainant submits that the Registrant has provided incomplete or incorrect contact details in the whois database.

**b) Registrant**

The Registrant has requested that this complaint be dismissed, and that the Dispute be denied for the following reasons, namely:

- i. The Dispute has been wrongly lodged by the Complainant and should have been lodged instead by Telkom Media (Pty) Limited.
- ii. The domain name is ambiguous and generic. Also the word TELKOM is too generic and common for the Complainant to claim rights to such word since it cannot claim the ambiguous and generic word as its own.
- iii. The Registrant has never attempted to sell the domain.
- iv. Registration information is often captured by automatic processes resulting in unintentional errors (i.e. in the whois database).

- v. Lastly, an incorrect procedure has been followed. The Complainant should have made a reasonable attempt to reclaim the disputed domain before the Dispute was lodged.

The Adjudicator has perused the record of this Dispute and all the documentation lodged in this Dispute by the parties.

#### 4. Discussion and Findings

##### 4.1 (First) Procedural objection by the Registrant

At the outset and before dealing with the substantive issues or merits of this Dispute, the Adjudicator needs to deal with the (first) procedural objection raised by the Registrant. As set out above, the Registrant has asserted that this Dispute/complaint should be rejected or dismissed because the Dispute has been (allegedly) wrongly lodged by the Complainant, and that it should have been lodged instead by Telkom Media (Pty) Limited.

In order to determine which person can validly lodge or initiate a Dispute, in other words who has *locus standi* in such Disputes, one needs to examine the procedural Rules. In this regard, the relevant part of Regulation 16 reads as follows:

##### **Dispute**

16 (1) Subject to a provider's supplementary procedure, **any person** may initiate a Dispute by submitting the Dispute ... (emphasis by the Adjudicator).

Firstly, the Adjudicator can confirm that SAIIPL's Supplementary Procedure does not qualify nor explain "any person" which is accordingly very broad in its effect. Secondly, the Regulations do not expressly require, as in some legislation, that it is only, for example, "an interested person" or "an affected person" or an "aggrieved person" who is entitled to initiate a Dispute. However, it will be seen that Regulation 3 clearly qualifies "any person". More particularly, Regulation 3 requires that a Registrant must submit to proceedings under these rules if the Complainant asserts that it has rights (as

defined in the definitions set out in Regulation 1) in a name or mark. In other words only a rights-holder – obviously in respect of relevant or applicable rights - may validly initiate a Dispute relating to an Abusive domain name registration.

Since the Complainant in this Dispute has asserted that it has such rights, it has, on the face of the Dispute lodged, clearly crossed the threshold, as it were. Hence in terms of Regulation 3(1) the Complainant has validly initiated this Dispute i.e. it is the correct person to have lodged this Dispute.

To digress momentarily and to clarify the *dramatis personae* - and their position - in this Dispute, it appears that one should briefly examine the relationship between the two Telkom companies. On the one hand, the Complainant, Telkom SA Limited, through its above assertions, alleges it is the rights-holder or owner in respect of the name and trade mark (and of the domain name) TELKOM/telkom. On the other hand, the Complainant's subsidiary, Telkom Media (Pty) Limited, is seen to be, and stands in the position of, the Complainant's licensee or permitted user (and decidedly not the rights-holder or owner) of the aforementioned rights. This particular relationship is provided for in, and governed by, the provisions of sections 38(1) and (2) of the Trade Marks Act 194 of 1993.

Accordingly, the Adjudicator dismisses the (first) procedural objection raised by the Registrant, and finds that the Complainant has validly initiated this Dispute.

#### **4.2 The substantive issues of this Dispute – Complainant's rights and Abusive registration**

Dealing now with the substantive issues or merits of this Dispute, from Regulation 3 it will be seen that, in order to succeed in a domain name Dispute based on an alleged Abusive registration, a Complainant is required to prove, on a balance of probabilities, to the Adjudicator, that the following three elements are present:

- a) that the Complainant has rights in respect of a name or mark; and
- b) that the name or mark is identical or similar to the domain name; and



c) that the domain name, in the hands of the Registrant, is an Abusive registration.

Dealing with the first element above -

a) **Does the Complainant have rights in respect of a (relevant) name or mark)?**

Under statute law, the Complainant is the proprietor of a number of trade mark registrations (dating from 23 July 1991) for the trade mark TELKOM or including TELKOM. These registrations are presently in force and are *prima facie* valid and enforceable. This clearly provides the Complainant with rights in terms of section 34 of the Trade Marks Act 194 of 1993, that can be enforced in case of infringement of any of its trade mark registrations. Infringement would take place if a person, in an unauthorised manner, used the identical trade mark TELKOM, or a confusingly similar trade mark such as TELKOM MEDIA, in respect of the goods or services specified in such registrations such as telecommunication services (or even in respect of other goods or services bearing in mind that the registered trade mark TELKOM is a well-known mark). Accordingly the Complainant claims registered rights in the name or mark TELKOM. See Webster and Page: South African Law of Trade Marks, Fourth Edition, paragraph 12.3 et seq, and the decided cases cited.

Furthermore, in terms of statute law, the Complainant claims to have rights in and to its name TELKOM flowing from its company registration in terms of the Companies Act 61 of 1973; and that it, and/or its subsidiary, Telkom Media (Pty) Limited has rights in and to the name TELKOM MEDIA flowing from the registration of the latter company.

Under the common law, the Complainant claims to have extensive rights in the name and trade mark TELKOM flowing from use thereof. In two surveys conducted (in 1998 and 2005 respectively) by a reputable survey company, Markinor, the name and trade mark TELKOM is clearly well-known amongst the public, and in fact features amongst the 10 top best known brands in South Africa. Accordingly the Complainant enjoys a considerable repute or reputation in South Africa in respect of the name and trade mark TELKOM that appears to have become a well-known mark or brand. This represents an

important part of the business assets, and goodwill, of the Complainant. Such goodwill, or more particularly reputation, could be damaged by means of unlawful competition, or specifically passing off, by another party wrongly representing that it is, or is associated with, the Complainant. The Complainant therefore claims to have justifiable rights under the common law in respect of its name or mark TELKOM i.e. rights that can be enforced against others who infringe such rights. See Webster and Page, op cit. paragraph 15.7 et seq, and the decided cases cited.

More particularly, it needs to be pointed out 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. See Webster and Page, op cit, in paragraph 15.26.17, and the decided United Kingdom High Court cases cited.

Lastly, the Complainant has asserted that it has rights in and to, and flowing from, its domain name registration telkom.co.za.

By way of summary, the Complainant has asserted that the required element of "rights" is present in respect of the name or mark TELKOM.

At this juncture an adjudicator could be justified, as shown in various foreign domain Dispute decisions, on the above submissions, in finding that the Complainant has satisfied the rights element required above, especially because the Registrant has not specifically challenged such rights. However, in the overall interests of the proper administration of justice and being mindful of the *audi alteram partem* principle ("hear the other side"), the Adjudicator wishes to consider the general objections lodged by the Registrant in its response.

The Registrant has, in its response and as set out above, in a general manner attacked such rights assertions by the Complainant, denying that it can claim such rights. More specifically, the Registrant has alleged that the (Disputed) domain name is ambiguous and generic. Also the word TELKOM is too generic and common for the Complainant to claim rights to since it cannot claim the ambiguous and generic word as its own.

In support of such assertions, the Registrant argues that the word TELKOM is an acronym for the word TELECOMMUNICATIONS. However, on closer examination, it appears that the correct acronym for the word TELECOMMUNICATIONS would be TELECOM. Relative to the word TELECOMMUNICATIONS, in the word TELKOM the second letter E has been omitted, and the letter K has been used as a misspelling of the first letter C in that word. This has created what appears to be an invented word viz TELKOM. This word is decidedly not a straightforward nor accepted acronym for the word TELECOMMUNICATIONS. Therefore the word TELKOM cannot be regarded as generic nor common nor ambiguous.

The aforementioned is confirmed by the registration of TELKOM as a trade mark. In terms of the Trade Marks Act, in section 9, in order to be registrable, a trade mark must be capable of distinguishing the goods or services of the Complainant from the goods or services of another person. The Registrar of Trade Marks has decided that TELKOM meets this criterion in denoting or identifying the goods or services of the Complainant. In addition, the name and trade mark (or brand) TELKOM has become well-known in South Africa through use, and it is clearly associated and identified with the Complainant and its goods or services.

The Registrant has also asserted that, from searches conducted internationally, they have found many company names containing TELKOM, and that these are used as names for a number of companies not linked to the Complainant. Specifically, the Registrant indicates that a Wikipedia search it had conducted, gives an "ambiguous" result viz that Telkom may refer to Telkom (Australia), Telkom (Indonesia), Telkom (South Africa), and Telkom (Kenya). In its reply, the Complainant indicates that the above search is certainly not ambiguous - it clearly indicates there are four Telkom entities throughout the world – in Australia, Indonesia, South Africa and Kenya.

By way of summary, the Adjudicator finds, on a balance of probabilities, that these assertions and objections by the Registrant cannot be sustained; and that the Complainant has proved that it has rights in the name or mark TELKOM.

It is noted here that the Registrant has not raised the above objections in terms of Regulation 5(b). This Regulation provides factors that the Registrant may use to indicate that the domain is not an Abusive registration. One of these factors provides that the Registrant may show that the domain name is used generically or in a descriptive manner **and** that the Registrant is making fair use of it. However, the Registrant has in fact not used the Disputed domain name, and so, in any event, it would not be able to avail itself of this provision even if it could show that the domain name is used generically or in a descriptive manner. On the documentation submitted to the Adjudicator, no such submission was made and hence no finding is required to be made in this regard.

Dealing next with the second element set out above -

**b) Is the name or mark identical or similar to the domain name?**

In support of this assertion, the Complainant has submitted the following:

Firstly, the disputed domain name (telkommedia.co.za) is similar to the Complainant's name and trade mark TELKOM since it merely adds a generic word MEDIA to the word TELKOM; and secondly, the Disputed domain name (telkommedia.co.za) is identical to the name of the Complainant's subsidiary company, Telkom Media (Pty) Limited.

It appears to the Adjudicator that the disputed domain name contains the Complainant's name and mark TELKOM in its entirety. This is undeniably the first and dominant feature of the domain name and is the feature well-known to the public. The Registrant has merely added a descriptive/generic word MEDIA to the distinctive TELKOM name/mark. The Registrant cannot escape the inevitable conclusion that the Complainant's name and mark TELKOM is similar to the Disputed domain name (and curiously that the Disputed domain is identical to the name of the Complainant's subsidiary, Telkom Media (Pty) Ltd).

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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 for example the decisions WIPO/D2000-1598 in which nikeltravel 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-ring-tones was found to be similar to NOKIA.

Accordingly, the Adjudicator finds, on a balance of probabilities, that the Complainant's name and trade mark TELKOM is similar to the Disputed domain name.

Dealing now with the last of the above-mentioned three elements -

**c) Is the domain name, in the hands of the Registrant, an Abusive registration?**

To date, the Registrant has not used the disputed domain name, and the consideration therefore falls to be determined under sub paragraph (a) of the definition of an Abusive registration.

In Regulation 4, various (non-exhaustive) factors are set out which may indicate that the Disputed domain name is an Abusive registration; and in Regulation 5, various (non-exhaustive) factors are set out which may indicate that the Disputed domain name is not an Abusive registration.

**4.3 The Complainant has asserted various of the former factors:**

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**(i) The Disputed domain was registered primarily to intentionally block registration of a name/mark in which the Complainant has rights**

The Registrant has not denied this in a specific way but in a general and indirect manner – see the extract from its letter set out below.

Although the Regulations (and definitions) are silent on what a “blocking registration” is or involves, it is clear both in general terms and in terms of various Nominet decisions that a blocking registration appears to have two critical features. The first is that it must act against a name or mark in which the Complainant has rights. The second is intent or motivation and suggests some knowledge and hence a purpose in registering the domain name to prevent a complainant from doing so. See DRS00583 and DRS01378.

On 31 August 2006 the Complainant announced its decision to apply for a TV pay-license through its subsidiary, Telkom Media (Pty) Limited. This was widely reported in the media. In other words the Complainant and its subsidiary, Telkom Media (Pty) Limited, featured prominently in the media on that day and, no doubt shortly thereafter. It is highly likely that this announcement and commentary thereon had come to the attention and knowledge of the Registrant, and its members, which are, or intend to be engaged, in the field of telecommunications.

A reasonable person would assume that, being involved or interested in the field of telecommunications, the Registrant, and its members, would or should have known that registration of the domain name telkommedia.co.za would not only infringe the rights of the Complainant but that it would also act as a blocking registration for the Complainant or Telkom Media (Pty) Limited to register TELKOMMEDIA as its domain name. However, on 4 September – only a few days after the important announcement - the Registrant registered the Disputed domain name. Such registration presently prevents or blocks the Complainant from registering the domain name TELKOMMEDIA in which it has rights. In these circumstances, registration by the Registrant of the Disputed domain name leads to the inescapable conclusion that the Registrant must have had the

intention to block the registration of TELKOMMEDIA by the Complainant or its subsidiary Telkom Media (Pty) Limited.

See WIPO/D2000-0545; and Global Projects Management and Citigroup Inc et al case (United Kingdom Chancery Division [2005] EWHC 2663 (Ch) which cites various decided cases in which similar company names were required to be changed – [1982] FSR 1; [1996] FSR 388; and [1997] FSR 374. The leading United Kingdom authority dealing with domain names and their “blocking” effect is of course the judgement in British Telecommunications plc v One in a Million Ltd [1999] FSR 1 (CA). The Court of Appeal held in this case that the Disputed domain registrations were unlawful on the grounds both of passing off and trade mark infringement, and interdicted One in a Million Ltd and the individuals who controlled it from such conduct and ordered them to transfer the registrations to the companies that in reality traded under those names.

The Adjudicator finds, on a balance of probabilities, that the Registrant had registered the Disputed domain name primarily to block intentionally the registration of a name in which the Complainant has rights.

**(ii) The Registrant has registered the Disputed domain primarily to disrupt unfairly the business of the Complainant**

The Disputed domain name registration will not only prevent the Complainant from registering the name of its subsidiary Telkom Media (Pty) Limited as a domain name but it will also prevent the Complainant (and its subsidiary) from operating a website from such domain name. This will disrupt the planned media/TV business of the Complainant unfairly.

Various UDRP decisions have found that 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. See for example WIPO/D2000-0777, NAF/FA94942, NAF/FA94963 and NAF/FA95402.

Accordingly, the Adjudicator finds, on a balance of probabilities, that the Registrant has registered the Disputed domain name primarily to disrupt unfairly the business of the Complainant (and its subsidiary Telkom Media (Pty) Limited).

**(iii) The Disputed domain was registered primarily to prevent the Complainant from exercising its rights**

The Complainant asserts that the Registrant has registered the Disputed domain primarily to prevent the Complainant from exercising its rights, more particularly from registering the name TELKOMMEDIA (in which it has substantial rights as shown above) as a domain name.

The Registrant has not dealt directly with this assertion but alleges in its response that: "Our use of the word telkom in the domain telkommedia.co.za is not an infringement of the Complainant since they cannot claim the ambiguous and generic word as there (sic) own."

Besides the factual question of the Disputed domain name preventing the Complainant from exercising its rights i.e. registering TELKOMMEDIA as its own domain name, this raises the question whether the Registrant had acted in good faith or otherwise in registering the Disputed domain name. The Registrant had warranted, when registering the Disputed domain name, in terms of the UniForum SA terms and conditions (clause 5.1), that:

I."it has the right without restriction to use and register the Domain Name"

II."the use or registration of the Domain name by (the Registrant) does not or will not interfere with, nor infringe the right of any third party in any jurisdiction with respect to trade mark, service mark, trade name, company name, close corporation name, copyright or any other intellectual property right".



It appears to be undeniable that the Registrant, and its members, knew of the Complainant's name and trade mark TELKOM, as well as its subsidiary Telkom Media (Pty) Limited.

It therefore appears to the Adjudicator that the disputed domain registration was made in bad faith.

The Adjudicator accordingly finds, on a balance of probabilities, that the disputed domain was registered primarily to prevent the Complainant from exercising its rights.

**(iv) Circumstances indicating the Registrant is using or has registered the Disputed domain in a way that leads people to believe that the domain name is registered to, operated to or authorised by, or otherwise connected with the Complainant**

In the Registrant's letter dated 23 January 2007 explaining to the Complainant the background to its adoption of the Disputed domain name, it had stated: "We set out looking for domain names and while many domain names were available, we decided on the domain telkommedia.co.za because it was shorter and had the same meaning as our trading name." Further: "We Dispute your client's contention that the use of the domain **telkommedia.co.za** will confuse the public. Since the website will be branded under our trading name **Telecommunications Media** (Cool Ideas1209 CC), we believe that a reasonable person would not assume that the site is a website of your client." However, in its formal response, the Registrant did not expressly deal with this allegation other than to say: "Our use of the word telkom in the domain telkommedia is not an infringement of the Complainant since they cannot claim the ambiguous and generic word as there (sic) own."

The Disputed domain name currently links to an incomplete website under construction that states: "This Web site is coming soon".

The above Regulation requires either use or registration. Various foreign decisions have confirmed that actual use is not a hard and fast requirement and have found that sites "under construction" or "coming soon", for example, create a likelihood of confusion, or have found that if the domain were used, it would create confusion. See for example the decisions in the foreign cases WIPO/D2000-0545, NAF/FA95319, NAF/FA95464 and NAF/FA95498.

The Complainant asserts that, particularly where the Registrant has registered a domain name containing the Complainant's name plus a generic term, the Disputed domain name would (or is likely to) lead people or businesses to believe that the Disputed domain name has some association with the Complainant and/or its subsidiary, Telkom Media (Pty) Limited. The Registrant had, in its letter of 23 January 2007, Disputed the Complainant's contention that the use of the domain TELKOMMEDIA.CO.ZA will confuse the public (since it will be branded under the Registrant's trading name (Telecommunications Media)). However, the Complainant asserts that actual confusion is not necessary – the potential or likelihood for (reasonable) confusion is sufficient. In support hereof various foreign decisions have found that confusion may be inferred in situations where the Registrant registered a domain name containing the complainant's name plus a generic term. See for example the foreign decisions in WIPO/D2000-0777, WIPO/D2000-878, NAF/FA95033 and NAF/FA95402; and the above NIKE and NOKIA decisions.

Accordingly, the Adjudicator finds, on a balance of probabilities, that the Registrant has registered the domain name in a way that leads, or will lead, people and businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

#### **(v) False or incomplete contact details in the whois database**

Regulation 4(1)(d) provides a further factor that may indicate that the domain name is an Abusive registration namely that false or incomplete contact details have been provided by the Registrant in the whois database.

The Complainant asserts that the Registrant had provided incomplete or incorrect information in the whois database relating to the Disputed domain name registration viz

Registrant Street Address – Only postal address given

Registrant fax – No fax number provided

Name of admin contact – Only name of Registrant given

Admin fax – no fax number provided

Name of technical contact – Simply stated as “Administrator, Domain”

Tech title – Simply stated as “Domain Administrator”

Tec fax – no fax number provided.

The Registrant responds to this assertion by simply stating that:

“With regards to the incomplete information on the registration records, registration information is often captured by automatic processes resulting to (sic!) unintentional errors.”

Clause 5.1.1 of the UniForum SA terms and conditions states: ‘Applicant (the Registrant) hereby irrevocably represents, warrants and agrees that its statements in the Application are accurate and complete’.

In various WIPO and NAF decisions it has been found that such incomplete or inaccurate information indicates bad faith on the part of the Registrant. See for example WIPO/D2000-0501 and NAF/FA92016.

This appears to indicate that the disputed domain registration was made in bad faith.

The Adjudicator finds that the above actions by the Registrant fall within the scope of the above Regulation.

By way of summary, the Adjudicator finds that the above factors indicate, on a balance of probabilities, that the disputed domain name is an Abusive registration.

#### **4.4 Two final submissions made by the Registrant**

The Registrant in its response had submitted that: "We have never attempted to sell the domain". One could couple to this the final sentence of its letter dated 23 January 2007, where it had said: "Nevertheless, we are hopeful that a compromise can be reached which will suit both parties." This suggests that they wanted to negotiate some kind of settlement, and one can only ponder what they really had in mind to suit the Complainant and themselves. However, the Registrant's bald submission in this regard can unfortunately not take this matter any further.

Lastly, the Adjudicator wishes to deal with the second procedural objection raised by the Registrant. The Registrant submits that the Complainant should have made a reasonable attempt or request to reclaim the disputed domain name before initiating this Dispute.

The Adjudicator points out that the Regulations do not require a complainant to make a reasonable attempt to reclaim a disputed domain before it lodges a Dispute. Hence the Registrant is incorrect in making its above assertion.

Moreover, in examining the details hereof, the Complainant has shown that an update request was sent by its attorneys, Buys Inc, on its behalf namely on 11 April 2007 and was received by the Registrant but this was refused/rejected by the Registrant. The Registrant's reason for refusing the request was that the request had indicated that the company/Registrant was Buys Inc and that the administrative and technical contact was Cybersmart – both instances apparently unknown to the Registrant. However, the Registrant would have known from the Complainant's attorney's letter of demand dated 16 January 2007 and their final letter of demand dated 5 April 2007 that Buys Inc was the attorneys firm representing the Complainant in relation to this domain name matter. In addition the last-mentioned letter from Buys Inc had expressly forewarned the Registrant that Buys Inc would initiate a domain name update request on at noon on 11

April. If they were still not familiar with Buys Inc, a simple enquiry to Buys Inc and/or Cybersmart, would have clarified the origin and purpose of such update.

The Adjudicator therefore rejects the above assertion by the Registrant that the Complainant and their attorneys had followed an incorrect procedure.

Based on the reasons and findings set out above, the Adjudicator makes the overall finding that, in the hands of the Registrant, the domain name telkommedia.co.za is an Abusive registration in that it was registered in a manner which, at the time when the registration took place, took unfair advantage of, or was unfairly detrimental to, the Complainant's rights.

## **5. Adjudicator's Decision**

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

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**ANDRE VAN DER MERWE**  
SAIIPL SENIOR ADJUDICATOR  
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