

ADJUDICATOR DECISION

CASE NUMBER:	ZA2007-0010
DECISION DATE:	7 January 2008
DOMAIN NAME	mwebsearch.co.za
THE DOMAIN NAME REGISTRANT:	JP Botha
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	Multichoice Subscriber Management
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1. Procedural History

The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on 18 October 2007. On 18 October 2007 the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on 18 October 2007 UniForum SA confirmed that the domain name had indeed been suspended. The SAIIPL verified that the satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIIPL's Supplementary Procedure.

In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on 18 October 2007. In accordance with the Regulations the due date for the Registrant's Response was 15 November 2007. On 12 November 2007, the Registrant sent SAIIPL an e-mail advising that he had been unable to reach the SAIIPL telephonically on its Cape Town telephone number. As the SAIIPL does not have a Cape Town telephone number, the administrator sent a reply e-mail containing a cellular telephone number. The Administrator also telephonically contacted a person who claimed to be the registrant and claimed, furthermore, that he was unable to download the Response template. The Administrator immediately sent a copy of the Response template to the Registrant by e-mail.

However, when no response was submitted by 18 November 2007, the SAIIPL issued the customary Notice of Default, advising the Registrant of its failure to respond. In response to this Notice, the Registrant sent the Administrator an e-mail advising that he was unable to download the Complaint (Dispute). The Administrator re-sent the Complaint electronically as well as by post and granted a further opportunity to respond.

On 19 November 2007, the Registrant confirmed that he was in possession of a copy of the Complaint, but he required a 3-week extension to respond. The Administrator is of the view that the registrant was aware of the commencement of the dispute on or about 18 October 2007, but failed to contact the Administrator regarding his alleged inability to obtain details of the Complaint until 3 days before the deadline. Accordingly, the Administrator refused the request for the 3-week extension, but advised that it would

consider a request for a shorter extension. No such request was received and, on 28 November 2007, a further Notice of Default was issued.

Notwithstanding the second Notice of Default, and after consultation with the Complainant, the Provider granted a final extension of the term within which to respond until 11 December 2007. On this date a final Notice of Default was issued. No Response has been received.

The SAIPL appointed Advocate Gavin Morley S.C. as the Adjudicator in this matter on 3 December 2007. 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. Ms. Vanessa Lawrance, a junior adjudicator, has assisted Mr. Morley in this matter.

2. Factual Background

An Adjudicator is not obliged to simply accept the veracity of a Complainant's version in the absence of a Response from the Registrant concerned, and will generally analyse a Complainant's version in order to satisfy herself or himself that the allegations contained in a complaint are acceptable and probably true. In the present case, the facts presented to the adjudicator were compelling and were accepted to be true, particularly in the absence of a response from the Registrant.

These facts were as follows. The Complainant was formed in 1997, and is a direct, wholly owned subsidiary of MWeb Holdings (Pty) Ltd. It has, for the past nine years, been South Africa's leading Internet Service Provider. The Complainant is commonly known and referred to as "MWeb".

The Complainant is the proprietor in South Africa of the trade mark MWEB and various other marks incorporating MWEB. These trade marks are registered in various classes, primarily those relating to internet service provision and related goods and services.

The Complainant uses its MWEB trade marks extensively in Southern Africa. *Inter alia*, it is the proprietor of the domain name mweb.co.za.

The Registrant registered the domain name mwebsearch.co.za on 8 January 2004. The domain name is linked to a website that features the name and logo of "KZN Search" fairly extensively. "KZN Search" is the registrant of the domain name kznssearch.co.za, which was registered on 29 September 2003, and is linked to the identical website as that linked to the domain name mwebsearch.co.za. In addition, the postal address and other details of the Registrant of the domain name kznssearch.co.za are the same as those of the Registrant for the domain name mwebsearch.co.za. Furthermore, the administrative company, technical contact and other relevant details are the same for the mwebsearch and kznssearch domain names.

The mwebsearch website (ie the site linked to the domain name mwebsearch.co.za) offers the same services as those in respect of which the Complainant has registered its MWEB trade marks.

3. Parties' Contentions

3.1. Complainant

The Complainant submits that it has substantial statutory and common law rights in the trade mark MWEB, and marks incorporating MWEB. It is the owner of registered trade marks incorporating MWEB and has used its MWEB marks extensively.

In addition, it alleges that the MWEB mark is well known and it should be afforded the additional protection provided by the trade marks Act to well known marks.

The Complainant denies that the Registrant has any right or legitimate interest in the mwebsearch domain name.

The Complainant is of the view that the Registrant's use and registration of the mwebsearch domain name in respect of services identical to those in relation to which

the trade mark MWEB has been registered and extensively used by the complainant, is an intentional imitation with the view to attract internet users for his own commercial gain. The Complainant alleges that the Registrant's conduct will amount to confusion or deception that there is some association between the Complainant and the Registrant. Users of the internet are being intentionally diverted away from the Complainant by the Registrant. The Registrant's conduct also takes unfair advantage of and may be detrimental to the Complainant's rights in its MWEB trade marks.

At the time of registration of the mwebsearch domain name, namely 8 January 2004, the Complainant had already used its MWEB marks for 6 years in South Africa and the mark was well known. It is accordingly submitted that the "mwebsearch" domain name is an abusive registration.

3.2. Registrant

The Registrant submitted no formal response to the Provider following the Complaint. However, in a telephone conversation with a representative of the Complainant, the Registrant allegedly:

1. expressed the view that he was the rightful owner of the "mwebsearch" domain name and that he could not be expected to give up his ownership of the domain name merely because the complainant did not have the foresight to register the domain name; and
2. advised that he may be willing to sell the domain name to the Complainant if he were satisfactorily compensated for expenses incurred and losses that he would suffer through transfer of ownership of the name. These statements made by the Registrant are telling and the Registrant has not disputed that they were made as alleged by the Complainant.

4. Discussion and Findings

In terms of the Regulations, in order to succeed in an application on the basis of an abusive registration, the following three elements must be proved on the balance of probabilities:

- i. the Complainant has rights in respect of a name or mark; and
- ii. the name or mark is identical or similar to the domain name; and
- iii. the domain name, in the hands of the Registrant, is an abusive registration.

4.1. Complainant's Rights

Prima facie, the Complainant is the proprietor of validly registered trade marks that comprise or incorporate the trade mark MWEB. No evidence has been tendered to refute this. Accordingly, the Complainant is afforded the protection of section 34 of the Trade Marks Act. The evidence submitted by the Complainant is not disputed by the Registrant and the Adjudicator finds on such evidence that MWEB is indeed a well-known trade mark within the meaning of Section 34(1)(c) of the Trade Marks Act. It follows that the Complainant has established the requisite reputation and goodwill that would be required for the purposes of passing off proceedings. Thus it is the view of the Adjudicator that the Complainant has at the very least established its intellectual property rights in the mark MWEB.

In terms of the provisions of sections 34(1)(a) and 34(1)(b) of the Trade Marks Act, a trade mark is infringed by the use of an identical or similar mark to a registered trade mark where such use is made in respect of goods or services similar or identical to those covered by the trade mark registration. Section 34(1)(c) protects well-known registered trade marks from dilution in circumstances where unfair advantage is taken of the distinctive character or the repute of a registered mark or where the use complained of is detrimental to the distinctive character or repute of the registered mark concerned.

It is a well established legal principle that a domain name that comprises a trade mark coupled with a generic term, that domain name is still confusingly similar to the trade mark. In this regard, the Adjudicator agrees with the findings in SAIPL decisions ZA2007-0003 Telkom SA Limited v Cool Ideas 1290 CC and ZA2007-0004 Telkom SA Limited and TDS Directory Operations (Pty) Ltd v The internet Corporation. The finding of the adjudicator is that mwebsearch.co.za is indeed confusingly similar to the trade mark MWEB, incorporating as it does the whole of the distinctive mark MWEB in conjunction with the generic and non-distinctive term "search", which is in common use.

4.2. Abusive Registration

The Complainant submitted the following arguments in favour of its allegation that the mwebsearch.co.za domain name is an abusive registration:

1. the incorporation of the trade mark MWEB in the domain name amounts to trade mark infringement; and
2. the incorporation of the trade mark MWEB in the domain name amounts to passing off as it is likely to mislead members of the public to believe that there is some connection between the complainant and the Registrant.

The Adjudicator accepts the submission that registration and use of the domain name mwebsearch.co.za in respect of internet provision and related services amounts to trade mark infringement and passing off. In addition the registration and use of the domain name by the Registrant takes unfair advantage of the Complainant's well known mark in order to generate income and divert users from the Complainant. There is no explanation from the Registrant as to why the domain name was chosen or why the domain is linked to the Registrant's "kznsearch" web-site. In the view of the Adjudicator, the case made by the Complainant was compelling and called for an adequate response from the Registrant, which was not forthcoming.

Accordingly, the Adjudicator finds this registration to be abusive.

5. Decision

In the present case there does not appear to be a reasonable possibility that anyone might have a greater right to the domain name mwebsearch.co.za than the Complainant. This is an appropriate case to order that the domain name be transferred to the Complainant.

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

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Gavin Morley SC
SAIPL SENIOR ADJUDICATOR
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assisted by **Vanessa Lawrence**
SAIPL JUNIOR ADJUDICATOR