

ADJUDICATOR DECISION

CASE NUMBER: **ZA2010-0055**

DECISION DATE: **8 December 2010**

DOMAIN NAME: **googleadsense.co.za**

THE DOMAIN NAME REGISTRAN: **Digital Orange**

REGISTRANT'S LEGAL COUNSEL: **N/A**

THE COMPLAINANT: **Google Inc.**

COMPLAINANTS' LEGAL
COUNSEL: **Adams & Adams**

THE 2nd LEVEL DOMAIN NAME
ADMINISTRATOR: **UniForum SA (CO.ZA Administrators)**

1. Procedural History

- 1.1. The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on 21 September 2010.
- 1.2. On 22 September 2010, the SAIPL transmitted to UniForum SA, by email, a request for the Registry to suspend the domain name at issue, and thereafter verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIPL’s Supplementary Procedure.
- 1.3. In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on 8 October 2010. The due date for the Registrant’s Response was 5 November 2010. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on 10 November 2010.
- 1.4. The SAIPL appointed Adv Owen Salmon as the Adjudicator in this matter on 1 December 2010. 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. This dispute concerns the domain name <googleadsense.co.za>.

2.2. The domain was registered on 6 June 2009 in the name of Digital Orange with Joris Kroner as administrative contact. It has been noted in earlier decisions that Digital Orange is the alter ego of Mr Kroner.¹ The facts in the present matter lead to the same conclusion.

2.3. The following facts are undisputed and, their not being palpably implausible, the Adjudicator accepts them for the purposes of this adjudication.

2.4. The Complainant in this administrative proceeding is Google Inc., a Delaware corporation incorporated and existing under the laws of the State of California, of 1600 Amphitheatre Parkway, Mountain View, California 94043, United States of America.

2.5. The Complainant is the worldwide proprietor of the well-known trade marks GOOGLE, ADSENSE and the combination GOOGLE ADSENSE.

2.6. In particular, the Complainant is the proprietor in South Africa of the following trade mark registrations:-

2.6.1.No. 2003/04737 GOOGLE in Class 42;

2.6.2.No. 2005/12739 GOOGLE in Class 16;

2.6.3.No. 2005/12740 GOOGLE in Class 25;

2.6.4.No. 2005/12741 GOOGLE in Class 35; and

1

See, for example, ZA2009-0037 <ketelone.co.za>, paragraph 2.1; ZA2009-0034 <absapremiership.co.za>, paragraph 2.1.

2.6.5.No. 2005/05864 ADSENSE in Class 35.

2.7. The Complainant is a global internet communications, media and advertising company that delivers a network of comprehensive searching, directory, information, communication and advertising services, as well as other online activities to millions of internet users daily.

2.8. The Complainant's GOOGLE trade mark was coined by its founders in 1997. The word "Google" is a play on the word "Googol", which is the mathematical term for the number 1 followed by 100 zeros. The Complainant's play on the term reflects the company's mission to organise the immense amount of information on the internet.

2.9. The Complainant's business expanded over the years into a vehicle for the world's most used search engine and it has offices in 35 countries, including in South Africa. Currently, the GOOGLE search engine maintains one of the largest collections of searchable documents in the world. The GOOGLE search engine provides an easy-to-use interface, advanced search technology, and a comprehensive array of search tools, and allows internet users to search for and find a wide variety of content in many different languages.

2.10. The Complainant's innovations continued to reshape not only the world of online search services, but also the advertising market place, with the introduction of its GOOGLE ADSENSE product. ADSENSE is a coined term which was chosen by the Complainant as the name for its advertising placement service. The GOOGLE ADSENSE program was launched internationally on 18 June 2003 and offers websites of all sizes a way to easily generate revenue through the placement of highly targeted advertisements adjacent to their content. Hundreds of thousands of publishers worldwide advertise through the GOOGLE ADSENSE service daily, including partners such as AOL, Earthlink, T-Online (Europe), AT&T WorldNet, InfoSpace, Eniro (Scandinavia), Nifty, NEC BIGLOBE, MapQuest, NTL (UK), Free.fr, Libero (Italy), shopping.com, ask.com, nhl.com, hi5.com, Fox Interactive, eBay, New York Times, About.com, CNET/News.com, WebMD, WSJ, and nfl.com.

2.11. Due to the high number of partners who use the Complainant's GOOGLE ADSENSE service, it has significant user reach. Advertising is the primary source of revenue for the Complainant, and in 2007, the Complainant generated over USD1.6 billion from the GOOGLE ADSENSE advertising service. The GOOGLE ADSENSE service is currently available in 31 countries (including South Africa) in a number of languages, including English, Arabic, Bulgarian, Chinese, Croatian, Czech, Danish, Dutch, Finnish, German, Greek, Hebrew, Hungarian, Indonesian, Italian, Japanese, Korean, Norwegian, Polish, Portuguese, Romanian, Russian, Serbia, Slovak, Spanish, Swedish, Thai, Turkish and Vietnamese.

2.12. A copy of a printout from www.google.com depicting the manner in which the Complainant uses its GOOGLE ADSENSE trade mark is provided with the Complaint.

2.13. The Complainant registered the domain names google.co.za and adsense.co.za on 26 June 2001 and 19 July 2004 respectively.

2.14. In light of the above, it is submitted by the Complainant that its GOOGLE trade mark is one of the most recognised brands in the world, and that it has become a well-known trade mark for purposes of Article 6 *bis* of the Paris Convention and Sections 34(1)(c) and 35 of the Trade Marks Act 194 of 1993.

3. Complainant's Contentions

3.1. The Complainant submits that the disputed domain name <googleadsense.co.za> wholly incorporates the Complainant's registered GOOGLE and ADSENSE trade marks and is therefore similar to these trade marks. In addition, the disputed domain name is identical to the Complainant's well-known trade mark GOOGLE ADSENSE. The Complainant's well-known GOOGLE and ADSENSE trade marks are coined terms, i.e. made up words. Accordingly, there is no doubt that the Registrant reproduced the Complainant's trade marks in the domain name, without the Complainant's authorisation or consent.

3.2. The Complainant further submits that the disputed domain name is an abusive registration, and that the Registrant is taking unfair advantage of its rights. It is not necessary to elaborate upon the grounds of the objection, given the operation of the three-strike rule (dealt with below).

3.3. The Complainant also alleges that the Registrant has a pattern of making abusive registrations. In this regard, the Complainant refers to the following decisions:-

3.3.1. Hackett Limited v Digital Orange [ZA2009-0033], decision date 10 September 2009, regarding the domain name <hackett.co.za>;

3.3.2. ABSA Bank Limited v Digital Orange (aka Joris Kroner) [ZA2009-0034], decision date 5 October 2009 regarding the domain name <absapremiership.co.za>;

3.3.3. Double Eagle Brands N.V. v Digital Orange/Joris Kroner [ZA2009-0037], decision dated 15 December 2009 regarding the domain name <ketelone.co.za>; and

3.3.4. Peroni Nastro Azzurro Limited and The South African Breweries Limited v Digital Orange/Joris Kroner [ZA2009-0038] decision date 19 February 2010 regarding the domain name <peroni.co.za>.

3.4. In terms of Regulation 4(3), there is a rebuttable presumption of an abusive registration if the Complainant proves that the Registrant has been found to have made an abusive registration in three or more disputes in the 12 months before the dispute was filed.

3.5. As is evident from paragraph 3.3 above, the Registrant has been found to have made at least three abusive registrations in the 12 months before the filing of this dispute.

4. Discussion and findings

4.1. The Adjudicator finds that the Complaint has rights in respect of the marks GOOGLE and ADSENSE as contemplated by Regulation 3(1) (a). The question is whether the registration in the hands of the Registrant is an abusive registration.

4.2. An abusive registration means a domain name which either:-

- a) 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
- b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

4.3. Ordinarily, the Complainant is required to prove on a balance of probabilities that the required elements are present.² However, in the present case, Regulation 4(3) is relevant. It creates the presumption of an abusive registration, in its following provisions:-

2

Regulation 3(2).

“There shall be a rebuttable presumption of abusive registration if the Complainant proves that the registrant has been found to have made an abusive registration in three or more disputes in the 12 months before the dispute was filed.”

4.4. In the 12 months preceding the present dispute Digital Orange and/or Mr Kroner has been found to have made an abusive registration as referred to by the Complainant. In addition, there has been a further decided dispute:-

- Domain Name: <hotelmissoni.co.za>

1 Case No. ZA2010-0047

Decision Date: 27 August 2010

4.5. That this is so brings the presumption into operation. It has not been rebutted. It follows, therefore, that the Adjudicator is entitled to find that the registration <googleadsense.co.za> in the hands of Digital Orange is abusive. The Adjudicator so finds.

4.6. In any event, it is clear that Digital Orange (or Mr Kroner) is engaged in a pattern of making abusive registrations and, as contemplated by Regulation 4(1)(c). This is a factor that may be taken into account in determining whether the instant registration is abusive. The inference can further be drawn that the domain was registered primarily to transfer it for a consideration in excess of the reasonable expenses incurred in acquiring the registration.

4.7. The Adjudicator finds the domain registration by Digital Orange was abusive.

4.8. Accordingly, the Adjudicator upholds the Complainant's Dispute.

5. Decision

5.1. For the foregoing reasons the Adjudicator orders that the domain name be transferred to the Complainant.

.....
ADV OWEN SALMON

SAIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za