

## Decision

**[ZA2011-0088]**

**.ZA ALTERNATE DISPUTE RESOLUTION  
REGULATIONS (GG29405)**

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2011-0088</b>
DECISION DATE:	<b>01 November 2011</b>
DOMAIN NAME	<b>ubankonline.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Martin Karota</b>
REGISTRANT'S LEGAL COUNSEL:	<b>N/A</b>
THE COMPLAINANT:	<b>UBANK Ltd</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Moore Attorneys – Tyrone Walker</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>UniForum SA (CO.ZA )</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **20 September 2011**. On **23 September 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **25 September 2011** 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.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **27 September 2011**. In accordance with the Regulations the due date for the Registrant’s Response was **24 October 2011**. The Registrant did not submit a response in accordance with Regulation 18, and accordingly, the SAIPL notified the Registrant of its default on **25 October 2011**. Further correspondence with the Registrant regarding the failure to respond in terms of Regulation 18 followed on **25 October 2011**, however, the Registrant has not filed a response which complies with Regulation 18.
- c) The SAIPL appointed **Janusz Luterek** as the Adjudicator in this matter on **31 October 2011**. 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

- a) The Complainant, UBANK LTD, conducts its business as an authorised financial services provider that offers a full range of financial products and services direct to the consumer. The Complainant is South Africa’s 9th largest Bank by assets with deposits of over R3bn and has become a well-recognised banking brand in the country. The Complainant’s,

www.ubank.co.za. website provides an electronic platform that allows the consumer to efficiently view the various products that is offered by the Complainant and provides various information relating to the Complainant and its business.

### 3 Parties' Contentions

#### 3.1 Complainant

- a) The domain names are identical or similar to a name or mark in which the Complainant has rights [Regulation 3(1)(a)]
  - i) The complainant has registered as its domain names u-bank.co.za and ubank.co.za and has advertised this extensively in the press.
  - ii) The Complainant is the proprietor of numerous trade mark applications consisting of or incorporating the word UBANK in South Africa and internationally and claims common law and famous trade mark rights therein.
  - iii) The offending domain names are, for all intents and purposes, identical to the Complainant's UBANK trade mark.
  - iv) Accordingly, the Complainant contends, it has established that the offending domain names are identical or at least similar to a trade mark in which the Complainant has rights, as required by Regulation 3(1)(a).
- b) The domain name in the hands of the Registrant is abusive registration [Regulation 3(1)(a)]
  - i) The Complainant submits that the Registrant has registered the offending domain name in a manner which, at the time when it was registered, took unfair advantage of and was unfairly detrimental to the Complainant's rights.

- ii) Although the registrant is not alleged to be using the domain name for any purpose whatsoever, however it has failed to respond to any correspondence from the Complainant or the SAIPL regarding the registration in suit.
- iii) The authorities support the view that actual use is not required that the domain name is an abusive registration.
- iv) The Complainant submits that it has shown at least the following factors, as itemised in Regulation 4(1), which indicate that the offending domain name is abusive registrations:
  - The Registrant has registered the domain name to block intentionally the registration of a name or mark in which the Complainant has rights;
  - The Registrant has registered the domain name to disrupt unfairly the business of the Complainant; and/or
  - The Registrant has registered the domain name to prevent the Complainant from exercising its rights.

### **3.2 Registrant**

- a) The Registrant did not reply in terms of Regulation 18 to the Complainant's contentions.

## **4 Discussion and Findings**

### **4.1 Complainant's Rights**

- a) The Complainant is the applicant for numerous trade mark applications consisting of or incorporating the word UBANK in South Africa and internationally which pre-date the Registrant's registration of the domain name.

- b) The Complainant has claimed common law rights in the trade marks through extensive use thereof, for example, in various domain names such as ubank.co.za and u-bank.co.za.
- c) The domain name at issue is, for all intents and purposes, identical to the Complainant's trade mark.
- d) It was held in WIPO Case No. D2000-0441 Reuters Limited versus Global Net 2000 Inc. that the practical effect of preceding a trade mark with the letters www in a domain name is so-called "typo-piracy". The addition of "online" thereto, in the adjudicators opinion, does not change this position. The domain name ubankonline.co.za cannot but be held to be confusingly similar to the Complainant's trade mark UBANK.
- e) The Complainant has thus established that the domain name in issue is identical or at least similar to a trade mark in which the Complainant has rights, as required by Regulation 3(1)(a).

#### 4.2 Abusive Registration

- a) Regulation 4(1), lists various factors which may be considered as indicating that registration of a domain name is an abusive registrations:
  - i) The Registrant has registered the domain name to block intentionally the registration of a name or mark in which the Complainant has rights;
  - ii) The Registrant has registered the domain name to disrupt unfairly the business of the Complainant;
  - iii) The Registrant has registered the domain name to prevent the Complainant from exercising its rights; and/or
  - iv) The Registrant is using, or has registered, the domain name in a

way that leads people or business to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

- b) Although the registrant is not alleged to be using the domain name for any purpose whatsoever it has failed to respond to any correspondence from the Complainant or the SAIPL regarding the registration in suit and this cannot be interpreted in any other way than obstructive. The authorities cited by the Complainant support the view that actual use is not required that the domain names are an abusive registration.
- c) The domain name has thus been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

## 5. Decision

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

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**JANUSZ LUTEREK**  
SAIPL SENIOR ADJUDICATOR  
www.DomainDisputes.co.za