

Decision

ZA2011-0103

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0103
DECISION DATE:	28 March 2012
DOMAIN NAME	thelittleblackbook.co.za
THE DOMAIN NAME REGISTRANT:	The Little Black Book
REGISTRANT'S LEGAL COUNSEL:	DLA Cliffe Dekker Hofmeyr – Eben van Wyk
THE COMPLAINANT:	Avusa Media Limited
COMPLAINANT'S LEGAL COUNSEL:	Moore Attorneys – Tyrone Walker
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA)

1 Procedural History

- 1.1) The Dispute was initially filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **21 December 2011**. It was thereafter amended and the amended version was filed on **11 January 2012**. On **17 January 2012** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **17 January 2012**. UniForum SA confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute together with the amendment to the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure.
- 1.2) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **18 January 2012**. In accordance with the Regulations the due date for the Registrant's Response was **15 February 2012**. The Registrant submitted its Response on **15 February 2012**, 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 **16 February 2012**.
- 1.3) In accordance with the Regulations the due date for the Complainant's Reply was **23 February 2012**. It was later found that the notification was flawed, and the Response was properly submitted for Reply on **01 March 2012**. The deadline for the Reply was **8 March 2012**. On **6 March 2012**, the attorneys representing the Complainant requested an extension of the term within which to Reply until **30 March 2012**. The Registrant's attorney objected to this request. Heated discussions followed after which, on **7 March 2012**, the Administrator granted a **5-day** extension until **15 March 2012**. On **15 March 2012**, the Complainant made application for an extension of the term within which to Reply until **30 March 2012**. The Registrant's attorney objected and the application for an extension was referred to the Adjudicator on **15 March 2012** for decision. The Adjudicator rendered a decision on **16 March 2012**, granting the Complainant until close

of business on **19 March 2012** to file its Reply. In accordance with the Regulations, and the Adjudicator's decision, the Complainant submitted its Reply on **19 March 2012**.

- 1.4) The SAIPL appointed **Vanessa Lawrance** as the Adjudicator in this matter on **1 March 2012**. 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 Avusa Limited complained about the registration of the domain name thelittleblackbook.co.za by "The Little Black Book".
- 2.2 Avusa Limited is a public company, listed on the Johannesburg Securities Exchange. Avusa Media Division is a publisher of various magazines. One of its publications, The Financial Mail, has, since approximately 2001, published a corporate listing and profile guide to South Africa's private and public sector's leadership, which is titled "The Little Black Book".
- 2.3 On or about **11 September 2010**, the Complainant became aware of the registration of the domain name thelittleblackbook.co.za. Correspondence was sent to the Registrant of the domain name demanding that the domain name be transferred to the Complainant's subsidiary, Northern Titles (Pty) Ltd.
- 2.4 Further correspondence was exchanged between the parties. During this correspondence, *inter alia*, the Complainant was informed that the Registrant of the domain name thelittleblackbook.co.za was in fact Marina's Little Black Book of Events CC. Also during the exchange between the legal representatives of both parties, the offer was made, on behalf of Marina's Little Black Book of Events CC, that it would change its name if the other side would bear the reasonable costs associated with the "change of business name and corporate identity" and the rebranding of "its business as

Marina's Little Black Book". These were estimated at a minimum of R50 000. This offer was refused and the present complaint was brought.

- 2.5 Northern Titles (Pty) Ltd is a subsidiary of the Complainant. It is the proprietor of Trade Mark Registrations Nos. 2002/06735 and 2003/11725 THE LITTLE BLACK BOOK in classes 16 and 38.

3 Parties' Contentions

3.1 Complainant

- 3.1.1) The Complainant alleges that it has spent a considerable amount of time, money and effort in the advertising and promotion of its products and services under "the various THE LITTLE BLACK BOOK trade marks". It provided evidence of its registration of the domain name littleblackbook.co.za and made allegations regarding the extensive advertisement and promotion of the trade mark and the fact that the mark is a "widely recognised brand". It did not, however, provide any examples of its use.
- 3.1.2) The Complainant's littleblackbook.co.za domain name was registered on **4 October 2002**, while the Registrant's domain name thelittleblackbook.co.za was registered on **15 March 2012**.
- 3.1.3) The Complainant alleges that the domain name thelittleblackbook.co.za is similar to the Complainant's "THE LITTLE BLACK BOOK trade marks" (the Adjudicator views this as only one trade mark) and littleblackbook.co.za domain name.
- 3.1.4) The Complainant (at 11.1.1, bullet point 11) refers to the complaint against the domain name metalock.co.za (case no 2010-0058), in which it was found that, where the domain name complained of is confusingly similar to a trade mark registered by the Complainant, the burden of proof shifts to the Registrant to show that the registration is not abusive.

-
- 3.1.5) The Complainant alleges that the disputed domain name, in the hands of the Registrant is abusive. It sets out its reasons for its allegations. The Adjudicator does not deem it necessary to deal with these in detail.
- 3.1.6) The Complainant, in its founding papers, claims, in paragraph 11.1.2 (bullet point 2), that “the mere fact that the Complainant has a registered trademark THE LITTLE BLACK BOOK in class 16 and 38 in relation to publications and telecommunications is sufficient reason to request the transfer of the disputed domain to Complainant”.
- 3.1.7) In its Reply, the Complainant explains the relationship between Johnnic Publishing Limited (which changed its name to Avusa Publishing Limited in 2007) and the Complainant (Avusa Publishing Limited, being a subsidiary of the Complainant). It also alleges that Northern Titles (Pty) Limited is a subsidiary of the Complainant and that the Complainant is licensed to use Northern Titles’s THE LITTLE BLACK BOOK trade mark.
- 3.1.8) The Complainant further points out that, in this matter, it is not enforcing an infringement action in terms of the Trade Marks Act, but that it is relying on the provisions of the Dispute Resolution process.
- 3.1.9) It claims that its allegations that it has spent “a considerable amount of time, money and effort in advertising and promoting the “THE LITTLE BLACK BOOK” trade mark remain undisputed.
- 3.1.10) It also calls attention to the fact that the WHOIS register details list the Registrant of the disputed domain name as “The Little Black Book”. The Complainant submits that it therefore follows that Marina’s Little Black Book Events CC has not legal basis to oppose the Complaint, and, accordingly, that the response received from “Marina’s Little Black Book Events CC” should be ignored, as it has

not been received from the Registrant.

- 3.1.11) It denies that any reputation has accrued in the Registrant in the words THE LITTLE BLACK BOOK, but continues that, had any reputation accrued, it would vest in Marina's Little Black Book Events CC, which, it submits, is not a party to these proceedings.
- 3.1.12) The Complainant alleges, further, that the Registrant offered to cease use of the disputed domain name against payment of R50 000, and that this offer clearly indicates an abusive registration as is envisaged by Regulation 4(1)(a)(i).
- 3.1.13) In paragraphs 7.3 and 7.4 of the Reply, the Complainant appears to switch tack from the allegation outlined in point f) hereof, and confirms that it is not the registered proprietor of the trade mark THE LITTLE BLACK BOOK, but submits that this Complaint was founded on its common law rights, acquired through use of the trade mark THE LITTLE BLACK BOOK since 2001.
- 3.1.14) The Complainant draws the attention of the Adjudicator to the fact that, prominently featured on the home page of the website attached to the domain name thelittleblackbook.co.za, is a depiction of a book. The Complainant believes, accordingly, that the Registrant is clearly using the domain name in respect of a publication.
- 3.1.15) The Complainant denies the Registrant's allegations that it has been using the domain name thelittleblackbook.co.za in respect of services dissimilar to those in relation to which the Complainant has registered and uses the trade mark THE LITTLE BLACK BOOK.
- 3.1.16) The Complainant denies that the Registrant has put forward any evidence of good faith offerings of services. It alleges that all evidence provided is in respect of Marina's Little Black Book Events' use of the mark, and is accordingly hearsay and

inadmissible.

3.2 Registrant

- 3.2.1) It is submitted that the Registrant is Marina's Little Black Book CC, a close corporation incorporated in 2009.
- 3.2.2) Marina Nestel is the sole member of the Registrant. It is submitted that she adopted the name Marina's Little Black Book and the LITTLE BLACK BOOK as reference to her database, built over many years as a result of the organisation of various events for personalities and celebrities.
- 3.2.3) The Registrant previously traded as a sole proprietorship under the names MARINA' S LITTLE BLACK BOOK and THE LITTLE BLACK BOOK. Use of these trading styles commenced in 2008.
- 3.2.4) The Registrant claims that its business and services are well known in the events management, hosting and public relations industry and that it has acquired a considerable reputation in the trade marks and trading styles MARINA' S LITTLE BLACK BOOK and THE LITTLE BLACK BOOK. This allegation has been supported by copies of various articles referring to the Registrant as MARINA'S LITTLE BLACK BOOK or THE LITTLE BLACK BOOK, and its involvement in various events.
- 3.2.5) The Registrant acknowledges the correspondence exchanged between the parties and emphasises that the contribution of R 50 000 requested was in respect of the change of name of the Registrant's entire business, as would be demanded from the holder of trade mark rights from an alleged infringer.
- 3.2.6) The Registrant denies that the Complainant has rights in the trade mark THE LITTLE BLACK BOOK or LITTLE BLACK BOOK. It asserts that the trade marks are registered to Northern Titles (Pty)

Ltd, a fact that is admitted by the Complainant. It draws to the attention to the Adjudicator that the trade mark proprietor is not a party to the Dispute.

- 3.2.7) It provides an extract from the register indicating that the Complainant is not a registered user of the LITTLE BLACK BOOK trade marks. It also denies that the Claimant produced any evidence that it is a licensee in respect of the trade marks. The Registrant denies, in paragraph 8.2.23, that the Complainant has provided any evidence of use of the domain name thelittleblackbook.co.za with the consent of the proprietor.
- 3.2.8) The Registrant claims that it uses the domain name thelittleblackbook.co.za in respect of goods and services dissimilar to those covered by the “THE LITTLE BLACK BOOK” trade mark registrations.
- 3.2.9) It submits that the phrase “little black book” is colloquially used as a reference to a personal telephone directorial book in which the names and telephone numbers of friends are listed. There are numerous entries on Google for the phrases “black book” and “little black book”.
- 3.2.10) The trade mark THE LITTLE BLACK BOOK was first applied for, in September 2001, by Kirkwood Promotions CC. The Adjudicator notes, from the extract from the register, that this mark has not proceeded to registration.
- 3.2.11) The Registrant points out that the domain name littleblackbook.co.za was initially registered to Johnnic Publishing Limited, an entity different entity to Northern Titles (Pty) Ltd, the proprietor of the LITTLE BLACK BOOK trade mark registration. The Complainant acquired the domain name littleblackbook.co.za in January 2010.

-
- 3.2.12) At 8.2.33, the Registrant denies that the Complainant has provided any evidence to support the allegation that it enjoys extensive common law rights in the domain name and that the domain name is a widely recognised brand.
- 3.2.13) It accordingly denies that there is any chance of deception and/or confusion regarding the identity of the Registrant, its services and the goods and/or services provided by the Complainant. It also mentions that there is no competition between the Registrant and Complainant and, accordingly, the Complainant will suffer no loss if the Registrant is allowed to continue its use of the domain name thelittleblackbook.co.za.
- 3.2.14) The Registrant avers that it has been using the domain name fairly, and that it had no intention to block the registration of a name or mark in which the Complainant has rights. It denies that its registration is abusive.
- 3.2.15) It then proceeds to allege that the Complainant instituted these proceedings in a bad faith attempt to deprive the Registrant of its registered domain name, with full knowledge that the Registrant was *bona fide* in registering and using the domain name.
- 3.2.16) The Respondent submits that the Complainant clearly had knowledge of its rights or legitimate interest in the domain name and, notwithstanding this, it instituted these proceedings. The Registrant submits that the Complainant's conduct during settlement proceedings prior to the institute of the Complaint, is evidence of harassment or similar conduct.
- 3.2.17) It submits that the Complainant attempted to bully the Registrant into transferring the domain name and, when that failed, it initiated this Complaint with the primary purpose of harassing the Registrant.

3.2.18) It accordingly calls for a finding of reversed hijacking against the Complainant.

4 Discussion and Findings

- a) Both parties have made the allegation of a lack of locus standi in respect of the other.
- b) Although it did not appear from the founding papers, the Complainant submitted enough argument in Reply to convince the Adjudicator that it has a license to use the trade marks THE LITTLE BLACK BOOK. These include the allegations that Northern Titles (Pty) Ltd is a subsidiary of the Complainant. In paragraph 1.6 of its Reply, the Complainant submits that it is required to pay a licensing fee and incur the costs associated with the advertising, promotion and utilisation of the trade mark THE LITTLE BLACK BOOK. In addition, there is no mention of Northern Titles (Pty) Ltd objecting to the Complainant's use of the trade mark THE LITTLE BLACK BOOK, and it must have been aware of the Complainant's use.
- c) The adjudicator finds it unnecessary to make a finding at this point in respect of the *locus standi* of Marina's Little Black Book of Events CC in this matter.
- d) In terms of Regulation 3(1)(a), in order to succeed in this Complaint, the Complainant must prove:
 - i. that it has rights in relation to a name or a trade mark;
 - ii. that name or trade mark is identical or similar to the domain name complained about; and
 - iii. the domain name in the hands of the Registrant, is abusive.

The Adjudicator must be convinced of all three the above factors on the balance of probabilities. The Adjudicator also wishes to make reference, at this point, of her duty, in terms of Regulation 4, to ensure that the parties are treated with equality and that each party is given a fair opportunity to present its case, and her duty to determine the admissibility, relevance, materiality and weight of the evidence.

- e) The first requirement is that the Complainant must prove that it had rights in a mark that is confusingly and/or deceptively similar to the domain name in dispute. There is no difficulty in the Adjudicator's finding that the domain name the littleblackbook.co.za is virtually identical to the registered trade marks of Northern Titles (Pty) Ltd, THE LITTLE BLACK BOOK in classes 16 and 38, in respect of which the Adjudicator has found the Complainant to hold a license on the balance of probabilities.

4.1 Complainant's Rights

- 4.1.1 It is common cause that the Complainant is not the proprietor of THE LITTLE BLACK BOOK trade mark registrations. It has, however, satisfied the Adjudicator that there is a licensing relationship between Northern Titles (Pty) Ltd and the Complainant.
- 4.1.2 In terms of the Trade Marks Act, and, particularly, Section 38(1) thereof, where a registered trade mark is used by a person other than the proprietor thereof, with the license of the proprietor, such use shall be deemed to be permitted use. Sub-section (2) of the same section, provides that permitted use shall be deemed to be use by the proprietor and shall not be deemed to be use by a person other than the proprietor.
- 4.1.3 Accordingly, as the Complainant does not hold registered rights in the trade mark THE LITTLE BLACK BOOK, and also any use that it may have made of the trade mark THE LITTLE BLACK BOOK accrues to the proprietor of the registered trade marks THE LITTLE BLACK BOOK, the Adjudicator finds that the Complainant does not have rights in the trade mark THE LITTLE BLACK BOOK.
- 4.1.4 The Adjudicator is perplexed as to why the proprietor of the trade mark rights in the trade mark THE LITTLE BLACK BOOK was not cited in this matter. Be that as it may, the Adjudicator finds that the Complainant has not proven, on the balance of probabilities that it

has any rights in a trade mark corresponding to the domain name complained of.

4.2 Reversed domain name hijacking

4.2.1 In order to succeed in a claim for reversed domain name hijacking, the Registrant must prove, on the balance of probabilities, that the Complainant used the Regulations in bad faith in an attempt to deprive the Registrant of a domain name.

4.2.2 In support of its allegation of reversed domain name hijacking, it must be shown that the Complainant had knowledge of the Respondent's rights or legitimate interest in the disputed name and evidence of harassment or similar conduct by the Complainant in the face of such knowledge must be produced.

4.2.3 It is customary for parties to engage in correspondence before initiating litigation of any nature (including in the form of a complaint to this forum) in an attempt to settle without incurring unnecessary costs.

4.2.4 The Registrant has not, in the view of the Adjudicator, provided any evidence of its allegations that the correspondence exchanged between the parties prior to the initiation of the complaint exceeded the usual parameters therefor and could be considered an attempt at bullying the Registrant into relinquishing its ownership of the domain name thelittleblackbook.co.za.

4.2.5 Nor can the Adjudicator find, on the evidence before her, that the primary purpose of instituting these proceedings was to harass the Registrant. The Complainant is entitled to attempt to protect the rights that it believes it owns.

5. Decision

5.1 For all the foregoing reasons, the Dispute is refused.

5.2 The claim on the basis of reversed domain hijacking is similarly refused.

.....

VANESSA LAWRENCE

SAIIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za