

Decision

[ZA2013-0133]

.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA2013-0133
DECISION DATE:	6 June 2013
DOMAIN NAME:	dnkcarfind.co.za
THE DOMAIN NAME REGISTRANT:	David Pieterse
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Car Find (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	Hahn & Hahn
2 nd LEVEL ADMINISTRATOR:	UniForum SA

1. Procedural history

- 1.1 The domain name in issue is <dnkcarfind.co.za>, which was registered on 25 May 2011.
- 1.2 The Complainant is Car Find (Pty) Ltd a South African company of Meadowdale, hereinafter referred to as “the Complainant” . The Registrant is David Pieterse, of Roggebaai, Cape Town.
- 1.3 This dispute was filed with the South African Institute of Intellectual Property Law (“SAIPL”), on **28 March 2013**. On **3 April 2013** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name, and on the same day UniForum SA confirmed the suspension.
- 1.4 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the dispute on **4 April 2013**. On **6 May 2013** the SAIPL were advised of a possible settlement between Complainant and Registrant, but on **8 May 2013** the Registrant notified SAIPL that a settlement could not be reached with the Complainant. The Registrant has not filed a response to the dispute.
- 1.5 The SAIPL appointed **Adv Owen Salmon** as the Adjudicator in this matter on **20 May 2013**. On **20 May 2012** the Adjudicator 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.

1. Factual Background

- 2.1 The Complainant is the proprietor in South Africa of Trade Mark Registration Nos 2010/19177-80 CARFIND and CARFIND.CO.ZA in classes 35 and 38.
- 2.2 The Complainant has advertised its CARFIND trade mark since 2000. Approximate amounts spent on advertising and promoting the CARFIND trade mark were set out in the Complaint, and in the last 3 years total R37 million. As the Complainant's business is primarily internet-based, it has also focused on using a Google adwords campaign to promote its services under the trade mark CARFIND. In the 10½ years period ending 17 August 2011, the Complainant spent in excess of R8.8 million on its Google adwords campaign alone.
- 2.3 The Complainant also makes wide use of radio advertisements and it has erected numerous billboards advertising its CARFIND services. The Complainant's billboards are alleged to be visible in most major centres across South Africa. It operates a fleet of more than 40 CARFIND-branded vehicles and, from time to time, the Complainant sponsors and exhibits at events relating to the automotive industry.
- 2.4 The number of hits on its <carfind.co.za> site was, in 2011 alone, in excess of 5 million, and by July 2011 the turnover generated through use of the Complainant's CARFIND trade mark exceeded R154 million.

2.5 It is submitted by the Complainant that its CARFIND trade mark, and the business that it runs through the domain name <carfind.co.za>, are well known and recognised throughout the whole of South Africa by consumers and competitors in the vehicle sales market. It is clear, at least, that the Complainant enjoys common law rights in the CARFIND trade mark.

3 The Complainant's Contentions

3.1 An extract from the Registrant's website at <dnkcarfind.co.za> is attached to the Complaint. The website advertises cars for sale, i.e. a business akin to the one found at <carfind.co.za>. (There is some similarity in the styles in which the respective domain names are represented on their sites.)

3.2 It is submitted that the Registrant must have been aware of the reputation vesting in the Complainant's CARFIND mark, and the <carfind.co.za> domain, when it registered the domain <dnkcarfind.co.za>.

3.3 It is further submitted that the Registrant specifically chose the domain name <dnkcarfind.co.za> to lead people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected to the Complainant. Moreover, that the addition of "dnk" before "carfind.co.za" indicates that the domain name <dnkcarfind.co.za> is (somehow) linked to the <carfind.co.za> domain.

3.4 Accordingly, the contention is that the domain is abusive.

4 The Registrant's Contentions

There is no response from the Registrant.

5 Discussion and Findings

5.1 In terms of Section 1 of the Regulations, an abusive registration means a domain name which either -

5.1.1 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

5.1.2 Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

5.2 An indication is given in the Regulations as to what could be considered an abusive registration. In terms of Section 4(1), such factors include:-

“(a) Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to -

(i) Sell, rent or otherwise transfer the domain name to a complainant or to a competitor of the complainant, or any third party, for valuable consideration

- in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name;
- (ii) Block intentionally the registration of a name or mark in which the complainant has rights;
 - (iii) Disrupt unfairly the business of the complainant; or
 - (iv) Prevent the complainant from exercising his, her or its rights;
- (b) Circumstances indicating that the registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorized by, or otherwise connected with the complainant;
- (c) Evidence, in combination with other circumstances indicating that the domain name in dispute is an abusive registration, that the registrant is engaged in a pattern of making abusive registrations;
- (d) False or incomplete contact details provided by the registrant in the Whois database; or
- (e) The circumstances that the domain name was registered as a result of a relationship between the complainant and the registrant, and the complainant has -

- (i) been using the domain name registration exclusively; and
- (ii) paid for the registration or renewal of the domain name registration.”

5.3 An indication is also given as to what would not be an abusive registration. In terms of Section 5, factors which may indicate this include:-

- “(a) before being aware of the complainant’s cause for complaint, the registrant has -
 - (i) used or made demonstrable preparations to use the domain name in connection with a good faith offering of goods or services;
 - (ii) been commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name; or
 - (iii) made legitimate non-commercial or fair use of the domain name;
- (b) the domain name is used generically or in a descriptive manner and the registrant is making fair use of it;
- (c) that the registrant has demonstrated fair use, which use may include websites operated solely in tribute to or fair criticism of a person or business: Provided that the burden of proof

shifts to the registrant to show that the domain name is not an abusive registration if the domain name (not including the first and second level suffixes) is identical to the mark in which the complainant asserts rights, without any addition”

5.4 In terms of Section 9, one of two outcomes is possible in the case of a complaint that the domain is an abusive registration: refusal of the dispute, or transfer of the disputed name.

5.5 To succeed in this complaint the Complainant has to prove,¹ on a balance of probabilities, the following:-

- It has rights in respect of a name or mark which is identical or similar to the domain name; and
- The domain name, in the hands of the Respondent, is an abusive registration as defined.

5.6 The domain name <dnkcarfind> is obviously not identical to the name or mark in which the Complainant asserts it has rights, namely <carfind.co.za>. Nevertheless, in the Adjudicator’s view, the name <dnkcarfind.co.za> is similar within the meaning of the Regulations to <carfind.co.za>.

¹ Section 3(1)(a) of the Regulations.

5.7 The next question is whether the Complainant has ‘rights’ in the mark “carfind” . Clearly it does, if only by virtue of the trade mark registrations (wherein the mark is presumed to be distinctive).

5.8 The question therefore to be decided is whether the domain name:-

- was registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’ s rights; or
- has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant’ s rights.

5.9 There are two potential abuses:-

- registration with abusive intent; and
- abusive use,

and the nature of “abusiveness” as contemplated by the Regulations does not require a positive intention to abuse the Complainant’ s rights, but that abuse was the effect of the use or registration.

5.10 There exists an element of difficulty, in the absence of contentions from the Registrant, in concluding that the complaint is without substance. Given the Complainant’ s allegations (summarized above) the absence of a response leads to the inference that they are correct. This, in turn, means that the domain falls to be found abusive within the meaning of the Regulations.

5.11 This conclusion is underpinned, in any event, by a check from different angles. One can readily recognize that “car find” has a user-friendliness probably stemming from its connotation implying a search-type function for the site. But there are myriad ways to achieve the same implication.

5.12 Besides, the prefix “dnk” (*prima facie*, at least; and there is nothing else to go on) does nothing to assist in this regard. Nor does it set the name apart from <carfind>, because it does not mean anything. The relevance of this is that, as an address-bar index functionary, it serves no purpose for the notional browser, whose only point of recognition would be <carfind>. And this, as the Complainant’s evidence shows, at least, has significant secondary meaning. An assumption of some connection in the course of trade is, at least, likely.

6 Decision

For the foregoing reasons the Adjudicator’s conclusion is that the domain name is abusive. In accordance with Regulation 9, the Adjudicator orders that the domain name be transferred to the Complainant.

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ADV OWEN SALMON
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za