

ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-00179
DECISION DATE	18 August 2014
DOMAIN NAME	Mandela-memorabilia.co.za
THE DOMAIN NAME REGISTRANT	Mandelamemorabilia
REGISTRANT'S LEGAL COUNSEL	NONE
THE COMPLAINANT	The Trustees for the Time Being of The Nelson Mandela Foundation
COMPLAINANT'S LEGAL COUNSEL	Edward Nathan Sonnenbergs
THE 2nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on 9 June 2014. On 26 June 2014 the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on 26 June 2014 UniForum SA confirmed that the domain name had 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 26 June 2014. In accordance with the Regulations, the due date for the Registrant's Response was 23 July 2014. The Registrant did not submit a Response, and accordingly, the SAIPL notified the Registrant of its default on 24 July 2014.
- c. The SAIPL appointed Lisa Thornton as the Adjudicator in this matter on 11 August 2014. 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 is The Trustees for the Time Being of The Nelson Mandela Foundation.
- b. The Registrant is mandelamemorabilia.
- c. The Complainant lists eleven trademarks containing the name Mandela or the image of Nelson Mandela that are registered in the name of the

Nelson Mandela Foundation. The Complainant lists five domain names in South Africa and twelve in other jurisdictions containing the name Mandela that are registered in the name of the Nelson Mandela Foundation. All of the registrations (or applications for registration) predate the registration of the disputed domain name.

- d. The disputed domain name, mandela-memorabilia.co.za, was registered on 30 May 2013 by the Registrant. The associated website offers coins for sale using the Mandela name.
- e. On 13 June 2013, the Complainant's legal representatives addressed a letter of demand to the Registrant and later attempted to communicate with the Registrant telephonically. The Registrant did not respond to the correspondence or telephone calls.

3) Parties' Contentions

a. Complainant

- i. The Complainant alleges that the domain name has been used in a manner that takes unfair advantage of or is unfairly detrimental to the Complainant's rights and is therefore abusive.

b. Registrant

- i. The Respondent did not respond to the Complainant's contentions.

4) Discussion and Findings

In terms of Regulation 3, the Complainant must prove on a balance of probabilities that it has rights in respect of a name or mark that is identical or similar to the disputed domain name, and that there is an abusive registration. An abusive registration is the registration or use of a domain name that takes unfair advantage of or is unfairly detrimental to the Complainant's rights.

Because the Respondent did not submit a Response, in terms of Regulation 18(3), this matter will be decided on the Dispute.

a. Complainant's Rights

- i. The Complainant did not provide proof that the trademarks and domain names that it listed are registered to it. However, because the Registrant did not respond to the Dispute, the Adjudicator accepts for the purposes of this matter, the factual allegations of the Complainant. The Adjudicator also verified in the whois database that the domain name, nelsonmandela.co.za, was registered in the name of the Nelson Mandela Foundation on 4 February 2011, and points to the Nelson Mandela Foundation website, within which considerable use of the Mandela name is made. The Adjudicator finds that the Complainant has rights in the name Mandela.
- ii. The Adjudicator finds that the disputed domain name, mandela-memorabilia.co.za, is similar to the name Mandela, because it incorporates the name Mandela. The addition of the generic word, memorabilia, in no way takes away from the similarity. See ZA2008-0022 and ZA2010-0046, *inter alia*.

b. Abusive Registration

- i. Regulation 4(1) sets out factors that may indicate an abusive registration. Included, in Regulation 4(1)(b), is circumstances indicating the Registrant is using the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Complainant did not provide evidence of actual people or businesses being misled. However, the likelihood of people or businesses being misled is sufficient. Indeed, in situations where a Registrant has registered a domain

name containing the Complainant's name or mark together with a generic term, an inference may be inferred. See ZA2010-0046, ZA2014-0164 and ZA2014-0167, *inter alia*. The Adjudicator finds that there is a likelihood that people and businesses will be and are being misled to believe the disputed domain name is registered to, operated by or authorised by the Complainant.

ii. Regulation 4(1)(d) provides that providing false or incomplete contact details in the whois database is another factor that may indicate an abusive registration. The name of the Registrant on the whois database does not appear to be a real person. The Adjudicator attempted to verify whether the Registrant was a registered South African company by performing an enterprise search on the Companies and Intellectual Property Commission's eSearch, but failed. Attempts to communicate with the Registrant by the Complainant failed. The Registrant failed to respond to all communications in this matter. The Adjudicator finds that the registrant provided incomplete and, in the circumstances, possibly false details in the whois database.

iii. In conclusion, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that the registration of the disputed domain name by the Registrant takes unfair advantage of or is unfairly detrimental to the Complainant's rights and is therefore an abusive registration.

5) Decision

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

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Lisa Thornton
SAIPL ADJUDICATOR
www.DomainDisputes.co.za