

Decision

ZA2015-0197

.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0197
DECISION DATE:	23 JUNE 2015
DOMAIN NAME	SOWETANJOBS.CO.ZA
THE DOMAIN NAME REGISTRANT:	JAMES SAI
REGISTRANT' S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	TIMES MEDIA (PTY) LIMITED
COMPLAINANT' S LEGAL COUNSEL:	Moore Attorneys
2 nd LEVEL ADMINISTRATOR:	ZACR (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on 24 April 2015. On **29 April 2015** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **29 April 2015** the ZACR 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 **30 April 2015**. In accordance with the Regulations the due date for the Registrant’ s Response was **29 May 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **1 June 2015**.
- c) The Complainant did not submit any Reply.
- d) The SAIPL appointed **NOLA BOND** as the Adjudicator in this matter on **09 June 2015**. 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 The Complainant is Times New Media (Pty) Limited, the owner of the South African daily newspaper, SOWETAN. The newspaper was started in 1981 and according to the Complainant’ s uncontested facts currently carries a readership of 2 million people and a circulation of 124 000 people.

2.2 The Complainant is the proprietor of the following pertinent South African trade mark registrations:

- Trade mark registration no 1995/03156 SOWETAN in class 16;
- Trade mark registration no 1995/03157 SOWETAN in class 18;
- Trade mark registration no 1995/03158 SOWETAN in class 24;
- Trade mark registration no 1995/03159 SOWETAN in class 25;
- Trade mark registration no 1995/03160 SOWETAN in class 28;
- Trade mark registration no 1995/03161 SOWETAN in class 35;
- Trade mark registration no 1995/03162 SOWETAN in class 41;
- Trade mark registration no 1995/03163 SOWETAN in class 35;
- Trade mark registration no 1995/03163/1 SOWETAN in class 41;
- Trade mark registration no 2005/11575 SOWETAN in class 38.

In addition, the Complainant is the proprietor of, *inter alia*, the following trade marks:

- SOWETAN DAILY MIRROR;
- SOWETAN WOMEN' S CLUB;
- SOWETAN EXTRATIME LOGO;
- SOWETAN BRIDAL COUPLE OF THE YEAR;
- SOWETAN WOMEN' S CLUB;
- SOWETAN BIG WALK;
- SOWETAN TELEVISION;
- SOWETAN WINE;
- SOWETAN WINE EXPERIENCE;
- SOWETAN TRAVELLER' S CLUB;
- SOWETAN LIVE.

2.3 The Complainant is the proprietor of the following relevant domain names:

- sowetan.co.za
- sowetanlive.co.za
- sowetandating.co.za

The Complainant in addition to providing current news through print media and digital platforms also provides a job market section in its newspaper.

2.4 It was submitted by the Complainant that as a result of their extensive advertising of their mark SOWETAN in all forms of media including radio, television and internet, the trade mark SOWETAN is a well-known mark and brand in South Africa.

2.5 In and during December 2014, it was brought to the Complainant's attention that the Registrant had registered the domain name SOWETANJOBS.CO.ZA

The Complainant upon becoming aware of the registration of the domain name dispatched a letter of demand to the Registrant on 15 December claiming transfer of the domain name on the basis of the Complainant's trade mark rights and that the Registrant's registration of the domain name was an abusive registration. No response was received from the Registrant.

A further letter of demand was addressed to Registrant on 23 January 2015 and, to date, no response has ever been received from the Registrant.

2.6 The Registrant has failed to put forward any defence to the dispute, notwithstanding the Registrant been given sufficient opportunity to respond to the Complainants' contentions.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant contends that the Registrant's domain name SOWETANJOBS.CO.ZA is identical to the Complainant's SOWETAN registered trade marks as it is visually and phonetically similar and wholly incorporates the Complainant's trade marks.

Furthermore, the Complainant submits that the Registrant's disputed domain name is identical to the manner in which the Complainant uses its SOWETAN trade mark in the market place.

- b) The Complainant contends that as a result of its extensive use, reputation and registered rights in the mark, SOWETAN, the registration of the domain name by the Registrant constitutes an abusive registration in terms of Regulation 3(1)(a) in that the Registrant has registered the domain name primarily to
- 1) Block intentionally the registration of a name or mark in which the complainant has rights [Regulation 4(1)(a)(ii)]
 - 2) Registered, 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 [Regulation 4(1)(b)]
- c) The Complainant, furthermore, submits that the domain name is abusive in that it is unfairly detrimental and takes unfair advantage of the Complainant's rights.
- d) Finally the Complainant drew the Adjudicator's attention to the SAIPL decision of ZA2014-0189 wherein the Registrant in the dispute was in fact

the same Registrant in the present matter. It may be inferred that the Complainant relies upon Regulation 4(1)(c).

In terms of Regulation 4(1)(c) factors, which may indicate that the domain name is an abusive registration include 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.

3.2 Registrant

- a) The Registrant failed to submit any response to the Complainant's contentions.

4.1 Complainant's Rights

4.1.1 The Complainants' SOWETAN trade mark is registered and a reputation subsists in the business to which the SOWETAN trade mark is applied.

4.1.2 Although the dominant element of the offending SOWETANJOBS domain name is identical to the Complainant's trade mark registrations, the domain name, as a whole (not including the second level suffixes), is not identical to the mark SOWETAN in which the Complainants assert rights, without any addition, as provided for in terms of the proviso contained in Regulation 5(c).

4.1.3 Regulation 5(c) states "factors which may indicate that the domain name is not an abusive registration include the domain name is used generically or in a descriptive manner and the registrant is making fair use of it."

The term "SOWETAN" or "A SOWETAN" is a term which is used generically to refer to the persons originating from the well-known

township of Soweto, situated outside of Johannesburg, South Africa.

The term may be used as an adjective indicating the source of goods or services originating from Soweto, for example, a Sowetan hat or Sowetan plumbing services.

As such, the word “SOWETAN” serves as a geographical indicator of specific persons, goods and services.

4.1.4 In *Century City Apartments v Century City Property Owners Association 2010 (3) SA 1 (SCA)*, the Supreme Court of Appeal had to consider the appellant’s reliance on Section 34(2)(b)¹ of the Trade Marks Act 194 of 1993 (“the Act”) which provides that “a registered trade mark is not infringed by the use by any person of any bona fide description or indication of the geographical origin of his services” .

The facts of the *Century City* case closely parallel those of the present matter in that the name CENTURY CITY represents a significant landmark in Cape Town in the same manner that Soweto represents a significant landmark in Johannesburg.

In *Century City*, Harms DP held that Section 34(2)(b) of the Trade Marks Act - “... represents the other side of the coin of the requirement that the infringing use has to be trade mark use. A bona fide description or indication of the geographical origin of an alleged infringer’s services amounts to non-trade mark use and whether one considers it as part of the trade mark owner’s cause of action or as a defence does not make

¹ Section34(2)(b)- A registered trade mark is not infringed by the use by any person of any bona fide description or indication of the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of his goods or services, or the mode or time of production of the goods or the rendering of the services;

² Section 10(2)(b) -The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register: a

much difference.”

Upon finding that the Appellant’s use of the trade mark CENTURY CITY amounted to trade mark use and, as such, the defence under S34(2)(b) failed, the Court was required to consider the appellant’s counter-application for the removal of the Respondent’s trade mark registrations in terms of Section 10(2)(b)² of the Act.

The Appeal Court held that Section 10(2)(b) is not concerned with distinctiveness or its loss and, further, that the prohibition is not directed at protecting trade mark use only, but would also include the situation where the name may designate the geographical origin of the goods or services.

The decision of the court in *Century City* was applied with approval by the learned Panel in the SAIPL decision ZA2011-0098, wherein the Panel, after considering the Court’s decision, stated [Paragraph 5.5.12] :

“On the evidence before it, the Panel finds on a balance of probabilities that the name V&A or V&A Waterfront is a geographical name. The fact that it is the most frequently visited destination in South Africa does not change this: to the contrary, it reinforces this finding. Indeed, the Complainant’s evidence establishes overwhelmingly the fame of the V&A Waterfront as a tourist destination, a harbour location set in beautiful surroundings with a multitude of service offerings from businesses established there and facilities that attract visitors. This finding does not, in terms of Century City, negate such trade mark rights as the Complainant has in its marks in relation to its particular services and business because

² Section 10(2)(b) -The following marks shall not be registered as trade marks or, if registered, shall, subject to the provisions of sections 3 and 70, be liable to be removed from the register: a mark which consists exclusively of a sign or an indication which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin or other characteristics of the goods or services, or the mode or time of production of the goods or of rendering of the services;

a mark can be both geographically descriptive and serve a trade mark function simultaneously for different services.”

In a similar manner, the Adjudicator finds that the word SOWETAN is geographically descriptive, especially when used in conjunction with a further noun which may, as a whole, represent the origin of goods, services or, as in the present matter, the location of specific job opportunities.

4.1.5 Accordingly, it remains for the Complainants to prove that the domain name is an abusive registration in terms of the Regulations, as held in the Expert’s statement at paragraph 7.6 of Nominet DRS 02201 *Viking Office Products Inc. v Wenda Sparey*, with approval by the Panel in SAAIPL Decision. ZA2007-0007.

4.2 Abusive Registration

4.2.1 An abusive registrations means a domain name which either:-

- (i) 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 Complainants’ rights; or
- (ii) Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainants’ rights.

The Complainant is required to prove, on a balance of probabilities, that the required elements are present.

4.2.2 In terms of Regulation 4(1), factors which may indicate that the Domains are abusive registrations include circumstances indicating that the registrations were primarily to:-

(a)

- (i) Block intentionally the registration of a name or mark in which the Complainant has rights;
- (ii) Disrupt unfairly the business of a Complainant;
- (iii) Prevent a Complainant from exercising 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 authorised 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.

4.2.3 *Regulations 4(1)(a)(ii), (iii) & (iv)*

No evidence was submitted that the registration of the domain name was done with the primary intention of disrupting the Complainant's business or preventing the Complainant from registering a name or mark in which it has rights. However, the effect of the registration of the domain name SOWETANJOBS.CO.ZA by the Registrant has the effect that the Complainant is unable to do register a domain name in which they have a legitimate interest, especially in light of the fact that the Complainant is known to advertise employment opportunities in their various publications. Logically the registration of a domain name in which the Complainant has legitimate interest and by virtue of which it is losing internet traffic, would in all likelihood disrupt the business of the Complainant. Given that the Complainant is blocked from exercising its legitimate rights, the disputed domain name appears to be an abusive registration.

In support thereof earlier domain name decisions indicate that such

“barring” or “blocking” are indicative of an abusive registration. See for example, the decisions in DRS00583 and DRS01378.

4.2.4 **Regulation 4(1)(b)**

Regulation 4(1)(b) states “*factors which may indicate that the domain name is an abusive registration includes 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 authorised by, or otherwise connected with the Complainant.*”

The Complainant is the proprietor of the domain names SOWETAN.CO.ZA and SOWETANLIVE.CO.ZA and is the publisher of the widely circulated and well known newspaper, SOWETAN, in which it advertises employment opportunities on a regular basis.

The website hosted on the disputed domain name SOWETANJOBS.CO.ZA contains a number of click-through advertisements relating to job opportunities in or around Johannesburg. The mark SOWETANJOBS.CO.ZA appears prominently in the top left hand corner of the website.

It is a well established legal principle that a domain name that comprises a trade mark coupled with a generic term, that domain name is still confusingly similar to the trade mark. In this regard, the Adjudicator agrees with the findings in SAIPL decisions ZA2007- 0003 Telkom SA Limited v Cool Ideas 1290 CC and ZA2007-0004 Telkom SA Limited and TDS Directory Operations (Pty) Ltd v The Internet Corporation.

In decision ZA2007/0003 it was held that actual confusion is not necessary and that the potential or likelihood of confusion would be sufficient. In this regard the Adjudicator therein referred to, with approval,

the foreign decisions in WIPO/D2000-0777, WIPO/D2000-878, NAF/FA95033 and NAF/FA95402. It was further held that confusion may be inferred in situations where the Registrant registered a domain name containing the Complainant's name or mark together with a generic term.

In *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 3 SA 623 (A) 640 the court stated:

“In an infringement action the onus is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, i.e. the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection.”

Taking into account the above well known principles, on a balance of probabilities, it is likely that a substantial number of persons when entering the Registrant's website will be confused or be deceived into believing that the Registrant's website and domain name are associated or connected in some manner with the Complainant or that the advertisements, as

appearing on the website, are placed there with the approval of the Complainant.

As such, the Adjudicator finds that in terms of Regulation 4(1)(b) the Registrant has both registered the domain name SOWETANJOBS.CO.ZA and is using the domain name in such a manner that it is likely to lead people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The registration of the domain name is abusive in terms of Regulation 4(1)(b).

4.2.5 **Regulation 4(1)(c)**

Regulation 4(1)(c) states “*factors which may indicate that the domain name is an abusive registration includes 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.*”

It was submitted by the Complainant that the Registrant in this matter, namely one JAMES SAI, was the Registrant in case ZA2014-0189. In this case the Registrant had registered the domain names SASOLLEARNERSHIP.CO.ZA and SASOL.CO.ZA.

Upon further investigation the Adjudicator found that the Registrant, JAMES SAI, was also the Registrant in case ZA2014-0187 wherein the domain name, STANDARDBANKMOBI.CO.ZA, was registered.

In Nominet case DRS 002806 the Expert found that the Registrant’s conduct in registering multiple domain names which contained a registered trade mark constituted a pattern of conduct.

In WIPO case D2008-1560, the Panel took into account the conduct of the Respondent and the fact that he was or had been involved in a number of domain name disputes. In holding that the Respondent had registered and was using the domain name in bad faith, the Panel stated that the Respondent “has engaged in a pattern of conduct involving the disregard of the trademark rights of others.”

It is clear that the Registrant, JAMES SAI, has registered a number of domain names incorporating well-known South Africa registered trade marks. The registration of domain names incorporating well-known trade marks cannot logically be put down to pure co-incidence. The Registrant therefore appears to be engaging in a practice of registering domain names which contain well-known South Africa trade marks with the view to generating revenue from click through advertising. Such conduct can be said to take unfair advantage of the reputation or distinctive character of the trade marks concern. The registration of the domain names, furthermore, appears to have been done so with blatant disregard to the trade mark rights of others. Such conduct is clearly abusive and the Adjudicator therefore finds on a balance of probabilities that the registration is abusive taking into account Regulation 4(1)(c).

5. Decision

- 5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, SOWETANJOBS.CO.ZA be transferred to the Complainant.

.....

NOLA BOND

SAIIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za