

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0203
DECISION DATE:	21 September 2015
DOMAIN NAME	PROPUK.CO.ZA
THE DOMAIN NAME REGISTRANT:	CARINA BESTER
REGISTRANT'S LEGAL COUNSEL:	SPOOR AND FISHER (CARL VAN ROOYEN)
THE COMPLAINANT:	NORTH-WEST UNIVERSITY
COMPLAINANT'S LEGAL COUNSEL:	Kisch IP (Mr A van der Merwe)
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZACR (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIIPL”) on **18 June 2015**. On **22 June 2015** the SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **23 June 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 **25 June 2015**. In accordance with the Regulations the due date for the Registrant’s Response was **23 July 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **27 July 2015**.
- c. The SAIPL appointed **Deon Bower** as the Adjudicator in this matter on **3 August 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.
- d. On **11 August 2015** attorneys Spoor & Fisher advised that they have “*belatedly been instructed by our client, Solidarity (Pty) Limited, to file a response to the objection filed by D M Kisch on behalf of North-West University*” and that they “*anticipate that we will be in a position to file a response by the end of this week, i.e. Friday 14 August 2015*”.
- e. On 12 August 2015, the Adjudicator advised Spoor & Fisher that should their client “*wish to put facts before the Adjudicator to support the extension or condonation request*” a decision can only be taken once the Complainant has been afforded the opportunity to consider and respond to the request.
- f. The Adjudicator also alerted Spoor & Fisher to the fact that their client, Solidarity (Pty) Limited (“Solidarity”), is not the Registrant and invited Spoor & Fisher to make suitable representations setting out the basis on which Solidarity believes it is entitled to respond to the Complaint.

- g. On **13 August 2015**, Kisch IP responded to Solidarity's informal request for an extension of the period within to file a response to the Complaint and requested the Adjudicator to deny the requested extension.
- h. Solidarity filed a Response on **17 August 2015** and on **19 August 2015** the Complainant, without conceding that Solidarity had the required *locus standi* to file a Response to the Complaint or condoning the late filing of the Response, agreed to file its Reply by no later than close of business on **31 August 2015**.
- i. On **19 August 2015**, the Parties also agreed that the Adjudicator will hand down its decision by no later than close of business on **21 September 2015**.

2) Factual Background

- a. The Complainant, previously known as, amongst others, the Potchefstroom University College and the Potchefstroom University for Christian Higher Education, has been using the names PUK or PUKKE, and other similar names, extensively, for many decades. The Complainant alleges that the name PUK is well known.
- b. The Complainant further submits that it has established an extensive repute or reputation, not only in the distinctive name PUK, but also variants of the name, such as PUKKE, PUKKIE and NWU-PUK, and enjoys a reputation in the aforementioned names, and, as such, enjoys extensive common law rights, at least in the name, PUK.
- c. The Complainant is further the registered proprietor of various trade mark registrations for the trade marks PUK, PUKKE, PUKKIE and PUKKI, which trade mark registrations are in full force and effect.
- d. On **9 April 2015**, the Complainant addressed a letter of demand to the "Pro-Puk Groep" calling on them to, amongst others, cease using the PROPUK name and Disputed Domain Name.
- e. On **29 April 2015**, the attorneys for the "Pro-Puk Groep", Spoor & Fisher, informed the Complainant that it was not prepared to adhere to the Complainant's demands.

- f. On **7 May 2015**, the Complainant addressed a further letter the “Pro-Puk Groep”, again, calling on them to cease using the PROPUK name and propuk.co.za domain name and advising them that the propuk.co.za domain name was an abusive registration as defined by the Regulations to the Electronic Communications and Transactions Act, No. 25 of 2005.
- g. On **26 May 2015**, the “Pro-Puk Group” rejected the demands and allegations made by the Complainant in its letter of **7 May 2015**.

3) Parties’ Contentions

a. Complainant

The Complainant has made various submissions and submitted evidence, including the following:

- i. It is the proprietor of the distinctive trade mark PUK and its plural PUKKE, which is registered in terms of the Trade Marks Act 194 of 1993 (“the Trade Marks Act”), under trade mark registration numbers 2011/25961 – 2 and 1998/23462 - 8 in various classes.
- ii. It holds extensive common law trade mark rights in the trade marks PUK and PUKKE as a result of the extensive use of the names over many decades.
- iii. Evidence which illustrates the manner in which the Disputed Domain Name is being used by a group of former students of the Complainant, for non-commercial purposes, i.e. to protect the use of the Afrikaans language on the campus of the Complainant (“*om Afrikaans op die Puk-kampus te beskerm*”).
- iv. It is unlawful for the Registrant or the “Pro-Puk Group” to use the Complainant’s trade marks, including as part of the Disputed Domain Name, to promote the above objectives.
- v. The Disputed Domain Name i.e. PROPUK.CO.ZA is similar to the PUK, PUKKE, PUKKI or PUKKIE trade marks resulting from the Registrant incorporating the distinctive PUK trade mark as a whole and the word PRO being “*a purely generic word*”.

- vi. Where the Disputed Domain Name includes the Complainant's entire mark the likelihood of confusion cannot be avoided by adding descriptive or non-distinctive matter to it.
- vii. Submits that although use of the Disputed Domain Name does not, necessarily constitutes statutory trade mark infringement, it does amount to passing-off under the common law as there is a substantial likelihood that internet users and consumers will be confused into believing that there is some affiliation, connection, approval or association between the Complainant and the Registrant (or the "Pro-Puk Groep), when in fact, there is no such relationship
- viii. The Disputed Domain Name is an abusive registration.

b. Registrant

- i. The Registrant did not respond to the Complainant's contentions but Solidarity, belatedly, attempted to submit a Response.
- ii. It is, accordingly, necessary to determine, not only if Solidarity has the *locus standi* to submit a Response but also, if the late filing of such a Response should be condoned.

Locus Standi

- iii. Regulation 18 of the ADR Regulations ("the Regulations") provides that:
"Within 20 days of the date of commencement of the dispute the registrant must submit a response in paper format, in triplicate and in electronic format to the provider". (emphasis added)
- iv. It is therefore necessary for Solidarity to prove that it is, in fact, the Registrant, alternatively, that it is authorised by the Registrant to file a response.
- v. It is common cause that the 2nd Level Domain Administrator's Whois facility lists the Registrant as Carina Bester ("Ms Bester").
- vi. Solidarity, however, submits, that *"it was decided that Ms Carina Bester, the current Registrant, who is employed by Solidarity in its Electronic*

Communications Department, would take transfer of the domain as Solidarity indicated it will take the matter further” ;

- vii. Solidarity further submits that “*In retrospect, the name should have been transferred to Solidarity as opposed to Ms Bester*”.
- viii. In making the above, and other, submissions, it appears that Solidarity is arguing that Ms Bester is not the true Registrant as Ms Bester was either holding the Disputed Domain Name on behalf of Solidarity, alternatively, agreed to transfer the Disputed Domain Name to Solidarity.
- ix. However, Solidarity elects not to submit any evidence, on oath or otherwise, from Ms Bester confirming the submissions made by Solidarity.
- x. In the absence of confirmatory evidence, the submissions made by Solidarity are hearsay and inadmissible and must, as such, be rejected.
- xi. The Adjudicator therefore finds that Solidarity has no *locus standi* as it is not the Registrant and also holds no authority to file a Response or to act on behalf of the Registrant. As such, the submissions of Solidarity are not considered for the purpose of deciding whether or not the Disputed Domain Name amounts to an abusive registration, or not.
- xii. In view of the above, it is not necessary to deal further with the application for condonation filed by Solidarity. It may, however, be appropriated to state that *prima facie* Solidarity did not discharge the requirements as laid down in Smith NO v Brummer NO 1954(3) SA 353 (0).

4) Discussion and Findings

- a. There is no absolute prohibition against the, unauthorised, use of a third party’s trade mark as part of a domain name. Such use, may, however, be objectionable if the domain registration amounts to an abusive registration or offensive registration.
- b. Regulation 3(1)(a) requires that a Complainant proves each of the following elements in order for the Disputed Domain Name to be transferred on the basis that it constitutes an abusive registration, namely that:

- i) The Complainant has established rights in respect of a name or mark;
 - ii) The name or mark is identical or similar to the Disputed Domain Name;
and
 - iii) In the hands of the Registrant, the Disputed Domain Name is an abusive registration.
- c. The adjudicator will draw such inferences from the Registrant's default as he considers appropriate. This will include the acceptance of plausible evidence of the Complainant, which has not been disputed.

4.1 Complainants' Rights

- a) Regulation 1 defines "*rights*" to include intellectual property rights, commercial, cultural, religious and personal rights protected under South African law, but are not limited thereto.
- b) The above definition is broad and "*rights*" is not restricted to rights founded on the principles of trade mark law, but recognises rights going beyond those in terms of the Trade Marks Act No. 194 of 1993 ("the Trade Marks Act") or the requirements at common law for passing off. Such rights must, however, find recognition in law. See [ZA2007-0008](#) ([privatesale.co.za](#)).
- c) The Complainant is the proprietor of trade mark registrations for the PUK and PUKKE trade marks.
- d) The Adjudicator finds that the Complainant has discharged the onus in showing that it has established suitable rights in respect of, particularly, the PUK and PUKKE trade marks in terms of the Trade Marks Act.
- e) The Disputed Domain Name not only includes the Complainant's mark PUK in its entirety, but the PUK trade mark is also the dominant feature of the Disputed Domain Name.
- f) The incorporation of the generic word PRO does not assist the Registrant in escaping the aforesaid finding and reference is made to a similar case in the South African domain dispute matter [ZA2007/0003](#), where it was found that the

domain name telkommedia.co.za was identical or confusingly similar to the well-known trade mark TELKOM.

- g) In another, similar, foreign case, NAF/FA141825, it was found that “[It] is also well-established under the Policy that a domain name composed of a trademark coupled with a generic term still is confusingly similar to the trademark”.
- h) In the foreign decision of WIPO/D2002-0367, the Panel concluded that “The Disputed domain name contains Complainant’s EXPERIAN trademark in its entirety. The addition of the generic term ‘automotive’ does not distinguish Respondent’s domain name from Complainant’s mark”.
- i) Reference is also made to foreign cases WIPO/D2000-1598 in which NIKETRAVEL and NIKESPORTSTRAVEL were found to be similar to NIKE; DRS04601 in which NIKESTORE was found to be similar to NIKE; and DRS01493 in which NOKIA-RING-TONES was found to be similar to NOKIA.
- j) The Adjudicator accordingly, also, finds that the Disputed Domain Name is similar to the Complainant’s PUK and PUKKE trade mark as required in terms of Regulation 3(a).

4.2 Abusive Registration

- a) “Abusive Registration” is defined in the Regulations to mean a domain name which either -
 - (a) 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
 - (b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the complainant’s rights.
- b) Regulation 4(1) provides for a number of grounds (non-exhaustive) which may indicate that the Disputed Domain Name is an abusive registration, namely:
 - “(a) Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to -

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- (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
- (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 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;
- (d) false or incomplete contact details provided by the registrant in the
- (e) circumstance 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) registration paid for." (emphasis added)
- c) For purposes of this dispute, the Complainant relies on Regulations 4(1)(a)(ii) - (iv) and 4(1)(b), namely that the Registrant:
- (i) registered or acquired the Disputed Domain Name primarily to block intentionally the registration of a name or mark in which the Complainant has rights;
- (ii) registered or acquired the Disputed Domain Name primarily to prevent the Complainant from exercising his, her or its rights;

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- (iii) registered or acquired the Disputed Domain name primarily to disrupt unfairly the business of the Complainant; and
- (iv) 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;
- d) In view of the above, it is necessary to determine if the Disputed Domain Name constitutes an abusive registration.
- e) First ground of objection: *“Registered or acquired the Disputed Domain Name primarily to block intentionally the registration of a name or mark in which the Complainant has rights”*
- i. The Complainant, in its letter dated 9 April 2015, which is attached as Annexure “DK23” to the Complaint, stated as follows:
- “dat die aanname van die hierdie naam heelwaarskynlik goedertrou geskied het”.*
- ii. However, the Complaint, now submits that the Registrant, or its predecessor in title, registered the Disputed Domain Name, in bad faith.
- iii. The Complainant does not explain this, apparent, discrepancy.
- iv. Irrespective, the Complainant does not submit evidence in support of its first ground of objection, but rather elect to argue that the fact that the Disputed Domain Registration will prevent the registration of the Disputed Domain Name by the Complainant and the fact that the initial registrant and Registrant *“were undoubtedly aware of these names”*, are confirmation that the intention of the Registrant was, primarily, to, block the Complainant from registering the Disputed Domain Name.
- v. The above submissions do not constitute proof, on a balance of probabilities, that the Disputed Domain Name was registered primarily to *“block intentionally the registration of a name or mark in which the Complainant has rights”*. The aforementioned becomes clear, especially, if the evidence which the Complainant submitted and which illustrates the intentions of and the manner in which the Disputed Domain Name is used

in a non-commercial manner by the Registrant or the “Pro-Puk Groep”, is considered.

- e) Second ground of objection: *“Prevent the Complainant from exercising its rights”*
- i. The Complainant does not submit any evidence in support of its objection, and only submit that the fact that the Disputed Domain Registration will prevent the registration of the Disputed Domain Name by the Complainant and the fact that the initial registrant and Registrant *“were undoubtedly aware of these names”*, confirm that the intention of the Registrant was, primarily, to, prevent the Complainant from exercising its rights in the Disputed Domain Name.
 - ii. The evidence which the Complainant submitted illustrates the intentions of and the manner in which the Disputed Domain Name is used, in a non-commercial manner, by or the Registrant or the “Pro-Puk Groep” and although it will be difficult to dispute the “facts” to which the Complainant makes reference to above, it is quite conceivable that the Disputed Domain Name was registered for the purpose of “protecting” Afrikaans, as the evidence suggests, and not otherwise.
 - iii. In the absence of any evidence to the contrary, the Complainant’s submissions alone do not constitute proof, on a balance of probabilities, that the Disputed Domain Name was registered primarily to *“prevent the complainant from exercising his, her or its rights”*.
- f) Third ground of objection: *“Registered or acquired the Disputed Domain name primarily to disrupt unfairly the business of the Complainant”*
- i. There is no evidence demonstrating how the use of the Disputed Domain Name disrupts or unfairly disrupts the Complainant’s business.
 - ii. To the contrary, the manner in which the Disputed Domain Name is used, suggests that the Registrant is not, primarily, seeking to disrupt the business of the Complainant, but rather to promote certain objectives, clearly, not associated with or linked to “disrupting” the business of the Complainant.

- iii. There is no evidence, which, on a balance of probabilities, proves that the Registrant, or its predecessor, had registered or acquired the Disputed Domain Name primarily to disrupt the business of the Complainant.

- g) Fourth ground: *“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”*
 - i. The evidence submitted by the Complainant, and, specifically, the contents of the www.propuk.co.za website and the manner in which the Complainant, presently, uses the PUK trade mark on its website, and, specifically, the fact that the PUK trade mark, in most instances, is used in combination with the NWU trade mark, does not support the submissions made by the Complainant.

 - ii. To the contrary, it is unlikely that people will be confused or deceived into believing the Disputed Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant, as it will be, immediately, apparent to persons accessing the website www.propuk.co.za that the website is associated, operated, authorised by a group which is connected with the Complainant.

 - iii. The evidence therefore does not, on a balance of probabilities, prove 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”*.

5) Decision

- a. It is accepted in international UDRP decisions that it is legitimate to use a trade mark of another as a part of a domain name for non-commercial criticism *“as long as the use is fair and non-commercial”* - [D2008-0430](#).

- b. The evidence confirms that the Complainant holds extensive trade mark rights in the various PUK trade marks, the Disputed Domain Name is similar to the Complainant’s PUK trade marks and, also, that the Disputed Domain Name is used for non-commercial purposes.

- c. However, the evidence does not, on a balance of probabilities, support the allegations of bad faith i.e. that the Disputed Domain Names 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 has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.
- d. As such, the Complainant is dismissed.

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DEON BOUWER

SAIIPL SENIOR ADJUDICATOR

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