



Decision
[ZA2015-0211]
**.ZA ALTERNATE DISPUTE
RESOLUTION
REGULATIONS (GG29405)**

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0211
DECISION DATE:	15 October 2015
DOMAIN NAME	adrienneherschproperties.co.za
THE DOMAIN NAME REGISTRANT:	Jan Horak
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Adrienne Hersch Properties CC
COMPLAINANT'S LEGAL COUNSEL:	Moore Attorneys
2 nd LEVEL ADMINISTRATOR:	ZACR

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **06 August 2015**. 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. On **12 August 2015** the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name at issue, and on **13 August 2015** ZACR confirmed that the domain name had indeed been suspended.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **13 August 2015**. In accordance with the Regulations the due date for the Registrant’s Response was **10 September 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **14 September 2015**.
- c) The SAIPL appointed **Tana Pistorius** as the Adjudicator in this matter on **22 September 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 Adrienne Hersch Properties CC, a close corporation duly incorporated according to the company laws of the Republic of South Africa and having its principal place of business at principal place of business at 46 Central Avenue, Houghton, Johannesburg.

2.2 On 17 June 2015 the Complainant, through its attorneys, Moore Attorneys, sent the Registrant a letter of demand regarding the disputed domain name.

3 Parties' Contentions

3.1 Complainant

- a) According to the relevant 2nd Level Domain Administrator's Whois information the disputed domain name, adrienneherschproperties.co.za was registered by Jan Horak, a natural person of Jaurisova 515/4, Prague, 14000, Czech Republic on 27 May 2015.
- b) The Complainant notes that it was founded in 1991 as a valuations, property sales and brokerage company.
- c) The Complainant avers that it is a successful company. The Complainant claims that it is a dynamic, fast growing, multi-million rand property company that serves residential and commercial markets in Gauteng in housing, sectional title and cluster developments. The Complainant is a valid member of the Estate Agency Board of South Africa. In 2013, the Complainant was awarded 2 awards by the International Property Awards, which include:
 - Highly Commenced Real Estate Agency South Africa, and
 - Highly Commenced Real Estate Agency Marketing South Africa.
- d) The Complainant has recently applied for the following trade marks:
 - Trade Mark Application No. 2015/12852 ADRIENNE

HERSCH in class 35,

- Trade Mark Application No. 2015/12853 ADRIENNE HERSCH in class 36,
- Trade Mark Application No. 2015/12854 ADRIENNE HERSCH PROPERTIES device mark in class 35, and
- Trade Mark Application No. 2015/12855 ADRIENNE HERSCH PROPERTIES device mark in class 36.

- e) The Complainant notes that it advertises ADRIENNE HERSCH extensively in all forms of media including radio, television and media publications, including but not limited to, media publications such as: www.property24.co.za; and www.sahometraders.co.za. Printouts from various websites containing said advertisements have been included as **Annexure ADH9**.
- f) The Complainant avers that it enjoys common law trade mark rights in its "ADRIENNE HERSCH" trade mark under the Trade Marks Act No.194 of 1993.
- g) The Complainant submits that it enjoys extensive common law rights. More particularly, it is submitted that its ADRIENNE HERSCH trade mark is a widely recognised brand. Due to the ADRIENNE HERSCH mark's extensive exposure in the market place it has become well-known in South Africa.
- h) The website www.web.archive.org is a digital time capsule created by an Internet archive facility. The Complainant notes that the service offered by this website enables one to see the archived version of web pages across time. Several print-outs from the web archive are attached as **Annexure ADH5**. The Complainant notes that this attachment evidences the

Complainant's use of the trade mark ADRIENNE HERSCH in respect of the real estate industry since at least 1991.

- i) The Complainant avers that the Registrant's disputed domain name `adrienneherschproperties.co.za` is identical to the Complainant's ADRIENNE HERSCH trade mark as it is visually and phonetically similar and wholly incorporates the Complainant's ADRIENNE HERSCH trade mark.
- j) The Complainant also submits that the Registrant's disputed domain name `adrienneherschproperties.co.za` is confusingly similar to the Complainant's ADRIENNE HERSCH trade mark.
- k) The Complainant notes that it conducted a search of the Registrant's website to ascertain what services it offers. It ascertained that the disputed domain name is dormant and it attaches **Annexure ADH7** as evidence. It also notes that to date, the domain name still remains inactive and in the Registrant's name and as a result the Complainant has been left with no alternative but to proceed with this dispute.
- l) The Complainant avers that the Registrant's purpose of registering the disputed domain name `adrienneherschproperties.co.za` is to confuse members of the public into believing that the disputed domain name is that of the Complainant.
- m) The Complainant alleges that the disputed domain name in the hands of the Registrant is an abusive registration. In support of this contention, the Complainant has submitted that in terms of Regulation 4, the disputed domain name is a blocking registration.

- n) The Complainant also points out that the disputed domain name 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.
- o) The Complainant submits that it is clear that the Registrant has deliberately registered the disputed domain name to possibly confuse members of the public in the future into believing that the disputed domain name is in fact the Complainant's domain name.
- p) The Complainant also avers that the disputed domain name has been used in a manner that is unfairly detrimental to the Complainant's rights as it is visually and phonetically similar to the Complainant's ADRIENNE HERSCH trade mark.
- q) The Complainant submits that the Registrant has registered or otherwise acquired the domain name primarily to disrupt unfairly the business of the Complainant.
- r) The Complainant alleges that the Registrant has registered or otherwise acquired the domain name primarily to prevent the Complainant from exercising its rights in that the Complainant is prevented from registering the domain name. In further support of this contention, the Complainant also submits that, in terms of Regulation 4, the Registrant has registered the domain name in a way that leads people to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

3.2 Registrant

- a) Regulation 18(1)(a) provides that a Registrant must respond to the statements and allegations contained in the Dispute in the form of a Response. In such a Response, the Registrant must detail any grounds to prove the domain name is not an abusive registration.
- b) The Registrant failed to submit a Response and the Adjudicator must decide the matter on the Dispute (see Regulation 18(3)).
- c) Regulation 28(2) provides that in the absence of exceptional circumstances, an Adjudicator shall draw such inferences, as she considers appropriate, from the failure of a party to comply with a provision or requirement of the Regulations.
- d) The Adjudicator draws the following two inferences:
 - the Registrant does not deny the facts that the Complainant asserts, and
 - the Registrant does not deny the conclusions that the Complainant draws from these facts.
- e) Notwithstanding these inferences, the Adjudicator must analyse Complainant's version in order to satisfy herself that the allegations contained in its Complaint are acceptable and probably true (see *Multichoice Subscriber Management / JP Botha* (ZA2007-0010)). The Adjudicator must determine the admissibility, relevance, materiality and weight of the evidence put forward by the Complainant (Regulation 24(3)).
- f) In terms of Regulation 29(1) the Adjudicator must decide the Dispute in accordance with the principles of law and on the basis of the dispute. The adjudication is done on the

documentation submitted (Regulation 27).

4 Discussion and Findings

- a) Regulation 3 provides that a Complainant is required to prove, on a balance of probabilities, that the following three elements are present in order to succeed in a domain name dispute based on an alleged abusive registration:
- (a) that the Complainant has rights in respect of a name or mark;
 - (b) that the name or mark is identical or similar to the domain name;
- and
- (c) that the domain name, in the hands of the Registrant, is an abusive registration.

4.1 Complainant's Rights

- 4.1.1 The cornerstone of the Complainant's case is proof on a balance of probabilities that it has rights in the name or mark ADRIENNE HERSCH.
- 4.1.2 The Complainant's trade mark applications are still pending. These trade mark applications confer no enforceable rights and will therefore be ignored for purposes of this decision.
- 4.1.3 The Complainant asserts common-law rights in respect of the mark ADRIENNE HERSCH "in terms of the Trade Marks Act 194 of 1993" (see 3.1(f) *supra*). This is incorrect and the statement is ignored for purposes of this decision.
- 4.1.4 In order to establish common law rights in a mark it must be shown that the consequence of the use and reputation has brought about a situation where the name or mark has acquired a "secondary meaning" which in fact denotes one

trader, and no other.

- 4.1.5 In *Nyama Catering Limited / Francois Wessels* (ZA 2011-0092) the Adjudicator noted that although the *Allstates Global Karate Do, Inc / Sais Karate* (APZA2009-0030) decision held that the threshold in establishing the existence of a right in a domain name dispute is “fairly low”, there is nevertheless a threshold. The height of the bar will be influenced by the nature and meaning (if any) of the word or mark relied on.
- 4.1.6 Unsubstantiated allegations will not suffice. Allegations of “secondary meaning” must be bolstered by relevant evidence. Relevant evidence may include evidence related to the length and amount of sales under the mark; the nature and extent of the advertising; consumer surveys and media recognition (see *Uitgeverij Crux v W Frederic Isler Skattedirektoratet / Eivind Nag* D2000-0575; *Amsec Enterprises, LC / Sharon McCall* D2000-1314; *Australian Trade Commission / Matthew Reader* D2001-0083; and *Imperial College / Christophe Dessimoz* D2004-0322;)).
- 4.1.7 The Complainant has submitted **Annexures ADH1-ADH9** as evidence to support its case. The following Annexures are deemed to be relevant to the establishment of common law rights in the mark ADRIENNE HERSCH: **Annexure ADH2; Annexure ADH4; Annexure ADH5** and **Annexure ADH9**. Each of the Complainant’s claims as to the establishment of common law rights in the mark ADRIENNE HERSCH will be discussed below together with the relevant Annexure that has been submitted as evidence.
- 4.1.8 The Complainant notes that a full description of the varied

services offered by the Complainant is available on its website www.ahprop.co.za. By way of example a printout of some web pages from this web site is attached as **Annexure ADH2** to the Complaint.

This Annexure depicts web pages printed from the web site www.ahprop.co.za (printed on 21 July 2015). The web pages display the ADRIENNE HERSCH logo as well as the name “ADRIENNE HERSH PROPERTIES”. The web pages depict properties for sale and homes to let (under “latest news” 21 July 2015). The pages also depict properties on show during the month of July 2015.

The company profile, information on media marketing and the fact that it has been advertised on social media since 2010 can also be read on the web pages. This annexure contains printed web pages (dated 31 July 2014) wherein it is mentioned that the agency has been in the property business for the last 23 years. The annexure also contains a web page with information about the founder and CEO Ms. Adrienne Hersch (dated 21 July 2015). It is noted that in 1991 she started her business from home and that she currently heads a successful company with 60 estate agents. The subsequent pages contain information about the leadership of Adrienne Hersch Properties CC and print-outs of web pages depicting *inter alia* the sales agents, the brand manager, and rental agents.

The annexure contains sufficient information on the nature of the services offered by the Compliant.

- 4.1.9 The Complainant notes that it promotes its ADRIENNE HERSCH trade mark in various print media platforms such as,

for example, pamphlets, advertisements in magazines and publications and newspapers. Copies of a few examples of advertisements are attached as **Annexure ADH4**.

This annexure depicts a brochure advertising properties for sale and to let. The first two pamphlets are undated whereas the third pamphlet is dated 01 February 2014. It also depicts an advertisement for ADRIENEE HERSCH PROPERTIES on page 54 of *Property* dated 27 September 2014. Lastly the Annexure contains reproductions of pamphlets, folders, business cards and writing paper marked ADRIENEE HERSCH PROPERTIES. The nature of the advertising is clear but the extent of the advertising (such as the marketing budget and proof of marketing for a number of years) is neither addressed by the Complainant nor is it alluded to in the evidence apart from the fact that the one pamphlet is dated 01 February 2014.

- 4.1.10 The Complainant attached **Annexure ADH5** consisting of print-outs from the website www.web.archive.org which the Complainant claims evidences the Complainant's use of the trade mark ADRIENNE HERSCH in respect of, *inter alia*, the real estate industry since at least 1991.

This Annexure depicts print outs from the Wayback machine (the Internet Archive). It depicts 41 changes to the web site www.ahprop.co.za from 17 December 2004 to 7 April 2015. This Annexure only contains a few and only the latest examples of the archived web pages of www.ahprop.co.za.

An Adjudicator may undertake limited factual research into matters of public record if it deems this necessary to reach the right decision. This may include consulting a repository

such as the Internet Archive (at www.archive.org) in order to obtain an indication of how a domain name may have been used in the relevant past (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Second Edition ("WIPO Overview 2.0") and cases cited such as *InfoSpace.com, Inc. v. Hari Prakash* (Case No. D2000-0076) and *Sensis Pty Ltd., Telstra Corporation Limited v. Yellow Page Marketing B.V.*, (Case No. D2011-0057). This is especially important in the case of default proceedings.

The first web page of www.ahprop.co.za that has been captured on www.archive.org is dated 17 December 2004 and it displays the web site of "Audrey Hickman Properties – Hermanus". A few additional captures reveal that the web site was operated under that name until at least 09 December 2007. The Internet Archive does not reveal any information on the web site between 09 December 2007 and 12 September 2012. The web site www.ahprop.co.za reflects the name of the Complainant for the first time on 12 September 2012 and subsequent thereto an additional five times up to 07 April 2015.

It is unknown what the Complainant's relationship, if any, is with "Audrey Hickman Properties – Hermanus". According to the "whois" lookup facility the domain name ahprop.co.za was first registered on 12 September 2012 (incidentally this is also the date of the first capture of the web site under the name ADRIENNE HERSCH).

The statement by the Complainant that it has used the mark ADRIENNE HERSCH since at least 1991 in relation to the web site is not supported by **Annexure ADH5**.

4.1.11 The Complainant notes that it advertises its ADRIENNE HERSCH mark on various media platforms including media publications such as

www.property24.co.za; www.privateproperty.co.za;
www.betterlife.co.za; www.brabys.com;
www.iolproperty.co.za; and www.sahometraders.co.za.

The Claimant attached print-outs from the various web sites mentioned above under **Annexure ADH9**. The services of ADRIENNE HERSCH are advertised on these web pages. However, these advertisements were all printed on 27 of July 2015. It is thus not possible to deduct the duration and the extent of advertising of the Complainant's mark on these media platforms.

4.1.12 In this case, the Complainant has, in fact, failed to adduce sufficient evidence, apart from its own unsubstantiated statements, of its alleged reputation and goodwill. The Complainant claims to have spent a "substantial amount" on advertising, publicity and media coverage. However, nothing was included in the evidence bundle to indicate what this "substantial amount" adds up to; there is no indication of the expenditure on advertising and promotion in monetary terms.

The Complainant claims to have used the mark ADRIENNE HERSCH since its incorporation in 1991. Although the Complainant's evidence depicts use of the mark in the advertising, publicity and media coverage, including on its own web site, the earliest date of use of the mark is 12 September 2012. Evidence of the Complainant's use of the mark for the twenty years preceding 2012 is lacking.

The Complainant claims that it is a multi-million rand property

company that serves residential and commercial markets in Gauteng. The Adjudicator has only the say-so of the Complainant regarding its turnover with no figures or proven facts to support this.

The Complainant has certainly not gone one step further to show that the mark ADRIENNE HERSCH has in fact become distinctive of it through use, and denotes it and no other. It therefore fails to get over the first hurdle of proving that it has any relevant rights. The Adjudicator has similar problems with the Complainant's claim that the mark ADRIENNE HERSCH has become well-known in South Africa.

4.1.13 Weighing up all relevant considerations, the Adjudicator therefore holds that the Complainant has failed to discharge its onus of showing, on a balance of probabilities, that it has rights in respect of the name or mark ADRIENNE HERSCH enforceable against any third party, and in particular against the Registrant as is required by Regulation 3(1)(a).

5. Abusive registration

5.1 There is no need to decide on this aspect as the Adjudicator finds that the Complainant has failed to discharge its onus of showing, on a balance of probabilities, that it has rights in respect of the name or mark ADRIENNE HERSCH enforceable against any third party.

6. Decision

6.1 For all the foregoing reasons, in accordance with Regulation 9, the Dispute is refused.

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TANA PISTORIUS
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