

Decision

[ZA2016-0242]

**.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)**

ADJUDICATOR DECISION

CASE NUMBER:	ZA2016-0242
DECISION DATE:	26 September 2016
DOMAIN NAME	nedbankgreenback.co.za, nedbankloan.co.za, nedbankloans.co.za, nedbankhomeloan.co.za, nedbankpersonalloans.co.za, nedbankcareer.co.za, nedbankcreditcard.co.za and nedbankvacancies.co.za
THE DOMAIN NAME REGISTRANT:	James Sai
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Nedbank Limited
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
2 nd LEVEL ADMINISTRATOR:	ZACR

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIIPL”) on **19 July 2016**. On **20 July 2016** 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 **21 July 2016** ZACR confirmed that the domain name had indeed been suspended. 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.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **21 July 2016**. In accordance with the Regulations the due date for the Registrant’s Response was **19 August 2016**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **22 August 2016**.
- c) The SAIPL appointed **Tana Pistorius** as the Adjudicator in this matter on **29 August 2016**. 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 in this administrative proceeding is NEDBANK LIMITED, a South African Bank, having its principal place of business at 135 Rivonia Road, Sandown, Sandton, Gauteng, 2196, South Africa.
- 2.2 The Registrant is James Sai, a resident of Malaysia.
- 2.3 The Complainant provides a broad range of wholesale and retail banking services, and has a growing insurance, asset management and wealth management offerings.

3 Parties’ Contentions

3.1 Complainant

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- a) The Complainant is NEDBANK, one of the five largest South African Banks and offers a wide range of wholesale and retail banking services. The Complainant's ordinary shares have been listed on the JSE Limited since 1969 and on the Namibian Stock Exchange since 2007. It is a JSE Top 40 company with a market capitalisation of R119.5 billion as at 30 June 2015.
- b) The Complainant owns trade mark registrations for the NEDBANK word mark on its own and in association with other words, logos and devices in many countries across the world. A list with the details of all the Complainant's NEDBANK trade mark registrations and trade mark applications is attached as Annexure B.
- c) The Complainant also owns trade mark registrations for the word GREENBACKS in South Africa and Namibia. A list with the details of all the GREENBACKS trade mark registrations and trade mark applications is annexed as Annexure C. The NEDBANK GREENBACKS rewards programme rewards the Complainant's customers for their spend on their linked NEDBANK GREENBACKS Credit - or Cheque Cards, with points which can be redeemed for a variety of rewards.
- d) The Complainant also owns a number of domain names that incorporate its NEDBANK and GREENBACKS trade marks, including:
- nedbankgreenbacks.co.za,
 - nedbank.co.za,
 - oldmutualbankgreenbacks.co.za,
 - nedbankmvfinanciallife.co.za,
 - nedbankbankingapp.co.za,
 - nedbankwealth.co.za,
 - nedbankinsurance.co.za,
 - nedbankhomeloans.co.za and
 - nedbankonline.co.za.
- e) The Complainant notes that an example of an eNewsletter reflects the Complainant's use of the NEDBANK and the GREENBACKS trade marks, together with extracts from the Complainant's website associated with its

nedbankgreenbacks.co.za domain name. The Complainant also attaches extracts from social media pages dedicated to itself. The Complainant avers that the NEDBANK and GREENBACKS trade marks enjoy a substantial reputation in the territories where the Complainant trades, as well as in surrounding territories.

- f) The Complainant notes that the Disputed Domain Names wholly incorporate either the Complainant's NEDBANK and GREENBACKS trade marks together, or just the NEDBANK trade mark. The Complainant notes that either way, the Disputed Domain Names are all confusingly similar to trade marks in which the Complainant has rights.
- g) The Complainant's trade mark and domain name registrations existed prior to the registration of the Disputed Domain Names in the Registrant's name. The Complainant has not authorised the Registrant's use of the said trade marks as part of the Disputed Domain Names or otherwise and the Registrant has not transferred the Disputed Domain Names to the Complainant despite a letter of demand.
- h) The Complainant avers that the Registrant is not known by the name NEDBANK or GREENBACKS, nor has he acquired any trade mark rights in these marks.
- i) The Complainant avers that the Disputed Domain Names are all linked to active websites which offer sponsored links to the websites of third parties where goods and services competing with that of the Complainant are provided. As such the Registrant is not making any legitimate, non-commercial, or fair use of the Disputed Domain Names. His use infringes the Complainant's rights both in terms of Section 34 of the Trade Marks Act and South African common law.
- j) The Complainant notes that the use of the Disputed Domain Names by the Registrant is thus unlawful. As such, the Registrant's use of the Disputed Domain Names is primarily for the purpose of:
- Disrupting the business of the Complainant;

- Blocking the registration of similar domain names in the Complainant's name;
 - Preventing the Complainant from exercising its rights; and
 - Leading people or businesses to believe that the Disputed Domain Names are registered operated or authorised by or otherwise connected with the Complainant.
- k) The Complainant concludes that taking into account all the factors above, the Disputed Domain Names in the hands of the Registrant are abusive registrations, exacerbated by the fact that the Registrant registered a total of 8 of them, all over a very short period of between December 2013 to August 2014.

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.
- c) In such a case the Adjudicator must decide the matter on the Dispute (see Regulation 18(3)). 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:
- (i) the Registrant does not deny the facts that the Complainant asserts,
and
 - (ii) the Registrant does not deny the conclusions that the Complainant draws from these facts.
- e) Notwithstanding these inferences, the Adjudicator has analysed Complainant's version in order to satisfy herself that the allegations

contained in its Complaint are acceptable and probably true (see ZA2007-0010 (*Multichoice Subscriber Management v JP Botha*)).

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:
- (i) that the Complainant has rights in respect of a name or mark;
 - (ii) that the name or mark is identical or similar to the domain name; and
 - (iii) 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 Complainants' case is proof on a balance of probabilities that it has rights in the trade marks NEDBANK and GREENBACKS and that these trade marks are identical or similar to the Disputed Domain Names. The Complainant notes that its trade marks are registered. The Complainant attaches extracts of its legal representative's database of trade mark registrations (Trade Mark Listing). The Adjudicator does not regard this as adequate evidence of the Complainant's trade-mark rights.

4.1.2 As a rule, only copies of official certificates of registration issued by registration authorities are apt to demonstrate trade mark rights (see *Red Bull GmbH v Ian Andrew D2001-0709*). This oversight was almost fatal to the Samsung case (see ZA2008-0022 *Samsung Electronics Co Ltd v Sean Elseworth*) where the Complainant averred to hold numerous registered trade marks but only provided the registration certificate of **one** trade mark as evidence of the rights. The Adjudicator in that case held as follows (on page 6):

“No documentary proof in support of the validity of the numerous trade mark registrations listed by the Complainant in annexures B & C of its evidence has been provided, apart from the registration

certificate for trade mark registration 2000/19449 SAMSUNG in class 9. This lacuna in the Complainant's evidence is, however, not fatal to its claim to statutory rights, as those rights are adequately protected for the purposes of these proceedings by the above registration".

4.1.3 This principle is also upheld internationally. It is generally recognized that where a Complainant bases its claim on a registered trade mark, such a right is proved by an official certificate of registration (see NAF Claim Number: FA133759 (housselaw.com); WIPO/D2002-1039 (microsoft.com); and WIPO/D2002-0087 (pwc.com)). In *Upstream v The Simple Solution LLC* (NAF Claim Number: FA0004000094451) the Dispute was refused because the Complainant did not provide any evidence that it had any protectable rights in the trademark. In *Virgin Enterprise Limited v Wang Hong Wei* (NAF Claim Number: FA1607001683953) the facts were similar to the case at hand as the Complainant provided a list of more than 100 trademarks allegedly registered in the name of the Complainant but no official documentation to prove that the marks were registered. The Panel held that the Complainant did not prove trademark rights as the Complainant failed to provide a single copy of a trademark certificate or a printout of an official trademark database.¹

4.1.4 The Complainant asserts common-law rights in respect of the marks NEDBANK and GREENBACKS. In order to establish common law rights in a mark the Complainant must be able to illustrate, on a balance of

¹ See in this regard *TotalFinaElf E&P USA Inc v Farnes* (NAF Claim Number: FA 117028) wherein it was held that in order to bring a claim under the Policy, Complainant must first establish a *prima facie* case.

Complainant's initial burden is to provide proof of "valid, subsisting rights in a mark that is similar or identical to the domain name in question"; See *NBA Prop Inc v Adirondack Software Corp* (D2000-1211) where a Complaint was denied because the Complainant was not the owner of the trademarks); See also *CMG Worldwide Inc v Pitanguy Plastic Surgical Clinic* (NAF Claim Number: FA 155888) where it was held that as Complainant provided no evidence to the Panel that it has any arrangement to represent the actual trademark holder, or that any rights in the relevant trademark had been assigned or licensed to Complainant, Complainant did not have standing to bring a claim under the UDRP.

probabilities, that it has goodwill and reputation that can be protected by way of an action for passing off (see ZA2007-009 *Holistic Remedies (Pty) Ltd and Amka Pharmaceuticals (Pty) Ltd v Oxyzen for Life (Pty) Ltd*).

4.1.5 In *Nyama Catering Limited / Francois Wessels* (ZA 2011-0092) the Adjudicator noted that although the *Allstates Global Karate Do, Inc / Saids 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.

4.1.6 The Adjudication is done on the documentation submitted (Regulation 27). Unsubstantiated allegations will not suffice. Allegations of reputation must be bolstered by relevant evidence (see *Uitgeverij Crux v W Frederic Isler Skattedirektoratet / Eivind Nag* D2000-0575; *Amsec Enterprises LCv Sharon McCall* D2000-1314; and *Australian Trade Commission v Matthew Reader* D2001-0083). In *ImageShack Corp v RegisterFly.com* (NAF Claim Number: FA0505000473833) the Panel reviewed the evidence submitted by the Complainant in its apparent effort to establish common law rights in “Imageshack.” The Panel noted:

Suffice it to say, the Panel is not convinced that such evidence, including the results of the Google® search, establish sufficient use to create common law rights or, more fundamentally, that the relevant public would perceive the term “ImageShack” to function as a mark. ... Hits alone do not establish trademark use. All a hit represents is the inclusion of the search term on a web page – and that term can be present for a wide variety of uses and for uses having nothing whatsoever to do with trademark usage. The fact that Complainant includes the ® symbol in connection with the term “ImageShack” is not controlling on whether such term functions as a mark. Complainant cannot bootstrap its contention regarding rights in the “ImageShack” term through improper reliance on the ® symbol.

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The Complainant is quite correct that common law rights, if shown, may satisfy the first criterion, but the vague facts recited by Mr. Botten are

woefully inadequate. In addition to being claimed recent figures, Mr. Botten gives no indication of the geographic extent of Complainant's claimed services in any jurisdiction, numbers of customer, or such common indicia as are normally required to satisfy the bar of establishing common law rights.

4.1.7 It should also be noted that the mere registration of a domain name does not automatically create common law, trade mark or service mark rights (see *Ebénisterie Beaubois ltée (Alex Vignola) v Reserved for Customers / MustNeed.com* (NAF Claim Number: FA1511001645810). A domain name registration may establish rights but the evidence must show that the public associates the mark with Complainant's goods or services.

4.1.8 The Complainant failed to adduce any evidence, apart from the eNewsletter, social media pages and its own unsubstantiated statements, of its alleged trade mark registrations and common law rights. The Adjudicator is aware of the services that the Complainant offers but "the strict rules defining judicial cognisance" prevent her from reaching the conclusion that the Complainant has established rights in NEDBANK or GREENBACKS that are enforceable in common law in the absence of evidence to that effect (see page 7 of ZA2008-0022 *Samsung Electronics Co Ltd v Sean Elseworth*). 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 names or trade marks NEDBANK and GREENBACKS that are enforceable against any third party, and in particular against the Registrant as is required by Regulation 3(1)(a).

4.2 Abusive Registration

4.2.1 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 trade marks or names NEDBANK or GREENBACKS enforceable against any third party.

5. Decision

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

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Tana Pistorius
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za