

Decision

[ZA2016-0249]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2016-0249
DECISION DATE:	30 November 2016
DOMAIN NAME	t1meslive.co.za
THE DOMAIN NAME REGISTRANT:	Registration Private
REGISTRANT'S LEGAL COUNSEL:	Unrepresented
THE COMPLAINANT:	Times Media (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	Tyrone Walker, Moore Attorneys
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIIPL”) on **12 October 2016**. On **12 October 2016**, 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 **18 October 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 **19 October 2016**. In accordance with the Regulations the due date for the Registrant’s Response was **16 November 2016**. [The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **17 November 2016**.
- c) The SAIPL appointed **Mike du Toit** as the Adjudicator in this matter on **22 November 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 matter is Times Media (Pty) Ltd (previously known as Avusa Media Limited) a company listed on the Johannesburg Stock Exchange, and is a media company that informs, educates, entertains and connects people.
- 2.2 In 2007, the Complainant established its newspaper "THE TIMES, a sister paper to its Sunday Times newspaper. "THE TIMES" newspaper has limited street sales and is distributed free of charge to the Sunday Times subscribers. The newspaper is published and distributed from Monday to Friday, and has a readership of 137 054 (one hundred and thirty-seven thousand and fifty four) throughout the Republic of South Africa. The Complainant's newspaper is an advocate of political truth and national development, as well as a proud promoter of personal liberation and a

champion of lifestyle development.

2.3 The Complainant's "THE TIMES" newspaper is the first totally interactive newspaper which is published in conjunction with the websites www.thetimes.co.za and www.timeslive.co.za.

2.4 The Complainant is the registered trade mark proprietor of the trademarks:

-Trade Mark No. 2008/25404 TIMESLIVE in class 09,

-Trade Mark No. 2008/25405 TIMESLIVE in class 38,

-Trade Mark No. 2009/04656 TIMES LIVE in class 09, and

-Trade Mark No. 2009/04657 TIMES LIVE in class 38.

The Complainant has used the trade mark "TIMES LIVE" in respect of, inter alia, newspaper publications since at least 2009.

The Complainant is also the registrant of the following domain names:

-timeslive.co.za since 11 July 2008, and

-thetimeslive.co.za since 5 February 2009

2.5 The Complainant has spent a considerable amount of time, effort and money in advertising and promoting its products and services under the "TIMES LIVE" trademarks. The Complainant advertises the "TIMES LIVE" trademarks extensively in all forms of media including radio, television and on social media platforms.

2.6 The Complainant enjoys extensive common law rights. It is submitted that its "TIMES LIVE" trademarks are a widely recognised brand. Due to the extensive exposure of the "TIMES LIVE" trademarks in the market place the brand has become well-known in south Africa within the media industry and to members of the public.

2.7 In August 2016, the Complainant discovered that the Registrant had registered the domain name tmeslive.co.za and immediately thereafter, the Complainant discovered that the website is active and is currently being used as an online news website/blog, however, the articles published on this website are untrue and fictitious. In addition to the above, the Registrant has used a proxy registration to hide its identity, which raises suspicion and the Complainant is concerned that the

Registrant might be seeking to damage the Complainant's "TIMES LIVE" brand.

2.8 The Complainant through its attorneys, Moore Attorneys, addressed a letter of demand to the Registrant on 12 August 2016 pointing out the Complainant's rights and the Registrant's abusive registration, and demanding transfer of the domain name to the Complainant. The letter of demand was sent to the Registrant's email address, as provided in the WHOIS records. To date, no response has been received from the Registrant and the domain name remains active and in the Registrant's name, thus the Complainant has been left with no alternative but to proceed with this dispute.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant is the proprietor of the Times Live trademarks, registered in terms of the Trade Mark Act No. 194 of 1993.
- b) The Complainant also enjoys extensive common law rights. More particularly, it is submitted that its "TIMES LIVE" trademarks are a widely recognised brand. Due to the extensive exposure of the "TIMES LIVE" trademarks in the market place the brand has become well-known in South Africa within the media industry and to members of the public.
- c) The Registrant's disputed domain name t1meslive.co.za is identical to the Complainant's "TIMES LIVE" registered trademarks as it is visually and phonetically similar and wholly incorporates the Complainant's trademarks. The addition of the numerical "1" does not distinguish nor differentiate the Registrant's domain name t1meslive.co.za from the Complainant's trademarks and domain names. The Complainant is concerned about its clientele and/or internet users in general viewing the Registrant's website, when in fact such users had intended to view the Complainant's website.
- d) The purpose of registering the domain name t1meslive.co.za is to confuse members of the public into believing that the disputed domain name is that of the Complainant.

- e) 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 Registrant has registered the domain name primarily to:
- Block intentionally the registration of a name or mark i.e. www.tlmeslive.co.za in which the Complainant has rights.
 - Unfairly disrupt the business of the Complainant.
 - Prevent the Complainant from exercising its rights in and to the domain name tlmeslive.co.za .
 - Lead people or business to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.
 - Attract internet users to the www.tlmeslive.co.za website and does so for commercial gain, by creating confusion with the Complainant's trademarks as to the source, sponsorship, affiliation or endorsement of the website.
 - Be used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

3.2 Registrant

- a) The Respondent did not reply to the Complainant's contentions.

4 Discussion and Findings

4.1 Complainant's Rights

- 4.1.1 Complainant has rights in respect of a name or mark which is identical or like the domain name in dispute. The Complainant has proven rights in its registered Times Live trademarks referred to above. These trademarks have been incorporated in its domain name timeslive.co.za. It has also proven common law rights in its Times Live trademarks through its extensive use of the trademarks.
- 4.1.2 The disputed domain name is for all intents and purposes identical to the trademarks of the Complainant, whether registered or at common law. The addition of the numeral "1" in the domain name is clearly intended to take

the place of the letter "i". It may therefore be regarded as a case of typo squatting although it may not be a classic example of this type of abusive domain names. Whereas typosquatters register misspelt domain names to drive traffic to their websites for various reasons, in this case, the misspelt domain name clearly intends to gain legitimacy in the eyes of the unsuspecting reader of its news site, based on the reputation of the Complainant. South African decided cases of cyber-squatting include ZA2007-2006 Standard Bank of South Africa Limited v Daniel Cox (standerdbank.co.za et al); ZA2012-0107 Primedia (Pty) Ltd v DMF Industries (sterkinikor.co.za); and ZA2013-0140 Enterprise Holdings Inc v Chen Boxin Enterprize.co.za; ZA 2014-0161 Comair v Olis Baptiste(kalula.co.za)

4.2 Abusive Registration

- 4.2.1 The disputed domain name has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights. Apart from the grounds as set out in the Complainant's contentions, the evidence suggests that the Registrant had every intention to abuse the rights of the Complainant by posting untrue and fictitious news articles on its website, fully utilising the reputation and goodwill of the Complainant, to the detriment of the Complainant. The public would, on all probabilities be confused into believing that the website of the Registrant is that of the Complainant, due to the confusing similarity of the disputed domain name to the Complainant's domain names and trademarks. The spelling of the disputed domain name amounts to typosquatting by the Registrant which in turn is evidence of an abusive domain name.
- 4.2.2 The Registrant has used a proxy registration to hide its identity, which confirms the conclusion that the disputed domain name is an abusive registration.
- 4.2.3 The Adjudicator likewise finds, on a balance of probabilities, that the disputed domain name has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights and that the disputed domain name is an abusive registration.

5. Decision

- 5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name t1meslive.co.za be transferred to the Complainant.

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Mike du Toit
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za