

Decision

ZA2016-0251

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2016-0251
DECISION DATE:	9 JANUARY 2017
DOMAIN NAME	ABSAPERSONALLOANS.CO.ZA
THE DOMAIN NAME REGISTRANT:	JAMES SAI
REGISTRANT'S LEGAL COUNSEL:	NONE
THE COMPLAINANT:	ABSA BANK LIMITED
COMPLAINANT'S LEGAL COUNSEL:	ADAMS & ADAMS
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 **28 October 2016**. On **1 November 2016** the SAIIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **2 November 2016** ZACR confirmed that the domain name had indeed been suspended.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **3 November 2016**. In accordance with the Regulations the due date for the Registrant’s Response was **1 December 2016**. The Registrant did not submit any response, and accordingly, the SAIIPL notified the Registrant of its default on **2 December 2016**.
- c) The SAIIPL appointed **Deon Boucher** as the Adjudicator in this matter on **12 December 2016**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Complainant is listed on the JSE and the proprietor of the trade mark ABSA. The Complainant’s use of the ABSA trade mark commenced in 1997.
- 2.2 The Complainant is one of South Africa’s largest Investment and financial services providers, and offers a complete range of the retail business corporate and investment banking, insurance and wealth management products and services under the ABSA trade mark. In 2015, the Complainant’s ABSA brand was rated as one of the top 10 banking brands in Africa.
- 2.3 The Complainant is the proprietor in South Africa of various trademark registrations incorporating the ABSA trade mark, including the following:

- a. 1991/07473 ABSA in class 36 in respect of, amongst others, “*insurance financial banking and investment services*”;
- b. 1991/10305 ABSA in class 36 in respect of “*insurance and financial services*”;
- c. 1998/016393 ABSA PERSONAL LOAN/ABSA PERSOONLIKE LENING in class 36 in respect of “*insurance financial affairs, monetary affairs, retail estate affairs*”, and
- d. 2012/02799 ABSA PERSONAL LOANS CASH-BACK in class 36 in respect of “*insurance, financial affairs, monetary affairs, retail estate affairs*”.

2.4 The Complainant has used and advertised the ABSA trade mark, extensively, since 1997 and has, since 2010, annually, spent many hundreds of millions of Rand in advertising the ABSA trade mark in South Africa.

2.5 The Complainant’s holding company, Barclays Africa Group Limited, is the registrant of the absa.co.za domain name, which domain name was registered on 1 January 1995 and the Complainant has sued, extensively, to promote its business.

2.6 The Complainant, finally, submits that the Registrant has, in the past, registered several domain names which incorporated the registered trade marks of third parties.

3 Parties’ Contentions

3.1 Complainant

- a) The Complainant submits that its ABSA trade mark is well-known for the purposes of Section 34 (1) (c) of the Trade Marks Act of 194 of 1993 and, also, that it has a protectable reputation and, therefore, common-law rights, in the ABSA trade mark.
- b) The Complainant also submits that its statutory and common-law rights in the trade mark ABSA predate the registration of the disputed

domain name i.e. 5 January 2014.

- c) The Complainant further submits that the Disputed Domain Name is confusingly similar to its ABSA trade mark as the Disputed Domain Name, wholly, incorporates the Complainant's ABSA and ABSA PERSONAL LOAN trade marks as well as the greater part of the Complainant's ABSA PERSONAL LOANS CASH-BACK trade mark.
- d) The Complainant, accordingly, submits that the Disputed Domain Name is visually, phonetically and conceptually, virtually identical to the Complainant's trade mark ABSA and ABSA PERSONAL LOAN and phonetically and visually similar to the Complainant's registered trade mark ABSA PERSONAL LOANS CASH-BACK.
- e) The Complainant further submits that the Disputed Domain Name is deceptively and confusingly similar to the Complainant's ABSA trade mark and was registered some 20 years after the Complainant had first obtain registration of its ABSA trade mark in South Africa and more than 7 years after, the Complainant first obtain registration of its ABSA PERSONAL LOAN trade mark.
- f) The Complainant, accordingly, submits that the Disputed Domain Name constitutes an abusive registration in the hands of the Registrant.

3.2 Registrant

- a) The Registrant is in default, and has filed no papers.

4 Discussion and Findings

- a) 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.

4.1 Complainant's Rights

4.1.1 Complainant's Rights

- a) Regulation 1 defines "rights" to include intellectual property rights.
- b) The Complainant has submitted evidence confirming, not only that it is the proprietor of various trade mark registrations incorporating the distinctive ABSA trade mark but, also, that it has used the ABSA trade mark, extensively, and established rights in this trade mark under the common law.
- c) The Adjudicator accordingly finds that the Complainant has discharged the onus of showing that it has established suitable rights in respect of the ABSA trade mark.
- d) The Disputed Domain Name, clearly, incorporates the Complainant's mark ABSA trade mark in its entirety, and the ABSA trade mark is the dominant feature of the Disputed Domain Name.
- e) The incorporation of the generic phrase PERSONAL LOANS does not assist the Registrant in escaping the aforesaid finding.
- f) In another 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".
- g) In 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".

- h) Reference is also made to 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.
- i) The Adjudicator accordingly finds that the Disputed Domain Name is similar to the Complainant's ABSA trade mark as required in terms of Regulation 3(a).

4.2 Abusive Registration

- 4.2.1 a) "Abusive Registration" is defined in the Regulations to mean 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 complainant's rights; or
 - ii) 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.
- 4.2.2 In the absence of an explanation by the Registrant as to why he holds a bona fide interest in the Disputed Domain Name which incorporates, substantially, the well-known ABSA trade mark, to which the Complainant holds rights to, there can be no doubt that, as the Complainant submits, the Registrant registered the Disputed Domain Name either to: -
- i. intentionally block the registration of a name in relation to which the Complainant holds rights to; or
 - ii. take unfair advantage of the Complainant's rights; or
 - iii. confuse members of the public into believing that the

- disputed; or
- iv. unfairly, disrupt the business of the Complainant.

5. Decision

- 5.1 For all the foregoing reasons, the Adjudicator finds that the Disputed Domain Name is an abusive registration and, in accordance with Regulation 9, orders that the domain name absapersonalloans.co.za be transferred to the Complainant.

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DEON BOUWER
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za