

Decision

[ZA2016-0253]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2016-0253
DECISION DATE:	6 February 2017
DOMAIN NAME:	yellowp.co.za
THE DOMAIN NAME REGISTRANT:	Lucio Heleno Guilhermino Campos
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Telkom SA SOC Limited
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry (co.za)

1. PROCEDURAL HISTORY

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIIPL”) on **18 November 2016**. On **21 November 2016** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request to the registry to suspend the domain names in issue, and on the same day ZACR confirmed that the domain name had 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.
- 1.2 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **23 November 2016**. The due date for the Registrant’s Response was **22 December 2016**. The Registrant did not submit any formal response, and accordingly, the SAIPL notified the Registrant of its default on **28 December 2016**.
- 1.3 On that date, an email from ‘Lucio Campos’ was received by the SAIPL. It reads:-

“Good afternoon.

Initially we want to thank for the contact.

We want to apologize but due to some setbacks at the end of the year we ended up not being able to read some emails, which was the case with the first one they sent us.

As for the attachments we can not open, but I would like to clarify that we are a small company and we are expanding, the domain www.yellowp.co.za is a fundamental part of our business.

We do not quite understand what this whole dispute is about.
Can you help us?

Hugs,

Lucio Campos”

1.4 The Administrator responded:-

“Dear Lucio

I have attached the documents herein again for you to read and understand what the complainant is disputing about the domain name.

If you still can't open the documents, kindly give me an alternative email address where I can send to or an alternative way for you to be able to receive the documents.

Kindly note that if you wish to respond to the Complaint I will have to ask the appointed adjudicator since you responded to us after the response deadline date has lapsed.

Please do not hesitate to contact me should you require further assistance.”

1.5 Nothing further was heard from Mr Campos.

1.6 The SAIPL appointed **Adv Owen Salmon SC** as the Adjudicator in this matter on **16 January 2017**. 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 The Facts

2.1 The Complainant is Telkom SA SOC Limited, a South African state-owned company incorporated on 30 September 1991.

- 2.2 The Registrant in these proceedings is Lucio Heleno Gulhermino Campos, of Rue Henrique Dias 409, Bairro Benfica, Juiz de Fora, Minas Gerais, Brazil.
- 2.3 The Complainant owns several trade mark registrations for the mark YELLOW PAGES in South Africa dating back to 1972. Through its subsidiary and licensee, Trudon (Pty) Limited (and its predecessors-in-title) it has made use of the YELLOW PAGES mark in South Africa since 1992.
- 2.4 The Complainant uses the mark in the domain name <yellowpages.co.za> and prints telephone directories under the mark YELLOW PAGES which it distributes in 19 geographical areas throughout South Africa. Approximately 24 million copies of the publication have been distributed during the years 2010 to 2015.
- 2.5 During 2011, a YELLOW PAGES mobile application was launched. It includes mapping features, and geocoding. The application has been downloaded over 448 000 times.

3 Complainant's contentions

- 3.1 The disputed domain name, <yellowp.co.za> incorporates the dominant part of the Complainant's YELLOW PAGES trade mark. Accordingly, YELLOW PAGES and YELLOW P are conceptually identical or, alternatively, confusingly similar.
- 3.2 The mark YELLOW P is likely to appear to the public as an abbreviated or short-form for YELLOW PAGES and does not distinguish the disputed domain name from the Complainant's trade mark YELLOW PAGES. As a result, the disputed domain name is likely to deceive or confuse members of the public into believing that it is somehow associated with the Complainant.

- 3.3 The website linked to the disputed domain name refers directly to the mark YELLOW PAGES. The website states (immediately below the mark YELLOW P), “The yellow pages service that you love”.
- 3.4 In light of this, the Complainant submits that the mark YELLOW P was purposely derived, from the Complainant’s mark YELLOW PAGES, and is, accordingly, aimed directly at bringing the Complainant’s mark to mind or, at the least, creating an association with the Complainant’s YELLOW PAGES mark.
- 3.5 The disputed domain name resolves to a website promoting the exact services offered by the Complainant, through its subsidiary, Trudon (Pty) Limited. The Registrant is also using the disputed domain name in relation to services covered by the Complainant’s trade mark registrations. The Registrant is, therefore, infringing the Complainant’s rights in its YELLOW PAGES trade mark in terms of Section 34(1)(a) of the Trade Marks Act.
- 3.6 In terms of Regulation 5(c) a Registrant bears the burden of proof to show that the disputed domain name is not an abusive registration if the domain name is identical to the trade mark in which the Complainant asserts rights. The Complainant submits that, because the disputed domain name resolves to a website that uses the Complainant’s identical YELLOW PAGES mark this presumption should apply to its complaint. (The Adjudicator does not agree with this submission. The presumption requires the disputed domain name itself to be identical, which is not the case. Nothing turns on this for present purposes and it will not be further addressed.)
- 3.7 It is submitted that the Registrant registered the disputed domain name with full knowledge of the Complainant’s trade mark rights in the mark YELLOW PAGES.

- 3.8 It is also submitted that the registration of the disputed domain name amounts to typo-squatting. Reliance is placed on Columbia Pictures Industries Inc. v Caribbean Online International Ltd WIPO Case No. D2008-0090 and particularly the dictum that “... *adding or removing letters to a domain name is not sufficient to escape the finding of similarity and does not change the overall impression of the designation as being connected to the trade mark of Complainant*”.
- 3.9 Lastly, it is contended that as the disputed domain name is not registered to, operated or authorized by, or otherwise connected with the Complainant, but resolves to a website that states “*The yellow pages services you love!*” it offends the provisions of Regulation 4(1)(b) and is thus an abusive registration.

4 Discussions and Findings

- 4.1 Firstly, it is clear that the Complainant has rights in respect of a mark as is contemplated by Regulation 3(1)(a). The mark YELLOWPAGES is registered in terms of the Trade Marks Act 194/1993 and that fact is sufficient to confer *locus standi* on the Complainant.
- 4.2 Is “YELLOW P” similar to the Complainant’s mark “YELLOW PAGES”? On basic trade mark principles, the answer is yes. It is so that a section - “-ages” or something else to compare it with – is missing, but that is not the sole criterion for assessing similarity. Once the dominant feature has similarity – identity, in the present case - which is supported visually, aurally, and conceptually, the absence of the final syllable loses import as a distinguishing feature.¹ And, perhaps, the Registrant recognised this because the domain name, after all, leads a user to Mr Campos’ allegedly growing business in “Yellow Pages” advertising. Mr Campos

¹ Non-constat the same applies if there existed a final syllable – as in “YELLOWPAINT”, for example.

therefore perceived a benefit in the name he chose, attributable to its comparability with “Yellow Pages”. He bargained, therefore, on its “similarity”.

4.3 In the absence of submissions and explanations from Mr Campos, it is difficult not to conclude but that he set out to take some advantage of the reputation in the YELLOW PAGES mark. This is, that he invites interest in “yellow pages services”, which – it must be inferred – is in competition with the Complainant. Thus, that advantage, *prima facie*, would be unfair.

4.4 There again, how Mr Campos aimed to eke out that business, in the South African internet domain space, whilst based in Brazil, lends itself to another eminently possible conclusion. That is, that he does not really intend to eke out such a business, but disrupting the Complainant’s ability to do so is rather his intention. Again, in the absence of a response from the Registrant, nothing presents to avert or negate such an inference.

4.5 Taking all into account, the Adjudicator finds, on a balance of probabilities, that the disputed domain name is an abusive registration.

5 Decision

5.1 In the circumstances, the complaint that the domain name is abusive is upheld. I order that it be transferred to the Complainant.

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ADV OWEN SALMON SC
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za