

Decision

ZA2017-0256

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0256
DECISION DATE:	9 March 2017
DOMAIN NAME	mybidveststory.co.za
THE DOMAIN NAME REGISTRANT:	Ultimate Linux Solutions CC
REGISTRANT'S LEGAL COUNSEL:	Self representing
THE COMPLAINANT:	Bid Industrial Holdings (Pty) Limited
COMPLAINANT'S LEGAL COUNSEL:	Mr D Greenberg, Lexsynergy Limited
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 (“SAIIPL”) on **11 January 2017**. On **12 January 2017** 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 **12 January 2017** ZACR confirmed that the domain name had indeed been suspended. SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and SAIIPL’s Supplementary Procedure.
- b) In accordance with the Regulations, SAIIPL formally notified the Registrant of the commencement of the Dispute on **16 January 2017**. In accordance with the Regulations, the due date for the Registrant’s Response was **13 February 2017**. The Registrant failed to file its Response by **13 February 2017**, and a Notification of Default was issued. The Registrant then filed its Response on **14 February 2017**, *ie* one day after the due date. The Complainant objected to this late filing and the Adjudicator was requested, on **22 February 2017**, to provide a ruling in respect of the late filing. The Adjudicator provided a ruling on **22 February 2017**, indicating that he agreed retrospectively to grant the Registrant a one-day extension, and he instructed the Administrator to invite the Complainant to file its Reply within five days from his ruling, *viz* by **1 March 2017**.
- c) In accordance with the Regulations, the Complainant was originally due to file its Reply by **20 February 2017**, but in view of the late filing of the Response, the Complainant was invited to file its Reply by **1 March 2017**. The Complainant duly filed its Reply on **24 February 2017**. In accordance with the Regulations, SAIIPL formally notified the Registrant of the Complainant’s Reply on **27 February 2017**.
- d) SAIIPL appointed **Andre van der Merwe** as the Senior Adjudicator in this matter on **21 February 2017** and **Christiaan Steyn** as the trainee adjudicator on **22 February 2017**. The Adjudicators have submitted the Statement of Acceptance and Declaration of Impartiality and Independence,

as required by SAIPL, to ensure compliance with the Regulations and Supplementary Procedure.

Procedural Aspects

Firstly, the Adjudicator refers to the late filing of the Registrant's Response and the objection thereto by the Complainant, as set out above.

The Adjudicator provided a ruling to the Administrator, and hence to the parties, indicating that, although Regulation 24(2) requires an adjudicator to ensure that a dispute is handled as expeditiously as possible, Regulation 24(1) also requires an adjudicator to ensure that the parties are treated with equality and that each party is given a fair opportunity to present its case. SAIPL's Supplementary Procedure (in Rule 11) expressly provides that, the Case Administrator (and by inference the Adjudicator) may, in his/her discretion, allow limited extensions of time periods on good cause shown by the requesting party. In addition, there is a general obligation on an adjudicator to apply the rules of natural justice.

The Adjudicator considered that the short extension of one day is not sufficiently material and would not unduly delay the Dispute. He indicated that there were various precedents in foreign and South African domain name decisions where a short extension had been granted to one party or another. Accordingly, the Adjudicator agreed to grant the Registrant a one day extension retrospectively for the filing of its Response herein; and, from the date of providing this ruling, granting the Complainant 5 days for filing its Reply.

Secondly, during the week after the Complainant had filed its Reply, there was an exchange of e-mails from the parties to the Administrator. Although the Adjudicator is not convinced that the contents of those e-mails are key in this Dispute, he will comment thereon in his decision.

2 Factual Background

- 2.1 The Complainant is a subsidiary company of The Bidvest Group, that is listed on the Johannesburg Stock Exchange, and that is a South African and

international services, trading and distribution company. The Complainant licences the use of its trade marks to the Bidvest Group and its member companies. The Bidvest Group was established in 1988 and has meanwhile diversified its operations to become one of the world's largest companies, with more than 141 000 employees worldwide viz spread across 4 continents. The Complainant has registered the (Group's) name and trade mark **BIDVEST** in South Africa and abroad in more than 24 countries. In South Africa alone it has registered around eleven trade mark registrations for **BIDVEST** and more for **BIDVEST & B DEVICE**, the earliest registration dating from 1995. The Complainant has provided proof of these trade mark registrations.

- 2.2 The Complainant has also registered various domain names that include **BIDVEST** in such domain names, including bidvest.com on 17 February 1998; bidvest.co.za on 2 February 1998; and mybidvest.be registered on 4 December 2013.
- 2.3 The Complainant launched its website www.bidvest.co.za on or about 7 October 1999 and its main website www.bidvest.com on 11 April 2000. The number of visits from various countries to the home-page of this latter website was around 286 000 for the period August 2009 to September 2015. From information supplied by the Complainant, the Bidvest Group's total revenue for the period 2013 to 2015 was around R476.3 billion. It spends a large amount of money on marketing and sponsorships, such as the Bidvest Wits Soccer Club, the Nedbank Golf Challenge, and the Bidvest Wanderers Cricket Stadium. It has also been listed in the Forbes Global 2000 that lists the world's largest companies.
- 2.4 During 2015, the Complainant became aware of the disputed domain name registration viz **mybidveststory.co.za**, owned and registered by the Registrant on 26 November 2014. During May 2015, the Complainant's representative contacted the Registrant telephonically, requesting that the disputed domain name be transferred to the Complainant. This was followed up during 2015 and 2016 by various e-mails and other telephone calls, including a letter of demand, to the Registrant. On 11 May 2016, the

Complainant's representative addressed a letter of demand, based on the Complainant's trade mark rights, to the Registrant, requiring that the disputed domain name be transferred to the Complainant, on the basis that the disputed domain name is an abusive registration. No response was received to this communication from the Registrant. Despite reminders sent, and some communications between the parties, the Registrant failed to comply with the above demand.

- 2.5 On 7 June 2016, the Registrant wrote to the Complainant's representative, advising that the Complainant's trade mark had been "acknowledged" on the website of the disputed domain name, and that its use therefore constitutes "fair use". The notice on the website also stated that the disputed domain name was registered by the Registrant on behalf of a client.
- 2.6 Further communications between the parties followed, and on 4 August 2016 the Complainant's representative sent a final e-mail to the Registrant, putting them on notice that formal proceedings would be initiated. This Complaint was thereafter filed with the Administrator on 11 January 2017.

3 Parties' Contentions

3.1 Complainant

- a) Based on the above factual background, the Complainant contends that it has registered trade mark rights in and to the name and trade mark **BIDVEST**, in South Africa and in other countries of the world. It also contends that it has registered rights in its domain name registrations, both in South Africa and in various foreign countries, that include the name and trade mark **BIDVEST**. It further contends that, through its sales, marketing and promotion of its name and trade mark **BIDVEST**, it has over almost 30 years developed a substantial reputé or reputation and goodwill, in South Africa, in terms of the common law. The aforementioned rights had been obtained and developed before the date of registration of the disputed domain name, viz before 26 November 2014.

- b) The Complainant contends that, on a comparison of the two terms/names, the Complainant's name and trade mark **BIDVEST** is similar to the disputed domain name **mybidveststory.co.za**.
- c) The Complainant contends that, because of such similarity, there is a likelihood of confusion and deception occurring in that members of the public would assume that any product or service being offered on a website including the **BIDVEST** name and trade mark, would be linked or associated with the Complainant. Such use would amount to trade mark infringement in terms of the Trade Marks Act, and passing-off under the common law. Hence the Complainant contends that the Registrant is able to unlawfully and unfairly benefit from the Complainant's substantial reputation and goodwill in the marketplace.
- d) The Complainant contends that there are various factors that indicate that the disputed domain name is an abusive registration, and hence that the disputed domain name takes unfair advantage of, and is unfairly detrimental to, the Complainant's rights. These factors will each be discussed by the Adjudicator below.
- e) Accordingly, the Complainant contends that, in the hands of the Registrant, the disputed domain name is an abusive registration.

3.2 Registrant

- a) The Registrant does not dispute that the Complainant has registered rights in and to the name and trade mark **BIDVEST**. However, the Registrant contends that, while the disputed domain name includes the name and trade mark **BIDVEST**, it is clear that the disputed domain name "*does not attempt (sic!) to infringe*" the Complainant's rights. The Registrant explains this by stating that it may not attempt to trade under that name (-viz the disputed domain name) or pretend to be one of the various subsidiaries of the Complainant.
- b) The Registrant contends that the disputed domain name is plainly not similar or confusing to the Complainant's name and trade mark

BIDVEST, and that the intention is plainly not to pretend to be the Complainant.

- c) The Registrant contends that it is plain that the intent of the disputed domain name *“was to tell the Registrant’s story regarding the Complainant”*.
- d) The Registrant contends that the Complainant implies that *“there is a business running under the disputed domain name”*. However, the Registrant goes on to state: *“... as can be plainly seen this is not the case”*.
- e) The Registrant therefore contends that the disputed domain name is not an abusive registration.

4 Discussion and Findings

- a) In order to make a finding that the disputed domain name is an abusive registration, the Adjudicator is required to find that the Complainant has proved, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present viz:
 - i) that the Complainant has rights in respect of a name or mark,
 - ii) that is identical or similar to the disputed domain name; and
 - iii) that, in the hands of the Registrant, the disputed domain name is an abusive registration.

An abusive registration is defined in the definition section viz in Regulation 1, to mean a domain name which either:–

- a) 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
- b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant’s rights.

SUBSTANTIVE ASPECTS

Turning to the substantive aspects of this complaint, the Adjudicator has

carefully perused the Complaint, the Response, and the Reply filed herein, and has fully considered the facts and contentions set out therein.

RIGHTS IN RESPECT OF A NAME OR MARK

In terms of Regulation 1, the term “rights” is widely defined. The Regulation states that “rights” and “registered rights” include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law but is not limited thereto.

As has been decided in the South African appeal decisions of *seido.co.za* (ZA2009-0030) and *xnets.co.za* (ZA2011-0077), the notion of “rights” for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. The threshold in this regard should be fairly low.

It is also a matter of *locus standi* in order to make sure that the person who complains is someone with a proper interest in the complaint. The threshold in this regard should be fairly low.

DOES THE COMPLAINANT HAVE RIGHTS?

The first element that the Adjudicator needs to establish is whether, as set out above, and in terms of Regulation 3(1)(a), on a balance of probabilities, the Complainant has rights in respect of the name or trade mark **BIDVEST**. This will also determine whether the Complainant has the necessary *locus standi* to bring this Complaint. The Complainant contends that it has rights in and to the name and mark **BIDVEST**, and the Registrant does not contest this.

The Complainant has shown that it has registered its name and trade mark **BIDVEST** as a trade mark in various foreign countries and in South Africa, from as early as 1995. These trade mark registrations are shown to be in force and are considered by the Adjudicator to be *prima facie* valid.

Considering for convenience only the South African registrations, the rights flowing from these registrations could be enforced by the Complainant against an infringer who without authority was to use the name and trade mark **BIDVEST**, or a confusingly similar trade mark, in the course of trade.

In support of the abovementioned, the Adjudicator refers to the textbook: South African Law of Trade Marks by Webster and Page, Fourth Edition, paragraph 12.5 *et seq*, and the foreign and South African decided cases

cited therein.

These rights could also be used against a third party who was to attempt to register such a trade mark, in order to oppose such a trade mark application. In support of the abovementioned, the Adjudicator refers to the textbook by Webster and Page, cited above, paragraph 8.30 *et seq*, and the foreign and South African decided cases cited therein.

The Complainant has also registered various domain names in South Africa and in various other countries, that include their name and trade mark **BIDVEST**. This provides the Complainant with rights in terms of the Regulations to object to a disputed domain name in the event that their name and trade mark **BIDVEST** is identical or similar to a disputed domain name.

The Complainant has further shown that it has enjoyed considerable sales of its **BIDVEST** products and services over almost 30 years, namely both internationally and in South Africa. It also asserts that it has also expended considerable resources on marketing and promoting its **BIDVEST** products and services, which have become known to, and associated by, a substantial number of the public, with the Complainant. Accordingly, the Complainant contends that, by virtue of its aforementioned activities, internationally and in South Africa, it has developed a substantial repute or reputation, and hence goodwill, in terms of the common law.

Such reputation, as forming part of the goodwill, stemming from that reputation, in respect of its name or trade mark **BIDVEST**, could be damaged by means of unlawful competition or more particularly passing-off under the common law by another party wrongly representing that it is, or is associated with, or part of, the Complainant and its business.

It was pointed out in the South African domain name decision ZA2007-0003 (telkommedia.co.za) that the registration, adoption and use of a domain name being a name or mark that enjoys a reputation, of another person, could readily amount to passing-off under the common law. The Complainant therefore claims to have justifiable and justiciable rights under the common law in respect of its name and trade mark **BIDVEST** *viz* rights

that can be enforced against others who infringe or would be likely to damage such rights.

In support of the above, the Adjudicator refers to the above-mentioned South African domain name decision ZA2007-0003 at page 9; and the textbook Webster and Page, cited above, at paragraphs 15.5 and 15.7 and the South African and foreign court decisions cited therein.

The Adjudicator may mention that the Complainant's trade mark rights in **BIDVEST** have previously been established in four UDRP decisions.

Finally, the Adjudicator accepts that the Registrant does not dispute that the Complainant has registered trade marks in respect of **BIDVEST**, and moreover that the Registrant does not dispute or challenge the above-mentioned rights as claimed by the Complainant.

Considering all the above factors, the Adjudicator therefore finds that the Complainant has proved, on a balance of probabilities, that it has both registered and unregistered rights *viz* common law rights in respect of the name and trade mark **BIDVEST**. The Complainant has thereby also established that it has the necessary *locus standi* to bring this Complaint.

NAME OR MARK IDENTICAL OR SIMILAR TO THE DISPUTED DOMAIN NAME?

The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proved that its name or mark **BIDVEST**, in which it has rights as set out above, is identical or similar to the disputed domain name. The Complainant contends that its name and mark **BIDVEST** is similar to the disputed domain name, while the Registrant denies that the disputed domain name is confusingly similar to the Complainant's name and trade mark **BIDVEST**.

The Complainant's name and mark (in which it has rights) is **BIDVEST**, while the disputed domain name is **mybidveststory.co.za**. Ignoring the first and second level suffixes, in terms of Regulation 5(c), the comparison becomes **BIDVEST v MYBIDVESTSTORY**. The Registrant has simply added the pronoun 'MY' as a prefix to the Complainant's name and trade mark **BIDVEST**, and the word 'STORY' as a suffix thereto.

The disputed domain name contains the Complainant's name and mark **BIDVEST** in its entirety. This is undeniably the distinctive, dominant and memorable element of the domain name, and this is the term or feature that is likely to be known to a substantial number of members of the public. In other words, the Registrant has merely added the simple, descriptive, and non-distinctive, pronoun 'MY' and the non-distinctive/generic word 'STORY' to the distinctive **BIDVEST** name/trade mark. A reasonable person – such as the often cited reasonable man – will therefore find it difficult to avoid the inevitable conclusion that the Complainant's name and mark **BIDVEST** is similar to the disputed domain name.

More particularly, the Adjudicator points out that the disputed domain name is similar to the Complainant's domain name mybidvest.be used for the Complainant's food business in Belgium.

In support of the above, see the following foreign domain name decisions:- In NAF/FA141825 it was held that: *"It is also well-established under the policy that a domain name composed of a trade mark coupled with a generic term still is confusingly similar to the trade mark."*

In WIPO/D2002-0367 (experianoutomotive.com) the Panel concluded that: *"The disputed domain name contains Complainant's EXPERIAN trade mark in its entirety. The addition of the generic term "automotive" does not distinguish Respondent's domain name from Complainant's mark."*

See also the decisions WIPO/D2000-1598 in which niketravel.com and nikesportstravel.com were found to be similar to NIKE; DRS04601 in which nikestore.com was found to be similar to NIKE; and DRS01493 in which nokia-ringtones.com was found to be similar to NOKIA.

The Adjudicator also refers to the following foreign domain name decisions:- In WIPO/D2006-1031 the disputed domain name mymastercard.com was found to be similar to the registered trade mark MASTERCARD. In other words, the addition of the pronoun 'MY' was held not to be sufficient to avoid confusion. The panel also referred to the decision WIPO/D2000-1007 (Sony Corporation v Sin, Eonmok).

In NAF/FA1412001596504 (2015) the disputed domain name youwenttojared.com was found to be similar to the trade mark HE WENT TO

JARED. In this case the pronoun 'YOU' was substituted for the pronoun 'HE'.

In DRS1061 (2015) the .nz Dispute Resolution Service found that the disputed domain names mycoke.co.nz and mycoke.net.nz were similar to the COKE registered trade mark. The Expert found that: *"Adding 'MY' is insufficient to differentiate the term from the Complainant's marks."*

The Adjudicator finally refers to the following South African domain name decisions:–

- a) in ZA2007-0003 telkommedia.co.za was found to be similar to TELKOM;
- b) in ZA2007-0010 mwebsearch.co.za was found to be similar to MWEB;
- c) in ZA2008-0025 suncityshuttle.co.za was found to be similar to SUN CITY;
- d) in ZA2009-0034 absapremiership.co.za was found to be similar to ABSA;
- e) in ZA2010-0048 etravelmag.co.za was found to be similar to ETRAVEL; and
- f) in ZA2013-00149 autotraderauction.co.za was found to be similar to AUTOTRADER.

The Adjudicator wishes to point out that the test or criterion in the Regulation, the wording of which is set out above, is not "confusing similarity" but merely "similarity", which involves a lower standard of comparison.

Accordingly, the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that the name and trade mark **BIDVEST** is similar to the disputed domain name.

IS THE DISPUTED DOMAIN NAME AN ABUSIVE REGISTRATION?

The third element that the Adjudicator needs to establish is whether, on a balance of probabilities, the disputed domain name, in the hands of the Registrant, is an abusive registration. The Complainant asserts that the disputed domain name is an abusive registration while the Registrant denies

this.

The Adjudicator is required to determine whether the disputed domain name is an abusive registration as defined in the definition section of the Regulations *viz* in Regulation 1, and as set out above.

According to the definition, and to various Nominet decisions, there are two potential abuses (or two types of abuse) *viz*:

- a) Registration with an abusive intent; and/or
- b) Use in an abusive manner.

At the outset, the Adjudicator refers to the foreign decisions DRS02464 (Aldershot Car spares v Gordon); and to DRS00658 (Chivas Brothers Ltd v David William Plenderleith); and also to the South African decision ZA2007-0007 (FIFA v X Yin). Against the background of the aforementioned decisions, the Adjudicator concurs with the view that the nature of “abusive” in the Regulations does not necessarily require a positive intention to abuse the Complainant’s rights but that such abuse can be the result/effect or consequence of the registration and/or use of the disputed domain name.

Regulation 4 provides a list of (non-exhaustive) factors/circumstances, which may indicate that a disputed domain name is an abusive registration. More particularly, Regulation 4 lists factors or circumstances that indicate that the Registrant has registered the disputed domain names for various stated reasons. The Complainant has asserted the following factors or circumstances that will be discussed below *viz*:

Regulation 4(1)(a)(ii) – Circumstances indicating that the Registrant has registered or otherwise acquired the (disputed) domain name primarily to sell, rent or otherwise to transfer the domain name to the Complainant for valuable consideration in excess of the Registrant’s reasonable out-of-pocket expenses directly associated with acquiring the domain name.

The Registrant had asked the Complainant’s representative in correspondence to make an offer to purchase the disputed domain name. Hence the Complainant alleges that one of the Registrant’s intentions was to sell the disputed domain name and to profit from the Complainant. From a

factual perspective, when negotiation is commenced on this basis, it can usually be assumed that the Registrant's intention was to obtain more than was the reasonable expense of the Registrant in registering the disputed domain name.

Accordingly, the Adjudicator concludes that this circumstance applies in the present dispute, and that this factor indicates that the disputed domain name may be an abusive registration.

Regulation 4(1)(a)(ii) – Circumstances indicating that the Registrant has registered or acquired the (disputed) domain name primarily to block intentionally the registration of a name or mark in which the Complainant has rights.

The Complainant points out that the Complainant has no association with the Registrant and has never authorised or licensed the Registrant to use its name or trade mark **BIDVEST**. However, the Registrant is based in South Africa and it is unlikely that the Registrant is not aware of the Complainant, its business activities, or its rights. The Complainant therefore alleges that the Registrant has intentionally registered the disputed domain name to sell it to the Complainant for profit, and in that process to block the Complainant from using the disputed domain name for a legitimate purpose in its business.

In addition, the Registrant has indicated that it *“may not intend to trade under that name”*, ie under the disputed domain name. If the Registrant did not have the intention to trade under the disputed domain name, then there would be no reason for it to have registered the disputed domain name except possibly to frustrate and block the business of the Complainant.

Although the Regulations (and definitions) are silent on what a “blocking registration” is or involves, it is clear both in general terms and from various Nominet decisions that a blocking registration appears to have two critical features. The first is that it must act against a name or mark in which the Complainant has rights. The second is intent or motivation and suggests some knowledge and hence a purpose in registering a domain name to prevent the Complainant from doing so. See the foreign decisions

DRS00583 (club1830uncovered.co.uk) and DRS01378.

The disputed domain name undeniably prevents the Complainant from registering this domain name, or its name or trade mark in this form, for itself whether through the intent of the Registrant and/or as an unintended consequence of the disputed domain name registration.

As indicated above, the Registrant's actions herein appear to indicate the Registrant's bad faith in dealing with the disputed domain name.

In support of the above, see WIPO/D2000-0545 (bancolumbia.com); and the leading United Kingdom authority dealing with domain names and their "blocking" effect viz British Telecommunications plc v One in a Million Ltd [1999] FSR 1 (CA). In this case, the Court of Appeal held that the disputed domain name registrations were unlawful on the grounds of trade mark infringement and passing off, and interdicted One in a Million Ltd and those who controlled it from such conduct, and ordered them to transfer the disputed domain name registrations to the companies that in reality traded under those names.

In further support of the above, see also the foreign decision WIPO/D2000-0766 (Red Bull GmbH v Harold Gutch) which is cited in the South African decision ZA2008-0014 (Automobiles Citroen v Mark Garrod).

Accordingly, the Adjudicator concludes that this circumstance applies in the present dispute, and that this factor indicates that the disputed domain name may be an abusive registration.

Regulation 4(1)(b) - Circumstances indicating that the Registrant is using, or has registered the (disputed) domain name in a way that leads people or businesses to believe that the (disputed) domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Complainant has clearly established that it has rights in and to the name and mark **BIDVEST** in respect of various products and services; and the Complainant's name and trade mark **BIDVEST** is similar to the disputed domain name. Hence there is a likelihood that a significant number of

persons will be confused or deceived into thinking that the Registrant and its goods or services (if the disputed domain name was to be used for a business website) are somehow linked, or are associated with, the Complainant. Consequently, there appears to be a real likelihood of passing-off taking place in the marketplace. See also the brief discussion under the above heading '**DOES THE COMPLAINANT HAVE RIGHTS?**'

In addition to the above, the disclaimer notice that the Registrant posted – after this Dispute was filed – has the potential to cause more confusion in the minds of the public because the public may believe that, since the Registrant has the right to use the trade mark **BIDVEST**, its business is duly authorised by the Complainant and hence legitimate.

In view of potential passing off taking place, it appears to the Adjudicator that the abovementioned relevant circumstances are present.

The above Regulation requires either registration OR use. Various foreign decisions have found that actual use is not a hard and fast requirement. These decisions have found that sites “under construction” or “coming soon”, for example, create a likelihood or confusion, or have found that, if the disputed domain name were used, it would create confusion. See for example the decisions in the foreign cases WIPO/D2000-0545; NAF/FA91359, NAF/FA95464 and NAF/FA95498.

Actual confusion is not necessary – and the potential or (reasonable) likelihood for confusion is sufficient. In support hereof, various foreign decisions have that confusion may be inferred in situations where the disputed domain name contains the complainant's name/trade mark plus a generic term, as in the present case. See for example the foreign decisions in WIPO/D2000-0777, WIPO/D2000-0878, NAF/FA95033 and NAF/FA95402; as well as the above NIKE and NOKIA decisions. See also the South African decision ZA2007-0003 (Telkom SA Limited v. Cool Ideas 1290 CC) and subsequent cases citing that decision in this regard.

Accordingly, the Adjudicator concludes that this circumstance applies in the present dispute, and that this factor indicates that the disputed domain name may be an abusive registration.

DISCUSSION OF OTHER FACTORS HEREIN

- (a) In addition to the above, the Registrant should, in the course of its business offering various on-line solutions, have been aware of the Complainant's rights at all relevant times, or at least it should have been aware of the Complainant's name and trade mark **BIDVEST** and its rights therein which would prevent unauthorised use and registration thereof by unauthorised parties.

The Registrant is also familiar with domain names and their relevance for businesses, such as are required for some of its services (for example its "Mail Solutions" services). The Registrant should therefore reasonably have been aware of the effect of the disputed domain name on the Complainant and its business. This begins to call into question whether the Registrant acted in good faith in registering the disputed domain name.

Although awareness or lack of awareness of the Complainant's name and trade mark **BIDVEST** at the relevant time is not *per se* a requirement herein, in circumstances where the Registrant should have known or been aware thereof, this raises a suspicion that the Registrant was not acting in good faith at that time *viz* when it decided to register the disputed domain name.

- (b) See in this regard the foreign decided domain name decisions *viz* WIPO/D2000-0037, WIPO/2000-0137-1492, WIPO/2001-1492, and WIPO/2003-0257, in which it was held that bad faith may be inferred from the registration of a well-known trade mark as part of a domain name.
- (c) Failure by the Registrant to reply to the letter of demand dated 11 May 2016 from the Complainant's representative, also appears to indicate a measure of bad faith on the part of the Registrant herein.
- (d) In addition to the above considerations, the direct question arises whether the Registrant had acted in good faith or otherwise in registering the disputed domain name. In this regard, the Registrant had warranted, when applying to register the disputed domain names, in terms of the Uniform SA terms and conditions (in clause 5.1) that:

- I. *“It has the right without restriction to use and register the Domain Name”*; and
- II. *“The use or registration of the Domain Name [by the Registrant] does not or will not interfere with, nor infringe the right of any third party in any jurisdiction with respect to trade mark, service mark, trade name, company name, close corporation name, copyright, or any other intellectual property right.”*

Clause 5.1.1 of the ZA Central Registry terms and conditions state further (-to which the Registrant had agreed): *“Applicant (the Registrant) hereby irrevocably represents, warrants, and agrees that its [above] statements in the Application are accurate and complete.”*

It is highly unlikely that the Registrant had not known, at all material times, of the Complainant and its rights in and to its name and trade mark **BIDVEST**, and hence it appears both from this knowledge and more directly from the above false statements or warranties by the Registrant that the disputed domain name was registered in bad faith.

In support of the above, the Adjudicator refers to the South African decision ZA2012-0117 (South African Revenue Services v Antonie Goosen) and the foreign decisions: WIPO/D2005-0283 (associatedbritishfoods.com) and WIPO/D2009-0286 (qualitair4u.com).

- (e) In the Adjudicator’s view, although the disputed domain name has to date not been used, it can be used by the Registrant (or another person), and if used, it has the potential of disrupting and potentially damaging the reputation and business of the Complainant, and eroding the distinctive character of its name and trade mark **BIDVEST**. The Complainant alleges the dispute domain name is being held passively, and that this is evidence of bad faith.

Regarding such non-use, in certain foreign decisions such as Telstra Corporation Limited v. Nuclear Marshmallows (WIPO/D2000-0003), it was established that registration together with “inaction” can support a finding of bad faith. This decision has been cited for that proposition and followed by subsequent panels.

In further support of the above, it has been held that failure to make

use of a domain name during a two-year period after registration, constitutes bad faith. See the foreign cases Hexagon v. Xspect Solutions Inc (D2005-0472), and Mondich & American Wine Biscuits Inc v. Brown (D2000-2000-0004).

In the South African case Telkom SA Ltd & TDS Directory Operations (Pty) Ltd v. The Internet Corporation (ZA2007-0005), the Adjudicator stated that the Registrant had failed to explain why it did not make good faith use of the disputed domain name and that the Registrant took the first and only preparatory steps to using the disputed domain name after receiving the Complainant's letter of demand. While not conclusive, this led to the inference of a bad faith registration. The Complainant alleges that the same has happened in this matter – because the website at the disputed domain name did not resolve until after receipt of the Complainant's letter of demand when the Registrant amended the relevant website.

- (f) The Registrant contends that it is plain that the intent of the disputed domain name *“was to tell the Registrant's story regarding the Complainant”*. However, the Registrant does not elaborate on this statement in any way, and hence it does not assist the Registrant.
- (g) The Complainant has contended in its Reply that the Registrant has been involved, either directly or indirectly with the aid of a member or employee, in registering other (foreign) domain names during the period 2010 to 2014, that appear to infringe the names and trade marks of well-known South African businesses and at least one foreign business such as First For Women Insurance, Auto and General Insurance, Dial Direct Insurance, Hippo Insurance, and Virgin Money Insurance. In e-mail correspondence after the Complainant had filed its Reply, the Registrant stated that their international domains seemingly reflect the wrong Registrants, and that this would be corrected because such domains had been registered on behalf of a client, SABest (Pty) Ltd, which had registered those domains with the permission of the various companies involved. The Complainant responded to this by stating that this is an admission by the Registrant of the above abusive registrations targeting

major South African insurance companies and one foreign insurance company and changing the evidence after the fact by updating the WHOIS details. The Adjudicator finds it unlikely that these major companies would have given SABest (Pty) Ltd permission to register their domain names in its name – and not in their own, respective, names.

Lastly, viewed overall and in the opinion of the Adjudicator, the Registrant has, in its Response not been able to provide any real, or substantial, or compelling reason(s) to defend or justify the registration of the disputed domain name, or to disprove the factors and arguments put forward by the Complainant. Unfortunately, the Registrant does not appear to understand the nature and essence of a trade mark and trade mark rights – nor that the unauthorised use by the Registrant of the Complainant's name and trade mark **BIDVEST** in registering the disputed domain name is in breach of the Domain Name ADR Regulations (issued in terms of the so-called "ECT" Act), and as set out above.

Accordingly, the Adjudicator comes to the conclusion that the above factors and circumstances apply in the present Dispute, including a lack of good faith on the part of the Registrant, and that these factors indicate that the disputed domain name may be an abusive registration.

4.1 Abusive Registration

4.1.1 In view of the above, the Adjudicator concludes that the disputed domain name was registered in a manner which, at the time when the registration took place, took unfair advantage of, or was unfairly detrimental to, the Complainant's rights.

4.1.2 Accordingly the Adjudicator finds, on a balance of probabilities, that the disputed domain name, in the hands of the Registrant, is an abusive registration.

5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the

Adjudicator orders that the disputed domain name, **mybidveststory.co.za**,
be transferred to the Complainant.

ANDRE VAN DER MERWE

SAIIPL SENIOR ADJUDICATOR

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Assisted by: **CHRISTIAAN STEYN**

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