

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0265
DECISION DATE:	29 June 2017
DOMAIN NAME	reedexpo.co.za reedexhibitions.co.za
THE DOMAIN NAME REGISTRANT:	Karma Venty
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	RELX GROUP PLC
COMPLAINANT'S LEGAL COUNSEL:	Tyrone Walker, Moore Attorneys Inc, Fourways, RSA
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZA Central Registry (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **5 May 2017**. On **8 May 2017** SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain names at issue, and on **8 May 2017** ZACR confirmed that the domain names had indeed been suspended. SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and SAIPL’s Supplementary Procedure.
- b. In accordance with the Regulations, SAIPL formally notified the Registrant of the commencement of the Dispute on **9 May 2017**. In accordance with the Regulations the due date for the Registrant’s Response was **6 June 2017**. The Registrant did not submit any response, and accordingly, SAIPL notified the Registrant of its default on **7 June 2017**.
- c. The Complainant did not need to submit any Reply.
- d. SAIPL appointed **Christiaan Steyn** as the Adjudicator in this matter on **9 June 2017**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2) Factual Background

- a. The Complainant is RELX GROUP PLC, a company duly incorporated according to the laws of the United Kingdom, having its principle place of business in London, and its parent companies (RELX PLC and RELX NV) being listed on the London and Amsterdam Stock Exchanges. The Complainant manages various subsidiary companies *inter alia* in Asia Pacific, Europe, Middle East, the Americas and Africa, with its South African subsidiary company being Reed Exhibitions (Pty) Ltd (registered on 28 November 1997), and offers scientific-, technical and medical-, risk and business analytics-, legal-, and exhibition services. Complainant has provided sufficient proof hereof.
- b. The Complainant’s business was established around 1966 and has meanwhile diversified its operations to become one of the world’s leading event organising companies, with over 500 events being hosted in 30 countries. It has 38 offices

and serves 43 industry sectors, with more than 3 900 employees worldwide, spread across various continents. Complainant has also provided sufficient proof hereof.

- c. The Complainant has registered the name and trade mark ('brand') **REED** and **REED EXHIBITIONS** in various classes in South Africa, the dates of these being 22 August 2003 and 11 July 2013 respectively, along with other trade mark registrations containing the "**REED**" name. The Complainant has provided proof of these trade mark registrations.
- d. The Complainant further registered various domain names which include its "**REED**" marks, including *reedexpoafrika.co.za* and *reedexpo.com*. The Complainant has hosted its website on these domains, and made use of its **REED** and **REED EXHIBITION** marks thereon, since 1996. The Complainant has provided proof of this use.
- e. From information supplied by the Complainant, its South African subsidiary company, Reed Exhibitions (Pty) Ltd's, total turnover for the period of 2013 to 2015 was around R102 million. This was done *inter alia* through the hosting of various exhibitions, #BUY A BUSINESS EXPO, DECOREX (-JOBURG, -CAPE TOWN and -DURBAN) and FIBO (to name a few). The Complainant, through its subsidiary company, Reed Exhibitions (Pty) Ltd, further spent around R1.3 million during the period of 2013 to 2015.
- f. In December 2016, the Complainant became aware of the disputed domain name registrations *reedexpo.co.za* and *reedexhibitions.co.za*, owned and registered by the Registrant on 3 October 2016.
- g. On 6 December 2016, the Complainant, through its representative, addressed a letter of demand based on the Complainant's rights, to the Registrant, *inter alia* demanding that the disputed domain names be transferred to the Complainant on the basis that the disputed domain names are abusive registrations, and putting them on notice that formal proceedings would be initiated if the demands were not met.
- h. No response was received hereon from the Registrant and the Registrant failed to comply with the Complainant's demands. This Complaint was thereafter filed with the Administrator on 5 May 2017.

3) Parties' Contentions

a. Complainant

- i. In order to make a finding that the disputed domain names are abusive registrations, the Adjudicator is required to find that the Complainant has proven, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present:
 1. that the Complainant has rights in respect of a name(s) or mark(s);
 2. that is identical or similar to the disputed domain names; and
 3. that, in the hands of the Registrant, the disputed domain names are abusive registrations.
- ii. An abusive registration is defined in the definitions of Regulation 1, to mean a domain name(s) which either:
 1. 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
 2. has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

b. Substantive Aspects

- i. Turning to the substantive aspects of this Complaint, the Adjudicator has carefully perused the Complaint, and has fully considered the facts and contentions set out therein.

c. Rights in Respect of Names or Marks

- i. 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.
- ii. 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.

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

d. Does the Complainant have Rights

- i. 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 names or trade marks **REED** and **REED EXHIBITIONS**. 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 names or trade marks **REED** and **REED EXHIBITIONS**, and, as no response was lodged by the Registrant, the Registrant does not contest this.
- ii. The Complainant has shown that it has registered its names or trade marks **REED** and **REED EXHIBITIONS** in various classes in South Africa, from as early as 2003. These trade mark registrations are shown to be in force and are considered by the Adjudicator to be *prima facie* valid.
- iii. The South African trade mark registrations and the rights flowing from these registrations could be enforced by the Complainant against an infringer who without authority was to use the names or trade marks **REED** and **REED EXHIBITIONS**, or a confusingly similar trade mark, in the course of trade.
- iv. In support of the abovementioned, the Adjudicator refers to the South African Law of Trade Marks by Webster and Page, Fourth Edition, paragraph 12.5 *et seq* (hereafter “Webster and Page”), and the foreign and South African decided cases cited therein.
- v. 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.

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- vi. In support of the abovementioned, the Adjudicator refers to Webster and Page, paragraph 8.30 *et seq*, and the decided cases cited therein.
 - vii. The Complainant has also registered various domain names in South Africa and in other countries, which include its names or trade marks **REED** and **REED EXHIBITIONS**. This provides the Complainant with rights in terms of the Regulations to object to a disputed domain name in the event that their names or trade marks **REED** and **REED EXHIBITIONS** is identical or similar to a disputed domain names.
 - viii. The Complainant has further shown that it has enjoyed considerable revenue in its **REED** and **REED EXHIBITIONS** brand(s) for over 50 years, both internationally and in South Africa. It also states that it has spent considerable resources on marketing and promoting its **REED** and **REED EXHIBITIONS** brand(s), 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, both internationally and in South Africa, it has developed a substantial repute or reputation, and hence goodwill, in terms of the common law.
 - ix. Such reputation, as forming part of the goodwill, stemming from that reputation, in respect of its names or trade marks **REED** and **REED EXHIBITIONS**, 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.
 - x. 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 names or trade marks **REED** and **REED EXHIBITIONS** rights that can be enforced against others who infringe or would be likely to damage such rights.

- xii. In support of the above, the Adjudicator refers to the above-mentioned South African domain name decision ZA2007-0003; and Webster and Page, at paragraphs 15.5 and 15.7, including the decisions cited therein.
- xiii. The Registrant, by virtue of omission, does not dispute that the Complainant has registered trade marks in respect of **REED** and **REED EXHIBITIONS**, and furthermore, the Registrant does not dispute or challenge the above-mentioned rights as claimed by the Complainant.
- xiv. Considering the above factors, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that it has both registered and unregistered (common law) rights in respect of the names and trade marks **REED** and **REED EXHIBITIONS**. The Complainant has thereby also established that it has the necessary *locus standi* to bring this Complaint.

e. Names or Marks Identical or Similar to the Disputed Domain Names

- i. The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proven that its names or trade marks **REED** and **REED EXHIBITIONS**, in which it has rights, are identical or similar to the disputed domain names. The Complainant contends that its names or trade marks **REED** and **REED EXHIBITIONS** are similar to the disputed domain name, which was, by omission, not contested by the Registrant.
- ii. The Complainant's names and trade marks (in which it has rights) are **REED** and **REED EXHIBITIONS**, while the disputed domain names are *reedexpo.co.za* and *reedexhibitions.co.za*. Ignoring the first and second level suffixes, in terms of Regulation 5(c), the comparison becomes a comparison of **REED** and **REED EXHIBITIONS**, against **REEDEXPO** and **REEDEXHIBITIONS**.
- iii. Herein, firstly, the Registrant has simply substituted the word 'EXHIBITION(S)' with a derivative thereof, being 'EXPO', and removed the space between the words 'REED' and 'EXHIBITIONS', respectively. It is therefore evident that the disputed domain names are conceptually identical to, or confusingly similar to, the Complainant's name and trade mark **REED EXHIBITIONS**. In support hereof, in ZA2016-00253, the

domain name *yellowp.co.za* was found to be conceptually identical or confusingly similar to YELLOW PAGES.

- iv. Furthermore, both the disputed domain names contain the Complainant's name and trade mark **REED** in its entirety. In support hereof, in ZA2016-00248, the domain name *timeslives.co.za* was found to be confusingly similar to TIMES LIVE, and similarly, in ZA2016-00254, the domain name *anglogoldashantiafrica.co.za* was found to be confusingly similar to ANGLOGOLD and ANGLOGOLD ASHANTI. Also see WIPO/D2002-0367 herein.
- v. Subsequent, the Adjudicator is of the view that a reasonable person will inevitably come to the conclusion that the Complainant's names and trade marks **REED** and **REED EXHIBITIONS** are similar to the disputed domain names.
- vi. Furthermore, the Adjudicator takes note that the disputed domain names are also similar to the Complainant's domain names *reedexpoafrika.co.za* and *reedexpo.com*, used by the Complainant for its official websites.
- vii. The Adjudicator also wishes to point out that the test herein is not "confusing similarity" but merely "similarity", which involves a lower standard of comparison.
- viii. Accordingly, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that the names and trade marks **REED** and **REED EXHIBITIONS** are similar to the disputed domain names.

f. Are the Disputed Domain Names Abusive Registrations

- i. The third element that the Adjudicator needs to establish is whether, on a balance of probabilities, the disputed domain names, in the hands of the Registrant, are abusive registrations.
- ii. The Complainant contends that the disputed domain names are, in the hands of the Registrant, abusive registrations, while the Registrant omitted to respond. The Complainant herein submitted that, in terms of Regulation 4, the Registrant has registered the domain names primarily to:

1. Intentionally block the registration of the domain names *reedexpo.co.za* and *reedexhibitions.co.za* in which the Complainant has rights;
 2. Unfairly disrupt the business of the Complainant;
 3. Prevent the Complainant from exercising its rights in and to the domain names *reedexpo.co.za* and *reedexhibitions.co.za*;
 4. Lead people or business to believe that the domain names are registered by, operated or authorised by, or otherwise connected to the Complainant;
 5. Attract internet users to the disputed domain names and does so for commercial gains, as is evident by the fact that the Registrant is willing to sell the domain names; and
 6. Be used in a manner that takes unfair advantage of, or is ungainly detrimental to, the Complainant's rights.
- iii. The Adjudicator is subsequently required to determine whether the disputed domain names are abusive registrations as defined by Regulation 1, and as set out above.
- iv. According to the definition, and to various Nominet decisions, there are two potential abuses (or two types of abuse), being:
1. Registration with an abusive intent; and/or
 2. Use in an abusive manner.
- v. The Adjudicator herein refers to the foreign decisions DRS02464 (Aldershot Car spares v Gordon), DRS00658 (Chivas Brothers Ltd v David William Plenderleith), and the South African decisions ZA2007-007 (FIFA v X Yin). Against the background of the aforementioned decisions, the Adjudicator agrees 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.
- vi. As contended above by the Complainant, Regulation 4 lists factors or circumstances which indicate that the Registrant has registered the disputed domain names for various stated reasons. The Adjudicator will

now focus on the most pertinent aspects, in its view, which *inter alia* include:

1. **Regulation 4(1)(a)(ii):**

- a. Although the Regulations are silent on what a “blocking registration” is, 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 and DRS01378 herein.
- b. The disputed domain names undeniably prevents the Complainant from registering these domain names, or its names or trade marks in these forms, for itself, whether through the intent of the Registrant or as an unintended consequence of the disputed domain name registrations.
- c. The Registrant, by omission to lodge a Response, has offered no reason for registering the disputed domain names.
- d. Herein, also see WIPO/D2000-0545 (*bancolumbia.com*); and *British Telecommunications plc v One in a Million Ltd [1999] FSR 1*, as well as the South African decision ZA2008-0014 (*Automobiles Citroen v Mark Garrod*), referring to WIPO/D2000-0766.

2. **Regulation 4(1)(b):**

- a. The Complainant has clearly established that it has rights in the names and trade marks **REED** and **REED EXHIBITIONS**, and that the Complainant’s names and trade marks **REED** and **REED EXHIBITIONS** are

conceptually identical or confusingly similar to the disputed domain names. Therefore, there exists a likelihood that the public will be confused or deceived into thinking that the Registrant (if the disputed domain names were to be used) is related to, or associated with, the Complainant.

- b. Although the Registrant did not make actual use of the disputed domain names, the above Regulation requires either registration OR use. Various foreign decisions have found that actual use is not a hard and fast requirement. Therefore, the mere registration of the disputed domain names by the Registrant is sufficient herein. See foreign decisions WIPO/D2000-0545, NAF/FA91359, NAF/FA95464 and NAF/FA95498 herein.
- c. Actual confusion is furthermore not necessary, and the potential or (reasonable) likelihood for confusion is sufficient. See foreign decisions WIPO/D2000-0777, WIPO/D2000-0878, NAF/FA95033 and NAF/FA95402, as well as the South African decision ZA2007-0003 and ZA2016-00254 herein.

3. Regulation 4(1)(d):

- a. The Complainant contends that the disputed domain names are in contravention of this Regulation, as the contact details provided in the *whois* database are false or incomplete. The Adjudicator finds this is in fact the case, and refers to the decision in ZA2016-00254, where reference was made to ZA2007-0003, WIPO/D2000-0501 and NAF/FA92016, in support hereof.
- b. The Registrant omitted to respond or provide any reasonable explanation for such false or incomplete contact details.

- vii. Accordingly, the Adjudicator concludes that *inter alia* the above circumstances apply in the present dispute, and that these factors indicate that the disputed domain names are abusive registrations.

g. Registrant

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

4) Discussion and Findings

a. Abusive Registration

- i. The Adjudicator concludes that the disputed domain names were registered in a manner which, at the time when the registrations or acquisitions took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights. Therefore, the Adjudicator finds that the disputed domain names, in the hands of the Registrant, are abusive registrations.

5) Decision

- a. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain names, *reedexpo.co.za* and *reedexhibition.co.za*, be transferred to the Complainant.

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CHRISTIAAN STEYN
SAIPL ADJUDICATOR
www.DomainDisputes.co.za