



Decision
ZA2017-0273
**.ZA ALTERNATE DISPUTE
RESOLUTION REGULATIONS**
(GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0273
DECISION DATE:	8 September 2017
DOMAIN NAME:	www.sundaytimes.co.za
THE DOMAIN NAME REGISTRANT:	Malkhaz Kapanadze
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Times Media (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	Moore Attorneys
THE 2 nd LEVEL DOMAIN NAME 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 "SAIPL") on **6 July 2017**. On **6 July 2017** the SAIPL transmitted by email to ZA Central Registry (ZACR), a request for the registry to suspend the domain name at issue, and on **7 July 2017** ZA Central Registry confirmed that the domain name had indeed 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 **12 July 2017**. In accordance with the Regulations the due date for the Registrant's Response was **10 August 2017**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **14 August 2017**.
- 1.3. The SAIPL appointed **Tana Pistorius** as the Senior Adjudicator in this matter on **21 August 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.
- 1.4. The SAIPL appointed **Nicole Krige**, a trainee adjudicator, to assist the Adjudicator in this matter on **23 August 2017**. The Trainee Adjudicator has submitted the Trainee Adjudicator Declaration, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2. Factual Background

- 2.1. The Complainant is Times Media (Pty) Ltd, a JSE (Johannesburg Stock Exchange) listed company, who established its Sunday newspaper, the "SUNDAY TIMES", in February 1906. This paper is distributed all over South Africa and in neighbouring countries such as Lesotho, Botswana and Swaziland.

- 2.2. The Complainant's "SUNDAY TIMES", is one of South Africa's biggest selling Sunday newspapers. The Complainant distributes and sells the "SUNDAY TIMES" newspaper online, in major retail shops, filling stations, etc.
- 2.3. The Complainant is the proprietor of eighteen registered trade marks comprising of the phrase "SUNDAY TIMES" namely:
 - 2.3.1. Trade Mark No. 1985/03771 SUNDAY TIMES in class 16;
 - 2.3.2. Trade Mark No. 1985/05949 SUNDAY TIMES in class 41;
 - 2.3.3. Trade Mark No. 1998/11237 SUNDAY TIMES LIFESTYLE in class 16;
 - 2.3.4. Trade Mark No. 1998/11238 SUNDAY TIMES LIFESTYLE in class 38;
 - 2.3.5. Trade Mark No. 1998/11239 SUNDAY TIMES LIFESTYLE in class 41;
 - 2.3.6. Trade Mark No. 2005/02141 SUNDAY TIMES TOP 100 BRANDS in class 16;
 - 2.3.7. Trade Mark No. 2005/02142 SUNDAY TIMES TOP 100 COMPANIES in class 16;
 - 2.3.8. Trade Mark No. 2005/02731 SUNDAY TIMES in class 38;
 - 2.3.9. Trade Mark No. 2005/02732 SUNDAY TIMES TOP 100 BRANDS in class 38;
 - 2.3.10. Trade Mark No. 2005/02733 SUNDAY TIMES TOP 100 COMPANIES in class 38;
 - 2.3.11. Trade Mark No. 2007/05944 SUNDAY TIMES MARKETING EXCELLENCE in class 41;
 - 2.3.12. Trade Mark No. 2009/04653 SUNDAY TIMES PRIME in class 09;
 - 2.3.13. Trade Mark No. 2009/04654 SUNDAY TIMES PRIME in class 16;
 - 2.3.14. Trade Mark No. 2009/04655 SUNDAY TIMES PRIME in class 38;
 - 2.3.15. Trade Mark No. 2011/26170 SUNDAY TIMES TRAVELLER'S CLUB in class 39;
 - 2.3.16. Trade Mark No. 2011/26729 SUNDAY TIMES TRAVELLER'S CLUB in class 38;
 - 2.3.17. Trade Mark No. 2015/18447 SUNDAY TIMES FNB SHARK TANK in class 35; and

2.3.18. Trade Mark No. 2016/14535 SUNDAY TIMES PLATINUM PLUS in class 35.

2.4 The Complainant became aware of the Registrant's website and the Disputed Domain Name on or about June 2016. A letter of demand was sent to the Registrant's email address (as provided by the WHOIS records) on 29 June 2016, demanding transfer of the Disputed Domain Name to the Complainant. No response was forthcoming by the Registrant to the aforesaid demand.

2.5 Based on the WHOIS page in respect of the Disputed Domain Name, the Registrant is **Malkhaz Kapanaz**, with postal address at 16 Metechi Street, Tibilisi, 0103, AZ.

3. Parties' Contentions

3.1. Complainant

3.1.1. The Complainant is the proprietor of various trade marks, namely: "SUNDAY TIMES", "SUNDAY TIMES LIFESTYLE", "SUNDAY TIMES TOP 100 BRANDS", "SUNDAY TIMES TOP 100 COMPANIES", "SUNDAY TIMES MARKETING EXCELLENCE", "SUNDAY TIMES PRIME", and "SUNDAY TIMES TRAVELLER'S CLUB", "SUNDAY TIMES FNB SHARK TANK", "SUNDAY TIMES PLATINUM PLUS" registered in South Africa in classes 9, 16, 35, 38, 39 and 41 respectively.

3.1.2. The "SUNDAY TIMES" newspaper has a weekly circulation of 442 018 (four hundred and forty two thousand and eighteen) and a readership of 3,436 000 (three million four hundred and thirty six thousand).

3.1.3. The Complainant advertises the "SUNDAY TIMES" extensively in all forms of media including radio and television.

3.1.4. The Complainant's "SUNDAY TIMES" newspaper has an online presence on the following websites, namely:

3.1.4.1. www.sundaytimes.co.za;

3.1.4.2. www.timeslive.co.za;

3.1.4.3. www.timesmedia.co.za

- 3.1.5. A printout from an internet archive website establishes that the domain name sundaytimes.co.za has been used since 3 December 1998.
- 3.1.6. The Complainant contends that due to its extensive exposure in the market place SUNDAY TIMES is a well-known trade mark.
- 3.1.7. The Complainant contends that the Disputed Domain Name is identical to Complainant's "SUNDAY TIMES" registered trade marks as it is visually and phonetically similar and wholly incorporates the Complainant's trade marks.
- 3.1.8. The Complainant avers that it has a domain name rights based on its prior registration of its "sundaytimes.co.za" domain name that was registered on 10 August 1998 as compared to the Disputed Domain Name which was registered on 30 October 2015. The Complainant notes that this is about thirty years after the Complainant obtained registration of most of its trade marks in respect of "SUNDAY TIMES".
- 3.1.9. The Complainant avers that the Registrant's website is being used as an advertisement platform for "Sunday Times South Africa", "Sunday Times Jobs", "Career Courses", "IT Jobs Africa" etc. The Complainant contends that the Registrant registered the Disputed Domain Name to generate website "hits" from members of the public who incorrectly believe that the Disputed Domain Name is linked or associated to the Complainant and its "SUNDAY TIMES" trade marks.
- 3.1.10. The Complainant contends that the Registrant's Disputed Domain Name is also confusingly similar to the Complainant's "SUNDAY TIMES" trade marks and domain name.
- 3.1.11. The Complainant asserts that the Disputed Domain Name amounts to "typo-piracy".
- 3.1.12. The Complainant concludes that the Disputed Domain Name in the hands of the Registrant amounts to an abusive registration, as envisaged in Regulation 3(1)(a).

3.1.12.1. The Complainant in addition to the above, also contends that the Registrant is a habitual offender who has been involved in several domain name complaints filed with the SAIPL (namely AA2016-00231; ZA2016-00245; and ZA2016-00248). The Complainant concludes that the Registrant is engaged in a pattern of making abusive registrations in terms of sub-regulation 4(1)(c) and 4(3).

3.1.13. The Complainant therefore contends that the domain name ought to be transferred to the Complainant.

3.2. Registrant

3.2.1. Regulation 18(1)(a) provides that a Registrant must respond to the statements and allegations contained in the Dispute in the form of a Response. In such a Response, the Registrant must detail any grounds to prove the domain name is not an abusive registration.

3.2.2. The Registrant did not file a Response. Accordingly, the Adjudicators must decide the matter on the Dispute (see Regulation 18(3)).

3.2.3. Regulation 28(2) provides that Adjudicators shall draw such inferences as they consider appropriate from the failure of a party to comply with a provision or requirement of the Regulations.

3.2.4. The Adjudicators draw the following two inferences:

3.2.4.1. The Registrant does not deny the facts that the Complainant asserts; and

3.2.4.2. The Registrant does not deny the conclusions that the Complainant draws from these facts.

3.2.5. Notwithstanding these inferences, the Adjudicators have analysed Complainant's version in order to satisfy themselves that the allegations contained in its Complaint are acceptable and probably true (see *Multichoice Subscriber Management v JP Botha* (Case number: **ZA2007-0010**)).

4. Discussion and Findings

4.1. Complainant's Rights

- 4.1.1. Regulation 1 defines "*rights*" and "*registered rights*" to include: "*intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law, but is not limited thereto*".
- 4.1.2. The definition of "*rights*", is therefore rather broad and is not merely limited to rights protected in terms of trade mark law.
- 4.1.3. The Complainant has established that it has statutory and common law rights in the trade mark SUNDAY TIMES.
- 4.1.4. The mere registration of a domain name does not automatically create common law, trade mark or service mark rights (see *Ebénisterie Beaubois Itée (Alex Vignola) v Reserved for Customers / MustNeed.com* (NAF Claim Number: **FA1511001645810**)). A domain name registration may establish rights but the evidence must show that the public associates the mark with Complainant's goods or services. The Complainant has shown that its domain name is strongly associated with the goods and services it offers.
- 4.1.5. Given the extent of use by the Complainant of its *www.sundaytimes.co.za* website, the magnitude upon which the "SUNDAY TIMES" newspaper is distributed (boasting a readership of over 3.4 million people) and the fact that the name SUNDAY TIMES has been in use since its establishment in 1906, at common law, the Complainant can certainly claim a reputation in the trade mark SUNDAY TIMES (whether spelt as one word, or two).
- 4.1.6. Considering the undisputed evidence adduced by the Complainant, there is no doubt that there is a substantial reputation and goodwill in the name and mark of SUNDAY TIMES. The aforesaid is specifically protected by the Trade Marks Act as well by the common

law. The Adjudicators hold that the Complainant has furnished sufficient evidence to establish that its trade mark SUNDAY TIMES is well-known.

4.1.7. The Adjudicators agree with the Complainant's contention that the Registrant's disputed domain name is identical to the Complainant's trade mark, as it is visually and phonetically similar and wholly incorporates the Complainant's trade mark. In fact, the only difference in the Complainant's registered domain name and that of the Registrant's, is that a period appears after "www".

4.1.8. The Adjudicators therefore find that the Complainant indeed has rights in respect of a name or mark which is identical or similar to the Disputed Domain Name.

4.2. Abusive Registration

4.2.1. The registration of the Disputed Domain Name, which wholly incorporates the Complainant's trade mark, by the Registrant, has the effect that the Complainant is barred from registering or using the Disputed Domain Name for itself.

4.2.2. Previous WIPO UDRP decisions have held that the unauthorised registration of a well-known trade mark as a domain name is a clear indication of bad faith in itself, even without considering other elements (see *Veuve Clicquot Ponsardin Maison Fondée en 1772 v The Polygenix Group Co* (WIPO Case No **D2000-0163**); *PepsiCo Inc v "null", aka Alexander Zhavoronkov* (WIPO Case No **D2002-0562**); *Pepsico Inc v Domain Admin*, (WIPO Case No. **D2006-0435**). The Adjudicators hold that the Disputed Domain Name was registered in bad faith.

4.2.3. Furthermore, the Complainant has directed us to three prior co.za domain disputes, in terms of which in all three matters the Registrant was found to have made an abusive registration:

- a) *Forever New Clothing (Pty) Ltd v Malkhaz Kapanadze* (Case number: **ZA2016-00231**);

- b) *Kentucky Fried Chicken International Holdings Inc v Malkhaz Kapanadze* (Case number: **ZA2016-00245**);
- c) *Times Media (Pty) Ltd v Malkhaz Kapanadze* (Case number: **ZA2016-00248**).

4.2.4. In the above mentioned decision of **ZA2016-00245**, the following was recorded in respect of the Registrant at paragraph 4.2.2 thereof:

"We have independently established that the Registrant has, in addition, been found to have made one further bad-faith registration by a UDRP panel – see the decision in DCH2016-0017 of the WIPO Arbitration and Mediation Centre. We have also independently established that the Registrant has registered numerous domains within the .co.za namespace that are clearly misspellings or adoptions of well-known brands, for example, ackemans.co.za, adidasrunning.co.za, adultword.co.za, amzon.co.za and a host of others. Adjudicators are permitted to undertake limited factual research into matters of public record, especially if this is in the interests of justice (see the decision in ZA2015-0193 at para 4.2.9)."

4.2.5. There is therefore clearly a pattern of making abusive registrations by the Registrant. Abusive registrations were found to have been made on 6 October 2016 (*Raiffeisen Schweiz Genossenschaft v. Malkhaz Kapanadze Verfahren* (Case number **DCH2016-0017**); on 7 November 2016 (*Kentucky Fried Chicken International Holdings Inc v Malkhaz Kapanadze* (Case number: **ZA2016-00245**)); and on 7 December 2016 (*Times Media (Pty) Ltd v Malkhaz Kapanadze* (Case number: **ZA2016-00248**)).

4.2.6. Regulation 4(3) provides that there shall be a rebuttable presumption of abusive registration if the complainant proves that the registrant has been found to have made an abusive registration in three or more disputes in the 12 months before the dispute was filed.

- 4.2.7. The Adjudicators do not believe that Regulation 4(3) presumption is limited only to .za dispute decisions. It is all too easy for a Registrant to habitually make abusive registrations over various domains. Regulation 4(3) simply creates a rebuttable presumption once there is evidence of a pattern. It remains open to a Registrant to respond to evidence supporting such patterns, as the presumption is a rebuttable one.
- 4.2.8. Accordingly, we find that the Disputed Domain Name www.sundaytimes.co.za is an abusive registration. It is a domain name which will lead to deception and confusion and will unfairly disrupt the business of the Complainant. It also takes unfair advantage of the Complainant's mark and prevents the Complainant from exercising its rights in that the Complainant is prevented from registering the disputed domain name.

5. Decision

- 5.1. For all the foregoing reasons, in accordance with Regulation 9, we order that the domain name, www.sundaytimes.co.za be transferred to the Complainant.

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