

## Decision

**ZA2017-0289**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2017-0289</b>
DECISION DATE:	<b>5 January 2018</b>
DOMAIN NAMES:	<b>siemenspeak.co.za siemenstrading.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Bamaketse Pheladi Molele</b>
REGISTRANT'S LEGAL COUNSEL:	<b>N/A</b>
THE COMPLAINANT:	<b>Siemens Aktiengesellschaft</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Mr. G M du Plessis, Adams &amp; Adams</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA )</b>

## 1 Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **25 October 2017**. On **26 October 2017** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain names at issue, and on **26 October 2017** ZACR confirmed that the domain names have 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 **30 October 2017**. In accordance with the Regulations the due date for the Registrant's Response was **27 November 2017**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **29 November 2017**.
- 1.3 The SAIPL appointed **Tana Pistorius** as the Adjudicator along with **Liézal Mostert** as the Trainee Adjudicator in this matter on **11 December 2017**. The Adjudicators have submitted the Statements of Acceptance and Declaration of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

## 2 Factual Background

- 2.1 The Complaint is in respect of the Disputed Domain Names ***siemenspeak.co.za*** and ***siemenstrading.co.za***.
- 2.2 The Complainant is Siemens Aktiengesellschaft, a German company of Wittelsbacher Platz 2, Munich, Federal Republic of Germany. The Complainant is active in the fields of electrification, automation, digitisation and healthcare solutions.

2.3 The Complainant was founded in 1847 and commenced use of the mark SIEMENS in South Africa in 1860 when it supplied telegraph equipment for the line from Cape Town to Simons Town. The Complainant currently employs 1200 employees in South Africa and more than 362 000 employees worldwide. Its South African headquarters are located in Johannesburg and it has 6 corporate offices and 5 manufacturing and service sites in South Africa.

2.4 The Complainant is the proprietor of six registered trade marks comprising of the word "SIEMENS" namely:

- Trade mark Number 1964/02710 in class 7;
- Trade mark Number 1964/02711 in class 9;
- Trade mark Number 1964/02712 in class 10;
- Trade mark Number 1964/02713 in class 11;
- Trade mark Number 1972/00329 in class 35; and
- Trade mark Number 1972/00331 in class 40.

2.5 The Complainant registered the domain name **siemens.com** on 29 September 1986, as well as the domain name **siemens.co.za** on 14 August 1996.

2.6 The Registrant registered the Disputed Domain Names **siemenspeak.co.za** on 9 April 2017 and **siemenstrading.co.za** on 6 February 2017 respectively.

2.7 The Complainant became aware of the Registrant and the Disputed Domain Names **siemenstrading.co.za** and **siemenspeak.co.za** during June 2017. The Complainant sent a letter of demand to the Registrant on 27 June 2017. No response to the letter of demand was received and a further letter was addressed to the Registrant on 17 July 2017.

### 3 Parties' Contentions

#### 3.1 Complainant

3.1.1 The contentions of the Complainant can be summarised as follows:

3.1.1.1 it registered the trade mark SIEMENS as a word mark in South

Africa in classes 7, 9, 10, 11, 35 and 40;

- 3.1.1.2 its earliest trade mark registration dates back to 4 August 1964 and predates the registration of the Disputed Domain Names;
- 3.1.1.3 it is the proprietor of 46 trade mark registrations in South Africa for the mark SIEMENS and marks incorporating SIEMENS such as SIEMENS CLIMATE SOLUTIONS, SIEMENS CARING HANDS & device, SIEMENS INTEGRATED SERVICE MANAGEMENT, SIEMENS IT CARE PLAN, SIEMENS logo etc;
- 3.1.1.4 it has made substantial use of its SIEMENS trade mark internationally and in South African and it has, therefore, acquired, in addition to its statutory rights, strong common law rights in its SIEMENS trade mark;
- 3.1.1.5 its SIEMENS trade mark furthermore qualifies as a well-known trade mark in terms of the Trade Marks Act no 194 of 1993;
- 3.1.1.6 its domain name **siemens.com** resolves to the global website of the Complainant and the domain name **siemens.co.za** resolves to the South African extension of the Complainant's aforementioned global website at [www.siemens.com/za](http://www.siemens.com/za);
- 3.1.1.7 the Disputed Domain Names **siemenspeak.co.za** and **siemenstrading.co.za** wholly incorporates the Complainant's well-known SIEMENS trade mark and is, therefore, identical or confusingly similar to the Complainant's SIEMENS trade mark;
- 3.1.1.8 at least one of the Disputed Domain Names resolved to an active website at [www.siemenstrading.co.za](http://www.siemenstrading.co.za) on which a business named Siemens Peak Trading and Projects was, *inter alia*, offering for sale SIEMENS products such as SIEMENS street lights;

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- 3.1.1.9 it submits that the SIEMENS products advertised on the website were not genuine or authorised SIEMENS products and the business operating from the website was defrauding members of the public by dishonouring orders and alleging that it is related to the Complainant when this was not the case;
- 3.1.1.10 it became aware that the Disputed Domain Name **siemenstrading.co.za** no longer resolved to an active website on 20 July 2017. The Complainant avers that the Disputed Domain Name **siemenspeak.co.za** is also currently inactive;
- 3.1.1.11 the Registrant is intentionally trying to benefit from the goodwill and reputation vesting in the SIEMENS trade mark for commercial gain through the registration and use of the Disputed Domain Names;
- 3.1.1.12 the use of the Disputed Domain Names amounts to trade mark infringement in terms of Sections 34(1)(a) or, in the alternative, Section 34(1)(b) and/or Section 34 (1)(c) of the Trade Marks Act;
- 3.1.1.13 the registration and use of the Disputed Domain Names amount to passing-off in terms of the common law;
- 3.1.1.14 the Disputed Domain Names amount to offensive registrations as they previously resolved to a website that was used to defraud members of the public; and
- 3.1.1.15 that the following circumstances as set out in Regulation 4 are present, namely that:
- the Registrant has no legitimate rights or interest in the Disputed Domain Names and that they were registered in bad faith;
  - the registration of the Disputed Domain Names has the effect of blocking the Complainant from registering the

- corresponding domain names;
- the conduct of the Registrant amounts to an unfair disruption of the Complainant's business;
  - the Registrant is preventing the Complainant from exercising its rights in its SIEMENS trade mark;
  - use of the Disputed Domain Names would lead people or businesses to believe that the Disputed Domain Names are registered to, operated or authorised by, or otherwise connected to the Complainant; and
  - that use of the Disputed Domain Names will mislead and/or deceive consumers.

## 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 Disputed Domain Name is not an abusive registration.
- 3.2.2 The Registrant did not reply to the Complainant's contentions and has not disputed the Complainant's evidence or submissions. 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 Notwithstanding these inferences, the Adjudicators have analysed the 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 [ZA2007-0010]).

## 4 Discussion and Findings

### 4.1 Complainant's Rights

- 4.1.1 The Complainant is required to show, on a balance of probabilities, that it has rights in respect of a name and/or mark and that the name or mark is identical or similar to the Disputed Domain Names.
- 4.1.2 The Complainant is the proprietor of various trade mark registrations for the mark SIEMENS in South Africa. Details of the registrations were attached to the Complaint and the trade mark registrations appear to be *prima facie* valid and in force.
- 4.1.3 The Complainant submitted that it has established common law rights in the mark SIEMENS by virtue of the use made thereof in South Africa. The Complainant furthermore submitted that its SIEMENS mark qualifies as a well-known trade mark in South Africa.
- 4.1.4 The Complainant has provided evidence of the longstanding use that it has made of the name and mark SIEMENS internationally and in South Africa. It has further presented evidence which appears, in the absence of any challenge, to support an inference that the Complainant and its SIEMENS mark is known to a substantial number of members of the public in South Africa.
- 4.1.5 The Registrant did not challenge or place any of the evidence or rights claimed by the Complainant in dispute. The Adjudicators, therefore, accept that the Complainant has rights under statutory and common law to the mark SIEMENS and that this mark is well-known in South Africa.
- 4.1.6 The Disputed Domain Names both wholly incorporate, as the dominant and memorable element, the Complainant's SIEMENS trade

mark. Various decisions have held that where a Complainant's mark is included in its entirety in a Disputed Domain Name, this is sufficient for a finding of identical or confusing similarity, despite the addition of other words. The Adjudicators refer specifically to The Car Trader (Pty) Ltd v Junk Mail Publishing (Pty) Ltd [ZA2008-0018], as well as Experian Information Solutions, Inc. v. Credit Research, Inc. [WIPO/D2002-0095] and Oki Data Americas, Inc. v. ASD, Inc. [WIPO/D2001-0903].

4.1.7 The word "TRADING" which is added to the Disputed Domain Name ***siemenstrading.co.za*** is generic and does not serve to distinguish the Disputed Domain Name from the Complainant's SIEMENS trade mark. This is supported by various local and international decisions which have held that the addition of a generic word to a trade mark is not sufficient to render a Disputed Domain Name distinctive from a Complainant's trade mark. In support hereof, see Barloworld Limited & Barloworld Africa (Pty) Ltd v David Godfrey [ZA2012-0120] and Telkom SA Limited Cool Ideas 1290 CC [ZA2007-0003] as well as the international decisions referred to therein.

4.1.8 While the Disputed Domain Name ***siemenspeak.co.za*** contains the additional word "PEAK", the Adjudicators are of the view that this does not detract from the overall impression that the Disputed Domain Name is similar to the Complainant's well-known trade mark. The SIEMENS trade mark remains the dominant element of the Disputed Domain Name. In this regard reference is made to LEGO Juris A/S v. PDAWerks [WIPO/D2013-0918] where the domain name ***legoolympics.com*** was found to be similar to the mark LEGO and it was held that the suffix does not detract from the overall impression. Anyone who sees the Disputed Domain Name is bound to mistake it for a domain name related to the Complainant. Reference is further made to Wikimedia Foundation, Inc. v. Domain Manager, USA Domain Manager [WIPO/D2014-0920] where it was held that the test



for confusing similarity involves a comparison between the trade mark and the Disputed Domain Name to determine likelihood of Internet user confusion and that, in order to satisfy this test, the relevant trade mark would generally need to be recognisable as such within the domain name, with the addition of common, dictionary, descriptive, or negative terms typically being regarded as insufficient to prevent threshold Internet user confusion.

4.1.9 The Adjudicators find that, as the trade mark SIEMENS remains recognisable, the Disputed Domain Names are confusingly similar to the trade mark. Of course, the test here is simply similarity, which involves a lower standard of comparison. See Capitec Bank Limited v Capstone Property Holdings (Pty) Ltd [ZA2017-00285].

4.1.10 Consequently, the Adjudicators hold that the Complainant has rights in the trade mark SIEMENS and that the Disputed Domain Names ***siemenstrading.co.za*** and ***siemenspeak.co.za*** are similar to the mark SIEMENS.

## 4.2 Abusive Registration

4.2.1 In terms of Regulation 3(1) the Complainant has to show that the Disputed Domain Names in the hands of the Registrant are abusive registrations. An abusive registration is defined in terms of Regulation 1 as a domain name that 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 has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

4.2.2 Various decisions, such as Federation Internationale De Football Association (FIFA) vs. X Yin [ZA2007-0007], have held that a positive intention to abuse the rights of the Complainant is not necessarily required. It is sufficient that the effect or consequence is such that

the Complainant's rights are abused.

- 4.2.3 In the present matter the Complainant alleges that there was positive intention on the part of the Registrant to register and use the Disputed Domain Names in a manner that intentionally abused the Complainant's rights.
- 4.2.4 The Complainant provided evidence that the Disputed Domain Names were used by a business which advertised that it was selling genuine and authorised SIEMENS products when this was not the case. The Complainant furthermore submitted that this business defrauded members of the public by dishonouring orders placed for products they believed to be SIEMENS products. In this regard, the Complainant provided a copy of an affidavit deposed to by Hafieza Khan.
- 4.2.5 The Complainant also provided evidence that the Disputed Domain Names were used in relation to goods to which the Complainant's SIEMENS trade mark registrations extend. Even in the event that it could be found that the Disputed Domain Names were not used to defraud intentionally members of the public, the Disputed Domain Names were clearly used in competition with the business of the Complainant.
- 4.2.6 In light of the manner in which the Disputed Domain Names were used and given the similarities between the Disputed Domain Names and the Complainant's trade mark, the Adjudicators agree with the submissions of the Complainant that Internet users visiting the website to which the Disputed Domain Names resolved would be deceived and/or confused into believing that the website is operated by the Complainant or in some manner affiliated with the Complainant when this is not the case.
- 4.2.7 The Registrant benefitted, or intended to benefit, from the reputation

and goodwill that vests in the well-known SIEMENS trade mark and was seemingly intentionally trying to create a likelihood of deception and/or confusion with the Complainant's trade mark.

4.2.8 The Disputed Domain Names were seemingly registered and used with the intention to draw Internet users away from the Complainant, either to defraud members of the public or, alternatively, to benefit for commercial gain from the reputation and goodwill that vests in the Complainant and its SIEMENS trade mark.

4.2.9 Although the Disputed Domain Names currently do not resolve to an active website, they once resolved to active Universal Resource Locators (URLs). According to information provided on the *Internet Archive* (the Wayback Machine) URLs were captured for both the Disputed Domain Names, namely **simenspeak.co.za** on 25 May 2017 and 1 July 2017 and **simenstrading.co.za** on 9 June 2017 (<https://web.archive.org/web/20170701071651/http://www.siemenspeak.co.za:80/>; <http://www.simenstrading.co.za/robots.txt>). Notwithstanding, the comments above apply equally to the current status of the Disputed Domain Names as the effect of the continued registration of the Disputed Domain Names is that they take unfair advantage of, and are detrimental to the Complainant's rights.

4.2.10 The Adjudicators, therefore, find that the Disputed Domain Names in the hands of the Registrant amount to abusive registrations.

4.2.11 The Complainant also advanced the grounds set out below in support of the Complaint.

4.2.11.1 The Registrant has no legitimate claim in respect of the Disputed Domain Names and the Registrant acted in bad faith when registering the Disputed Domain Names. The Registrant did not file any Response and did not present any arguments to indicate that he has any claim to the

Disputed Domain Names. It has been held that opportunistic bad faith in registering a domain name can be inferred where a domain name, which is obviously connected to a well-known product, is registered by someone with no connection thereto. In support hereof, the Adjudicators refer to Encyclopaedia Britannica v La Porte Holdings [WIPO/D2005-0866], as well as Veuve Clicquot Ponsardin, Maison Fondée en 1772 v The Polygenix Group Co. [WIPO/D2000-0163] The uncontested facts support the above inference that the Registrant has no legitimate claim to the Disputed Domain Names and registered them in bad faith.

4.2.11.2 The registration of the Disputed Domain Names has the effect that the Complainant is barred from registering or using the identical domain names. While there is no evidence that the Disputed Domain Names were registered primarily to block the Complainant from registering corresponding domain names, this effect is present. The Adjudicators, therefore, also find in favour of the Complainant on this ground as well and refer to the decisions of Barloworld Limited and Barloworld Africa (Pty) Ltd v David Godfrey [ZA2012-0120] and Multifix (Pty) Ltd v Leelan Srugaser [ZA2013-0132].

4.2.11.3 The third ground advanced under the list of factors as set out in Regulation 4 is that the Registrant's conduct unfairly disrupts the Complainant's business. The use of Disputed Domain Names which are similar to the Complainant's SIEMENS mark will mislead consumers and divert consumers away from the Complainant to the Registrant's website. Having regard to the manner in which the Disputed Domain Names were used, this factor appears to

be present. In accordance with the precedent set by numerous previous decisions, an unfair disruption of the Complainant's business can also be inferred by the conduct of the Registrant in registering a variation of the Complainant's mark with merely a generic or descriptive word added to the mark as in this present matter. See the decision of Telkom SA Ltd v Cool Ideas 1290 CC [ZA2007-0003] in this regard.

4.2.11.4 The Complainant contends that the Registrant, through the registration of the Disputed Domain Names, is preventing the Complainant from exercising its rights in its SIEMENS trade mark. In light of the findings in Netconnect CC v Millennium Desktop Services (Pty) Ltd t/a Millennium Computer Services [ZA2009-0035], the Adjudicators agree that the effect of the registration of the Disputed Domain Names is that the Complainant is prevented from using the corresponding domain names to attract customers or to expand its business. Therefore, it is prevented from exercising its rights.

4.2.11.5 In addition to the above, the Complainant submitted that the use of the Disputed Domain Names would lead people and/or businesses to believe that the Disputed Domain Names are registered to, operated or authorised by, or otherwise connected to the Complainant. The Adjudicators agree with the submissions made by the Complainant based on the uncontested facts, in particular the use made of the Disputed Domain Names to sell SIEMENS products which are not genuine and the similarities between the Disputed Domain Names and the Complainant's mark.

4.2.12 Accordingly, the Adjudicators find that the Complainant has proven,

on a balance of probabilities, that the Disputed Domain Names are abusive registrations in the hands of the Registrant.

#### 4.3 Offensive registration

- 4.3.1 Regulation 1 defines an offensive registration as a domain name in which the Complainant cannot necessarily establish rights but of which the registration is contrary to law, *contra bonos mores* or likely to give offence to any class of persons. Regulation 4(2) provides that an offensive registration may be indicated if the domain name advocates hatred that is based on race, ethnicity, gender or religion and/or that constitutes incitement to cause harm.
- 4.3.2 Regulation 4(2) mirrors the constitutional limitations on the right to freedom of expression. It follows that the phrase "contrary to law" in the definition of an offensive registration should be interpreted purposively (*inter alia* with reference to Regulation 4(2)) and should not be read to literally mean "any law" (in this case the common-law offence of fraud).
- 4.3.3 The .za Domain Name Authority (ZADNA) notes that "**men-are-dogs.co.za**" is an example of an offensive registration as it incites hatred against a certain gender (see <https://www.zadna.org.za/content/page/what-constitutes-a-dispute/>).
- 4.3.4 It should be noted that for a domain name to be deemed offensive its registration must be contrary to law, *contra bonos mores* or likely to give offence to any class of persons. The "offensiveness" does not relate to the "use" that is made of the domain name. The Complainant's contention that the Disputed Domain Names amount to offensive registrations as they previously resolved to a website that was used to defraud members of the public is not supported. Furthermore, should the Disputed Domain Names be held to

constitute an offensive registration they must be deleted and their future registration must be prohibited (see Regulation 9(b)). This can hardly be said to be applicable to the Disputed Domain Names.

4.3.5 In view of the above, the Adjudicators hold that the Disputed Domain Names are not offensive registrations.

## 5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicators order that the domain names, ***siemenstrading.co.za*** and ***siemenspeak.co.za***, be transferred to the Complainant.

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