

## APPEAL DECISION

CASE NUMBER:	<b>ZA2021-0419</b>
DECISION DATE:	<b>17 January 2022</b>
DOMAIN NAME:	<b><i>thedonpizza.co.za</i></b>
THE DOMAIN NAME REGISTRANT / APPEAL RESPONDENT:	<b>Don Millar</b>
REGISTRANT'S LEGAL COUNSEL:	<b>D'Archy-Herrman Raney Inc - Steve Raney</b>
THE COMPLAINANT / APPELLANT:	<b>Khan's Chemical Industry CC</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Adams &amp; Adams - Somayya Khan</b>
THE 2 <sup>nd</sup> LEVEL DOMAIN NAME ADMINISTRATOR:	<b>ZA Central Registry (ZACR)</b>

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## 1) Procedural History, Factual Background and Parties' Contentions

- a. This Appeal is against the Decision of the single Adjudicator, **Jeremy Speres** (assisted by a trainee Adjudicator, Zama Buthelezi), dated **19 October 2021**, in which the initial complaint was refused (the "Decision").
- b. The procedural history, factual background and parties' contentions leading up to the Decision are set out sufficiently in the Decision and, for the sake of brevity, shall not be repeated herein.
- c. In accordance with the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), the due date for the Appellant to lodge a Statement of Intention to Appeal was **25 October 2021**. The Appellant (Complainant in the first instance) lodged a Statement of Intention to Appeal with the South African Institute of Intellectual Property Law (the "SAIIPL") on **25 October 2021**. On **15 November 2021** the Appellant lodged its Appeal Notice containing its Grounds of Appeal. The SAIIPL verified that the Appeal Notice satisfied the formal requirements of the Regulations and the SAIIPL's Supplementary Procedure. The SAIIPL forwarded a copy of the Appeal Notice to the Appeal Respondent (Registrant in the first instance) on **16 November 2021**.
- d. In accordance with the Regulations, the due date for the Appeal Respondent to lodge its Appeal Notice Response was **30 November 2021**, whereon the Appeal Respondent requested an extension until **10 December 2021** – which was granted by the SAIIPL. On **10 December 2021** the Appeal Respondent submitted its Appeal Notice Response. The SAIIPL verified that the Appeal Notice satisfied the formal requirements of the Regulations and the SAIIPL's Supplementary Procedure. The SAIIPL acknowledged that a copy of the Appeal Notice Response was sent to the Appellant by the Appeal Respondent on **10 December 2021**.
- e. The SAIIPL appointed an Appeal Panel consisting of **Christiaan Steyn**, **Vanessa Ferguson** and **Mike du Toit** (the "Panel") in this matter on **17 December 2021**. Each member of the Panel has submitted a

Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

## 2) Decision under Appeal

- a. The Adjudicator, in the Decision, held that the disputed domain name ***thedonpizza.co.za*** incorporates the first and dominant element of the name and mark **THE DONS PIZZA & CONES** (in which the Complainant has rights), being the element **THE DONS**, and thus found that the disputed domain name is similar to the name and mark in which the Complainant has rights.
- b. The Adjudicator held that the Appellant did not offer sufficient evidence to support its claims of common law rights based on goodwill and reputation in the mark. Accordingly, the Adjudicator held that, on a balance of probability, there was no common law rights enjoyed by the Appellant in the mark **THE DON**.
- c. The Adjudicator held that there was no evidence in this matter that the Appeal Respondent was aware of the Appellant's mark at the time of registration of the domain name, or at any time prior to the Appellant's letter dated 24 December 2020.
- d. The Adjudicator held that there was nothing in the way in which the Appeal Respondent has used the domain name, or the way in which it has traded, that would suggest any familiarity with the Appellant's offering or mark, or any attempt to take unfair advantage thereof.
- e. The Adjudicator further held that, apart from the shared **THE DON** element, which was held to be diluted in the relevant industry, there are no obvious similarities between the get-up or trading styles of the parties.
- f. Accordingly, the Adjudicator held that the Appellant did not meet the onus of the provisions of Regulation 4(1)(a), specifically that intent on the side of the Appeal Respondent was present.

- g. The Adjudicator therefore held that the Appellant's case was one of "innocent trade mark infringement", as the Appeal Respondent has registered and used a domain name without any knowledge of the Appellant's mark, let alone any intention to take unfair advantage thereof, and without the Appellant's enjoying any reputation in its mark, the Complainant was held to rely in that respect on Regulation 4(1)(b).
- h. The Adjudicator further held that the Appeal Respondent succeeded in making out a case under Regulation 5(a)(i).
- i. The Adjudicator thus held that although the disputed domain name may be similar to the mark in which the Appellant has rights, the domain name is, in the hands of the Appeal Respondent, not an abusive registration and that it has not been used in a manner that takes unfair advantage of or is unfairly detrimental to the Appellant's rights. Accordingly, the Adjudicator refused the Dispute.

### **3) Parties' Submissions on Appeal**

#### **a. Appellant**

The Appellant submits that the Adjudicator erred in various instances, set out as follows:

- i. In the assessment of the evidence offered by the Appellant in the Complaint and in considering the Appellant's rights strictly under the requirements of an action for passing off, submitting that such is contrary to the intention or requirements of the Regulations.
- ii. In not finding that the evidence provided by the Appellant in support of the Complaint had met and satisfied all the criteria stipulated by Regulation 3(a).
- iii. Not considering the evidence attached to the Appellant's reply in making a factual finding that the Appellant only commenced using the disputed domain name in 2018.

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- iv. In not considering all of the Appellant's intellectual property rights, including those in the registered trade mark no. 2012/30507 **THE DON PIZZA & CONES** in class 43 and pending trade mark application nos. 2020/16201 **THE DON** in class 30 and 2021/08148 **THE DON** in class 43.
  - v. In not taking account thereof that the Appellant commenced operations of its restaurant in June 2020 under the **THE DON PIZZERIA** mark, or the fact that the Appellant registered its Instagram account under the name @thedonpidza on 1 October 2020.
  - vi. Made contradicting statements in so far as whether the Appellant has rights, specifically citing the fact that the Adjudicator confirmed in the Decision that the Appellant "*has statutory rights in respect of a mark that is similar to the Domain Name*" (Para 4(a)(iii)), thereby erring in finding no registered or common law rights (Para 4(b)(v) and (vi)).
  - vii. In not efficiently examined the Appellant's trade mark registration no. 2012/30507 **THE DONS PIZZA & CONES** in class 43, even though the Appellant was the bona fide proprietor of the trade mark registration prior to the date of the Complaint and relied on this registration in the Complaint, claiming that this fact has largely been ignored and not properly considered by the Adjudicator.
  - viii. In holding that there is a requirement of intention to find abuse, stating that such a requirement is incorrect and render most of the decisions ordering the transfer of disputed domain names under summary judgement, for instance, foul of the Regulations, further stating that "positive intention" to abuse rights is not a requirement intended by the Regulations.
  - ix. In reasoning that "intention" is different to "knowledge" and that the reference to "positive intention" does not rule out knowledge as a pre-requisite and in placing reliance on the **Chivas Brothers UK case** where the adjudicator in that case could not have meant

that "intention" is not required. Reference which only justifies the Adjudicator's findings to the extent that it is an abusive registration and finds no application in an "abusive use" situation.

- x. In its assumptions about the use of the domain name before and after the date of the Appellant's letter of demand without the availability of any supporting evidence.
- xi. In holding that the Appeal Respondent lacked intention.
- xii. In not finding the likelihood of confusion between the domain name and the mark, in which the Appellant has rights, on the part of customers accessing the domain name.
- xiii. In not properly considering the evidence of actual confusion in the trade and rejecting the evidence of actual confusion on the basis that this arose through a business associate.
- xiv. In not properly considering Regulation 4(1)(b).
- xv. In his finding that the Appeal Respondent has shown that he has satisfied the requirements of Regulation 5(a)(i), specifically in making assumptions about the use of the domain name by the Appeal Respondent without any supporting evidence and on this basis decided that the Appeal Respondent satisfied the requirements of the said Regulation.
- xvi. In conducting its own online investigations, thereby going beyond the scope of its powers as Adjudicator in an attempt to find evidence to support the Appeal Respondent's case.
- xvii. In referring to the Appellant's mark as a diluted mark.
- xviii. In referring to the Appellant's commercial premises as being situated at "BP filling station in Crown Mines, Johannesburg ", when in fact it is located at Cnr. Crownwood & Main Reef Roads, Fordsburg, Johannesburg. The reference to the Complainant's other commercial interests, in particular, Krusties Bakery is of no relevance to the matter at hand.

- xix. In considering that the Appellant traded from a "*filling station under joint brands*".
- xx. The Adjudicator has erred in taking the Appeal Respondent's unsubstantiated assertion to be the factual situation.
- xxi. In stating that "the Registrant's (Appeal Respondent's) company's restaurants" used the provided logo on "*social media accounts, billboards and other marketing material*" (Para 2(h)), where no evidence was offered to support these assertions.

**b. Appeal Respondent**

The Appeal Respondent submits that the said submissions shall be confirmed to certain issues and stands by its Response to the Complaint. Such submissions are as follows:

- i. That the Appellant's claim that it does not operate a business in Fordsburg (which, after referring to the Complaint and Response was interpreted to be intended to refer to "Crown Mine") is misleading and false, as the Appellant does have business premises at a Fordsburg location.
- ii. That the Appellant's claims that it does not trade under "joint brands" is inaccurate, reiterating that the Appellant trades under various names at the same location.
- iii. That the Appellant deliberately misleads the Panel in its Appeal Notice.
- iv. That the Appellant did not secure rights in 2012.
- v. That the Appellant's reliance on *locus standi* authority is misplaced and irrelevant in the context of the Appeal.
- vi. That the Appellant misread Regulation 3(a) and that the requirements for abusiveness set in Regulation 4 was not met.
- vii. That the Adjudicator was correct in placing less emphasis on the registered mark of the Appellant, stating that at the time of its

registration of the domain name, the Appellant was not the proprietor of such mark.

- viii. That there exists uncertainty towards the Appellant's statement of "*vulnerable to reconsideration*", as well as state that the Adjudicator was correct in distinguishing between "rights" and "registered rights".
- ix. That the Adjudicator was correct in its findings on abusive registrations, and that the Appellant is erroneously attempting to read "abusive use" into "abusive registration".
- x. That the domain name was registered before the Appellant's letter of demand, yet that the Appellant apparently states the contrary in an attempt to mislead the Panel.
- xi. That the Appellant offered no evidence of confusion other than an affidavit from a business associate and that there has been no confusion.
- xii. That there is generic use of the word "DON" in trade.
- xiii. That there exists no restaurant trading under the name THE DON PIZZARIA, and only a business trading under the KRUSTIES BAKERY name where pizza is also available.
- xiv. That the name "THE DON" is diluted.

#### **4) Discussion and Findings**

- i. At the onset the Panel wishes to address certain aspects not necessarily all bearing relevance to the merits of this dispute, yet brought forward through the parties' papers herein – all unreasonably relevant to the administrative proceedings in this Appeal. These include the following:
  1. Various statements were made in the Appeal Notice which, in the view of the Panel, alluded to an accusation of gross impartiality on the side of the Adjudicator. Although not specifically listed as a ground for appeal, the Panel



considered such and found that the Adjudicator was at all times impartial and professional in executing his duties and powers as an Adjudicator in this Decision. Accordingly, any statement and/or allegations, either explicit or allusive, are rejected out of hand.

2. There appears to be a dispute on the location of the Appellant's business. After referring to all submitted documents by both parties, as well as conducting our own limited factual research into this matter, the Panel found that the locations referred to are all one and the same, and that such business location of the Appellant in fact exists at the provided address, being Cnr Crownwood & Main Reef Roads, Fordsburg, where a BP filling station is also located. Furthermore, the geographical locations of Fordsburg and Crown Mine appear to be adjacent to each other and the said location is situated on the boundary thereof. The Panel accordingly disregards all statements to this effect by both parties as mere miscommunication and regarded this point as clarified and settled.
3. The Appellant's statement that the Adjudicator exceeded his powers by conducting an online investigation is rejected out of hand. Adjudicators are in fact permitted to undertake factual research into matters, especially if this is in the interests of justice. See ZA2015/0193. However, in so far as it may be relevant, the Panel did not consider the evidence of the online investigation conducted by the Adjudicator.
4. Both parties made accusations that the other intentionally made efforts to mislead the Adjudicator and the Panel. Although the Panel confirms that there are some inconsistencies throughout both parties' papers, none thereof were found to be intentionally misleading. Accordingly, such claims were rejected out of hand.

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- ii. In order to make a finding that the disputed domain name is an abusive registration, the Panel is required to find that the Appellant 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 Appellant has rights in respect of a name and mark;
  2. that is identical or similar to the disputed domain name; and
  3. that, in the hands of the Appeal Respondent, the disputed domain name is an abusive registration.
- iii. An abusive registration is defined in the definitions of Regulation 1, to mean a domain name 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 Appellant's rights; or
  2. has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Appellant's rights.

**a. Substantive Aspects**

- i. Turning to the substantive aspects of this Appeal, in terms of Regulation 11(8) an Appeal proceeds on the basis of a full review of the matter. The Panel is thus obliged to consider this matter afresh.
- ii. As such, the Panel has carefully perused the Appeal documents, as well as all the original evidence submitted herein, and has fully considered the facts and contentions set out therein.
- iii. The Panel is further *ad idem* in its Decision that the Appellant has established a right in respect of the name and that the disputed domain name is similar to the Appellant's right. The Panel is not *ad*

*idem* in its decision as to whether, in the hands of the Appeal Respondent, the disputed domain name is an abusive registration. The dissenting decision by Mr. Christiaan Steyn, is set out hereunder separately.

#### **b. Rights in Respect of Name and Mark**

- i. In terms of Regulation 1, the term “rights” is widely defined and includes intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law - but are not limited thereto.
- ii. As has been decided in the South African appeal decisions of ZA2009-0030 (*seido.co.za*), ZA2011-0077 (*xnets.co.za*) and ZA2019-0378 (*istore.co.za*), 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. See also ZA2012-0115 (*konftel.co.za*), ZA2014-0168 (*heliocol.co.za*) and ZA2019-0357 (*gameready.co.za*).

#### **c. Does the Appellant Have Rights?**

- i. There is no dispute that the Appellant has registered rights in its figurative mark **THE DONS PIZZA & CONES** in South Africa in the form of a 2012 trade mark registration, and therefore enjoys statutory rights in this specific mark. This mark is however not identical to the disputed domain name, and as such we are to establish whether it is at least similar thereto (our emphasis).
- ii. It is further not required that these rights pre-date the 2020 registration of the disputed domain name. The Appellant’s rights only need to exist on the date of the Complaint, which it does in this instance (our emphasis). See ZA2008-0020 (*mixit.co.za*), ZA2016-0245 (*kfclists.co.za*) and ZA2019-0378 (*istore.co.za*). Whether the disputed domain name is abusive is another enquiry.
- iii. Although various claims are further made by the Appellant of common law rights in the names and marks **THE DON** and **THE**

**DON PIZZARIA**, we agree with the Adjudicator that the evidence provided in support thereof was not sufficient to corroborate such claims, nor for the Panel to find the existence of reputation and goodwill in these specific names and marks in their own right (*ie* in **THE DON** and **THE DON PIZZARIA**). Further reference can herein be made to pending trade mark applications for **THE DON** which the Appellant has filed in 2020 and 2021 respectively, both predating the date of the Complaint. In so far as the Appellant relies on “rights” flowing from these pending trade mark applications, this is rejected as any trade mark application which has not been used, and in this case, of which no sufficient evidence of use was submitted, remains a mere *spes* of future rights.

- iv. Irrespective of this lack of common law rights in **THE DON** and **THE DON PIZZARIA** being established by the Appellant, the existence of statutory rights in registered trade mark **THE DONS PIZZA & CONES** cannot be overlooked (our emphasis). Accordingly, the Panel finds that the Appellant has proven, on a balance of probabilities, that it has rights in respect of the name and composite mark **THE DONS PIZZA & CONES**, which rights would be sufficient herein if found to be similar to the domain name.
- v. Furthermore, the Panel takes cognisance of the fact that the Appellant was, at the time of the Complaint, not recorded as the proprietor of South African Trade Mark Registration No. 2012/30507 **THE DONS PIZZA & CONES** in class 43 – a fact that was explained by the Appellant in the Complaint (Para 11.1.1.3). The said mark was however formally assigned in the South African Trade Marks Office to the Appellant, and such assignment was formally recorded on the Trade Marks Register on 3 May 2021. It is further trite that this assignment would effectively provide the Appellant with statutory rights in the mark from the effective date of said assignment, which is not specifically provided by the

Appellant in its evidence lodged in support of the Complaint. It should further also be noted that – taking the Panel’s knowledge of the administrative processes of the Trade Marks Office into account – for the said assignment to have been recorded on the mentioned date, the required document for such assignment would have been completed and lodged at the Trade Marks Office well before at least the date of lodging the complaint on 9 April 2020. Thus, any argument to the contrary must be rejected out of hand

**d. Is the Name and Mark Identical or Similar to the Disputed Domain Name?**

- i. Now, as was established above, the Appellant has rights in the name and mark **THE DONS PIZZA & CONES**, a composite mark consisting of a combination of words and a graphic element. The question however is whether this name and mark, in which the Appellant has rights, is similar to the disputed domain name. Herein, when comparing the mark against the domain name, the dominant elements of both are considered. Such elements being “THE DONS” (on the side of the mark) and “thedon” (on the side of the domain).
- ii. As stated by the Adjudicator in the Decision, it is trite that where a dominant element of a mark is recognisable in the disputed domain name, the latter will generally be considered similar under the Regulations – as is clear in this instance. See ZA2011-0093 and WIPO Overview 3.0 at Para 1.7.
- iii. Therefore, when considering the indicated dominant elements, the Panel finds that the mark **THE DONS PIZZA & CONES** (in which the Appellant has rights) is similar to the disputed domain name.

**e. Is the Disputed Domain Name an Abusive Registration?**

- i. Now, as it was established that the Appellant does have rights in the name and composite mark **THE DONS PIZZA & CONES**, and that such mark is similar to the disputed domain name, only the

question of abusiveness remains – *i.e.* whether the domain name, at the hands of the Appeal Respondent, is an abusive registration.

- ii. For a registration to be abusive one of the two potential types of abuse need be established. According to the definition of abuse, as confirmed in 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.
- iii. As the Panel is not *ad idem* in their decision, on whether the disputed domain name constitutes an abusive registration, what follows summarised the findings of the presiding Adjudicators Mr. Mike du Toit and Ms Vanessa Ferguson.
- iv. The Onus of proof remains with the Appellant to establish the criteria of abusiveness on a balance of probabilities. It specifically relies on Regulation 4(1)(a) and (b).
- v. Regulation 4 accordingly lists various factors (or circumstances) which indicate that registration of a disputed domain name may be abusive. In considering the Complaint the provisions of Regulation 4(1)(a)(i) is not applicable or relevant to the Complaint.
- vi. In considering the express language of regulation 4(1)(a), we agree with the Adjudicator that intent on the Registrant is clearly required, which cannot have been present in the absence of awareness of the Complainant's mark.
- vii. We agree with the Adjudicator that there is no evidence in this matter that the Registrant was aware of the Complainant's mark at the time of registration of the Domain Name or at any time prior to the complainant's letter of 24 December 2020. For this reason, and based on the lack of any evidence of common law rights in the name and mark THE DON PIZZA, the complaint based on Regulation 4(1)(a) must fail.

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- viii. In considering the provisions of Regulation 4(1)(b), the Appellant is required to establish, on a balance of probabilities *circumstances indicating that the registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the complaint.*
- ix. The Appeal Respondent's use of the disputed domain name has been consistent throughout, from date of registration until date of the complaint.
- x. In considering the Appeal record and complaint, there is nothing that shows the Appeal Respondent changed its behaviour and use of the domain name, once becoming aware of the Appellant's rights in the 2012 trade mark registration, that would result in the domain now being abusive, but not then.
- xi. We agree with the Adjudicator that The Complainant's case is therefore one of innocent trade mark infringement; innocent in the sense that the Registrant has registered and used a Domain Name that may or may not be confusingly similar to a registered trade mark, without any knowledge of the Complainant's mark let alone any intention to target it, and without the Complainant's mark enjoying any proven reputation which could impute knowledge to the Registrant. The evidence of a single business associate of the Complainant has not been corroborated by independent evidence and the evidentiary value of the evidence is therefore considered to be inconclusive.
- xii. The Panel needs to also deal with the Regulation 5(a)(i) and the onus placed thereby on the Appeal Respondent to show that it made use of the domain in connection with a good faith offering of the goods and services – a onus the Adjudicator held was in fact met.
- xiii. After consideration of the evidence offered by the Appeal Respondent in support of the above through its Response and

Appeal Notice Response, we agree with the Adjudicator herein that the Appeal Respondent has discharged the onus of showing that the domain name is not abusive in respect of Regulation 5(a)(i).

## 5) Dissenting Appeal Decision (Christiaan Steyn)

- a. The dissenting Adjudicator has read the judgement of his co-panellists Mr. Mike du Toit and Ms Vanessa Ferguson. The conclusion to which he has come is different from theirs. As required by regulation 29(5) read with regulation 32(1) the dissentient view is to accompany the concluding decision as is set out hereunder.
- b. The nature of "abusiveness" as contemplated in the Regulations does not 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. Herein I respectfully disagree with the Adjudicator's findings that intention is a prerequisite to Regulation 4(1)(a). See: DRS02464 (Aldershot Car spares v Gordon), DRS00658 (Chivas Brothers Ltd v David William Plenderleith), and ZA2007-0007 (*fifa.co.za*). Further, a registration can be abusive "now" although not "then". See also ZA2013-0126 (*sonnenkraft.co.za*), ZA2019-0376 (*fidelityadt.co.za*) and ZA2019-0378 (*istore.co.za*).
- c. In my view it is not necessary to consider every ground of appeal raised by the Appellant, nor every response submitted by the Appeal Respondent. There is a simple basis upon which to decide the matter, and the most pertinent thereof shall be dealt with next:

### i. 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 Appellant 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 foreign decisions DRS00583 and DRS01378, as well as ZA2017-0294 (*aldoshoes.co.za*).

- b. Herein I concur with the Adjudicator that this specific Regulation may lack the desired "intention" on the side of the Appeal Respondent.
- c. Regardless, it is clear (in my view) that the disputed domain name undeniably prevents the Appellant from registering the domain name ***thedonpizza.co.za*** for itself, whether through the intent of the Appeal Respondent or as an unintended consequence of the disputed domain name registration.
- d. 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 (*citroen.co.za*), referring to WIPO/D2000-0766.

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

- a. Although the Appellant did not speak to this aspect in the Complaint and Appeal Notice *per se*, on considering the provided evidence and the aspects herein insofar as it relates to Regulation 4(1)(a)(ii) above, I am of the view that this Regulation is a pertinent aspect in this matter and shall therefore consider such herein further.
- b. It is clear from the provided evidence that the disputed domain name, in the hands of the Appeal Respondent, shall prevent the Appellant from exercising its rights. More particularly, in this case, the Appellant is prevented by the disputed domain name from registering the domain name as its own, which it should be entitled to do based on its

established rights in the name or mark **THE DONS PIZZA & CONES** – which the Panel reiterates is similar to the domain name.

- c. In this regard, I wish to refer to Regulation 4(1)(a)(ii), as discussed above, insofar as the current registration of the disputed domain name by the Appeal Respondent prevents the Appellant from registering such as its own (or “blocks”).

iii **Regulation 4(1)(b):**

- a. The Appellant has clearly established that it has rights in the name and trade mark **THE DONS PIZZA & CONES**, and that such mark is similar to the disputed domain name. It is further clear that the Appeal Respondent used this dominant element of the mark, in which the Appellant has rights, in its domain name. This use of the dominant element of the Appellant’s mark (*ie* “THE DONS”) in a domain name is undoubtedly prejudice to the Appellant as there exists a reasonable likelihood that the public will be confused or deceived into thinking that the Appeal Respondent is related to, or associated with, the Appellant.
- b. Actual confusion is furthermore not necessary, and the potential or (reasonable) likelihood for confusion is sufficient. See WIPO/D2000-0777, WIPO/D2000-0878, NAF/FA95033 and NAF/FA95402, as well as the South African decisions ZA2007-0003 (*telkommedia.co.za*), ZA2016-0254 (*kfclistsens.co.za*), ZA2017-0265 (*reedexpo.co.za*), ZA2017-0272 (*heraldonline.co.za*), ZA2017-0285 (*capitech.co.za*), ZA2017-0286 (*absa-barclays.co.za*) and ZA.

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- v. Accordingly, I conclude that *inter alia* the above circumstances apply in the present Appeal, and that these factors indicate that the disputed domain name is in fact an abusive registration
  - vi. Taking cognisance of the above, it is necessary to also deal with the Regulation 5(a)(i) and the onus placed thereby on the Appeal Respondent to show that it made use of the domain in connection with a good faith offering of the goods and services – a onus the Adjudicator held was in fact met.
  - vi. However, after consideration of the evidence offered by the Appeal Respondent in support of the above through its Response and Appeal Notice Response, I respectfully disagree with the Adjudicator herein and finds that the Appeal Respondent has not discharged the onus of showing that the domain name is not abusive in respect of Regulation 5(a)(i).
  - vii. Thus, although I agree with the Adjudicator’s findings that the registration of the disputed domain name may not have been abusive, I respectfully disagree with the Adjudicator in so far as the “abusiveness through use”.
  - viii. In conclusion, based on the above and in the absence of non-abusiveness being established by the Appeal Respondent, I find that the disputed domain name, in the hands of the Appeal Respondent, is an abusive registration.

## 6) Appeal Decision

- a. For all the foregoing reasons, the majority of the Panel finds the initial Adjudicator came to the correct conclusion and the Appeal is therefore dismissed.

.....  
**CHRISTIAAN STEYN**

SAIPL SENIOR ADJUDICATOR

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