



# Decision

**[ZA2021-0425]**

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

## ADJUDICATORS APPEAL DECISION

CASE NUMBER:	<b>ZA2021-0425</b>
DECISION DATE:	<b>11 February 2022</b>
DOMAIN NAME	<b>Uspa.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Mr A Greenberg</b>
REGISTRANT'S LEGAL COUNSEL:	<b>MG Law Incorporated</b>
THE COMPLAINANT:	<b>United States Polo Association</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Spoor &amp; Fisher</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZACR</b>

## 1. Procedural History

- a) The SAIPL appointed **Mr Deon Bouwer** as the Adjudicator in this matter on **13 October 2021**. The Adjudicator ruled against the Complainant on 3 November 2021.
- b) The Complainant delivered its Notice of Intention to Appeal on **10 November 2021**. Its Appeal Notice followed on **1 December 2021**.
- c) The Registrant responded to the Notice of Appeal on **15 December 2021**.
- d) The SAIPL appointed **Tana Pistorius, Owen Salmon and Vanessa Lawrance** as the Adjudicators to decide the Appeal in this matter on **5 January 2022**. The Adjudicators have submitted Statements of Acceptance and Declarations of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

## 2. Factual Background

- 2.1 The Complainant is proprietor of the USPA trade mark and South African trade mark registration numbers 2012/10327 – 8 USPA in classes 18 and 25.
- 2.2 The Registrant is Mr. D Greenberg, a South African citizen.
- 2.3 The Registrant registered the Disputed Domain Name on **30 October 2014** on behalf of IdealPrepaid (Pty) Ltd (“IDP”) who intended to promote the services of the Utility Service Providers Association (“Association”). The Association was formed in response to events relating to the use of pre-paid electricity meters that occurred in 2014.
- 2.4 The Disputed Domain Name was, prior to the present Dispute, not in use but is at the date hereof in use to promote the services of the Association.

## 3. Parties’ Contentions

The Parties' initial contentions were outlined in the decision of Mr Boucher and need not be repeated here. The parties' contentions insofar as they relate to this appeal are dealt with hereunder.

#### 4. Discussion and Findings

- 4.1 The issue concerns the reversal of the onus. Regulation 5(c) provides that *"the burden of proof shifts to the registrant to show that the domain name is not an abusive registration if the domain name ... is identical to the mark in which the Complainant asserts rights, without any addition."*
- 4.2 As the domain name is USPA.CO.ZA, it is identical to the mark in which the Complainant has asserted – and established – rights as noted above. Accordingly, it is for the Registrant to discharge the presumption of abusiveness.
- 4.3 Ordinarily, at face value, that could be considered a tall ask. After all, the name is made up; it is not a known word in the English or other languages found in South Africa. It is not obviously acronymic – in the sense that, pronounced 'ussper', it may well be a word of sorts, but fanciful. That then would also apply to the Complainant's mark.
- 4.4 However, that is not the case the Complainant brings. Its approach is that the word *is* acronymic; indeed, eponymously so. Yet, therein lies the difficulty for the Complainant. There are several other USPA names, being acronyms of the organizations and entities to which the names relate. One need only consult sites such as [www.abbreviationfinder.org](http://www.abbreviationfinder.org) and [www.acronyms.thefreedictionary.com](http://www.acronyms.thefreedictionary.com) to be faced with scores of them. Admittedly, these are not necessarily authoritative reference works, but the domain (forgive the pun) in which this contest takes place is the internet.
- 4.5 Perhaps additionally to the point, some of them have domain names in which USPA features, exclusively:
  - [www.uspa.org](http://www.uspa.org) – the United States Parachute Organization
  - [www.uspa.net](http://www.uspa.net) – the United States Powerlifting Association

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- 4.6 This might explain why – or, in any event - the Complainant’s own domain is [uspoloassn.com](http://uspoloassn.com), its United Kingdom domain is [uspoloassn.co.uk](http://uspoloassn.co.uk), there is [uspoloassnglobal.com](http://uspoloassnglobal.com) and its South African domain is [uspoloassn.co.za](http://uspoloassn.co.za).
- 4.7 Tangential to this aspect is the prevalence of acronymic domain names – including those close in similarity to USPA; here are two quick examples:
- [www.ispa.org](http://www.ispa.org) – the International Society for the Performing Arts
  - [www.ispa.org.za](http://www.ispa.org.za) – the Internet Service Providers Association
- 4.8 Of course, the domain name which is in dispute in this Appeal is also acronymic: Utility Services Providers Association. This being the position, what is it that would prevent the Registrant, Mr Greenberg, from discharging the onus of abusiveness? The incidence of the onus does not mean that the Complainant must show that it *is* abusive; it is presumed to be abusive, and Mr Greenberg must establish that it is not.
- 4.9 Herein lies the import of the particular acronym. To illustrate: if the name in dispute was, say, [www.bafta.co.za](http://www.bafta.co.za) (British Academy of Film and Television Arts) or [www.sasol.co.za](http://www.sasol.co.za) (South African Synthetic Oil Limited) the *evidentiary* burden required to discharge the presumption of abusiveness would be demanding, as one might think is obvious. As has been shown above, “uspa” is quite common. Of the factors referenced in Regulation 4(1) which may be indicative of abusiveness, all except two (false registration details – 4(1)(d); pattern of abusive registrations – 4(1)(c)) are denominated either by a *mens rea* of sorts *vis à vis* the Complainant, or deception of which the Complainant is the object.
- 4.10 Conversely, one factor which may indicate that the domain name is not abusive (Regulation 5(a)(ii)) is that before being aware of the Complainant’s cause for complaint, the Registrant has been legitimately connected with a mark which is similar or identical to the domain. So the enquiry, here, reflects on this element of an intention: put differently, is the domain and/or its use shrouded with good faith, or is it tainted? This must be the criterion, when there is a “first-come-first-served” component

to the registration of domain names. The present case demonstrates the rationale of this. The entity with which the registrant is aligned, Utility Service Providers Association, was conceived of in 2014 and is the genesis of the domain name in question. There is no evidence to gainsay or challenge the *bona fides* of this assertion.

4.11 What is, or where is to be found, the detraction from good faith so that the presumption will remain intact? The facts in this regard are of limited scope and they are fairly straightforward. The Complainant presents a screenshot showing that, at a time when the website [www.uspa.co.za](http://www.uspa.co.za) was parked, it was linked to a website displaying links referencing the type of goods sold by the Complainant, namely polo shirts; and polo shirts are goods in which the Complainant trades and fall into the specification of its class 25 trade mark registration.

4.12 The Complainant alleges in its Notice of Appeal:

2.2.4 It is common cause that for the period 2014 to 2020, the Registrant did not point the domain name to a website for an alleged Association but parked it, allowing it to be *"linked to a website that advertised the goods of third party clothing manufacturers, including competitors of the Complainant"*.

2.2.5 It is not a coincidence that the PPC links included [www.polo.co.za](http://www.polo.co.za), which belongs to the Complainant's largest competitor in South Africa. This in itself is evidence that the Registrant (or the authorised user) was aware of the Complainant, its USPA trade marks and the clothing industry in South Africa.

2.2.6 Actual confusion is not necessary, and the potential or likelihood of confusion is sufficient.<sup>1</sup> It is likely that a substantial number of persons when entering the website linked to the parked domain would be confused or deceived into believing that the website or

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<sup>1</sup> It is not necessary here to visit this aspect of the references given by the Complainant as authority for this proposition: it has generally been accepted that the likelihood of confusion or deception can underpin a complaint of abusiveness. Nevertheless we query this. Regulation (4(1)b) talks of circumstances indicating *"that the registrant is using, or has registered, the domain name in a way that leads people to believe that the domain name is registered to, operated by or authorised by, or otherwise connected with the complainant."* Our underlining. This is the language of deception, not confusion. To believe is to put trust in the truth of something - COD. And this accords with rationale: in the cyber world denominated by one's address bar, keyboard, and screen, confusing domain names are not an issue, and not likely to lead to lost business. Deceiving names are a different story.

the websites linked thereto are in some manner associated with or connected to with the Complainant or that the advertisements are placed there with the approval of the Complainant.

2.2.7 Use of a domain name that conflicts with a Complainant's trade mark purely for the purposes of providing pay-per-click advertisements to third party businesses that compete with the Complainant does not amount to a good faith offering of goods or services.

4.13 The evidence doesn't get that far, though. True, the links are PPC links, and they include [www.polo.co.za](http://www.polo.co.za), but the Registrant's assertions to this effect in its response to the Notice of Appeal (a repeat of the complaint documentation, in this regard) are not shown to be unreliable or lacking in veracity or credibility:

"As mentioned in the Respondent's response to the Complaint, the Respondent was in no way connected or involved in the linking of the website relating to the competitor of the Complainant. This linking was completely out of the control of the Respondent and as proven in the Respondent's reply to the Complaint, it was not at all aware of the existence of the Complainant before such time that the Complainant contacted the Respondent regarding the domain name. It is not a requirement for a domain name to be pointed to another domain name with a functioning website and the Complainant never expressly allowed the linking which appeared on the domain name while it was parked. The Respondent has no interest or say in the advertisements displayed on the domain name while it was parked and received no compensation for such advertising."

4.14 Holding the Registrant to account in such circumstances is, in our view, unwarranted. Moreover, it is not what is contemplated by the factors in Regulation 4, which all want to investigate what the *registrant* is doing – particularly that relating to the likelihood of deception, Regulation 4(1)(b). Besides, if that were the case, a domain would become objectionable in the hands of a *bona fide* successor in title merely on account of what happened at a stage when the domain was parked, prior to his or her interest or even knowledge. This cannot be what is contemplated by the Regulations.

- 4.15 Moreover, the posting of the PPC links was transient; according to the Registrant, they run in an automated process, and it is common practice for advertisements to be placed on parked pages. That being so, it has to be asked where lies the Registrant's intention to use the domain for any of the purposes that would indicate abusiveness. Surely, then, it would be a phenomenon of something more than that fleeting use by a third party?
- 4.16 In regard to the principle referred to in the paragraph quoted (2.2.7) from the Appeal Notice, the Complainant references the decision in ZA2015-0209 (flysaexpress.co.za) as authority. The difference is that, there, it was the *registrant* that was using the domain for such purposes.<sup>2</sup> That is not the position in the present matter, as has been canvassed above.
- 4.17 The Complainant relies on the factors enunciated in Regulation 4(1)(a)(i), contending that the initial Adjudicator erred in failing to deal with them. These all postulate an intention on the part of the Registrant, in that the registration is (indicated to be potentially abusive if it was or is) *primarily .... to sell, rent or otherwise transfer the domain name.....* . However, the facts contraindicate this. The Registrant, a nationwide participant in the business of (inter alia) selling prepaid utility metering, was concerned at a social media incident casting aspersions on the industry and resolved to set up the Utility Service Providers Association as an interest/lobby type body. As a result, it sought the domain [uspa.co.za](http://uspa.co.za). This purpose is polarised from the grounds contemplated in Regulation 4(1)(a)(i). The initial Adjudicator (correctly, in our view) assessed that the evidence in this regard was somewhat thin, but there is no basis to disbelieve the assertion. The adjudication cannot proceed on surmise or speculation; in the absence of countervailing facts, or other reason to find that the explanation is a fabrication, or untenable, it must stand.
- 4.18 In addition, the Registrant proves that it was not aware of the Complainant's trade mark USPA prior to receiving a demand in December

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<sup>2</sup> See Paragraph 5.1 of the Adjudicator's decision.

2020. Apart from its undisputed averment in this regard, it attaches an email string evidencing an unsolicited approach from a third party in September 2020, offering to acquire the Disputed Domain Name; and which it declined – not because the price offered (US\$500, and possibly higher) was too low, but because it was using the Disputed Domain Name. This evidence tends to controvert the notion of an abusive intent – or effect.

4.19 The Complainant seeks traction<sup>3</sup> from the fact that the Registrant had, for as long as six years, not linked the domain name to a website of the alleged Association, and had not produced any evidence that the Association actually existed. These facts are accepted, but it remains speculative to convert them into something less than *bona fides* in the registration of the Disputed Domain Name.

4.20 In our view the Registrant does enough to show that its intention, and the effect of its domain registration, and its use thereof, is not abusive vis à vis the United States Polo Association.

## 5. Decision

- a) The Appeal is dismissed.

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**VANESSA LAWRENCE**  
SAIIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)

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<sup>3</sup> The Complainant's fourth ground of appeal.



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