

Decision

ZA2021-0425

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2021-0425
DECISION DATE:	03 NOVEMBER 2021
DOMAIN NAME	USPA.CO.ZA
THE DOMAIN NAME REGISTRANT:	MR A GREENBERG
REGISTRANT'S LEGAL COUNSEL:	MG LAW INCORPORATED
THE COMPLAINANT:	UNITED STATES POLO ASSOCIATION
COMPLAINANT'S LEGAL COUNSEL:	SPOOR & FISHER
2 nd LEVEL ADMINISTRATOR:	ZACR

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **19 July 2021**. On **12 August 2021** the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name(s) at issue, and on **12 August 2021** ZACR confirmed that the domain name had indeed been suspended. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **11 August 2021**. The SAIPL verified that the Dispute [together with the amendment to the Dispute] satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIPL’s Supplementary Procedure.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **19 August 2021**. In accordance with the Regulations, the due date for the Registrant’s Response was **16 September 2021**. The Registrant submitted its Response on **15 September 2021** and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL’s Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on **16 September 2021**.
- c) In accordance with the Regulations, the due date for the Complainant’s Reply was **23 September 2021**. The Complainant submitted its Reply on **23 September 2021**.
- d) The SAIPL appointed **Mr Deon Boucher** as the Adjudicator in this matter on **13 October 2021**. 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.

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 Complainant alleges that it has used the USPA trade mark since 1980 and that the USPA trade mark is well-known, including in South Africa.
- 2.3 The Registrant is Mr. D Greenberg, a South African citizen.
- 2.4 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.
- 2.5 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

3.1 Complainant

- a) The Complainant holds trade mark registrations for USPA in South Africa, which registrations are registered with effect from 20 April 2012.
- b) The Complainant denies that the Disputed Domain Name was used prior to 9 December 2020 when it first objected to the registration of the Disputed Domain Name. The earliest date on which the Disputed Domain Name was linked to a website is 22 December 2020.

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- c) The Complainant further submitted evidence that the Disputed Domain Name, while parked, at least when the Complainant first became aware of the Disputed Domain Name in September 2020, was linked to a website displaying links referencing the type of goods sold by the Complainant, namely *“polo shirts”*. The Complainant argues that the aforementioned serves as confirmation that the Registrant and/or the party who was allowed to use the domain name was *“undoubtedly aware of the Complainant’s goods and services and realised the value of the Complainant’s (USPA) trade mark”*.
- d) The Complainant further denies the existence of the Association and, also, that even if the Association exists, which it denies, it has ever used the USPA mark.
- e) The Complainant accordingly submits that the Disputed Domain Name is an abusive registration in terms of Regulation 3(1)(a) as the Disputed Domain Name, is identical to the USPA trade mark registered by it in classes 18 and 25 and which predate the Disputed Domain Name.
- f) The Complainant further submits that the *“Registrant’s conduct in registering or otherwise acquiring the domain name was primarily to disrupt unfairly the business of the Complainant or to prevent the Complainant from exercising its rights.”*
- g) The Complainant submits that the Disputed Domain Name is therefore an abusive registration in terms of Regulations 4(1)(a)(ii) and (iii).

3.2 Registrant

- a) The Registrant submits that the Disputed Domain Name is an acronym for the *“registrant’s association (Utility Service Provider’s*

Association)... which was founded in 2014” to address utility services complaints/ issues.

- b) The Registrant further submits that IDP, the company of which he is a director, is the beneficial owner of the Disputed Domain Name and is currently “making use of the domain name *uspa.co.za*” on behalf of the Association, which the Registrant describes as “a collective for strategic purposes”.
- c) IDP and the Association are, both, involved in “the utility payments industry” and the Registrant submits that IDP and the Association both have legitimate interests in the Dispute Domain Name and that the Disputed Domain Name was registered in good faith.
- d) Although the Registrant admits that the Disputed Domain Name was parked for a long period of time, it was done so with the intention of being used in the future, effectively, in relation to prepaid metering solutions.
- e) The Registrant further admits that the Disputed Domain Name was parked until recently but denies that he, the Association or any other related entity or person was in control of the linking of the domain to websites or that any such person received any compensation from the advertising displayed on the website linked to the Disputed Domain Name.
- f) The Registrant denies that the Disputed Domain Name constitutes an abusive registration and submits that as the respective parties’ goods and services of interest are not in conflict, confusion or deception will not arise from the Association’s use of the Disputed Domain Name.

- g) The Registrant further submits that IDP and the Association have a legitimate interest in the Disputed Domain Name and, also, that IDP and the Association never had the intention to take advantage of the Complainant's trade mark of which they were not aware of until receiving a letter from the Complainant's attorneys late in 2020.

- h) Finally, the Registrant submits that the "*first come first serve*" principle should prevail, as he has acted in good faith and IDP and the Association are, presently, making *bona fide* use of the Disputed Domain Name.

4 Discussion and Findings

4.1 Complainant's Rights

4.1.1 General:

It is common cause that IDP is the beneficial owner of the Disputed Domain Name and, also, that the Registrant acted on behalf of IDP.

The Complainant denies the existence of the Association and, also, that even if the Association exists, which it denies, that the Association has used and acquired rights in the Disputed Domain Name. The Adjudicator finds it unnecessary to deal further with the Complainant's submissions in this regard, for the reasons set out below.

4.1.2 Regulation 1 defines "*rights*" to include intellectual property rights, commercial, cultural, religious and personal rights protected under South African law, but are not limited thereto.

4.1.3 The above definition is broad and "*rights*" is not restricted to rights founded on the principles of trade mark law, but recognises rights

going beyond those in terms of the Trade Marks Act No. 194 of 1993 (“the Trade Marks Act”) or the requirements at common law for passing off. Such rights must, however, find recognition in law. See ZA2007-0008 (privatesale.co.za).

4.1.4 There is no dispute that the Complainant holds registered rights in the USPA trade mark and, also, that the registered trade mark is identical to the Disputed Domain Name.

4.1.5 The Adjudicator accordingly finds that the Complainant has established rights in the USPA trade mark and, also, that the Disputed Domain Name is identical to the Complainant’s USPA trade mark as is required in terms of Regulation 3(a).

4.1.6 The fact that the Disputed Domain Name is identical to the Complainant’s registered trade mark is not the end of the enquiry. It is further necessary to consider the goods covered by the registrations and to compare that with the manner in which the Registrant (or the Utility Services Providers Association) uses or intends using the Disputed Domain Name. This aspect is dealt with further below.

4.2 Abusive Registration

4.2.1 A domain name is abusive when it 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 Factors that may indicate that a disputed domain name is an abusive registration include:

(a) Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to (ii) block intentionally the registration of a name or mark in which the complainant has rights; (iii) disrupt unfairly the business of the complainant; or (iv) prevent the complainant from exercising his, her or its rights;

(b) 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 complainant; and

(c) False or incomplete contact details provided by the registrant in the database.

4.2.3 For purposes of the Dispute, the Complainant relies on the provisions of Regulations 4(1)(a)(ii) and 4(1)(a)(iii), and submits that the Disputed Domain Name is an abusive registration on the basis that there are:

(a) Circumstances indicating that the Registrant has registered or otherwise acquired the Disputed Domain Name primarily to-
(ii) block intentionally the registration of a name or mark in which the Complainant has rights; or
(iii) disrupt unfairly the business of the Complainant.

4.2.4 The first ground of objection is that the Registrant had “*registered or acquired the Disputed Domain name primarily to block intentionally the registration of a name or mark in which the complainant has rights*”.

The Adjudicator in ZA2007-0003 (Telkom SA Limited v Cool Ideas 1290 CC) held that a blocking registration has two critical features. The first is that it must act against a name or mark in which the Complainant holds rights. The second feature relates to an intent or

motivation in registering the domain name in order to prevent a Complainant from doing so.

There is, presently, no dispute that the Complainant holds rights to the USPA trade mark. However, although the Complainant argues that the USPA is well-known the evidence presented by the Complainant does not support the Complainant's contentions that USPA trade mark was well-known or that the Complainant had built up a reputation in the USPA trade mark in South Africa at the date of registration of the Disputed Domain Name. In fact, there is no evidence confirming that the USPA trade mark was used in South Africa prior 2015. As such, the level recognition of the Complainant's USPA mark on 30 October 2014 was, evidently, not high.

Furthermore, although the Disputed Domain Name prevents the Complainant from using its trade mark in a corresponding domain name in the .co.za registry, there is no evidence that the Registrant was aware of the Complainant's USPA trade mark at the time of the registration of the Disputed Domain Name registration. To the contrary, the Registrant, specifically, denies any such knowledge, which denial the Complainant does not appear to dispute with any conviction and is in line with the absence of any evidence establishing that the Complainant's USPA trade mark was well-known or that the Complainant had established a reputation in the trade mark in South Africa at the time of registration of the Disputed Domain Name.

It is further trite law that the use of a disputed domain name in a manner that may lead to confusion or deception may prove that the registrant had acted in bad faith. In this regard, it is common cause that the Disputed Domain Name was, after a lengthy delay and subsequent to the Complainant's initial objection, for the first time used late in 2020 to promote the services of the Association. The

services which are promoted on the website are in no way in conflict with the goods covered by the Complainant's trade mark registrations. Important, however, are that the services advertised are in line with the explanations proffered by the Registrant for IDP's adoption and registration of the Disputed Domain Name.

The Registrant specifically denies that IDP or the Association was involved in the linking of the Disputed Domain Name to websites that promoted the goods of competitors of the Complainant. He also denies that he or the Association received any compensation from the advertising displayed on the website linked to the Disputed Domain Name.

There is further no evidence that the Registrant was aware of the Complainant's USPA trade mark at the time of registering the Disputed Domain Name.

As such, the Adjudicator finds that the Registrant had made out a *bona fide prima facie* case that he had not registered or acquired the Disputed Domain Name primarily "to block intentionally the registration of a name or mark in which the Complainant has rights". (emphasis added)

- 4.2.5 The second ground of objection is that there are "circumstances that indicate that the Registrant has registered or otherwise acquired the Disputed Domain Name primarily to disrupt unfairly the business of the Complainant".

It is, as stated above, trite law that the use of a disputed domain name in a manner that may lead to confusion or deception amongst consumers, may prove that the registrant had acted in bad faith (see UDRP decisions such as Red Bull GmbH v Unasi Management Inc WIPO Case No D2005-0304; Banca di Roma SpA v Unasi Inc a/k/a

Domaincar WIPO Case No D2006-0068; Zinsser Co Inc Zinsser Brands Co v Henry Tsung WIPO Case No D2006-0413).

Although the Disputed Domain Name, while parked was, at least when the Complainant first became aware of the Disputed Domain Name in 2020, linked to a website that advertised the goods of third party clothing manufacturers, including competitors of the Complainant, the Registrant denies any involvement in the process and, also, that any confusion or detriment had resulted therefrom. The Registrant also denies having received any benefit from the above process. There is no evidence to contradict the Respondent's denials.

Also stated above, is that although the Disputed Domain Name was, for the first time used in 2020, it is important to note, not only that the services promoted are in no way on conflict with the goods covered by the Complainant's trade mark registrations, but also that the use of the Disputed Domain Name is in line with the explanations proffered by the Registrant for adopting and registering the Disputed Domain Name.

There is also no evidence that the Registrant was aware of the Complainant's USPA trade mark at the time of registering the Disputed Domain Name, which is in line with the Registrant denials and the absence of evidence to support the Complainant's contentions that USPA trade mark was well-known or that the Complainant had built up a reputation in the USPA trade mark at the date of registration of the Disputed Domain Name.

The Complainant's evidence further shows that when it approached the Registrant, anonymously, with a view to acquiring the Disputed Domain Name as it believed that the Disputed Domain Name might be for sale, the Registrant's representative confirmed that the

Disputed Domain Name was not for sale. The aforementioned *prima facie* aligns with the Registrant's stated intention, namely not only that it always intended to use the Disputed Domain Name but also to promote the services of the Association.

As stated above, the Registrant's response contains very little evidence regarding the alleged existence and operation of the Association which casts some doubt over the Registrant's defence, especially, as there was a long delay in commencing use of the Disputed Domain Name.

However, as the services offered on the website linked to the Disputed Domain Name in all respects align with the Registrant's stated reasons for adopting and registering the Disputed Domain Name, the goods and services of the parties are not in conflict and in the absence of any evidence confirming that the Registrant was aware of the Complainant's USPA trade mark when registering the Disputed Domain Name, the Adjudicator finds that the Registrant had made out a *bona fide prima facie* case that he had not registered or acquired the Disputed Domain Name primarily to disrupt the business of the Complainant. The Adjudicator is therefore of the opinion that in this case the "*first come first serve*" principle should prevail.

5. Decision

5.1 For all the foregoing reasons, the Dispute is refused.

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[DEON BOUWER]

SAIPL SENIOR ADJUDICATOR

