

ADJUDICATOR DECISION

CASE NUMBER:	ZA2023-0491
DECISION DATE:	08 March 2024
DOMAIN NAME	poetry.co.za
THE DOMAIN NAME REGISTRANT:	Deon Venter
REGISTRANT’S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	Cape Union Mart International (Pty) Ltd
COMPLAINANT’S LEGAL COUNSEL:	Adams & Adams
2 nd LEVEL ADMINISTRATOR:	ZARC (CO.ZA)

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1. Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **13 December 2023**. On **13 December 2023** SAIPL transmitted by email to the ZA Registry a request for the registry to suspend the domain name at issue, and on **13 December 2023** the ZA Registry confirmed that the domain name had indeed been suspended. SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and SAIPL's Supplementary Procedure.
- 1.2 In accordance with the Regulations, SAIPL formally notified the Registrant of the commencement of the Dispute on **14 December 2023**. In accordance with the Regulations the due date for the Registrant's Response was **17 January 2024**. On **15 January 2024** the Registrant submitted a response.
- 1.3 In accordance with the Regulations, SAIPL formally notified the Complainant of the Reply on **16 January 2024**. In accordance with the Regulations the due date for the Complainant's Reply was **23 January 2024**. On **23 January 2024** the Registrant submitted a reply, following by additional attachments thereto on **24 January 2024** – the latter date of which falling beyond the deadline will be condoned by the Adjudicator.
- 1.4 In accordance with the Regulations, the SAIPL notified the Parties on **24 January 2024** that the Dispute was being referred to the ZA Domain Name Authority to proceed with an informal mediation process. On **7 February 2024** the ZA Domain Name Authority notified the SAIPL that it had conducted the informal mediation between the Parties and that the Parties were unable to achieve an acceptable resolution through mediation within the time-frame provided for in Regulation 19A. Accordingly, the Dispute was referred to adjudication.
- 1.5 SAIPL subsequently appointed **Christiaan Steyn** as the Senior Adjudicator in this matter on **8 February 2024**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by SAIPL to ensure compliance with the Regulations and Supplementary Procedure. SAIPL further appointed **Liézal Mostert** as the Trainee Adjudicator in this matter on **15 February 2024**.
- 1.6 Mention may be made to the fact that the original decision deadline was **05 March 2024**, yet was subsequently extended to **8 March 2024** due to technical and unforeseen circumstances.

2. Factual Background

- 2.1 The Complainant is Cape Union Mart International (Pty) Ltd, and it is the proprietor in South Africa of a number of trade mark registrations for the trade mark **POETRY** in classes 3, 4, 14, 18, 20, 21, 24, 25, 29, 30 and 35, the earliest of which dates back to 2005. It is also the owner of the domain name <poetrystores.co.za> which resolves to its active website at www.poetrystores.co.za.
- 2.2 The Complainant uses its trade mark **POETRY** in relation to clothing, footwear, headwear, accessories, furniture, and retail services. The Complainant has been using its **POETRY** trade mark since 2008 and contends that, as a result of this use, it has acquired a substantial and valuable goodwill and reputation, and consequently common law rights in the trade mark **POETRY**. The Complainant also submits that the **POETRY** trade mark is well-known.
- 2.3 The Registrant is Deon Venter, and the disputed domain name was registered on 27 November 2014. The disputed domain name resolves to a website at www.poetry.co.za. The website has a landing page with a single post titled "Hello" and an entry saying "*Hello there... This is a test*". This post is dated 9 December 2021. The website provides basic information about different types of poetry forms such as sonnets, haikus, etc.
- 2.4 The website to which the disputed domain name resolves lists its address under the "Contact Us" page as 18 Athlone Drive, Three Rivers, Vereeniging, 1961.
- 2.5 The Registrar of the disputed domain name is Software Incorporated and according to the Registrar's website at www.softinc.co.za its address is 18 Athlone Drive, Three Rivers, Vereeniging. Software Incorporated seemingly trades as Softinc.
- 2.6 The Registrar Abuse Contact Email listed on the Whois information for the disputed domain name is deon@softinc.co.za. This is the same email address as that of the Registrant as listed with the ZA Registry Consortium.
- 2.7 The Complainant therefore submitted that the Registrant and the Registrar of the disputed domain name are one and the same. This has not been denied by the Registrant.
- 2.8 The Registrar is, according to its website, involved in the business of selling and investing in domain names. According to the website of the Registrar, the

Registrar is a service provider for investing.co.za. Investing.co.za is involved in the business of selling domain names for profit according to its website at www.investing.co.za. The CEO of investing.co.za is listed as Deon Venter. The telephone number of investing.co.za and the address of investing.co.za is the same as the details of the Registrant listed at the ZA Registry consortium for the disputed domain name. This has not been denied by the Registrant.

- 2.9 The Complainant contacted the Registrant on two occasions in an attempt to purchase the domain name.
- 2.10 During 2015, the Complainant contacted the Registrant directly in order to purchase the domain name via an employee. At that time the Complainant submits that the employee, Mr Hufkie, advised the Registrant that he represented the Complainant, and that the Complainant would like to purchase the domain name for their **POETRY** business. The exchanges between the parties were made verbally and the Complainant submits that the Registrant insisted on a purchase price of R 50 000. This was disclosed in the Complainant's Replying papers.
- 2.11 The Complainant also contacted the Registrant via an agent to purchase the domain name during July 2023. The Registrant indicated that *"Poetry.co.za is for sale. It is a premium domain name with excellent branding opportunities. We will consider serious offers only"*. The Complainant asked the Registrant where a serious offer would start but the Registrant did not respond.
- 2.12 During 2023, the Complainant noted that the disputed domain name had lapsed and requested that it be transferred to it. This request was denied by the Registrar of the disputed domain name.
- 2.13 The Registrant has previously been involved in domain name disputes where decisions were handed down against the Registrant. These decisions are purdey.co.za ZA2016-00236 (*purdey.co.za*); ZA2015-0208 (*fly-saa.co.za*), ZA2015-00213 (*thawte.co.za*) and D2014-2232 (*match.com – Nordic AB v CoZaNic, Deon Venter*).

3. Parties' Contentions

3.1 Complainant

- 3.1.1 Based on the above factual background, the Complainant submits that the disputed domain name is identical to a trade mark in which it has

statutory and common law rights as already set out above. The Complainant submits that these rights existed at the time that the disputed domain name was registered.

- 3.1.2 The Complainant submitted evidence showing that the Registrant is a controlling force behind two businesses, Softinc and investing.co.za, that are in the business of selling and investing in domain names.
- 3.1.3 The Complainant also submitted printouts from a reverse Whois search for the Registrant and the Registrar of the disputed domain name. The searches showed that both parties registered numerous domain names. The Complainant submitted only printouts from the first 500 results of the searches. The Complainant submitted that these domain names all appeared to be linked to the email addresses of the Registrant and Registrar, being deon@softinc.co.za and info@softinc.co.za.
- 3.1.4 The Complainant submitted that the disputed domain name was acquired with the view of commercial gain.
- 3.1.5 The Complainant submitted that it tried to purchase the domain name anonymously during 2023 and following this approach the Registrant indicated that the domain name is for sale and as it is a "premium" domain name he will only consider "serious offers" for the domain name. The Complainant therefore submits that, as the domain name was offered for sale, bad faith can be inferred and that the disputed domain name was registered and/or is being held in bad faith.
- 3.1.6 The Complainant submits that the statements that the domain name was for sale for a premium price points to the true goal of the Registrant, namely, to sell the domain name for a profit and that he therefore clearly has no interest in the promotion of poetry.
- 3.1.7 In its Replying papers, the Complainant also submitted that it approached the Registrant during 2015 to purchase the domain name. The Complainant submits that the Registrant was aware that the offer was made by the Complainant for its **POETRY** business. The Complainant submits that the Registrant insisted on selling the domain name for R 50 000. In support of this submission the Complainant submitted a confirmatory affidavit in the name of Mr Frederick Hufkie, a then Systems Analyst focussing on e-commerce and employed by the Complainant. The Complainant submits that it was not prepared to pay such a large sum for the disputed domain name at the time.

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- 3.1.8 The Complainant submits that it was not aware of this information at the time of filing the complaint, and therefore included it in its Replying papers once it had obtained this information.
- 3.1.9 The Complainant therefore submits that in accordance with Regulation 4(1)(a)(i) the Registrant is holding the disputed domain name in order to sell, rent or otherwise transfer it to the Complainant or to a competitor of the Complainant, or any third party, for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name.
- 3.1.10 The Complainant submits that the website to which the domain name resolves does not appear to have been updated since 9 December 2021. It submits that the website contains nonsensical information under the "About Us" page and while the website features a list of poem types, no information about such poems have been included. The Complainant submits that the references to poetry is a weak attempt by the Registrant to claim that he is making legitimate use of the domain name.
- 3.1.11 The Complainant therefore submits that the Registrant has no intention of using the domain name and is simply holding on to it until it can be sold.
- 3.1.12 The Complainant also submitted evidence, as mentioned above, that the Registrant had previously been involved in domain name disputes. The Complainant therefore submits that the Registrant is engaged in a pattern of making abusive registrations in accordance with Regulation 4(1)(c).
- 3.1.13 The Complainant submits that the Registrant registered the disputed domain name, and continues to hold it, primarily to:
- 3.1.13.1 block intentionally the registration of a name or mark in which the Complainant has rights as contemplated by Regulation 4(1)(a)(ii);
 - 3.1.13.2 disrupt unfairly the business of the Complainant as contemplated by Regulation 4(1)(a)(iii); and
 - 3.1.13.3 prevent the Complainant from exercising its rights as contemplated by Regulation 4(1)(a)(iv).
- 3.1.14 The Complainant submits that given the substantial reputation vesting in the **POETRY** trade mark, the Registrant had to have been aware of the Complainant at the time that he registered the disputed domain

name, nor can he be unaware of the Complainant's rights as he continues to hold the disputed domain name.

- 3.1.15 In its Replying papers, the Complainant submitted that the trade mark **POETRY** is inherently distinctive and can therefore function as a trade mark as the term "poetry" has no relation to any of the Complainant's goods and services.
- 3.1.16 In its Replying papers, the Complainant also submitted that internet searches for "Deon Venter poet" rendered no results.
- 3.1.17 The Complainant in its Replying papers submitted that internet searches for "Deon Venter Domains" revealed an article indicating that the Registrant, through his company CoZaNic, appeared to have registered 143 domain names with a view of making profit by driving traffic to the websites through use of racial rhetoric and the publication of racist content.

3.2 Registrant

- 3.2.1 The Registrant contends that the disputed domain name is not an abusive registration and that he has made legitimate non-commercial or fair use of the domain name.
- 3.2.2 The Registrant contends that the word "poetry" is a generic word and that generic or descriptive words cannot be registered or give rise to a protectable right unless they have been used to such an extent that they have become capable of distinguishing the goods or services of the proprietor. The Registrant submits that this is not the case with the trade mark **POETRY**.
- 3.2.3 The Registrant submits that the rights claimed by the Complainant are not valid rights as the trade mark **POETRY** was allowed registration against the rules and regulations of the Companies and Intellectual Property Commission.
- 3.2.4 The Registrant submits that the trade mark **POETRY** is not well-known and that there are no **POETRY** stores near his place of residence and neither has he seen any television or other mainstream media advertisements for the Complainant. He submits that he had been unaware of the existence of the **POETRY** trade mark or the Complainant.

- 3.2.5 The Registrant submits that the disputed domain name was not registered or 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. The dispute domain name has also not been used in a manner that takes unfair advantage of, or is detrimental to the Complainant's rights.
- 3.2.6 The Registrant submits that before becoming aware of the Complainant's case for a dispute, it has been using the domain name for 10 years during which the Registrant made no effort to contact the Complainant.
- 3.2.7 The Registrant submits that the domain name was registered to develop a poetry portal and to monetise it through advertisements for the publications of hundreds of unpublished writers.
- 3.2.8 The Registrant denies that he owns several domains which are the same as registered trade marks, and submits that more than 90% of the list of domain names submitted by the Complainant is not correct and must be disregarded. He also submitted that many of the domain names on the list do not belong to him or do not exist. It is noted that the Registrant did not specify in which regards the list of domain names is not correct, which domain names do not belong to him or which domain names do not exist.
- 3.2.9 The Registrant submits that he does own several domain names but that his intent is to register generic domain names that are prone for development such as wifi.co.za. The domain names are registered by a robot and the Registrant, or others associated with him, reviews the list periodically in order to decide which domain names to keep.
- 3.2.10 The Registrant submits that he is a widely published poet and has published more than 100 poems prior to 2023. The Registrant submits that he belongs to a well-known poetry group called "*Diggroep vir Beginners en Begaafdes*".

4. Discussions and Findings

- 4.1 In order to make a finding that the disputed domain name is an abusive registration, the Adjudicator is required to find that the Complainant 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:

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- 4.1.1 that the Complainant has rights in respect of a name or mark;
 - 4.1.2 that is identical or similar to the disputed domain name; and
 - 4.1.3 that, in the hands of the Registrant, the disputed domain name is an abusive registration.
- 4.2 An abusive registration is defined in the definitions of Regulation 1, to mean a domain name which either:
- 4.2.1 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 Complainant's rights; or
 - 4.2.2 has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

5. Substantive Aspects

- 5.1 Turning to the substantive aspects of this Complaint, the Adjudicator has carefully perused the Complaint, and has fully considered the facts and contentions set out therein.

6. Rights and Respect of Name or Mark

- 6.1 In terms of Regulation 1, the term "rights" is widely defined. The Regulation states that "rights" and "registered rights" include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law but is not limited thereto.
- 6.2 As has been decided in the South African appeal decisions of ZA2009-0030 (*seido.co.za*) and ZA2011-0077 (*xnets.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 ZA2018-0352 (*revitalash.co.za*).

6.3 It is also a matter of *locus standi* in order to make sure that the person who lodges the Complaint is someone with a proper interest in that Complaint. The threshold in this regard should also be fairly low.

7. Does the Complainant have Rights?

7.1 The first element that the Adjudicator needs to establish is whether, as set out above, and in terms of Regulation 3(1)(a), on a balance of probabilities, the Complainant has rights in respect of the name or mark **POETRY**. This will also determine whether the Complainant has the necessary *locus standi* to bring this Complaint.

7.2 On this, the Adjudicator finds that the Complainant has clear rights in the trade mark **POETRY** by virtue of its trade mark registrations alone and which are in force on the Register of Trade Marks.

7.3 This Adjudicator is not tasked with ruling on whether trade mark registrations are validly registered on the Register of Trade Marks. In fact, such a determination is beyond the scope of the Adjudicator's powers and jurisdiction.

7.4 Therefore, and considering the above, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that it has rights in respect of the name and (trade) mark **POETRY**. The Complainant has thereby also established that it has the necessary *locus standi* to bring this Complaint.

8. Is the Name or Mark Identical or Similar to the Disputed Domain Name?

8.1 The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proven that its name or mark **POETRY**, in which it has rights (as determined above), is identical or similar to the disputed domain name.

- 8.2 On this, the Complainant contends that its name or mark **POETRY** is similar to the disputed domain name. This was not contested by the Registrant in its response.
- 8.3 The Complainant's name and mark (in which it has rights) is **POETRY**, while the disputed domain name is *poetry.co.za*. Ignoring the first and second level suffixes, in terms of Regulation 5(c), the comparison becomes a comparison of **POETRY**, against **POETRY**. Although the test herein is not one of "confusing similarity" but merely "similarity", which involves a lower standard of comparison, it is clear that these are in fact not only similar, but "identical".
- 8.4 Accordingly, the Adjudicator finds that the Complainant has proven, on a balance of probabilities, that the name and mark **POETRY** (in which it has rights) is similar to the disputed domain name.

9. Is the Disputed Domain Name an Abusive Registration?

- 9.1 The third element that the Adjudicator needs to establish is whether, on a balance of probabilities, the disputed domain name, in the hands of the Registrant, is and abusive registration. Herein, the Adjudicator is required to determine whether the disputed domain name is an abusive registration as defined by Regulation 1, and as set out in Regulation 4 read with Regulation 5.
- 9.2 Regulation 4 lists a number of factors which may show that a disputed domain name amounts to an abusive registration. Such factors include:
- 9.2.1 Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to:-
- 9.2.1.1 sell, rent or otherwise transfer the domain name to a complainant or to a competitor of the complainant, or any third party, for valuable consideration in excess of the

registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name;

9.2.1.2 block intentionally the registration of a name or mark in which the complainant has rights:

9.2.1.3 disrupt unfairly the business of the complainant; or

9.2.1.4 prevent the complainant from exercising his, her or its rights.

9.2.2 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.

9.2.3 Evidence, in combination with other circumstances indicating that the domain name in dispute is an abusive registration, that the registrant is engaged in a pattern of making abusive registrations;

9.2.4 False or incomplete contact details provided by the registrant in the Whois database; or

9.2.5 The circumstances that the domain name was registered as a result of a relationship between the complainant and the registrant, and the Complainant has:-

9.2.5.1 been using the domain name registration exclusively; and

9.2.5.2 paid for the registration or renewal of the domain name registration.

9.3 Regulation 5 lists factors which could indicate that a registration is not an abusive registration. These factors include:

9.3.1 Before being aware of the Complainant's cause for complaint, the Registrant has:-

- 9.3.1.1 used or made demonstrable preparations to use the domain name in connection with a good faith offering of goods or services;
 - 9.3.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name;
or
 - 9.3.1.3 made legitimate non-commercial or fair use of the domain name.
- 9.3.2 The domain name is used generically or in a descriptive manner and the Registrant is making fair use of it; and
- 9.3.3 That the Registrant has demonstrated fair use, which use may include websites operated solely in tribute to or fair criticism of a person or business: Provided that the burden of proof shifts to the Registrant to show that the domain name is not an abusive registration if the domain name (not including the first and second level suffixes) is identical to the mark in which the Complainant asserts rights, without any addition.

9.4 Regulation 4(1)(a)(i):

- 9.4.1 Having regard to the evidence presented by the Complainant, the Adjudicator finds on a balance of probabilities that there are circumstances indicating that the Registrant has registered or otherwise acquired the domain name primarily to sell, rent or otherwise transfer the domain name to a complainant or to a competitor of the complainant, or any third party, for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name.
- 9.4.2 The uncontested evidence shows that the Registrant is in the business of selling domain names for profit, which on its own may not necessary be indicative that the domain name is abusive. However, the

Registrant's statements to the Complainant that the domain name was for sale for a "premium price" does lead to the inference that the true goal of the Registrant was to sell the domain name for a profit.

9.4.3 In addition, the Registrant did not contest the further evidence submitted by the Complainant, namely, that the Registrant offered to sell the domain name for R50 000 (fifty thousand rand) in 2015, a year after registering the domain name. The Adjudicator finds that this amount is clearly in excess of the Registrant's reasonable expenses in obtaining and maintaining the domain name.

9.4.4 The Adjudicator has also conducted a search of the Wayback Machine for the website to which the domain name points. The Wayback Machine is an internet archive which takes snapshots of the contents of website pages and archives these pages. It allows the user to "go back in time" to see a webpage as it appeared at a prior point in time. The search of the Wayback Machine shows that the disputed domain name resolved to a parked page offering the domain name as for sale up until 11 February 2021, being the last time that the website was captured prior to the current website appearing on the Wayback Machine. This further supports the inference that the domain name was in fact acquired with the aim of selling the disputed domain name for profit. The fact that it has since been used in relation to a "poetry" website is irrelevant, as such latter use cannot be a defence against the clear predating intent of sale indicated above.

9.5 Regulation 4(1)(c):

9.5.1 The Adjudicator finds on a balance of probabilities that there are factors and circumstances which indicate that the Registrant is engaged in a pattern of abusive registrations.

9.5.2 The first factor that the Adjudicator has considered was the Registrant has been involved in 4 prior domain name disputes where the subject domain names were found to be abusive.

9.5.3 The second factor that the Adjudicator considered was that some of the domain names which form part of the lists of domain names submitted by the Complainant following the reverse Whois search for the Registrant and the Register contain clear third party names or trade marks. The list of domain names associated with the Registrant according to the searches include: *anc.co.za*; *apartheidsmuseum.co.za*; *malaysiaairlines.co.za*; *turkishairlines.co.za*; *juliusmalema.co.za* and *property-24.co.za*.

9.5.4 While the Registrant denied that the lists of domain names are accurate, he simply made a bald denial without giving any indication as to which domain names do not belong to him. Presumably the Registrant would indicate that domain names with clear third party trade marks do not belong to him.

9.6 Regulation 4(1)(a)(ii), (iii) and (iv):

9.6.1 Having found as above, the Adjudicator finds that the result of the registration of the disputed domain name is that the domain name was registered primarily to:

9.6.1.1 block intentionally the registration of a name or mark in which the Complainant has rights as contemplated by Regulation 4(1)(a)(ii);

9.6.1.2 disrupt unfairly the business of the Complainant as contemplated by Regulation 4(1)(a)(iii); and

9.6.1.3 prevent the Complainant from exercising its rights as contemplated by Regulation 4(1)(a)(iv).

9.7 Regulation 5:

9.7.1 The Adjudicator find that the Registrant did not discharge his onus in terms of Regulation 5. Based on the evidence, the Registrant listed the

domain name for sale seemingly since it was registered in 2014. The Registrant thereafter continued to list the domain name for sale for some time.

9.7.2 The website to which the disputed domain name points is incomplete and has not been updated since 2021. This further supports an inference that the Registrant never intended to make legitimate non-commercial use of the domain name. The website was, on the evidence, also created after the Registrant became aware of the Complainant as the Complainant contacted the Registrant as far back as 2015.

9.7.3 While the Registrant makes an allegation that he is a poet and has published many poems, no evidence in support of this allegation was submitted, nor has any works of poetry been published (by the Registrant or another party) on the website hosted on the disputed domain name.

9.7.4 On a balance of probabilities, the Adjudicator finds that the Registrant never intended to make legitimate non-commercial use of the domain name.

9.8 Consequently, the Adjudicator finds the disputed domain name by the Registrant to be abusive.

10. Decision

10.1 For all the foregoing reasons, in accordance with Regulation 9(1)(a), the Adjudicator orders that the domain name, *poetry.co.za* be transferred to the Complainant.

.....
CHRISTIAAN STEYN

SAIPL SENIOR ADJUDICATOR

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.....
LIEZAL MOSTERT

SAIPL TRAINEE ADJUDICATOR

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