

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0095
DECISION DATE:	15 March 2012
DOMAIN NAME	Movingforward212.co.za
THE DOMAIN NAME REGISTRANT:	Mabale Johannes
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	The Standard Bank of South Africa Limited
COMPLAINANT'S LEGAL COUNSEL:	Bowman Gilfillan Inc.
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1 Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **15 November 2011**. On **16 November 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **16 November 2011** UniForum SA confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure.
- 1.2 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **17 November 2011**. In accordance with the Regulations the due date for the Registrant's Response was **15 December 2011**. The Registrant submitted no Response by **15 December 2011**. The SAIPL notified the Registrant of its default on **20 December 2011**. A Response was then filed by the Registrant's hosting service provider on **20 December 2011** but did not satisfy the formal requirements of the Regulations and the SAIPL's Supplementary Procedure. The SAIPL accordingly considered the Registrant to be in default and proceeded with appointing the Adjudicator.
- 1.3 The Complainant received the deficient Response it. The Complainant submitted its Reply on **21 December 2011** objecting to the Response.
- 1.4 The SAIPL appointed **Janusz F Luterek** as the Adjudicator in this matter on **1 February 2011** after a number of attempts to appoint other adjudicators came to nought. 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.
- 1.5. On **7 February 2011** the Adjudicator requested the Complainant to provide a response to the prima facie defective Response by the Registrant and same was filed by Complainant on **29 February 2011**, which was out of time due to technical problems.

2 Factual Background

- 2.1 The domain was registered on 24 July 2011 by Mabale Johannes with Alex H Podile of Malopo Productions CC as the administrative contact.
- 2.2 The following facts are undisputed and, their not being palpably implausible, the Adjudicator accepts them for the purposes of this adjudication.
- 2.3 The Complainant is the Standard Bank of South Africa Limited, a public company incorporated according to the company laws of the Republic of South Africa, with its principal place of business at Standard Bank Centre, 5 Simmonds Street, Johannesburg. The Complainant is a subsidiary of Standard Bank Group Limited (hereinafter referred to as “the Group”).
- 2.4 The Group has registered various trade marks, including the trade mark STANDARD BANK, worldwide, in the name of the Complainant. The Complainant from time to time uses payoff lines in addition to the STANDARD BANK trade mark in the promotion of its business. Examples of these payoff lines are “INSPIRED. MOTIVATED. INVOLVED” and “SIMPLER. BETTER. FASTER”.
- 2.5 On 16 July 2009 the Complainant launched its new payoff line “MOVING FORWARD” internally to its employees, by means of a global broadcast and internal activations and in the Complainant’s employee magazine. On the same date, the Complainant also released a press statement on its website announcing the launch on 17 July 2010 of the payoff line “MOVING FORWARD” in the Complainant’s key markets in approximately 30 countries.
- 2.6 On 17 July 2009, the Complainant, through a multiplicity of media platforms including but not limited to television, print, outdoor, press, mobile, radio, online, cinema and networking sites, launched the payoff line “MOVING FORWARD” to the general public.
- 2.7 From 17 July 2009 to 3 September 2009, the Complainant advertised the payoff line “MOVING FORWARD” on a variety of television channels. The television

broadcast reached South Africa, Botswana, Zambia, Zimbabwe, Mozambique, Malawi and Namibia. The Complainant's television advertising totalled R762, 802.00 (Seven Hundred and Sixty two Thousand Eight Hundred and Two Rand).

- 2.8 The Complainant also advertised the payoff line "MOVING FORWARD" in a variety of printed local, national, international daily and weekly newspapers commencing between 17 July 2009 and 27 July 2009. The total advertising expenditure totalled R5, 428,698.00 (Five Million Four Hundred and Twenty Eight Thousand Six Hundred and Ninety Eight Rand).
- 2.9 The payoff line "MOVING FORWARD" received substantial exposure through the Complainant's massive advertising drive. It is alleged that, as a result of the Complainant's extensive advertising campaign, the public has come to associate "MOVING FORWARD" exclusively with the business of the Complainant, notwithstanding the short period of use.
- 2.10 The domain name <movingforward212.co.za> is similar to and entirely contains the Complainant's Registered trade mark "MOVING FORWARD" (2009/10032 – 10036). It was registered on 24 July 2011, this being five days after the official launch of the Complainant's slogan "MOVING FORWARD".

3 Parties' Contentions

3.1 Complainant

- 3.1.1 The "MOVING FORWARD" trade mark is well known and widely recognised as a result of the Complainant's extensive marketing which commenced on 16 July 2009 and continues to date.
- 3.1.2 Due to the extensive advertising of the "MOVING FORWARD" trade mark, it is improbable, if not impossible, that the Registrant was unaware of the existence of the Complainant's rights in the "MOVING FORWARD" trade mark" when it registered the corresponding domain name on 22 July 2009.

- 3.1.3 The Complainant has registered the "MOVING FORWARD" trade mark in South Africa under Registration numbers 2009/10032 - 10036. The Registrant's use of the domain name in question infringes Complainant's rights in the "MOVING FORWARD" trade mark because combination of the trade mark MOVING FORWARD with the numeral "212" creates a domain name that cannot be anything but confusingly similar to the Complainant's MOVING FORWARD trade mark. As a result of the above, the Complainant submits that there is a substantial likelihood that Internet users and consumers will be confused into believing that there is some affiliation, connection, sponsorship, approval or association between the Complainant and the Respondent, when in fact, there is no such relationship. The Complainant therefore contends that the disputed domain name is confusingly similar to the Complainant's MOVING FORWARD trade mark.
- 3.1.4 The Registrant's conduct falls within the ambit of Regulation 4(1) in that the Registrant there is evidence supporting that the disputed domain name is, at least, preventing the Complainant from freely exercising its rights. It is submitted that The WIPO UDRP decision of Red Bull GmbH vs. Harold Gutch (D2000-0766) where the panellist *in casu* found that the mere registration of a domain name that contains the well known mark of another is considered a trade mark infringement because it effectively prevents the trade mark owner from reflecting their distinctive and well-known mark in the corresponding domain name can be applied to the facts at hand *mutatis mutandis*.
- 3.1.5 Furthermore, Complainant relies on the WIPO UDRP decision of Encyclopaedia Britannica. Inc. vs. LaPorte Holdings (D2005-0866) where the panelist *in casu* held that registration and use of domain names "so obviously connected with such a well-known product. .. by someone with no connection with the product suggests opportunistic bad faith"
- 3.1.6 In conclusion based on the foregoing, the Complainant alleged that the domain registration is abusive within the meaning of Regulation 4(1).

3.2 Registrant

3.2.1 Although the Response by the Registrant was filed out of time and not in accordance with the Regulations, the Adjudicator was prepared to consider the Response and hence requested the Complainant to file a Reply thereto.

3.2.2 The Registrant has however not made any submissions of substance supported by any documents or evidence and accordingly the Response is merely a statement by the Registrant and it is thus not necessary to decide whether to accept the late filed Response or not.

4 Discussion and Findings

4.1 The Adjudicator finds that the Complainant has rights in respect of the trade mark "MOVING FORWARD" as contemplated by Regulation 3(1)(a). The question is whether the domain in question is abusive in the hands of the Registrant.

4.2 An abusive registration denotes a domain 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.

4.3 The Complainant is required by Regulation 3(2) to prove that the foresaid elements are present to support a finding that the disputed domain registration is abusive.

4.4 The Registrant has not proffered cogent reasons why he chose to register the disputed domain name, nor has he given any reason why he registered the domain name at the time he did. The Adjudicator is therefore entitled to hold that the domain name <movingforward212.co.za> is an abusive domain registration in the hands of the Registrant.

4.5 The Adjudicator finds the domain registration <movingforward212.co.za> to be abusive. Consequently, the Adjudicator upholds the Complainant's complaint.

5 Decision

- 5.1 For the above reasons, in accordance with Regulation 9(a), the Adjudicator orders that the domain name, <movingforward212.co.za> be transferred to the Complainant.

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JANUSZ F LUTEREK
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za