

ADJUDICATOR DECISION

CASE NUMBER:	ZA2009-0034
DECISION DATE:	5 October 2009
DOMAIN NAME	absapremiership.co.za
THE DOMAIN NAME REGISTRANT:	Digital Orange (aka Joris Kroner)
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	ABSA Bank Ltd
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1. Procedural History

- 1.1 The Dispute was filed initially with the South African Institute of Intellectual Property Law (the "SAIPL") on 14 July 2009. On 16 July 2009 the SAIPL emailed to UniForum SA a request for the registry to suspend the domain name at issue. On 21 July 2009 the SAIPL notified the Objector of an insufficient citation of the domain registrant and on 27 July 2009 the objection was duly supplemented.

- 1.2 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on 29 July 2009. In accordance with the Regulations, the due date for the Registrant's Response was 26 August 2009. On 11 August 2009 Joris Kroner emailed SAIPL as follows:-

"Due to a National Holiday my reply is a delayed by one day.

Regarding your e-mail I would like to bring the following to your attention.

Domain names are allocated on a "first come, first served" basis. Under this clause I have registered the domain (registration date 2008-11-26). Absa became the official sponsor of the PSL in 2007 which makes it reasonable to assume that they would have had ample time to register the domain. However, they have obviously chosen not to do so.

I see no reason to delete the name."

- 1.3 The Response did not satisfy the formal requirements of the Regulations and on 28 August 2009 the SAIPL notified the Registrant of its default. No further communication was received from the Registrant.
- 1.4 The SAIPL appointed Adv Owen Salmon as the Adjudicator in this matter on 17 September 2009. 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 domain was registered on 26 November 2008. It was originally registered in the name of Joris Kroner, but this changed to Digital Orange on 2 June 2009. Mr Kroner remains the administrative contact and the VAT number recorded on the registration has stayed the same. It would appear that Digital Orange is the alter ego of Mr Kroner.¹
- 2.2 The following facts are undisputed and, there not being palpably implausible, the Adjudicator accepts them for the purposes of this adjudication.
- 2.3 The Complainant is ABSA Bank Limited a public company incorporated in accordance with the Company laws of the Republic of South Africa, with its principal place of business at

¹ “Digital Orange” was the Registrant in the <hackett.co.za>. [ZA2009-0033] adjudication decision I gave on 10 September 2009. See para. 1.2 of the decision for reference to Joris Kroner.

ABSA Towers, 160 Main Street, Johannesburg, Gauteng, South Africa.

- 2.4 The Complainant is the proprietor in South Africa of a large number of registrations for the trade mark ABSA, or marks incorporating the mark ABSA. A schedule setting out details of the registrations was attached to the complaint. These include registrations dating from 1991 in fields of business as diverse as are covered by classes 9, 16, 36, 39, 41 and 42 of the International Classification of Goods and Services.
- 2.5 In addition to its statutory rights in the trade mark ABSA, on March 2008, the Complainant filed applications in the Republic for the registration of the trade mark ABSA PREMIERSHIP in various logo forms.
- 2.6 The Complainant's ABSA trade mark is arguably the most well known trade mark in South Africa. At the very least, it qualifies as a well known trade mark as contemplated in Section 35 of the Trade Marks Act and Article 6 *bis* of the Paris Convention.
- 2.7 The Complainant is the largest commercial bank in South Africa and has branches or automated teller machines in virtually every town in the country, with over 800 points of representation. The Complainant currently has in excess of 10 million clients and is well known to all its clients and virtually all clients of other banks alike. The Complainant commands a 37% market share in South Africa. No other bank in South Africa has a market share in excess of 30%, resulting in the Complainant being the market leader by a large margin.

- 2.8 It is not necessary to traverse the comprehensive averments submitted to establish the Complainant's common law rights in the mark ABSA. That it is a famous mark in South Africa is beyond doubt.
- 2.9 The Complainant is also the principal sponsor of the South African Premier Soccer League competition, founded by Kaizer Motaung and Irvin Khoza in 1996. In 2007, when the PSL signed a R1.6 billion television deal with SuperSport (the biggest sporting deal in the history of South Africa) the Complainant became the PSL's official sponsor, with the league's premier competition being named the ABSA PREMIERSHIP.
- 2.10 The ABSA PREMIERSHIP consists of the top 16 soccer teams in the Republic, and is the most popular soccer league in South Africa. A substantial amount of exposure is given to the ABSA and ABSA PREMIERSHIP trade marks in the Complainant's sponsorship of the competition.
- 2.11 The Complainant has acquired strong statutory and common law rights in the trade mark ABSA, and has also acquired strong common law rights in the trade mark ABSA PREMIERSHIP. Assuming the Complainant's applications proceed to registration, it will also have acquired statutory rights in the trade mark ABSA PREMIERSHIP and these will date back from 10 March 2008, some 8 months prior to the registration of the domain name.
- 2.12 The domain name <absapremiership.co.za> wholly incorporates the Complainant's ABSA trade mark and is identical to the Complainant's ABSA PREMIERSHIP trade mark.

2.13 The domain name points to a single static webpage which states that *“This will soon be the new home of the domain: www.absapremiership.co.za”*.

3. Complainant’s Contentions

3.1 The Complainant’s statutory and common law rights in the trade marks ABSA and ABSA PREMIERSHIP predate the registration of the disputed domain name. This, in turn, incorporates the ABSA trade mark and is identical to the trade mark ABSA PREMIERSHIP, both of which are extremely well known trade marks in South Africa.

3.2 It is contended that members of the public will associate the domain name <absapremiership.co.za> with the Complainant and the ABSA PREMIERSHIP Soccer League and will believe that the domain name, and whatever website it may point to in future, belongs to the Complainant. The existence of such confusion and deception will cause the Complainant irreparable harm to the reputation and goodwill which vests in its ABSA and ABSA PREMIERSHIP trade marks.

3.3 Further, the trade mark ABSA has no ordinary meaning in the English language, other than to refer to the Complainant and it (and ABSA PREMIERSHIP) is so well known that the Registrant premeditated registration of the domain name in question, with full knowledge of the Complainant’s rights. There is no other explanation for the incorporation of the ABSA trade mark in the domain name in question other than that the Registrant intended to take unfair advantage of the goodwill and reputation which vests in the ABSA and ABSA PREMIERSHIP trade marks.

- 3.4 Despite registering the domain name in November 2008, the Registrant has not pointed the domain name to an active website. This could create confusion or, if used, would create confusion. (In this regard, the Complainant relies on the decision in the matter of Telkom SA Limited v Cool Ideas 1290 CC [ZA2007-0003].) In particular, the Complainant is concerned that the Registrant may point the domain name to an active website in future, or may elect to sell the domain name, including for an exorbitant price.
- 3.5 The Registrant is inhibiting the marketing and advertising efforts of the Complainant by intentionally blocking the Complainant's registration of the domain name in question. By virtue of the Registrant's actions, the Complainant is unable to make use of a domain name which is identical to one of its most well known trade marks, in the domain name space which is most ideally suited to use in South Africa, being the .co.za domain name space. (In this regard the Complainant refers to the matter of Fédération Internationale de Football Association v X Yin [ZA2007-0007].)
- 3.6 Notwithstanding the above, the Complainant submits that the passive holding of a domain name, i.e. the registration and mere holding, without pointing to an active website, amounts to abusive use of a domain name. (In this regard, the Complainant relies on the decision in the matter of Telstra Corporation Limited v Nuclear Marshmallows [WIPO Case no. D2000-0003].)

4. Registrant's Contentions

4.1 The contentions of the Registrant (such as they are) have been set out above.² There is no answer to the Complainant's allegations.

5. Discussion and findings

5.1 The Adjudicator finds that the Complaint has rights in respect of the mark ABSA and the mark ABSAPREMIERSHIP as contemplated by Regulation 3(1)(a). The question is whether the registration in the hands of the Registrant is an abusive registration.

5.2 An abusive registration means a domain name which either:-

(a) 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

(b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.³

5.3 The Complainant is required to prove on a balance of probabilities that the required elements are present.⁴

² The Adjudicator notes that the response is not compliant with the Regulations.

³ The definition under (b) is not relevant for present purposes.

⁴ Regulation 3(2).

5.4 Mr Kroner's statement that:-

“Absa became the official sponsor of the PSL in 2007 which makes it reasonable to assume that they would have had ample time to register the domain. However, they have obviously chosen not to do so”

indicates a clear awareness as to the Complainant's rights and interests in the marks, and potentially in the domain.

5.5 The statement that “*domain names are allocated on a first come, first served*” basis is not an accurate reflection of the law. Without deciding that it is, this may be the position when the subject matter of the domain is thitherto unclaimed or – in, trade mark parlance, adopted. *Non constat* that this is the position with marks in which there are existing rights.

5.6 In terms of Regulation 4(1)(a), factors which may indicate that the domain name is an abusive registration include circumstances indicating that the registration was primarily to:-

5.6.1 transfer the domain name to a complainant for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring the domain name;

5.6.2 block intentionally the registration of a name or mark in which the Complainant has rights;

5.6.3 disrupt unfairly the business of a Complainant;

5.6.4 prevent the Complainant from exercising its rights.

- 5.7 Moreover, in terms of Regulation 4(1)(c), a further factor may be evidence that the registrant is engaged in a pattern of making abusive registrations.
- 5.8 In this regard, the finding in <hackett.co.za> [ZA2009-0033] was that the registration by Digital Orange (i.e. the same registrant) was abusive. No evidence has been presented in the current objection to indicate that Digital Orange (and/or Joris Kroner) is engaged in a pattern of making abusive registrations, and the Adjudicator cannot find that one (previous finding of an abusive registration) constitutes a “pattern”.
- 5.9 Nevertheless, the Adjudicator finds that the registration was abusive. On the Registrant’s own cognizance, it (he) was fully aware of the Complainant’s rights and interests in the name. Mr Kroner could not do anything by way of legitimate trade under the name ABSA PREMIERSHIP for to do so would, *prima facie* at least, be deceptive. Coupled with the dormant state of the site, this inference is inescapable that the registration was obtained for motives which, in the Adjudicator’s view, fall comfortably within Regulation 4(1)(a).
- 5.10 Accordingly, the Adjudicator upholds the Complainant’s Dispute.

6. Decision

For the foregoing reasons the Adjudicator orders that the domain name be transferred to the Complainant.

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ADV OWEN SALMON
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za