

ADJUDICATOR DECISION

CASE NUMBER:	ZA2016-0247
DECISION DATE:	30 NOVEMBER 2016
DOMAIN NAME	REMEMBERINGMADIBA.CO.ZA
THE DOMAIN NAME REGISTRANT:	RICKI ALLEMANN
REGISTRANT'S LEGAL COUNSEL:	NONE
THE COMPLAINANT:	THE TRUSTEES FOR THE TIME BEING OF THE NELSON MANDELA FOUNDATION TRUST
COMPLAINANT'S LEGAL COUNSEL:	EDWARD NATHAN SONNENBERGS INC.
2 nd LEVEL ADMINISTRATOR:	ZA CENTRAL REGISTRY (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAI IPL") on **04 October 2016**. On 07 October 2016 the SAI IPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **10 October 2016** ZACR confirmed that the domain name had indeed been suspended. The SAI IPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAI IPL's Supplementary Procedure.
- b) In accordance with the Regulations, the SAI IPL formally notified the Registrant of the commencement of the Dispute on **11 October 2016**. In accordance with the Regulations the due date for the Registrant's Response was **08 November 2016**. The Registrant did not submit any response, and accordingly, the SAI IPL notified the Registrant of its default on **09 November 2016**.
- c) The SAI IPL appointed **Mrs Vanessa Ferguson** as the Adjudicator assisted by **Mr Robin Richardson** as a Trainee Adjudicator in this matter on **16 November 2016**. The Adjudicator and Trainee Adjudicator have submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAI IPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Complainant is The Trustees for the Time Being of the Nelson Mandela Foundation Trust (hereafter referred to as "The Nelson Mandela Foundation"). According to the Complainant's uncontested facts, The Nelson Mandela Foundation was established by the late Nelson Mandela with a view to promoting the visions, values and work of its founder. The Complainant is tasked with providing and maintaining a dynamic and trusted resource on

the legacy of the late Nelson Mandela.

2.2 The Complainant is the proprietor of the following South African trade mark registrations:

- Trade mark registration nos. 2004/17450-3 **MADIBA** in classes 16, 35, 36 and 41.

2.3 The Complainant is the proprietor of the following domain names:

- NELSONMANDELA.ORG;
- MADIBAMEMORIAL.CO.ZA;
- MADIBAMEMORY.CO.ZA.

2.4 The Complainant's trade mark MADIBA appears, on the uncontested facts of the Complainant, to be in use in South Africa and appears on its website located at WWW.NELSONMANDELA.ORG.

2.5 On or about February 2016, the Complainant became aware of the domain name REMEMBERINGMADIBA.CO.ZA.

2.6 On 8 March 2016, the Complainant instructed its attorneys, Edward Nathan Sonnenburgs, to send a letter of demand to the Registrant setting out the Complainant's statutory rights and calling on the Registrant to cease all use of the trade mark "MADIBA" and cancel the domain name registration REMEMBERINGMADIBA.CO.ZA. By 12 May 2016, the Complainant had not received a response to its letter of demand and a further email was sent calling for a response by 16 May 2016.

The Complainant submits that to date no response has been received from the Registrant.

3 Parties' Contentions

3.1 Complainant

a) The Complainant contends that the domain name,

REMEMBERINGMADIBA.CO.ZA, incorporates the Complainant's MADIBA trade mark in its entirety. The Complainant contends that the word "REMEMBERING" is wholly descriptive and does not distinguish the domain name from the trade mark MADIBA. The Complainant further contends that presence of the word "REMEMBERING" enhances the similarity between the domain name and trade mark MADIBA in that it invokes reference to the late Nelson Mandela and how he can be remembered.

b) The Complainant drew the Adjudicator's attention to the following WIPO UDRP decisions:

- 1) D2000-1493 (4MICROSOFT2000.COM)
- 2) D2000-1534 (MYNUTELLA.COM)
- 3) D2003-0273 (WWWAMCTV.COM)
- 4) D2005-0037 (BUYLANTUS.COM)

The Complainant submitted that in the WIPO cases the panellist(s) found that a user of a mark may not avoid a likelihood of confusion by appropriating another's entire mark and adding descriptive or non-distinctive matter to it.

c) The Complainant contends that as a result of the Complainant's online presence and the fact that the domain was, in its opinion, confusingly similar to the mark MADIBA, there was likelihood of the public or internet users being confused or deceived into believing that there is an affiliation or association between the Complainant and the Registrant.

d) In summary, the Complainant contends that as a result of its extensive use, reputation and registered rights in the mark MADIBA, the registration of the domain name by the Registrant constitutes an abusive registration in terms of Regulation 3(1)(a) read with Regulation 4(1) in that the Registrant has registered the domain

name primarily to:

- 1) block intentionally the registration of a name or mark in which the Complainant has rights [Regulation 4(1)(a)(ii)];
- 2) disrupt unfairly the business of the Complainant [Regulation 4(1)(a)(iii)];
- 3) prevent the Complainant from exercising his, her, or its rights [Regulation 4(1)(a)(iv)]

The Complainant further contends that the Registrant 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 [Regulation 4(1)(b)]

- e) The Complainant, furthermore, submits that the domain name is abusive in that it is unfairly detrimental to and takes unfair advantage of the Complainant's rights. This, the Complainant contends, is especially in light of the fact that the Complainant has no control over the content and information provided on the website hosted on the domain name and, as such, any incorrect information on the website is likely to damage the reputation of the trade mark MADIBA and that of the late Nelson Mandela.
- f) The Complainant has furthermore contended that the mark MADIBA is well known and the existence of the domain name is likely to result in dilution of the trade mark.

The Complainant drew the Adjudicators attention to the WIPO decision of *Red Bull GMBH v Harold Gutch* (D2000-0766) where the panellist found that the mere registration of a domain name that contains a well known trade mark 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.

3.2 Registrant

- a) The Respondent did not reply to the Complainant's contentions.

4 Discussion and Findings

4.1 Complainant's Rights

4.1.1 The Complainant's MADIBA trade mark is registered and a reputation subsists in the name MADIBA which attaches to the late Nelson Mandela and, by association, The Nelson Mandela Foundation which is charged with maintaining the reputation and legacy of the late Former President.

4.1.2 Although the dominant element of the offending domain name is identical to the Complainant's trade mark registrations, the domain name, as a whole (not including the second level suffixes), is not identical to the mark MADIBA in which the Complainant asserts rights, without any addition, as provided for in terms of the proviso contained in Regulation 5(c).

In terms of Regulation 5(c) states "*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;*"

In decision ZA2012-0114, the Adjudicator held that although the domain name WALTONSJHB.CO.ZA incorporated the registered mark, WALTONS, the addition of the abbreviation JHB was a further addition and therefore the burden remained with the Complainant to show that the registration was abusive.

In the circumstances, the addition of the word REMEMBERING, is a further addition in terms of Regulation 5(c) and, as such, the burden

remains with the Complainant to show, on a balance of probabilities, that the registration of the domain name REMEMBERINGMADIBA.CO.ZA is abusive.

4.2 Abusive Registration

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

(i) 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 Complainants' rights;

or

(ii) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainants' rights.

The Complainant is required to prove, on a balance of probabilities, that the required elements in Regulation 3(1)(a) are present namely:

- i) the Complainant has rights in respect of a name or mark;
- ii) the domain name is identical or similar to a name or mark in respect of which the Complainant has rights;
- iii) the domain name in the hands of the Registrant is an abusive registration.

The Complainant has by virtue of its registered rights in the trade mark MADIBA established that it has rights in respect of the mark MADIBA. Furthermore, by incorporation of the trade mark MADIBA into the domain name, the domain name is similar to the mark in respect of which the Complainant has rights. The addition of the generic word "REMEMBERING" does not in Adjudicator's view serve to distinguish the domain name sufficiently from the mark MADIBA. In this regard, the Adjudicator agrees with the findings of the Adjudicator in case ZA2007-0003.

As such, it remains to determine whether the domain name,

REMEMBERINGMADIBA.CO.ZA, in the hands of the Registrant is an abusive registration on the grounds submitted by the Complainant, namely Regulations 4(1)(a)(ii), (iii) & (iv) and 4(1)(b).

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

(a)

- (i) 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;
- (ii) Block intentionally the registration of a name or mark in which the Complainant has rights;
- (iii) Disrupt unfairly the business of a Complainant;
- (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.

4.2.3 **Regulation (4)(1)(a)(ii), (iii) & (iv)**

No evidence was submitted that the registration of the domain name was done with the primary intention of blocking the registration of a name or mark in which the Complainant has rights in or disrupting the Complainant's business.

Furthermore, no evidence was submitted that showed that the domain name actually disrupted or disrupts the business of the

Complainant. From the evidence before the Adjudicator, the website appears to be a tribute to the late Nelson Mandela with the intention of allowing internet users to share stories about experiences they have had with Mr Mandela.

From the evidence before the Adjudicator it would furthermore appear that the Registrant does not use the domain name for commercial gain as there does not appear to be affiliate advertising or any goods or services pertaining to the late Nelson Mandela on offer.

Although the Registrant has registered a domain name in which the Complainant has an interest, the registration of the domain name does not prevent the Complainant from exercising its rights. The domain name was registered on 01 July 2013 and the Registrant has utilised the domain name since such date without preventing the Complainant from exercising its rights. The Complainant has failed to provide any evidence as to how the Registrant is preventing it from exercising its rights.

The Adjudicator finds that the Complainant has failed to discharge the onus on a balance of probabilities that the registration of the domain name is abusive in terms of Regulation (4)(1)(a)(ii), (iii) & (iv).

4.2.4 **Regulation 4(1)(b)**

Regulation 4(1)(b) states "*factors which may indicate that the domain name is an abusive registration includes 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.*"

The Complainant is the proprietor of the trade mark MADIBA as well as the domain names MADIBAMEMORIAL.CO.ZA and

MADIBAMEMORY.CO.ZA. The Complainant furthermore is tasked with protecting and ensuring that the legacy of the late Nelson Mandela is not tarnished or harmed in any way.

It is an established legal principle that a domain name that comprises a trade mark coupled with a generic term, that domain name is still confusingly similar to the trade mark. In support thereof, the Adjudicator agrees with the findings in SAIPL decisions ZA2007-0003 Telkom SA Limited v Cool Ideas 1290 CC and ZA2007-0004 Telkom SA Limited and TDS Directory Operations (Pty) Ltd v The Internet Corporation.

Furthermore, it was held in decision of ZA2007/0003 that actual confusion is not necessary and that the potential or likelihood of confusion would be sufficient. In this regard the Adjudicator in ZA2007/0003 referred to, with approval, the foreign decisions in WIPO/D2000-0777, WIPO/D2000-878, NAF/FA95033 and NAF/FA95402. It was further held that confusion may be inferred in situations where the Registrant registered a domain name containing the Complainant's name or mark together with a generic term.

It is important to note that in terms of Regulation 5(1)(c) that a Registrant may raise the defence that there has been fair use of the domain name, which use may include web sites operated solely in tribute to or fair criticism of a person or business. This defence was not raised by the Registrant. As the defence was not raised, it is not necessary to make a finding in this regard however in the interest of clarifying the situation regarding tribute websites, the Adjudicator will deal with, as orbiter, the ambit of such a defence.

The domain name REMEMBERINGMADIBA.CO.ZA appears to be a tribute website, however, it is still necessary for the Registrant to show that it has sufficiently distinguished itself from the Complainant such that on a balance of probabilities, it is unlikely that confusion or deception will arise.

A similar situation arose in the case of ZA2008-0014 *Automobiles Citroen vs. Mark Garrod* where a Citroen enthusiast registered the domain name CITROEN.CO.ZA in order to create a tribute website to the car manufacturer, Citroen. Although the purpose of the website hosted on the domain name was as a tribute to the car manufacturer and the Registrant did not commercially gain from the website or the use of the domain name, the Adjudicator found that *"the criteria by which (allegedly) tribute sites are to be assessed cannot exclude, but indeed should be lead by, the criteria in terms of which the unauthorized use of a trade mark is permissible"*. The Adjudicator went on to refer to the case of *Commercial Autoglass (Pty) Ltd v BMW AG [2007] (6) SA 637*. The following excerpts taken from the case are of equal importance in the present matter:

'Harms ADP, giving the judgment of the Court, stated:-

"The object of Trade Mark Law as reflected in Section 34(1)(a) and (b) is to prevent commercial "speech" that is misleading. Trade Mark use that is not misleading (in the sense of suggesting provenance by the trade mark owner) is protected, not only constitutionally but in terms of ordinary trade mark principles...."

and then continued:-

*"The question that arises is why the Appellant insists on conducting its business in the manner described. **Why can it not, through the use of a few words, convey the true facts to the public?** from this one can only deduce that the Appellant wishes to obtain an unfair advantage from the use of the trade mark and does not wish to inform the public of the true facts concerning the origin of the windscreens. In other words, the argument that the advertisements "consist wholly of descriptive, truthful commercial speech" is without factual foundation. "*

The principle taken from *Commercial Autoglass (Pty) Ltd v BMW AG* was eloquently summarised by the Adjudicator in case ZA2008-0014 as follows:

"When the mark of another is appropriated, it must be in a manner that cannot leave scope for doubt but that it is wholly descriptive and truthful. When that happens, jurisprudence deems the use acceptable, otherwise not."

In applying the above principles to the present matter, it is evident that the Registrant has not gone to any lengths to ensure that members of the public when entering the website are informed that the website is not operated, affiliated or associated with the Complainant. In the *Citroen* case the Registrant had placed disclaimers on his website which stated "THE WEBSITE OF CITROEN ENTHUSIAST MARK GARROD" and ""Please note that this site is purely a collectors site and has no links to Citroen South Africa." The Registrant in the present matter has placed no such disclaimers on the website located at REMEMBERINGMADIBA.CO.ZA.

The likelihood of confusion is enhanced by virtue of the fact that the Registrant has copied, in whole, the biography section of the Complainant's website located at <http://www.nelsonmandela.org/content/page/biography> and has referenced same on its website by simply stating "Taken From: <http://www.nelsonmandela.org/content/page/biography>". Such a reference does not clearly indicate the relationship between the Registrant and the Complainant or allow a member of public to determine whether the Registrant is affiliated to the Complainant by virtue of the link.

By failing to clearly indicate that the website is not affiliated or associated with the Complainant, by using the Complainant's protected biographical materials in whole and by utilising the Complainant's registered trade mark MADIBA in a dominant manner

in its domain name, the Registrant has left extensive room for doubt as to the whether the domain name and the website hosted thereon is affiliated, associated or connected with the Complainant.

As such the Complainant has on a balance of probabilities, and in the absence of evidence from the Registrant, shown that the registration of the domain name is abusive in terms of Regulation 4(1)(b) in that the Registrant is using 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 has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights in its registered trade mark, MADIBA.

Complainant's submissions as to the well known nature of its mark , MADIBA.

It is not necessary to deal in-depth with the well known nature of the Complainant's trade mark, MADIBA, as the Adjudicator has already found that the domain name is an abusive registration.

5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, REMEMBERINGMADIBA.CO.ZA, be transferred to the Complainant.

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VANESSA FERGUSON

SAIPL SENIOR ADJUDICATOR

www.DomainDisputes.co.za

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ROBIN RICHARDSON

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