

## ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2017-0271</b>
DECISION DATE:	<b>04 SEPTEMBER 2017</b>
DOMAIN NAME	<b>SOWETANONLINE.CO.ZA</b>
THE DOMAIN NAME REGISTRANT:	<b>JAMES SAI</b>
REGISTRANT'S LEGAL COUNSEL:	<b>NONE</b>
THE COMPLAINANT:	<b>TIMES MEDIA (PROPRIETARY) LIMITED</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>TYRONE WALKER, MOORE ATTORNEYS INCORPORATED</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZA CENTRAL REGISTRY (CO.ZA ADMINISTRATORS)</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **6 July 2017**. On **6 July 2017** the SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **7 July 2017** ZACR 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.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **12 July 2017**. In accordance with the Regulations the due date for the Registrant's Response was **10 August 2017**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **14 August 2017**.
- c) The SAIPL appointed **Marthinus Jacobus van der Merwe** as the Adjudicator on **15 August 2017**. The Adjudicator has submitted a 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 Times Media (Proprietary) Limited, a company duly incorporated according to the laws of the Republic of South Africa, having its principal place of business at 4 Biermann Avenue, Rosebank, Johannesburg. The Complainant is the owner of the South African daily newspaper, SOWETAN, established in 1981 with a readership of almost two million people and circulation of 98 258 people according to the Complainant's uncontested facts.

2.2 The Complainant is the Proprietor in South Africa of the following registered trade marks comprising the word SOWETAN:

- Trade Mark No. 1995/03156 SOWETAN in class 16;
- Trade Mark No. 1995/03157 SOWETAN in class 18;
- Trade Mark No. 1995/03158 SOWETAN in class 24;
- Trade Mark No. 1995/03159 SOWETAN in class 25;
- Trade Mark No. 1995/03160 SOWETAN in class 28;
- Trade Mark No. 1995/03161 SOWETAN in class 35;
- Trade Mark No. 1995/03162 SOWETAN in class 41;
- Trade Mark No. 1995/03163 SOWETAN in class 35;
- Trade Mark No. 1995/03163/1 SOWETAN in class 43; and
- Trade Mark No. 2005/11575 SOWETAN in class 38.

In addition the Complainant is the proprietor of, *inter alia*, the following registered and pending trade marks in various classes incorporating the word SOWETAN:

- SOWETAN EXTRATIME LOGO;
- SOWETAN EXTRA TIME;
- SOWETAN BRIDAL COUPLE OF THE YEAR;
- SOWETANWOMEN'S CLUB;
- SOWETANBIG WALK;
- SOWETANTELEVISION; and
- SOWETAN LIVE.

The above trade marks are collectively referred to as the "SOWETAN" trade marks.

In addition to the above, the Complainant is the Registrant of the following domain names, including but not limited to:

- sowetan.co.za since 28 January 1997;
- sowetanjobs.co.za since 05 December 2013;
- sowetandating.co.za since 25 August 2011;

- sowetanlive.co.za since 22 October 2008;
- sowetanliveshop.co.za since 12 August 2014, and
- sowetansoccer.co.za since 28 March 2014.

The above domain names are collectively referred to as the "SOWETAN" domain names.

The SOWETAN trade marks cover a wide range of goods and services, amongst others, telecommunication services, entertainment services, newspapers and periodicals. The trade mark registrations appear to have been timeously renewed and remain registered.

- 2.3 In addition to its registered trade marks, the Complainant claims to have developed a considerable reputation in its SOWETAN trade mark as a result of 35 plus years of extensive, consistent use of its mark in relation to printed matter and as contended "all forms of media including radio and television", and that as a result, it has acquired rights to protect its mark at common law. The Complainant has, under oath, adduced substantial evidence of use in support of its claim to a reputation, all for periods predating the registration date of the contested domain, including but not limited to circulation figures and estimated readership. Additionally, the Complainant owns the SOWETAN domain names, including sowetan.co.za, first registered in 1997. All of this evidence is uncontested by the Registrant.
- 2.4 The contested domain name, SOWETANONLINE.CO.ZA, was registered on **14 February 2014**. This domain appears to be used solely for affiliate or pay-per-click marketing of "online ordering, online games, online ticketing, etc." services of others.
- 2.5 Based on the WHOIS page for the contested domain, the Registrant is James Sai, ostensibly a resident of Kuala Lumpur, Malaysia.

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### 3 Parties' Contentions

#### 3.1 Complainant

- a) The Complainant contends that the contested domain name is confusingly similar to the Complainant's registered and common law trade marks consisting of incorporating the SOWETAN trade marks and domain names.
- b) The Complainant contends that as a result of its reputation and registered rights in its mark, the registration of the disputed domain constitutes an abusive registration in terms of Regulation 3(1)(a) in that the Registrant has, in terms of Regulation 4(1)(a), registered the domain name primarily to 1) block intentionally the registration of a name or mark in which the complainant has rights; 2) disrupt unfairly the business of the complainant; or 3) prevent the complainant from exercising its rights.
- c) The Complainant contends that the Registrant has registered the contested domain, and has in fact used it, in a manner that is likely to confuse consumers into believing that the associated website is connected to or endorsed by the Complainant. Additionally, the Complainant contends that the contested domain was deliberately chosen in order to divert traffic to the Registrant's website and then to misdirect that traffic to the websites of those third parties whose services are advertised on the Registrant's website.
- d) The Complainant additionally contends that the contested domain name was registered with the intention of taking unfair advantage of the Complainant.
- e) Finally, the Complainant contends that the Registrant has engaged in a pattern of making abusive registrations in terms of Regulation 4(1)(c). In this regard, the Complainant has directed us to numerous

other domains registered by this Registrant that have previously been found to be abusive registrations. This will be discussed in the findings below.

### 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 has chosen a trade mark, being the word SOWETAN, and SOWETAN used in conjunction with other words. Whilst "Soweto" is a place name and accordingly carries a geographical significance, and the word "Sowetan" would in its ordinary significance refer to an inhabitant of Soweto, in light of section 51 of the Act, I am bound to find that the Complainant's registered marks are *prima facie* valid. In any event, I agree with previous decisions by Adjudicators that these proceedings are neither designed nor appropriate for considering the validity of registered trade marks (see the decision in [ZA20110075](#) at para 4.9).

4.1.2 The Complainant has adduced significant evidence of use of its marks, which remains uncontested. In our view, the Complainant has tendered evidence sufficient to establish a reputation in its SOWETAN trade marks and rights to defend such mark at common law.

4.1.3 The disputed domain name SOWETANONLINE differs from the registered trade marks SOWETAN in that it is coupled with the word "online". The word "online" presupposes being linked to the Internet or a network of computers and phrases such as "online shopping",

“online banking” and “online publication” carry corresponding meanings. Having established registered trade mark rights and at common law in SOWETAN, specifically in respect of newspapers, periodicals, television and media; the addition of the word ONLINE defines the word SOWETAN, i.e. the “online” edition of SOWETAN. In this regard, I concur with the SAIIPL decision of ZA2016-0250, referred to by the Complainant where it was found that the use of the word LIVE is insufficient to distinguish one domain from another, specifically in respect of media and publishing industries. The addition of the word “online” to SOWETAN does not differentiate between the contested domain name and the rights of the Complainant, it merely defines the media or format of publication. I accordingly find that the Complainant has rights in respect of a mark that is confusingly similar to the contested domain name in terms of Regulation 3(1)(a).

#### 4.2 Abusive Registration

4.2.1 The Complainant has directed us to a number of previous decisions in which the Registrant was found to have made abusive registrations and listed hereunder are the examples:

<b>Case no.</b>	<b>Domain name(s)</b>	<b>Date of decision</b>
<a href="#">ZA2014-00187</a>	STANDARDBANKMOBI.CO.ZA	2 December 2014
<a href="#">ZA2014-00189</a>	SASOLLEARNERSHIP.CO.ZA SASOLCAREER.CO.ZA	23 January 2015
<a href="#">ZA2015-00197</a>	SOWETANJOBS.CO.ZA	23 JUNE 2015
<a href="#">ZA2015-00214</a>	TRANSLUXBUS.CO.ZA	22 October 2015
ZA2015-00224	INVESTMENTSOLUTION.CO.ZA	25 January 2016
ZA2016-00242	VARIOUS DOMAIN NAMES INCOPORATING NEDBANK	7 December 2016
ZA2016-00250	SUNDAYTIMESLIVE	1 DECEMBER

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		2016
ZA2016-00251	ABSAPERSONALLOANS.CO.ZA	4 JANUARY 2017

4.2.2 On all of the decisions referred to above, the Registrant was found to have made abusive registrations. Accordingly, I find that Regulation 4(3) is applicable and that a rebuttable presumption that the contested domain is an abusive registration applies. Given that the Registrant has not responded to the complaint, the presumption has not been rebutted and that the contested domain name must be found to be an abusive registration on this basis. Nevertheless, in case I am incorrect, I will consider the merits of the matter.

4.2.3 An abusive registration means a domain name which either:

- 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
- 2) Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

4.2.4 The Registrant uses the domain name to advertise the services of third parties which are similar to those offered by the Complainant. In addition, the contested domain name incorporates the registered trade marks of the Complainant as well as the Complainant's own domain name, differing only in respect of the addition of the word "ONLINE". In light of the meaning and the modern application of the word "online", i.e. an internet version of, for instance a paper publication the contested domain name is likely to lead to internet users viewing the Registrant's website when they in fact intended to view an Internet or "online" version of the Complainant's website.

4.2.5 This conduct may lead to a disruption of the Complainant's business as well as preventing the Complainant from exercising its rights to

enjoy, unhindered, the goodwill associated with its trade mark in terms of Regulation 4(1)(a)(iii) and (iv).

- 4.2.6 In light of the Registrant's history of abusive registrations, I find that the factor listed at Regulation 4(1)(c) is also applicable and that it is proper to take the Registrant's history of abusive registrations into account in this matter.
- 4.2.7 Given that the contested domain name has been put to some limited use, I need to consider whether Regulation 5(a)(i) applies and whether the Registrant can be said to have used the domain in connection with a good faith offering of goods or services. In numerous local and foreign domain name decisions it has been held that use of a domain name that conflicts with a complainant's trade mark purely for the purposes of providing pay-per-click advertisements to third party businesses that compete with the complainant does not amount to a good faith offering of goods or services. See WIPO decisions [D2007-1499](#), [D2010-1652](#) and the local decision in [ZA2015-0209](#). I respectfully agree with these decisions and find the principle to be equally applicable here, especially given the repute of the Complainant's mark in this case. If the general principle were otherwise, then it would be open to registrants to adopt the trade marks of others as domain names, use them for competing services and potentially profit from the exercise.
- 4.2.8 In the circumstances, I find that the contested domain name is an abusive registration.

5. **Decision**

5.1 For all the foregoing reasons, in accordance with Regulation 9, I order that the disputed domain name, SOWETANONLINE.CO.ZA, be transferred to the Complainant.

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[MARTHINUS JACOBUS VAN DER MERWE]

SAIIPL SENIOR ADJUDICATOR

[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)