

ADJUDICATOR DECISION

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| CASE NUMBER: | ZA2010-0050 |
| DECISION DATE: | 25 September 2010 |
| DOMAIN NAME | movingforward.co.za |
| THE DOMAIN NAME REGISTRANT: | Digitalorange |
| 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) |

Contents

| | |
|---------------------------------------|-----------|
| <u>1 Procedural History.....</u> | <u>2</u> |
| <u>2 Factual Background.....</u> | <u>3</u> |
| <u>3 Parties' Contentions.....</u> | <u>6</u> |
| <u>4 Discussion and Findings.....</u> | <u>9</u> |
| <u>5 Decision.....</u> | <u>11</u> |

1 Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on 29 June 2010. On 30 June 2010 the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on 30 June 2010 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 9 July 2010. In accordance with the Regulations the due date for the Registrant's Response was 5 August 2010. The Registrant submitted its Response on 4 August 2010, and the SAIPL found the Response to be deficient as it did not comply with Regulation 18. The SAIPL notified the Registrant of its default on 10 August 2010. Despite the notification the Registrant failed to file a proper Response which satisfies 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, as the Complainant was one of the addressees when the Registrant submitted the Response to the SAIPL on 4 August 2010. The Complainant submitted its Reply on 20 August 2010.
- 1.4 The SAIPL appointed Advocate Gavin Morley as the Adjudicator in this matter on 18 August 2010. On 18 August 2010, Advocate Gavin Morley advised the SAIPL that he could not act as Adjudicator in this matter as he has acted for the Complainant in the past; furthermore, he banks with the Complainant. The SAIPL appointed the Adjudicator, Vanessa Lawrance on 27 August 2010. 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. The Adjudicator was assisted by Likonelo Magagula.

2 Factual Background

- 2.1 The domain was registered on 22 July 2010 by Digital Orange, with Joris Kroner as the administrative contact. In prior decisions¹ it has been found that Digital Orange is the alter ego of Joris Kroner.
- 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,

¹ ZA2010-0047 <hotelmissoni.co.za>; ZA2009-0038 <peroni.co.za>; ZA2009-0034 <absapremiership.co.za>

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 <movingforward.co.za> is identical to the Complainant’s common law trade mark “MOVING FORWARD”. It was registered on 22 July 2009, this being five days after the official launch of the Complainant’s slogan “MOVING FORWARD”.
- 2.11 On 30 July 2009, the Registrant wrote an email to the Complainant, which stated:-
- “We are the domain holder of the domain movingforward.co.za. We have been approached by a commercial party to sell this domain. Please let me know if Standard Bank is interested as we will otherwise proceed with the sale of this domain.”
- 2.12 The Registrant’s email of 30 July 2009, precipitated a series of correspondence between the Registrant and the Complainant, which ultimately led to the Complainant writing a letter to the Registrant, on 10 November 2009, setting out the Complainant’s rights in MOVING

FORWARD, and demanding that the Registrant transfer the disputed domain name to the Complainant.

2.13 On 11 November 2009, the Registrant responded in part as follows to the Complainant's demand:-

“Registering domain names is done on a “first come first served basis”. Moving forward is a generic English term which as such has no connection with Standard Bank....

However I would consider selling the domain to Standard Bank”.

2.14 On 12 November 2009, the Registrant sent a further email to the Complainant, threatening to proceed with the sale of the domain name in question to an interested third party. The Registrant's email stated inter alia:-

“Should you not be interested in acquiring this domain, please let me know before Friday 13th November. After that we will move forward with selling the domain to other interested parties.”

2.15 The domain in question has not been in use since it was registered. When it is accessed it points to an inactive website which states “This will soon be the new home of the domain www.movingforward.co.za.”

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 applied for registration of the "MOVING FORWARD" trade mark in South Africa and in other countries, including, Angola, Argentina, Brazil, Botswana, the Democratic Republic of Congo, Ghana, Hong Kong, India, Lesotho, Mauritius, Malawi, Malaysia, Mozambique, Nigeria, Singapore, South Taiwan, Tanzania, Uganda, United Arab Emirates, Zambia and Zimbabwe.
- 3.1.4 In the event that the Complainant's trade mark applications proceed to registration, it claims that the Registrant's use of the domain name in question is likely to infringe Complainant's rights in the "MOVING FORWARD" trade mark. The Adjudicator is of the view that the more correct position is that use of the domain name under discussion has the potential to infringe the Complainant's rights.
- 3.1.5 The Registrant does not have legitimate rights in the "MOVING FORWARD" trade mark. The Registrant has no intention of using the disputed domain name, as evidenced by the fact that, from date of registration to date, the domain name points to an inactive website. Furthermore, the fact that the Registrant offered to sell the domain name to the Complainant just over a month after the registration thereof is evidence of the fact that Registrant registered the domain name in full knowledge of the Complainant's rights, with the intention to sell the domain in excess of its pocket expenses associated with

acquiring and with the intention of blocking the Complainant from exercising its rights.

- 3.1.6 Although the Complainant's "MOVING FORWARD" trade marks have not proceeded to registration in South Africa yet, this should not be bar to the Complainant bringing a complaint against the Registrant. In this regard the Complainant made reference to the WIPO decision of *Pahahalo Capital (Pty) Ltd v Lawrence E.M. Hart* Case No. D2007-0415.
- 3.1.7 The Registrant's conduct falls within the ambit of Regulation 4(1)(c) in that the Registrant is involved in a pattern of making abusive registrations. In this regard the Complainant referred to the decisions in *<hackett.co.za>* (ZA2009-0033) and in *<absapremiership.co.za>* (ZA2009-0034), which decisions found Registrant's registration of the domains *<hackett.co.za>* and *<absapremiership.co.za>* as abusive. The Complainant also referred to the cases: FIFA vs. X Yin (ZA2007-0007) and Telkom SA Limited vs. Customer Care Solutions (Pty) Ltd (ZA2007-0004).
- 3.1.8 In conclusion based on the foregoing, the Complainant alleged that the domain registration is abusive within the meaning of Regulation 1(a).

3.2 Registrant

- 3.2.1 “MOVING FORWARD” is a generic English term. It is not a brand or a registered trade mark and, as such, it is available for registration as a domain name.
- 3.2.2 It is coincidental that the time of registration of the domain name in dispute was five days after the launch of the Complainant’s “MOVING FORWARD” campaign.
- 3.2.3 At the time of registration of the disputed domain name, the “MOVING FORWARD” pay off line was not well known or synonymous with the Complainant. It was already widespread and well known as Toyota’s global payoff line
- 3.2.4 Point 4 and 5 of UniForums’ SA Legal FAQ’s clearly show that registering a domain name without immediately using it and offering to sell it to an interested party is not in conflict with CO.ZA terms and conditions and can thus not be considered as abusive.

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. In the present case, however, this will not be necessary, as Regulation 4(3) is applicable. Regulation 4(3) creates the rebuttable presumption that a domain registration is abusive if the Complainant proves that the Registrant has been found to have made abusive registrations in three or more disputes in the 12 months before the dispute was filed.
- 4.4 In the 12 months preceding the filing of the present dispute, Digital Orange / Mr. Jonis Kroner has been found to have made abusive registrations in the following disputes:-
 - 4.4.1 Domain Name: <hackett.co.za.>, case no. ZA2009-0033, Decision Date: 10 September 2009;
 - 4.4.2 Domain Name: <absanpremiership.co.za>, case number ZA2009-0034, Decision Date: 5 October 2009;
 - 4.4.3 Domain Name: <ketelone.co.za>, case number ZA2009-0037, Decision Date: 15 December 2009;
 - 4.4.4 Domain Name: <peroni.co.za> case number ZA2009-0038, Decision Date: 15 December 2009;

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- 4.4.5 Domain Name: <hotelmissoni.co.za> case number ZA2010-0047, Decision Date: 17 August 2010.
- 4.5 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, why he has failed to make legitimate use of the domain name or why he has not sold it, as he threatened to do as long ago as July 2009. In the circumstances, the Adjudicator finds that the Registrant has failed to rebut the presumption that the disputed domain name is an abusive domain registration. The Adjudicator is therefore entitled to hold that the domain name <movingforward.co.za> is an abusive domain registration in the hands of the Registrant.
- 4.6 Furthermore, the fact that the Registrant has been found to have made five abusive domain registrations in a period of 12 months preceding the filing of the complaint, is evidence that the Registrant is engaged in a pattern of making abusive registrations as contemplated in Regulation 4(1)(c). The Registrant's refusal to transfer the domain name to the Complainant and its threats that it has a third party willing to buy the domain name, further indicate that the Registrant had no intention of using the domain in commerce or in a fair manner. The factors indicate that the primary reason for registration of this domain name was to extort money from the Complainant. The inference that can be drawn from the foregoing is that the Registrant registered the domain name <movingforward.co.za> primarily to sell or otherwise to transfer the domain name to a complainant or to a competitor or third party for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses, as contemplated by Regulation 4(1)(a).
- 4.7 The Adjudicator finds the domain registration <movingforward.co.za> by Digital Orange 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, <movingforward.co.za> be transferred to the Complainant.

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VANESSA LAWRENCE
SAIPL SENIOR ADJUDICATOR
Assisted by Likonelo Magagula
www.DomainDisputes.co.za