DomainDisputes.co.za
SAIIPL Alternate Dispute Resolution

Decision

[ZA2010-0059]

.ZA ALTERNATE DISPUTE RESOLUTION REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	**ZA2010-0059**
DECISION DATE:	**21 February 2011**
DOMAIN NAME	**google-adwords.co.za**
THE DOMAIN NAME REGISTRANT:	**T/A GKS Global Consult**
REGISTRANT'S LEGAL COUNSEL:	**N/A**
THE COMPLAINANT:	**Google Inc**
COMPLAINANT'S LEGAL COUNSEL:	**Adams and Adams**
2nd LEVEL ADMINISTRATOR:	**UniForum SA (CO.ZA)**

1 Procedural History

1.1 The Dispute was filed with the South African Institute of Intellectual Property Law on 19 November 2010 (the "SAIIPL"). On 25 November 2010 the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on 30 November 2010 UniForum SA confirmed that the domain name had indeed been suspended. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIIPL's Supplementary Procedure.

1.2 In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on 07 December 2010. In accordance with the Regulations the due date for the Registrant's Response was 12 January 2011. The Registrant did not submit any substantial Response. The SAIIPL accordingly considered the Registrant to be in default and proceeded with appointing the Adjudicator.

1.3 The SAIIPL appointed Victor Williams as the Adjudicator in this matter on 28 January 2011. The Adjudicator has admitted the Statement of Acceptance and Declaration of Impartiality and Independence as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

2.1 The domain was registered on 11 June 2009 by T/A GKS Global Consult, with Peter Meintjies as the administrative contact

2.2 The following facts are undisputed and, as the voluminous evidence in support thereof was not contested, and in light thereof that they are not palpably implausible, the Adjudicator accepts them for purposes of this adjudication.

2.3 The Complainant is Google Inc, a Delaware corporation incorporated and existing under the laws of the State of California, with address at 1600

Amphitheatre Parkway, Mountain View, California 94043, United States of America.

2.4 The Complainant has registered various trade marks, including the trade mark GOOGLE and the trade mark ADWORDS in South Africa and other countries worldwide.

2.5 The Complainant also registered the domain names google.co.za (on 25 June 2001) and adwords.co.za (on 1 April 2003). In addition, the Complainant is the proprietor of the corresponding domain names in other web spaces (such as .com).

2.6 The Google search engine was first available in 1997. I do not think it is possible to dispute that the mark GOOGLE has become well known since that date. Indeed, the Complainant alleges, and the Adjudicator accepts, that the Google search engine is the most used search engine on the internet.

2.7 The Complainant coined the term ADWORDS for its online advertising service in October 2000. The Adjudicator does not believe that it can be argued that the term ADWORDS can be associated with anyone but the Complainant.

2.8 On 5 August 2010, the Complainant sent correspondence to the Registrant's e-mail address, setting out demands (which were not outlined in the Complaint but details of which are not, to the mind of the Adjudicator, essential to this Complaint). The Registrant failed to respond to the demands.

3 Parties' Contentions

3.1 Complainant

3.1.1 The trade marks GOOGLE and ADWORDS are well known and widely recognised as a result of the Complainant's extensive marketing and promotion.

3.1.2 Due to the extensive reputation of the GOOGLE and ADWORDS trade marks, it is improbable, if not impossible, that the Registrant was unaware of the existence of the Complainants' rights in the GOOGLE and ADWORDS trade marks when it registered the domain name google-adwords.co.za on 11 June 2009.

3.1.3 The Complainant has registered the GOOGLE and ADWORDS trade marks in South Africa and in various other countries worldwide.

3.1.4 The Complainant claims that the Registrant's use of the domain name in question infringes its rights in the GOOGLE and ADWORDS trade marks. As these marks are granted the more robust protection afforded to well known trade marks in terms of the south African Trade Marks Act, the Adjudicator is of the view that this position is correct, even were the Registrant to make use of the disputed domain name in respect of goods or services dissimilar to internet search services.

3.1.5 The Registrant does not have legitimate rights in the GOOGLE and ADWORDS trade marks. The Registrant has not yet used the disputed domain name, which been "parked" from the date of registration to the present (ie the domain name points to an inactive website). The Complainant claims that internet users that are aware that the Complainant owns the ADWORDS trade mark will assume that the disputed domain name is owned by the Complainant. The Complainant referred to the case Audi AG v Hans Wolf [D2001-0148].

3.1.6 The Complainant claims that the combination of the trade marks GOOGLE and ADWORDS has been used extensively and are well known and, as a result, the Complainant claims to have acquired common law rights therein. The Complainant cites the case of Bayerische Motoren Werke AG and Williams Grand Prix Engineering Limited v Neil Malkhandi [D2000-1171] and Société des Produits

Nestlé v Stuart Cook [D2002-0118] in support of its argument that the disputed domain name is confusingly similar to the Complainant's well known GOOGLE ADWORDS trade mark.

3.1.7 In conclusion, based on the foregoing, the Complainant alleges that the domain name registration is abusive within the meaning of Regulation 3(1)(a).

3.2 Registrant

3.2.1 The Registrant filed no substantial Answer.

4 Discussion and Findings

4.1 The Adjudicator finds that the Complainant has rights in respect of the trade marks GOOGLE and ADWORDS, as well as the combination GOOGLE ADWORDS, 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 aforesaid elements are present to support a finding that the disputed domain name registration is abusive.

4.4 The disputed domain name is identical to the Complainant's trade marks GOOGLE, ADWORDS and also GOOGLE ADWORDS.

4.4.1 Without analysing anything more, the Adjudicator is of the view that

the GOOGLE trade mark is so well known to internet users that use of any domain that incorporates this trade mark is likely to take unfair advantage of or be detrimental to the Complainant's rights.

4.4.2 The Registrant has made no reasonable use of its goggle-adwords.co.za domain name, and at present its domain name presents an obstacle to registration by the Complainant of the domain name, which corresponds with a term that it has widely used for more than ten years.

4.5 The Registrant has not proffered cogent reasons why it chose to register the disputed domain name, nor why it has failed to make legitimate use of the domain name. In the circumstances, the Adjudicator finds that the Registrant has failed to rebut the cogent arguments made by the Complainant that the disputed domain name is an abusive domain registration. The Adjudicator is therefore entitled to hold that the domain name google-adwords.co.za is an abusive domain name registration in the hands of the Registrant.

4.6 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 google-adwords.co.za be transferred to the Complainant.

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VICTOR WILLIAMS

SAIIPL SENIOR ADJUDICATOR

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