

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0094
DECISION DATE:	3 February 2012
DOMAIN NAME	kingo.co.za kingonumbers.co.za
THE DOMAIN NAME REGISTRANT:	DayNI (ODED DAYANI)
REGISTRANT'S LEGAL COUNSEL:	MICHAEL WERNER & ASSOCIATES INC
THE COMPLAINANT:	TALIUM INVESTMENTS (PTY) LTD and OXYPITE (PTY) LTD
COMPLAINANT'S LEGAL COUNSEL:	n/a
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **11 November 2011**. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **14 November 2011**. The SAIPL verified that the Dispute together with the amendment to the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure. On 15 November 2011 the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on 15 November 2011 UniForum SA confirmed that the domain name had indeed been suspended.
- b. In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **16 November 2011**. In accordance with the Regulations the due date for the Registrant's Response was **14 December 2011**. The Registrant submitted its Response on **13 December 2011**, and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL's Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on **14 December 2011**.
- c. In accordance with the Regulations the due date for the Complainant's Reply was **22 December 2011**. The Complainant submitted its Reply on **20 December 2011**.
- d. The SAIPL appointed **André Van der Merwe, Nola Bond** and **Vanessa Lawrance** as the Adjudicators in this matter on **11 January 2012**. The Adjudicators have submitted their Statements of Acceptance and Declarations of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

- e. The panel was called upon to decide an interlocutory question regarding a request, by the Complainant, to keep some parts of its submissions confidential. It was decided that, unless there was a truly compelling reason not to do so, the Complainants full case must be made available to the Registrant to allow for proper response thereto.

2) Factual Background

- a. The Complainant is Oxypite (Pty) Ltd, a software development company and Talium Investments (Pty) Ltd, the exclusive marketing "arm" or company of Oxypite.
- b. During 2010, the Complainant entered into discussions with a potential group of partners, Portapa (Pty) Ltd (hereinafter "Portapa"), with a view to forming a joint business partnership to launch a betting product known as KINGO.
- c. The relationship between the Complainant and Portapa disintegrated during or about January 2011.
- d. The Registrant of the domain names in question is a nominee of Portapa.
- e. The two domain names that form the subject matter of the complaint were registered on 29 November 2010. The Complainant applied for registration of the trade mark KINGO on 3 December 2010.

3) Parties' Contentions

a. Complainant

- i. The Complainant claims that the partnership between the parties did not materialise and no contracts were signed.

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- ii. The Complainant claims that all of its products (paper vouchers, marketing material, etc.) are branded "KINGO".
 - iii. The term KINGO was coined by Nicholas Ioannoy, an employee of the Complainant on or about 12 November 2010, and was introduced at a meeting between the Complainant and Portapa on 29 November 2010.
 - iv. The Complainant attached a commit log to its source control system, which shows that the first commit with the name KINGO was dated 12 November 2010.
 - v. The KINGO product was launched to the public on 3 August 2011, but advertising thereof commenced on 1 August 2011 through various media and marketing channels (including an sms advertising campaign, facebook advertising, please-call-me advertising and advertising in newspapers).
 - vi. The Complainant requested transfer of ownership of the domain names from Danny Dayani, a partner of Portapa, and the brother of the Registrant on many occasions.
 - vii. The Complainant believes that the domain names in question are being held for purposes of "effecting serious harm" to the Complainant's brand in future, or "to utilise it to profit from "the Complainant's investment in the KINGO trade mark"".

b. Registrant

- i. The Registrant claims that the KINGO game concept was initially introduced by Photios Anastassopoulos, an authorised representative of Portapa.

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- ii. The Registrant claims that a verbal agreement was concluded between the Complainant and Portapa, in terms of which Portapa or its nominee would become a 50% shareholder of the Complainant. This agreement was never reduced to writing.
 - iii. The Registrant denies that Portapa has been requested to transfer the domain names to the Complainants and that it declined to do so. It goes further to advise that, had it been so requested, which it denies, it would have declined the request.
 - iv. On January, before the Complainant and Portapa parted ways, the rights to "KINGO" were discussed, but no agreement could be reached in this regard.
 - v. The Registrant denies that the Complainant has any right to the domain name or the trade mark KINGO.

4) Discussion and Findings

The crux of this decision is who owns "KINGO". It is settled law that the person who has appropriated a mark for use in respect of goods or services as a trade mark may claim to be the proprietor. Legal precedent defines "appropriation" as the origination, adoption or acquisition of a mark (Victoria's Secret Inc v Edgars Stores Ltd 1994 3 SA 739 (A)).

From the papers, it appears that the first time that the KINGO mark was discussed by the Complainant and Portapa, was their meeting that took place on 29 November 2010. The Complainant submits that it had already originated the mark and introduced it to Portapa at that meeting. Portapa claims that the KINGO mark was originated by one of its employees, and it was introduced to the Complainant at the same meeting.

While the Complainant has provided copies of its commit logs to its source control systems, showing that it first used the mark on 12 November 2010, the Registrant has not substantiated its allegations that the trade mark KINGO was the concept of its employee. Indeed, the allegation made is that "the concept of the KINGO game was initially introduced by ... an authorised representative of Portapa". What is at issue here is the KINGO name and not the concept of the game that is to be marketed under the name.

a. Complainant's Rights

- i. Accordingly the Panel finds that the Complainant is the proprietor of the name or trade mark KINGO; and was the proprietor both before and as at the date of registration of the disputed domain names ie 29 November 2010. Hence the Complainant had rights in and to the name or trade mark KINGO which is identical or similar to the disputed domain names, respectively.

In support of the aforementioned, the Panel points out that the first disputed domain name kingo.co.za is identical to the name and trademark KINGO of the Complainant. The second disputed domain name kingonumbers.co.za is similar to the name and trade mark KINGO of the Complainant not only because it contains KINGO in its entirety but also because the first and dominant feature of the disputed domain name is KINGO and the Registrant has merely added the descriptive/generic word "numbers" to the distinctive word KINGO.

See NAF/FA141825 in which it was held that: "*[It] is also well-established under the Policy that a domain name composed of a trademark coupled with a generic term is still confusingly similar to the trademark.*"

In WIPO/D2002-0367 the panel concluded that: "*The disputed domain name contains Complainant's trademark EXPERIAN in its entirety. The addition of the generic term "automotive" does not distinguish Respondent's domain name from Complainant's mark.*"

See also for example the decisions WIPO/D2000-1598 in which niketravel and nikesportstravel were found to be similar; DRS04601 in which nikestore was found to be similar to NIKE; and DRS01493 in which nokia-ring-tones was found to be similar to NOKIA.

Lastly, see the various South African decisions which have found disputed domain names to be similar to the respective trademarks, for example ZA2007-003 in which the disputed domain name telkommedia.co.za was found to be similar to the trade mark TELKOM.

b. Abusive Registration

- i. Having found that the Complainant is the proprietor of the KINGO trade mark, it appears to have been "sharp practice" by the Registrant to register domain names incorporating KINGO in his own name within hours of being introduced to the name and trademark.
- ii. The panel finds, for the reasons set out above, that the disputed domain names kingo.co.za and kingonumbers.co.za were registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or were unfairly detrimental to the Complainant's rights.

Besides the reasons set out above, the Complainant has alleged that, if the Registrant were to utilize the disputed domain name in conjunction with Portapa, this would unfairly disrupt the Complainant's business. The Complainant has already commenced use of the trademark KINGO in its business and intends in the near future to make a large investment in its business in South Africa based on this trademark. Circumstances indicating that the Registrant has registered the disputed domain names primarily to disrupt unfairly the business of the Complainant, suggest or indicate that the disputed domain names are abusive registrations.

In the circumstances, the Panel finds, on a balance of probabilities, that the disputed domain names are abusive registrations, in terms of the Regulations, and more particularly Rule 3(1) of the Alternative Dispute Resolution Rules and Definitions.

5) Decision

- a. For all the foregoing reasons, in accordance with Regulation 9, the Panel orders that the domain names kingo.co.za and kingonumbers.co.za be transferred to the Complainant.

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