

Decision

[ZA2011-0097]

.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0097
DECISION DATE:	07 February 2012
DOMAIN NAME	Coronationfund.co.za
THE DOMAIN NAME REGISTRANT:	Greg Designs
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Coronation Asset Management (Pty)
COMPLAINANT'S LEGAL COUNSEL:	Norton Rose South Africa
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **23 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 **5 December 2011**. On **6 December 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **7 December 2011** UniForum SA confirmed that the domain name had indeed been suspended. 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.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **7 December 2011**. In accordance with the Regulations the due date for the Registrant’s Response was **9 January 2012**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **10 January 2012**.
- c) The SAIPL appointed **Charné le Roux** as the Adjudicator in this matter on **20 January 2012**. 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.

2 Factual Background

- a) The Complainant is Coronation Asset Management (Pty) Ltd, a private company based in Claremont, Cape Town. It is the owner of trade mark registration number 2007/18000 **CORONATION FUND MANAGERS AND INVESTMENTS EXCELLENCE** in class 36 for “insurance; financial affairs’ monetary affairs and real estate”. The date of registration is 4 September 2007.
- b) The Complainant is also the proprietor of the domain name **coronationfunds.co.za**, registered on 19 June 2002.
- c) The Complainant and its holding company Coronation Fund Managers Limited both use the marks **CORONATION** and **CORONATION FUNDS**.
- d) The Disputed Domain Name **coronationfund.co.za** was registered in the name of the Registrant on 10 March 2011.

3 Parties’ Contentions

3.1 Complainant

- a) The Complainant contends that in connection with its rights that:
 - i) It owns trade mark rights in the trade mark **CORONATION FUND** as a consequence of its trade mark registration number 2007/18000 **CORONATION FUND MANAGERS INVESTMENT EXCELLENCE** in class 36 and dated 4 September 2007.
 - ii) It is the proprietor of the domain name **coronationfunds.co.za** registered on 19 June 2002.
 - iii) It owns common law rights, jointly with its holding company

Coronation Fund Managers Limited, in the trade marks **CORONATION** and **CORONATION FUNDS**. It contends that its holding company (which has been listed on the stock exchange since 2003) has been making use of the domain name **coronationfunds.co.za** and that it, together with the Complainant, manage a wide variety of funds known to the public at large as **CORONATION FUNDS**.

- b) The Complainant claims that the Disputed Domain Name is, apart from the omission of an "s" at the end of the name, identical to the domain name registered by the Complainant and used by its holding company. The Complainant also contends that, for all intents and purposes, the Disputed Domain Name is identical to the Complainant's trade mark **CORONATION FUND MANAGERS INVESTMENT EXCELLENCE**, because the words "managers", "investment" and "excellence" are descriptive words, particularly if seen against the dominant feature of the trade mark, which is **CORONATION FUNDS**.
- c) The Complainant submits that the Disputed Domain Name is an abusive registration in the hands of the Registrant, in that its use of the trade mark **CORONATION FUNDS** constitutes trade mark infringement in terms of Section 34(1)(a) of the Trade Marks Act. The Complainant contends that its statutory and common law rights, as well as those of its holding company, respectively, precede the Registrant's registration of the Disputed Domain Name by a considerable margin. It contends that the Registrant disrupts unfairly the business of the Complainant and its holding company and is preventing the Complainant from exercising its rights. The

Complainant indicates, with reference to WIPO case number D2000/0766, that the mere registration of a domain name that contains a well-known mark or name of another, is considered a trade mark infringement because it effectively prevents the trade mark owner from using its distinctive and well-known mark in the corresponding domain name. The Complainant also contends that the Registrant used false and incomplete contact details in the WHOIS database.

- d) The Complainant further contends that the Registrant used the Disputed Domain Name to misrepresent to certain entities and members of the public that it is associated with and employed by the Complainant's holding company, in order to fraudulently solicit money from these entities and members of the public. The Complainant provides, in support of this contention, a due diligence report purported to be completed and executed by Mr Anton Pillay, who is the COO of the Complainant's holding company, and also an agreement between Kas Bank NV, a Netherlands company, and an unidentified User. The agreement appears to have been executed by two persons on behalf of Kas Bank NV and a person with the initials AP on behalf of the unidentified User (in reference to Mr Anton Pillay). The Complainant also provided an e-mail signature of one Gareth De Villiers, who is indicated in the signature as the person at Coronation Fund Managers responsible for Dealing and Implementation, having a website at www.coronationfund.co.za and e-mail address of gareth@coronationfund.co.za. The Complainant furthermore provided hearsay evidence to the effect that there were negotiations between Kas Bank NV and a Mr Gareth De Villiers during August 2011, that De Villiers purported to be an employee of

the Complainant's holding company and that Mr De Villiers approached Kas Bank NV for the purposes of entering into an agreement with it. Kas Bank NV apparently discovered the fraud of De Villiers, following an approach to the Complainant's holding company and negotiations terminated. The Complainant indicates that the Disputed Domain Name was fraudulently linked to the coronationfunds.co.za domain name of the Complainant.

- e) The Complainant submits, based on the facts set out above, that the Disputed Domain Name was used in a manner that takes unfair advantage of and is unfairly detrimental to the Complainant's rights and that the Disputed Domain Name has been used for fraudulent purposes. The Complainant suggests that the Registrant registered and has been using the Disputed Domain Name in a way that leads people or businesses to believe that the Disputed Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant and that, as a consequence, in terms of Regulation 4(1)(b), the Disputed Domain Name constitutes an abusive registration.
- f) The Complainant requests that the Disputed Domain Name be transferred to it.

3.2 Registrant

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

4 Discussion and Findings

- a) Regulation 3(1)(a) requires that the Complainant proves each of the following elements in order for a Disputed Domain Name to be transferred:

- i) That the Complainant has established rights in respect of a name or mark which is identical or similar to the Disputed Domain Name; and
 - ii) That in the hands of the Registrant, the Disputed Domain Name is an abusive registration.
- b) The adjudicator will draw such inferences from the Registrant's default as she considers appropriate. This will include the acceptance of plausible evidence of the Complainant which has not been disputed.

4.1 Complainant's Rights

- a) Regulation 1 defines rights to include intellectual property rights, commercial, cultural, religious and personal rights protected under South African law, but are not limited thereto. The definition is broad and rights are not restricted to rights founded on the principals of trade mark law, but recognises rights going beyond those in terms of the Trade Marks Act No. 194 of 1993. All the requirements at common law for passing off such rights must, however, find recognition in law. See ZA2007-0008 (privatesale.co.za).
- b) The Complainant did not provide proof of its rights in trade mark registration number 2007/18000 **CORONATION FUND MANAGERS INVESTMENT EXCELLENCE** in class 36 and dated 4 September 2007. An adjudicator may, in certain circumstances, conduct her own investigations and in this case, based on the fact that the Trade Mark Registry is a public record, she was prepared to conduct these investigations and is prepared to find that the Complainant is indeed the registered proprietor of the

aforesaid trade mark registration.

- c) Turning to the Complainant's claim that it owns the domain name coronationfunds.co.za, the adjudicator is not prepared to find that the domain name registration gives rise to any rights. See also ZA2007/0001 (mrplastic.co.za), where the adjudicator referring to supporting South African authority, confirmed that the registration of a company name, *per se*, confer to an entity no rights in that name enforceable against third parties in the sense that third parties can restrict others from using it. The adjudicator in this matter has made a similar decision in the case ZA2008-0020 (mxit.co.za).
- d) The Complainant's contention that it, together with its holding company, acquired common law rights in the trade marks **CORONATION** and **CORONATION FUNDS** requires careful consideration. The Complainant did not provide any supporting evidence of the use that has been made of these trade marks that would give rights to the common law rights so claimed. The adjudicator is mindful, however, that the Complainant's contentions were on affidavit and not contested by the Registrant. Nevertheless, the Complainant's statements regarding the joint common law rights that it and its holding company own in the trade marks **CORONATION** and **CORONATION FUNDS**, viewed against the statutory rights owned only by the Complainant, the absence of the Complainant's holding company as a second complainant (which would call for some explanation of the extent of the Complainant's own rights) all together lack the substance that would enable the adjudicator to make a finding of the common law rights claimed.

- e) The adjudicator finds that the Disputed Domain Name is similar to the Complainant's registered trademark **CORONATION FUND MANAGERS INVESTMENT EXCELLENCE** as required in terms of Regulation 3(a). The adjudicator agrees with the Complainant that the words "managers", "investment" and "excellence", and also the word "fund" are descriptive and that the dominant part of the registered trade mark is **CORONATION**, which is the exact feature incorporated by the Registrant in the Disputed Domain Name, in the same combination with the word "fund" as appears in the Complainant's trade mark.

4.2 Abusive Registration

- a) Regulation 4(1) provides for a number of grounds (non-exhaustive) on which the Complainant can rely in showing that the Disputed Domain Name is an abusive registration. For purposes of this dispute, the Complainant relies on Regulations 4(1)(a)(2), 4(1)(a)(3), 4(1)(b) and 4(1)(d), namely that the Registrant:
- i) blocks intentionally the registration of a name or mark in which the Complainant has rights;
 - ii) disrupts unfairly the business of the Complainant;
 - iii) is using or has registered the Disputed Domain Name in a way that leads people or business to believe that the Disputed Domain Name is registered to, operated, authorised by or otherwise connected with the Complainant; and

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- iv) submitted false or incomplete contact details on the WHOIS database.
- b) The adjudicator is not prepared to accept the hearsay evidence concerning the negotiations between Kas Bank NV and one Gareth De Villiers. The adjudicator is, however, prepared to accept that the Disputed Domain Name was used in a fraudulent manner by a person who was not employed by the Complainant or its holding company as purported on the e-mail signature that the Complainant provided, and that the Disputed Domain Name pointed to the website of the Complainant and/or its holding company in a way that leads people or businesses to believe, wrongly, that the Disputed Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant. The adjudicator also takes cognisance of the fact that the Registrant did not respond to any of the allegations made by the Complainant in this regard.
- c) Having considered all the evidence, the adjudicator finds that a case has been made out in terms of paragraphs 4.2 (a)(i), (ii) and (iii) as set out above. No evidence in support of the claim that the Registrant submitted false or incomplete contact details in the WHOIS database was provided to justify a finding in that regard.

5. Decision

- a) For all the foregoing reasons, in accordance with Regulation 9, the adjudicator orders that the Disputed Domain Name **coronationfund.co.za** be transferred to the Complainant.

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CHARNÉ LE ROUX
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za