

Decision

[ZA2012-0119]

**.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)**

ADJUDICATOR DECISION

CASE NUMBER:	ZA2012-0119
DECISION DATE:	19 December 2012
DOMAIN NAME	bluebeanproperty.co.za
THE DOMAIN NAME REGISTRANT:	Blue Bean Property
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	The Standard Bank of South Africa Limited
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
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 October 2012**. On **24 October 2012** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **24 October 2012** 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.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **25 October 2012**. In accordance with the Regulations the due date for the Registrant’s Response was **22 November 2012**. The Registrant did not submit any formal response, and accordingly, the SAIPL notified the Registrant of its default on **26 November 2012**.
- c) The SAIPL appointed **Mike du Toit** as the Adjudicator in this matter on **28 November 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

- 2.1 The Registrant registered bluebeanproperty.co.za with Uniform SA on 2 June 2009. Further particulars of the disputed domain name appear in Annexure A of the complaint, to be attached as Annexure “A” to this decision. The Registrant had a website offering property rental and

purchasing services, which website was associated with the disputed domain name. The Complainant, through its attorneys, issued a Take Down Notice in terms of sec 77 of the Electronic Communications and Transactions Act, 25 of 2002 in January 2012.

2.2 The Registrant responded by relying on the registration of Blue Bean Property CC in 2005. On 26 January 2012 the Registrant agreed to change the business name on the website to “Propit Realtor” but retained the domain name. The website is situated at www.bluebeanproperty.co.za and the disputed domain name is still registered in the name of the Registrant.

2.3 The Complainant lodged a dispute in terms of the .ZA ALTERNATIVE DISPUTE RESOLUTION REGULATIONS but the Registrant declined to lodge any response.

2.4 This dispute will therefore be adjudicated on an unopposed basis.

3 Parties' Contentions

3.1 Complainant

a) The Complainant's dispute relies on the fact that the disputed domain name is identical or similar to a name or mark in which the Complainant has rights [Reg 3(1)(a)]

The Complainant relies on the existence of the following registered trade marks:

1. 2000/13724 BLUEBEAN.COM in cl 36;
2. 2000/13279 BLUEBEAN.COM device in cl 36;
3. 2005/15317 BLUEBEAN device in cl 36;
4. 2009/18651 BLUEBEAN in cl 36

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- b) The BLUEBEAN trade marks are registered in cl 36 and covers insurance; financial affairs; monetary affairs; and real estate.
- c) The Complainant also relies on its common law rights in the BLUEBEAN trade mark. It claims to have built up these rights since 2000 in relation to loan facilities, which are used to transact and purchase property of different kinds.
- d) The Complainant argues that the dominant and memorable element of the disputed domain name is BLUEBEAN, which is phonetically and visually similar to its registered and well known BLUEBEAN trade marks. In addition, that the real estate services offered on the website associated with the disputed domain name are identical to services covered by the BLUEBEAN registrations. The Complainant submits that the use of the disputed domain name infringes the Complainant's BLUEBEAN trade marks.
- e) The Complainant relies on the fact that the domain name in the hands of the Registrant is an abusive registration [Reg 3(1)(a)]
- f) The Complainant believes that the continued use and registration of the disputed domain name is abusive in that:
1. It intentionally blocks the registration of a name or mark in which the Complainant has rights;
 2. It unfairly disrupts the business of the complainant; or
 3. It prevents the Complainant from exercising its rights.

3.2 Registrant

- a) The Resistant did not reply to the Complainant's contentions and the dispute is uncontested.

4 Discussion and Findings

- a) The Complainant's rights in and to its BLUEBEAN trade marks, whether registered or at common law are unchallenged as the Registrant has not filed a response to the complaint. The undisputed facts established that it, at the very least, prevents the Complainant from exercising its rights and disrupts unfairly the business of the Complainant. . Against that background, it appears on the face of it that the disputed domain name is an abusive registration. [Regulation 4(1)]

4.1 Complainant's Rights

- 4.1.1 The Complainant has submitted, with reference to Annexure C1-4, that it has registered rights in terms of the Trade Marks Act in its BLUEBEAN trade marks in cl 36. It has further submitted that it has substantial common law rights in its BLUEBEAN trade marks in relation to loan facilities which are used to transact and purchase property of different kinds. These rights are accepted as proven.

4.2 Abusive Registration

- 4.2.1 The Complainant has established that the disputed domain name is identical or similar to a name or mark in which it has rights. The Complainant's reference to the WIPO UDRP decision of 4microsoft2000.com[D2000-1493], is accepted and applied.

The Complainant's submissions are accepted in that the continued use and registration of the disputed domain name are abusive. The disputed domain name is preventing the Complainant from freely exercising its rights. Although the submission that the Complainant has well known rights in its BLUEBEAN trade mark is not supported

by the facts, it nevertheless proved substantial common law rights and as such, the judgement in Red Bull GmbH vs Harold Gutch (D2000-0766) would have relevance. The Complainant's reference to FIFA vs Yin (ZA 2007 – 0007) is sound and applies to the set of facts. In the absence of an explanation by the Registrant under oath, this adjudicator finds no reason not to apply the FIFA case to this set of facts.

5. Decision

- 5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, bluebeanproperty.co.za be transferred to the Complainant.

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Mike du Toit
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za