

## Decision

**ZA2012-0120**

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

### ADJUDICATOR DECISION

CASE NUMBER:	ZA2012-0120
DECISION DATE:	20 December 2012
DOMAIN NAME	barlowlogistics.co.za
THE DOMAIN NAME REGISTRANT:	David Godfrey
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Barloworld Limited & Barloworld Africa (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	Spoor & Fisher
2 <sup>nd</sup> 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 **29 October 2012**. On **30 October 2012** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and again on **30 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 **01 November 2012**. In accordance with the Regulations the due date for the Registrant’s Response was **29 November 2012**. A Response was submitted on **20 November 2012**, 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 Complainants on **20 November 2012**.
- c) In accordance with the Regulations the due date for the Complainants’ Reply was **27 November 2012**. The Complainants submitted a Reply on **27 November 2012**.
- d) The SAIPL appointed **Mr Andre van der Merwe** as the Adjudicator assisted by Trainee Adjudicator **Andrew Papadopoulos** in this matter on **10 December 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.

- e) A procedural aspect of this Complaint has to be dealt with at the outset. A Response was submitted, not by the Registrant but by another party, viz Barlow Logistics (Pty) Ltd that has attempted to join itself to the Complaint as the second Registrant (on the basis that it is allegedly the user of the disputed domain name). However, in their Reply, the Complainants have objected to the joining / addition to the Complaint of a second Registrant by reason of a Whois search of the disputed domain name (registration), which is attached to their Reply, showing that David Godfrey is the (sole) Registrant.

The Adjudicator confirms that David Godfrey is the (sole) Registrant of the disputed domain name. Accordingly, on a factual basis, the Adjudicator concurs with the Complainants and upholds their above objection.

The Adjudicator will deal with the above-mentioned Response submitted by Barlow Logistics (Pty) Ltd in greater detail below.

## 2 Factual Background

- 2.1 The first Complainant (previously known as Thomas Barlow & Sons) was founded in 1902. It has become a multi-national business and claims to have operations in 27 countries around the world. It is a distributor of goods bearing leading international brands and provides rental, fleet management, product support and logistics solutions.
- 2.2 The first Complainant has three main operating divisions viz Barloworld Equipment, Barloworld Automotive and Logistics, and Barloworld Handling (having an overall annual revenue of about R50 Billion). In 2000 the first Complainant changed its name to Barloworld, and in 2001 it launched a new division viz Barloworld Logistics.

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- 2.3 The first Complainant is the proprietor of various trade mark registrations consisting of or incorporating its name **BARLOWORLD**, as set out in Annexure “D” of the Complaint. These registrations include South African trade mark registration nos. 2000/09764 and 2000/09767 for **BARLOWORLD** in classes 35 and 39 respectively. These registrations are presently in force, and hence the first Complainant claims to have statutory rights in respect of this name and trade mark in South Africa *inter alia*.
- 2.4 The first Complainant also relies on having made extensive and continuous use of the name and trade mark **BARLOW** since 1902, and the **BARLOWORLD** trademarks since 2000 in respect of rental, fleet management, product support and logistics solutions. Hence it claims to have strong common law rights in these trade marks in South Africa and in other jurisdictions.
- 2.5 The second Complainant viz Barloworld Logistics Africa (Pty) Ltd is a subsidiary company of the first Complainant and part of its Barloworld Logistics division. The second Complainant has used and promoted the registered trademark of the first Complainant viz **BARLOWORLD** and the name **BARLOWORLD LOGISTICS** on an extensive scale since 2001, and it is claimed to be one of Southern Africa’s leading logistics and supply chain businesses. Substantial turnover and advertising expenditure have been provided to support this claim.
- 2.6 The Complainants have also registered, and have been using, various domain names including **barlow.co.za**; **barloworld.co.za**; and **barloworld-logistics.co.za**. These also include the domain names **barloworld.com**; and **barloworld-logistics.com**.
- 2.7 The disputed domain name **barlowlogistics.co.za** was registered on 8

December 2009 in the name David Godfrey.

### 3 Parties' Contentions

#### 3.1 Complainant

- a) The Complainants contend that they have prior common law rights in South Africa in and to the name / trademark **BARLOW** based on extensive and continuous use dating from 1902.
- b) They also contend that they have prior statutory viz registered trade mark rights in South Africa in respect of **BARLOWORLD** and **BARLOWORLD LOGISTICS**, and common law rights therein based on extensive and continuous use; both rights dating from 2000. These rights relate to business activities in the integrated rental, fleet management, product support and logistics solutions industries.
- c) The Complainants contend that the disputed domain name is identical or confusingly similar to its above trademarks **BARLOW**, **BARLOWORLD** and **BARLOWORLD LOGISTICS**, and to their above domain names, and hence is likely to create confusion or deception.
- d) Hence the Complainants contend that, for various reasons, the disputed domain name is an abusive domain name in the hands of the Registrant, and that the disputed domain name should be transferred to the Complainants.

#### 3.2 Registrant

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

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However, a company viz Barlow Logistics (Pty) Ltd (hereinafter referred to as “BLPL”) responded to the Complainants contentions by filing a Response, as explained above.

- b) BLPL has attempted to join itself to the Complaint as a second Registrant, to which the Complainants have objected, and with which the Adjudicator has concurred as set out above.
- c) BLPL contends that the disputed domain name was registered by the Registrant on instructions from BLPL, and for the use of BLPL as its e-mail address. BLPL therefore regards the disputed domain name as its domain name viz that BLPL is the beneficial owner of the disputed domain name.
- d) BLPL contends that the disputed domain name is simply a continuation of the use of its corporate name since 5 March 2001 when it was registered (originally as a Close Corporation by a Mr Luther Barlow and his wife viz Mrs Catharina Susanna Barlow).
- e) BLPL contends that the disputed domain name was registered in good faith in 2009, and that there has never been an intention on its part by registering the disputed domain name to take unfair advantage of, or to be detrimental to, the Complainants’ rights.
- f) BLPL does not use the disputed domain name to host any website.
- g) Although there has been one alleged case of actual confusion reported by the Complainants, BLPL has denied this, and has denied the likelihood of confusion or deception.
- h) BLPL therefore contends that it has statutory and common law rights

of use in and to the name **BARLOW LOGISTICS**, on which basis the disputed domain name was registered; and hence that the Complaint should be dismissed.

#### 4 Discussion and Findings

- a) The first aspect of this Complaint that the Adjudicator has to deal with is a procedural question that relates to the non-filing of a Response by the Registrant. In ordinary circumstances, this would lead to a default finding by the Adjudicator. However, in this Complaint a Response had been filed by another party viz BLPL in effect on behalf of the Registrant, and purportedly as a second Registrant.

The Regulations are silent on a situation such as this, and the Adjudicator has to be guided, partly by common sense and partly by what would best serve the interests of justice.

Firstly, and as stated above, a WHOIS search shows that the Registrant is David Godfrey. The proprietorship issue was first raised by the Complainants' attorneys in a letter to BLPL's attorneys dated 16 May 2012 and, although providing an explanation of the relationship between BLPL and David Godfrey, BLPL failed to rectify the domain name registration by substituting its name in place of David Godfrey as registrant. As a matter of fact therefore, according to the formal registration records, David Godfrey is the sole Registrant – and, in the circumstances, and on a factual basis, no other person can be considered as a second Registrant. Accordingly, the Adjudicator finds that BLPL cannot, on the above facts, join itself in this Complaint purportedly **as a second Registrant** (the Adjudicator's emphasis).

Secondly, the question arises as to whether the Adjudicator can admit

evidence provided (solely) by a person, natural or juristic, who is not the Registrant – seemingly on behalf of the Registrant who has remained completely silent in the defence of the disputed domain name that is registered in his personal name.

It would of course be a different situation if the affidavit by BLPL had, for example, been in the form of a supporting affidavit to support what the Registrant may have said under oath (and not as “a second Registrant”); or if, for example, the Registrant had submitted a confirmatory affidavit to confirm what BLPL had said in their affidavit; or at the very least that the deponent viz Mr B P van Staden, in the affidavit of BLPL had expressly mentioned, under oath, that the Registrant had authorized BLPL to deal with this matter on his behalf based on the alleged interest that BLPL may have in the disputed domain name. However, none of these scenarios apply in this case.

In addition to the above, there is no clear indication from BLPL as to the exact relationship with the Registrant either during 2009 or up to the present time. Although Mr B P van Staden states that BLPL “employs” the Registrant as “their IT Consultant responsible for all their electronic hardware, software and the domain used by Barlow Logistics”, that does not, on the face of it, make BLPL the beneficial owner of the disputed domain name. In addition to this, Mr B P van Staden has attempted to confirm the relationship with David Godfrey by annexing a written contract concluded between BLPL, on the one hand, and “VoIP Boyz” represented by David Godfrey, on the other hand, for Information Technology Support Services for the period from 1 February 2010 to 31 January 2011. This annexure/contract unfortunately does not support the contention of employment at the time of registration of the disputed domain name in 2009, or at the present time, and has lapsed almost two years ago. In any event, such contract is not an employment



contract but a contract for services by an outside entity/contractor. Moreover, this annexure/contract omits any provision regarding the registration or maintenance of a domain name on BLPL's behalf.

Although it may be market practice for internet service providers or information technology consultants to register domain names in their own names on behalf of their customers, the Adjudicator cannot assume that this is the case in this instance without the relevant confirmation thereof by the Registrant.

Lastly, there is no explanation from Mr B P van Staden or BLPL whatsoever as to why it has not taken transfer of the ownership of the disputed domain name from David Godfrey in the intervening period of about 3 years after the date of registration thereof, or at the very least, when the issue of proprietorship was raised by the Complainants' attorneys in May 2012. The effect of the aforementioned clearly shows that the Registrant is an entirely separate and independent person from BLPL.

In terms of litigation and procedure before our Courts, the affidavit (or the purported Response) filed by BLPL would, taking the above factors into account, be considered as non-responsive in this Complaint, and as hearsay evidence liable to be struck out as such *in toto*. In other words, the Adjudicator considers that the Response should be struck out and ignored in these proceedings.

Accepting that the Complainants have the necessary *locus standi* based on their *prima facie* rights, and on a balance of probabilities, that is the finding that the Adjudicator is inclined to make in this instance. This will leave this Complaint to be considered on a default basis. In other words, if the Complainants were to succeed in making out their case, on the merits and without any defence being raised by the Registrant, for the disputed domain

name to be an abusive registration, the Adjudicator would find in favour of the Complainants – that the disputed domain name is an abusive registration, and the Adjudicator would order this registration to be transferred to the Complainants (or more particularly to the first Complainant).

However, in the event that the Adjudicator may be incorrect in reaching this finding, and bearing in mind that this is an ADR matter requiring a possibly more flexible approach in the matter of admitting evidence (bearing in mind that often non-legally qualified persons deal with these complaints, which is the case in this specific instance in that BLPL defends this objection without legal representation), the Adjudicator wishes to consider admitting the Response to examine whether the Registrant will, on a consideration of the full merits of this matter including the various defences raised by BLPL, be unduly prejudiced by the afore-mentioned default finding. Furthermore, section 26 of the Regulations grants the Adjudicator the power to request further statements or documents relevant to the dispute, response or reply from either of the parties, and therefore if the Registrant would be unduly prejudiced by the afore-mentioned default finding, the Registrant could be requested to submit the necessary confirmatory affidavit.

Proceeding on this premise, and having regard to the full merits of this matter, the Complainants have contended that they enjoy prior common law and statutory rights in South Africa, as applicable, in respect of their name / trademarks **BARLOW**, **BARLOWORLD** and **BARLOWORLD LOGISTICS**, with the predominant part being **BARLOW**. This has not been challenged in any way in the Response filed. They have filed acceptable evidence in support of such rights in this Complaint.

Accordingly the Adjudicator finds, on a balance of probabilities, that the Complainants have rights, both statutory and under the common law, in the

above names / trademarks - in which the predominant part is clearly the name / trademark **BARLOW**.

It needs to be emphasized that in 2000 the above name / trademark **BARLOW** had already developed a considerable repute or reputation, and hence goodwill, for the First Complainant under the common law. In this way and by that time, a so-called secondary meaning had attached to the surname **BARLOW** - see below in this regard.

The Adjudicator should mention in passing that it is not always an easy or straightforward matter to claim exclusive rights in a surname, whether for company or trademark registration purposes. See in this regard the South African cases *Policansky Bros Ltd v L&H Policansky* 1935 AD 89 – 1012; and *Brian Boswell Circus (Pty) Ltd v Boswell-Wilkie Circus (Pty) Ltd* 1985 (4) SA 466 (A).

The reason for this is of course that common names, for example, are not inherently capable of distinguishing and the intention of the law is not to prevent a person unduly from using his/her surname in business or trade. The position is different when a surname is an unusual name or when a surname has, through extensive use and promotion, developed a secondary meaning so that members of the public associate that name with a particular business or product, for example, **FORD**, **MACDONALD'S**, **ROLLS ROYCE**, and **PORSCHE**, to name but a few.

In the South African case *Van der Walt v Humansdorp Marketing CC* 1993 4 SA 779 (SE) 782 I-J 783 A-B, Zietsman, JP had the following to say on the acquisition of a secondary meaning regarding trading names:

“It is however not sufficient for the applicant merely to prove that the respondent has adopted a name for his business similar to the name used by the applicant. Where the applicant has used an invented or fancy name

for his business it will more easily be found that that the respondent, if he uses the same or a similar name for his business, is falsely representing his business as being that of, or associated with, the business of the applicant. However, where an applicant uses his own name or mere descriptive words in naming his business, an interdict will not easily be granted unless the applicant can show that his name, or the descriptive words used by him, have become so associated with his business or his products that they have acquired a secondary meaning and are associated in the minds of the public with the applicant's products or business, and with that of no one else."

See also foreign cases such as *Office Cleaning Services Ltd v Westminster Window and General Cleaners Ltd* (1946) 63 RPC 39; *CANNON Trademark* [1980] RPC 519; [2005] RPC 12 243 (ECJ) 257-259; and [2005] RPC 20 535 (AP) 539-541.

The Complainants thereafter contended that the disputed domain name **barlowlogistics.co.za** is identical or confusingly similar to their names/trademarks **BARLOW**, **BARLOWORLD** and **BARLOWORLD LOGISTICS**, in which the predominant part is **BARLOW** (and where the word **LOGISTICS** is simply a descriptive term or word).

In the Response it is argued that the disputed domain name is not identical or sufficiently similar to the Complainants' marks but is identical to BLPL's registered trade name (i.e. company name) **BARLOW LOGISTICS**. This does not rebut the above contention by the Complainants.

There are a number of international domain name decisions, such as these cited hereunder, which provide that the addition of a generic word to a trade mark is not sufficient to render the two names distinctive. In NAF/FA141825 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 EXPERIAN trademark 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 nikesports were found to be similar to the trademark NIKE; DRS04601 in which nikestore was found to be similar to the trade mark NIKE; and DRS01493 in which nokia-ring-tones was found to be similar to the trade mark NOKIA. See further for example the South African domain name decisions in SAIPL ZA2007-0003 [tekommedia.co.za] in which that domain name was found to be similar to the trade mark TELKOM; SAIPL ZA2008-0021 [blackpearlbetting.co.za] in which that domain name was found to be similar to the trade mark BLACK PEARL; SAIPL ZA2008-0025 [suncityshuttle.co.za] in which that domain name was found to be similar to the trade mark SUN CITY; SAIPL ZA2008-0023 [suncityvacation.co.za] in which that domain name was found to be similar to the trade mark SUN CITY; and SAIPL ZA2010-0048 [etravelmag.co.za] in which that domain name was found to be similar to the trade mark ETRAVEL.

Accordingly the Adjudicator finds, on a balance of probabilities, that, on a proper comparison, the above name/trademarks of the Complainants are clearly identical, or at least confusingly similar, to the disputed domain name **barlowlogistics.co.za**.

The Complainants have lastly contended that, in the hands of the Registrant, and for various reasons that will be discussed more fully below, the disputed domain name is an abusive registration. This has been disputed in the Response filed by BLPL on the basis that it contends, as a defence, that it has rights, and is entitled, to use its company name and to register the

disputed domain name, as a continuance of use of the registered business i.e. company name since 2001. Further it contends that in acting as aforesaid, it has acted in good faith, without intending to act against the interests of the Complainants.

In its above contention BLPL does not appear to understand the principle that the registration of a company name does not grant rights of use *per se* and hence does not warrant that that name can be used on an absolute basis and without the possibility of an objection by a third party. For example, if another entity or company can prove a prior and stronger right to that name – *qui prior in tempore, fortior in jure est* - , then, on the filing of a formal name objection, the Registrar of Companies can find that company name to be undesirable and can order the company to change its name on that basis. Furthermore, BLPL has failed to provide any evidence of use of the name by the company since its incorporation and as discussed above, the registration of a company name itself, does not *per se* give rise to user rights under the common law.

The Adjudicator does not wish to elaborate further in this regard – because this aspect may yet find its way to another, separate dispute - save to say that, in the opinion of the Adjudicator, BLPL's view in this regard does not find support in our Company Law.

Accordingly, on a balance of probabilities, the Adjudicator rejects the view taken by BLPL in this regard.

#### 4.1 Complainants' Rights

4.1.1 As discussed above, and if considered on the merits, the Adjudicator finds, on a balance of probabilities, that the Complainants have rights in respect of names/marks which are identical or similar to the

disputed domain name.

4.1.2 The Adjudicator also finds that BLPL does not have a valid defence to the above position.

#### 4.2 Abusive Registration

4.2.1 The Complainants have contended that the disputed domain name 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 Complainants' rights; and/or has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainants' rights.

4.2.2 In contending that the disputed domain name is an abusive registration, the Complainants have pointed out that BLPL had, in negotiations, sought payment of an "exorbitant amount of money" failing which they would not change the disputed domain name. Regulation 4 (1) (a) (i) includes, as a factor which may indicate that a domain name is an abusive registration, the circumstance that a registrant has registered or otherwise acquired the domain name primarily to sell, rent or otherwise to transfer the domain name to a complainant for valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name.

In view of the above action of BLPL, although there is no evidence of an intention primarily to over-reach in such a manner, this factor has presented itself in this case, and hence it suggests that the disputed domain name appears, on these facts, to be an abusive registration.

4.2.3 The Complainants have argued that the disputed domain name is

inhibiting the Complainants' business activities and is seemingly intended to divert trade from the Complainants to the Registrant.

More particularly, the Complainants have argued that the offending domain name is intended to block the registration of a name in which the Complainants have rights. It seeks to obtain the registration of the domain name `barlowlogistics.co.za` in addition to the **barloworld-logistics** domain they already own. However, the disputed domain name blocks this registration by the Complainants.

Regulation 4 (1) (a) (ii) includes, as a second factor, that may indicate that the domain name is an abusive registration, the circumstance that the Registrant has registered or otherwise acquired the domain name primarily to block intentionally the registration of a name or mark in which the complainant has rights.

Although there is no evidence that such blocking has been intended primarily, certainly this is the effect that the disputed domain name has on the business of the Complainants. This factor is undeniably present, and hence the disputed domain name appears to be an abusive registration. In support thereof earlier domain name decisions indicate that such "barring" or "blocking" are indicative of an abusive registration. See for example the decisions in DRS00583 and DRS01378. More particularly, the Complainants have also argued that the disputed domain name unfairly disrupts the business of the Complainants because the disputed domain name is likely to cause confusion in that **barlowlogistics** is somehow connected to or involved with **barloworld-logistics**.

Regulation 4 (1) (a) (iii) includes, as a third factor, that may indicate that the domain name is an abusive registration, the circumstance that the registrant has registered or otherwise acquired the domain



name primarily to disrupt unfairly the business of the complainant. It appears to be undeniable that confusion or deception is likely as between **BARLOW** and **BARLOWORLD** with both being used in relation to logistics solutions/services. In fact, an actual incidence of confusion is reported by the Complainants (although BLPL appears to have an explanation for this incident). Given the likelihood of this occurring, and although there is no evidence of an intention primarily to do so, the disputed domain name has such an effect, and hence the disputed domain name appears to be an abusive registration. In addition, various foreign decisions have found that confusion may be inferred where the Registrant registered a domain name containing the Complainant's name plus a generic term. See for example the foreign decisions in WIPO/D2000-0777, WIPO/2000-878, NAF/FA95033 and NAF/FA95402; and foreign decisions cited above; and various South African domain decisions including those cited above.

4.2.4 Finally the Complainants have argued that the disputed domain name prevents them from exercising their rights to exploit their name/trademarks to their full extent viz **BARLOW**, **BARLOWORLD** and **BARLOWORLD LOGISTICS** and variations thereof as domain names, but the **disputed** domain name prevents them from doing so.

Regulation 4 (1) (a) (iv) includes as a fourth factor, that may indicate that a domain name is an abusive registration, the circumstance that the registrant has registered or otherwise acquired the domain name primarily to prevent the complainant from exercising his, her or its rights.

This factor is present and relates to, and reinforces the factor

discussed under sub-section (ii) above. Although there is no evidence of an intention to do so primarily, the effect is present, and hence the disputed domain name appears to be an abusive registration.

See the domain name decisions cited above in support of this factor.

4.2.5 Overall therefore it is clear that the Registrant has no rights in or to the name/trademark **BARLOW LOGISTICS** (or any similar name/trademark); and that he has gained an unfair advantage through the disputed domain name, the use of which will undeniably lead to the unlawful dilution of the distinctive character and repute of the Complainants' names/trademarks **BARLOW**, **BARLOWORLD** and **BARLOWORLD LOGISTICS**.

#### 4.3 Abusive Registration

4.3.1 In the above circumstances, and on a default basis viz without taking the Response filed herein into account, the Adjudicator finds, on a balance of probabilities, that the disputed domain name is an abusive registration.

As explained above, and in the interests of not prejudicing the Registrant, if the Response filed herein is taken into account, in the above circumstances, the Adjudicator finds, on a balance of probabilities, likewise that the disputed domain name is an abusive registration.

### 5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, **barlowlogistics.co.za**, be transferred to the Complainants, more particularly to the first Complainant.

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**ANDRE VAN DER MERWE**  
SAIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)