

Decision

[ZA2013-0156]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2013-0156
DECISION DATE:	24 January 2014
DOMAIN NAME	standardbankmall.co.za
THE DOMAIN NAME REGISTRANT:	Sadiyya Nosarka
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	The Standard bank of South Africa Ltd
COMPLAINANT'S LEGAL COUNSEL:	Adams & Adams
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIIPL”) on **8 November 2013**. On **13 November 2013** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **14 November 2013** 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 **26 November 2013**. In accordance with the Regulations the due date for the Registrant’ s Response was **27 December 2013**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **2 January 2014**.
- c) The SAIPL appointed **Vanessa Lawrance** as the Adjudicator in this matter on 6 January. 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 domain was registered on 10 July 2013 by Sadiyya Nosarka.
- 2.2 The following facts are undisputed and, their not being palpably implausible, the Adjudicator accepts them for the purposes of this adjudication.
- 2.3 The Complainant is The Standard Bank of South Africa Limited, a public company incorporated according to the company laws of the Republic of South Africa, with its principal place of business at Standard Bank Centre, 5 Simmonds Street, Johannesburg. The Complainant is a subsidiary of Standard Bank Group Limited (hereinafter referred to as “the Group”).

- 2.4 The Group has registered various trade marks, including the trade mark STANDARD BANK, worldwide, in the name of the Complainant. The Complainant's rights in the name and trade mark date back to 1862.
- 2.5 The Complainant is one of the largest banks in Africa, and is considered to be a leader in banking and related products and services in Africa. The Group was recently voted the most valuable banking brand in Africa by Brand Finance.
- 2.6 The Complainant's STANDARD BANK trade mark is widely used and advertised. In the 2012 financial year, in excess of R1 billion was spent in marketing the STANDARD BANK trade mark and the associated good and services.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant is the proprietor of numerous trade mark registrations consisting of or incorporating the words STANDARD BANK in South Africa and internationally, and claims common law and famous trade mark rights therein.
- b) The Complainant owns the domain name standardbank.co.za.
- c) The offending domain name is, for all intents and purposes, identical to the Complainant's STANDARD BANK trade mark (as the distinctive part thereof is "STANDARD BANK", the word "mall" is descriptive, and of lesser importance).
- d) Accordingly, the Complainant contends, it has established that the offending domain name is identical or at least similar to a trade mark in which the Complainant has rights, as required by Regulation 3(1)(a).
- e) The Complainant submits that the Registrant has registered the offending domain name in a manner which, at the time when it was registered, took unfair advantage of and was unfairly detrimental to

the Complainant's rights.

- f) Although the Registrant did not respond to the Complaint lodged, it responded to correspondence from the Complainant prior to lodging the Complaint, advising that it did not believe that its mere ownership amounted to infringement (as it was not using the domain name yet).
- g) The authorities support the view that actual use is not required that the domain names are an abusive registration.
- h) the Complainant submits that it has shown at least the following factors, as itemised in Regulation 4(1), which indicate that the offending domain names are abusive registrations:
 - i) The Registrant's registration of the domain name has as effect that the Complainant cannot freely exercise its rights in its STANDARD BANK trade mark; and
 - ii) The Registrant's registration of the domain name complained of has the potential to erode the distinctive nature of the Complainant's STANDARD BANK trade mark, as it paves the way for an argument that third parties should also be allowed to co-exist.

The Registrant has registered the domain names to prevent the Complainant from exercising its rights.

3.2 Registrant

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

4 Discussion and Findings

4.1 Complainant's Rights

- 4.1.1 The Complainant is the proprietor of numerous trade marks

consisting of or incorporating the words STANDARD BANK in South Africa which pre-date the Registrant's registration of the domain name.

4.1.2 Complainant has claimed common law rights in the STANDARD BANK trade mark through extensive use thereof.

4.1.3 The domain name at issue is, for all intents and purposes, identical to the Complainant's trade mark.

4.1.4 The domain name www.standardbankmall.co.za cannot but be held to be confusingly similar to the Complainant's trade mark STANDARD BANK. There are numerous cases that support the proposal that where a domain name comprises descriptive or non-distinctive matter added to the appropriated trade mark of another, that added material is not sufficient to avoid the likelihood of confusion. As submitted by the Complainant, the WIPO case of 4microsoft2000.com [D2000-1493] is one of these cases. There is also South African ADR case law supporting this: inter alia SAIPL Decision ZA2007-0003 (re telkommedia.co.za) and ZA2007-010 (re mwebsearch.co.za).

4.1.5 The Complainant has thus established that the domain name in issue is identical or at least confusingly similar to a trade mark in which the Complainant has rights, as required by Regulation 3(1)(a).

4.2 Abusive Registration

4.2.1 Regulation 4(1), lists various factors which may be considered as indicating that registration of a domain name is an abusive registrations:

- i) The Registrant has registered the domain names to block intentionally the registration of a name or mark in which the Complainant has rights;

- ii) The Registrant has registered the domain names to disrupt unfairly the business of the Complainant;
 - iii) The Registrant has registered the domain names to prevent the Complainant from exercising its rights; and/or
 - iv) The Registrant is using, or has registered, the domain names in a way that leads people or business to believe that the domain names are registered to, operated or authorised by, or otherwise connected with the Complainant.
- 4.2.2 Although the registrant is not alleged to be using the domain name for any purpose whatsoever, as it has registered a domain name wholly incorporating the Complainant's trade mark, the Adjudicator fails to see how this registration could be interpreted in any other way than obstructive. Even if there were a good and non-obstructive reason for registration of the domain name, the Registrant has failed to take the opportunity presented by these proceedings to put such reasons forward. The authorities cited by the Complainant support the view that actual use is not required that the domain name is an abusive registration.
- 4.2.3 The domain name has thus been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

5. Decision

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

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VANESSA LAWRENCE

SAIIPL SENIOR ADJUDICATOR

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