

ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-0164
DECISION DATE:	9 MAY 2014
DISPUTED DOMAIN NAME	inet-technologies.co.za
THE DOMAIN NAME REGISTRANT:	INET-TECHNOLOGIES INC.
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	I-NET BRIDGE (PTY) LTD
COMPLAINANT'S LEGAL COUNSEL:	MOORE ATTORNEYS
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **25 February 2014**. On **25 February 2014** the SAIPL transmitted by email to ZACR (ZA Central Registry) a request for the Registry to suspend the domain name at issue, and on **25 February 2014** ZACR confirmed that the Disputed 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 February 2014**. In accordance with the Regulations the due date for the Registrant’s Response was **27 March 2014**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **31 March 2014**.
- c) As the Registrant did not submit a Response, the Complainant did not submit any Reply.
- d) The SAIPL appointed **Charne Le Roux** as the Senior Adjudicator and **Christiaan Steyn** as Trainee Adjudicator in this matter on **4 and 17 April 2014** respectively. The Adjudicators submitted Statements of Acceptance and Declarations of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Complainant was established in 1990 as a Joint Venture between Ivor Jones Roy (currently Deutsche Securities) and Times Media Limited. The Complainant has been offering a range information and investment products to the South African and Southern African markets since 1990. It currently forms part of the Times Media Group of Companies.

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- 2.2 The Complainant is the proprietor of the following South African trade mark registrations for the mark I-NET, which are currently in force:
- i) Trade Mark Registration No. 1999/11087 I-NET in Class 9;
 - ii) Trade Mark Registration No. 1999/11088 I-NET in Class 36;
 - iii) Trade Mark Registration No. 1999/11089 I-NET in Class 38; and
 - iv) Trade Mark Registration No. 1999/11090 I-NET in Class 42.
- 2.3 The Complainant also owns the domain names *inet.co.za*, *inet-invest.co.za*, *inet-mobile.co.za*, *inet-payments.co.za*, *inet-trader.co.za*, *inetbridge.co.za*, *inetmobile.co.za*, *i-invest.co.za*, *i-mobile.co.za*, *i-netbridge.co.za*, *inetinvest.co.za*, *inet.xxx*, *i-netbridge.xxx*, *i-net.xxx* and *inetbridge.xxx*.
- 2.4 The Complainant's wide range of investment products comprising real-time and historical market data are packaged with breaking news and powerful analytical tools and are offered under the I-NET STATION, I-GRAPH and I-NET EQUITY brands. The Complainant also offers access to 'live' prices, data, research tools and market related local and international news on an on-line/web-based platform through its domain name (and related website) *inet.co.za*.
- 2.5 In July 2002 the Complainant started providing ISP services as an internet service provider, as well as other telecommunications and information technology related services.
- 2.6 The Complainant recently launched its I-NET MOBILE product with the intention of expanding its business into the mobile retail market.
- 2.7 In August 2013 the Complainant found that the Registrant registered the Disputed Domain Name *inet-technologies.co.za* without the Complainant's authority and was subsequently using this Disputed Domain Name in relation to its website whereon it offers ISP services such as web-hosting, web-design and web-management services and which are similar to those of the Complainant.

2.8 On 27 August 2013 the Complainant's attorneys forwarded a Letter of Demand to the Registrant informing it of the Complainant's rights in its I-NET range of trade marks and the Registrant's abusive use thereof in connection with the Disputed Domain Name. It requested that the Disputed Domain Name be transferred to the Complainant. The Registrant did not respond to this demand and to date the Complainant has not received any communication from the Registrant in connection with this matter.

3 Parties' Contentions

3.1 Complainant

The Complainant has made the following contentions, namely:

- a) That it is the proprietor of registered trade marks for I-NET. The Complainant has provided Register pages of 4 (four) trade mark registrations in South Africa filed on 23 June 1999 for the trade mark I-NET in Classes 9, 36, 38 and 42, which relate to goods and services associated with information technology (IT) and financial data, showing its rights in such marks.
- b) That it enjoys extensive common law rights in the I-NET trade mark and has under this brand become one of South Africa's preferred electronic providers of accurate, timely and quality financial content. In support of this statement, the Complainant states that it has an annual revenue of over R134 million, it has 135 employees and has a client base of over 300 leading institutions. The Complainant further asserts that it is involved in the Spire Awards in association with the JSE and that it has been selected as a "*Leading Performer*" by Tapco Media in 2011. Based thereon, the Complainant contends that I-NET, as well as the inet.co.za domain name are well-known brands in South Africa, specifically in the telecommunications, IT and financial information industry.

- c) That it has domain name rights based on the registration of the domain name *inet.co.za* in January of 1995.
- d) That the Disputed Domain Name *inet-technologies.co.za* is similar to the I-NET trade mark, in that it wholly incorporates the Complainant's I-NET trade mark, with the addition of the generic word TECHNOLOGIES failing to serve as a distinguishing factor.
- e) That the Disputed Domain Name is an abusive registration. In support of this, the Complainant has submitted that, in terms of Regulation 4, the Registrant has registered the Disputed Domain Name to block the registration of a domain name similar to the Complainant's trade mark I-NET, that the Disputed Domain Name was registered in a manner that took unfair advantage of the Complainant's rights, that the Registrant deliberately registered the Disputed Domain Name to confuse the public into believing that the Disputed Domain Name is the Complainant and that the Disputed Domain Name has been used in a manner that conflicts with the Complainant's rights.
- f) Furthermore, in terms of Regulation 4, in support of this contention, the Complainant submits that the Registrant has registered the domain name in a way that leads people to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- g) The Complainant requests that the Disputed Domain Name be transferred to it.

3.2 Registrant

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

4 Discussion and Findings

- a) Regulation 3(1)(a) requires that the Complainant proves, on a balance of probabilities, each of the following elements in order for the Disputed Domain Name to be transferred:
- i. that the Complainant has rights in respect of a name or mark that 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.

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

DOES THE COMPLAINANT HAVE RIGHTS IN RESPECT OF A NAME OR MARK:

- 4.1.1 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 principles of trade mark law, but recognises rights going beyond those in terms of the Trade Marks Act No. 194 of 1993 or the requirements at common law for passing off. Such rights must, however, find recognition in law. See ZA2007-0008 (privatesale.co.za).
- 4.1.2 The Adjudicator finds that the Complainant acquired rights in respect of the I-NET trade mark arising from its trade mark registrations for it.
- 4.1.3 The Adjudicator also finds that the Complainant has made sufficient use of its I-NET trade marks and domain names to give rise to common law rights in the I-NET mark.

- IS THE NAME OR MARK IDENTICAL OR SIMILAR TO THE DISPUTED DOMAIN NAME:

4.1.4 The Adjudicator also finds that the Disputed Domain Name is similar to the Complainant's I-NET trade mark as required in terms of Regulation 3(a). The Disputed Domain Name includes the Complainant's mark I-NET in its entirety. The I-NET trade mark is also the dominant feature of the Disputed Domain Name. The incorporation of the generic word TECHNOLOGY does not assist the Registrant in escaping the aforesaid finding and reference is made to a similar case in the South African domain dispute matter ZA2007/0003, where it was found that the domain name *telkommedia.co.za* was identical or confusingly similar to the well known trade mark TELKOM.

4.1.5 In another similar foreign case, NAF/FA141825, it was found that: *"[It] is also well-established under the Policy that a domain name composed of a trademark coupled with a generic term still is confusingly similar to the trademark"*.

4.1.6 In the foreign decision of 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"*.

4.1.7 Reference is also made to foreign cases WIPO/D2000-1598 in which NIKETRAVEL and NIKESPORTSTRAVEL were found to be similar to NIKE; 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.

4.2 Abusive Registration

4.2.1 Regulation 4 (1) provides for a number of grounds (non-exhaustive)

which can indicate that the Disputed Domain Name is an abusive registration. These include the following:

- i. that the Registrant has registered or otherwise acquired the domain name primarily to prevent the Complainant from exercising its rights; and
- ii. that the Registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

- THE REGISTRANT HAS REGISTERED OR OTHERWISE ACQUIRED THE DOMAIN NAME PRIMARILY TO PREVENT THE COMPLAINANT FROM EXERCISING ITS RIGHTS:

4.2.2 The Complainant asserts that the Registrant has registered the Disputed Domain Name primarily to prevent the Complainant from exercising its rights, more particularly from registering the name INET-TECHNOLOGY as a domain name.

4.2.3 The Registrant did not submit a response and therefore no evidence contrary to the assertion above has been brought forth. Based on this absence of contradictory evidence and the fact that the Disputed Domain Name incorporates both the Complainant's trade mark and a word directly associated with the Complainant's field of business, and is currently being used by the Registrant for a website offering services related to the Complainant's services, indicate that the Registrant knew of the Complainant's trade mark and that the Disputed Domain Name was registered for the purpose complained of.

4.2.4 Therefore the Adjudicator finds, on a balance of probabilities, that the Disputed Domain Name was registered primarily to prevent the Complainant from exercising its rights.

- THE REGISTRANT IS USING OR HAS REGISTERED THE DISPUTED DOMAIN NAME IN A WAY THAT LEADS PEOPLE TO BELIEVE THAT THE DOMAIN NAME IS REGISTERED TO, OPERATED OR AUTHORISED BY, OR OTHERWISE CONNECTED WITH THE COMPLAINANT:

4.2.5 The Complainant asserts that, particularly where the Registrant has registered a domain name that wholly incorporates the Complainant's trade mark, together with a generic term related to the Complainant's business, the Disputed Domain Name is likely to lead people and businesses to believe that such a domain name is associated to the Complainant. In ZA2007/0003 it was held that actual confusion is not necessary and that the potential or likelihood of confusion would be sufficient. It was also held that confusion may be inferred in situations where the Registrant registered a domain name containing the Complainant's name or mark together with a generic term. The above mentioned foreign decisions, including WIPO/D2000-0777, WIPO/D2000-878, NAF/FA95033 and NAF/FA95402 all support that decision.

4.2.6 Therefore the Adjudicator finds, on a balance of probabilities, that the Registrant has registered the Disputed Domain Name in a way that leads, or will lead, people and businesses to believe that it is registered to, operated or authorised by, or otherwise connected with the Complainant.

5. Decision

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

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CHARNE LE ROUX

SAIPL SENIOR ADJUDICATOR

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