

## ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2014-0174</b>
DECISION DATE:	<b>17 July 2014</b>
DOMAIN NAME	<b>standardbank-sa.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>John Chingy</b>
REGISTRANT'S LEGAL COUNSEL:	<b>n/a</b>
THE COMPLAINANT:	<b>The Standard Bank of South Africa Ltd</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Adams &amp; Adams</b>
THE 2 <sup>nd</sup> LEVEL DOMAIN NAME ADMINISTRATOR:	<b>UniForum SA (CO.ZA Administrators)</b>

## **1) Procedural History**

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on 17 April 2014. On 23 April 2014 the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on 23 April 2014 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 24 April 2014. In accordance with the Regulations the due date for the Registrant's Response was 26 May 2014. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on 27 June 2014.
- c. The SAIPL appointed Vanessa Lawrance as the Adjudicator in this matter on 9 July 2014. 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 name was registered on 8 July 2012 by John Chingy.

2.2 The following facts are undisputed and, they not been palpably implausible, the Adjudicator accepts them for purposes of this adjudication.

- 2.3 The Complainant is the Standard Bank of South Africa Limited, a public company, incorporated in accordance with the company laws of the Republic of South Africa, with 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 1 Billion Rand was spent in marketing the STANDARD BANK trade mark and the associated goods 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 it claims common law and well known trade mark rights in the mark.

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- 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"). "SA" is a common shortening for "South Africa, and is accordingly descriptive. The "-sa" part is of lesser importance than the distinctive part of the domain name "standard bank".
  - d. Accordingly, the Complainant contends that it has established that the offending domain name is identical or is similar to a trade mark in which the Complainant has rights, as required by Regulation(1)(a).
  - e. The Complainant submits that the Registrant has registered the offending domain name in a manner which, at the time that it was registered, took unfair advantage of and was unfairly detrimental to the Complainant's rights.
  - f. The Complainant submits that it has shown at least the following factors, as listed in Regulation 4(1) as factors that indicate that domain names are abusive registrations;
    - i. the Registrant's domain name was registered to intentionally block the registration of a name or mark in which the Complainant has rights'
    - ii. the Registrant's registration of the domain name unfairly disrupts the business of the Complainant; and

- iii. the Registrant's registration of the domain name has as effect that the Complainant is prevented from exercising its rights.

### **3.2 Registrant**

- a. The Registrant did not reply to the Complaint.

## **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 predate the Registrant's registration of the domain name complained of.
- 4.1.2 The 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 STANDARD BANK trade mark.
- 4.1.4 The domain name standardbank-sa.co.za cannot but be held 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 distinguish the domain name from the trade mark and avoid the likelihood of confusion. In this regard, the Adjudicator refers to the WIPO case of 4microsoft2000.com [D2000-1493]. This is also supported by

South African ADR case law, inter alia, the telkommedia.co.za (ZA2007-0003) and in websearch.co.za (ZA2007-010) cases.

- 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 three factors which may be considered and indicating that registration of a domain name is abusive. These include: In this regard, the Adjudicator refers to the WIPO case of 4microsoft2000.com [D2000-1493]. This is also supported by South African ADR case law, inter alia, the telkommedia.co.za (ZA2007-0003) and in websearch.co.za (ZA2007-010) cases.
- 4.2.2 As the domain name wholly incorporates the Complainant's trade mark, the Adjudicator fails to see how this registration could be found to be anything but 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.
- 4.2.3 The domain name is thus found to have been used in a manner that takes unfair advantage or is detrimental to the Complainant's rights, and is obstructive thereto.

## **5. Decision**

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

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**VANESSA LAWRANCE**

SAIIPL SENIOR ADJUDICATOR

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