

Decision

[ZA2014-0187]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-0187
DECISION DATE:	2 December 2014
DOMAIN NAME	standardbankmobi.co.za
THE DOMAIN NAME REGISTRANT:	James Sai
REGISTRANT'S LEGAL COUNSEL:	n/a
COMPLAINANT'S LEGAL COUNSEL:	Debbie Marriott Adams and Adams
THE COMPLAINANT:	Standard Bank of South Africa Limited
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry (CO.ZA Administrators)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) in terms of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIPL’s Supplementary Procedure on **25 August 2014**. On **2 October 2014** the SAIPL transmitted by email to ZA Central Registry a request for the registry to suspend the domain name at issue, and on **3 October 2014** ZA Central Registry confirmed that the domain name had indeed been suspended.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **8 October 2014**. In accordance with the Regulations the due date for the Registrant’s Response was **5 November 2014**. The Registrant sent a Response in the form of an e-mail message. The Response did not meet the formal requirements as prescribed by regulation 18. The SAIPL sent a notice of default to the Registrant on **4 November 2014**. The Registrant was informed that the Response was deficient and that he had until **5 November 2014** to submit a proper Response. The Registrant was also advised that the SAIPL would forward the deficient Response to the Adjudicator for consideration as to its admissibility, should he fail to submit a proper Response. The Registrant did not submit any response to the notice of default.
- c) The Complainant did not submit any Reply to the deficient Response.
- d) On **12 November 2014** the SAIPL appointed **Tana Pistorius** as senior adjudicator and **Sizwe Snail Ka Mtuze** as trainee adjudicator in this Dispute.

The Adjudicator and Trainee Adjudicator have 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, Standard Bank of South Africa Limited is a company operating the business of a bank. It is a subsidiary of Standard Bank Group Limited. The Complainant was established in 1862 as a limited liability company and has grown to be one of South Africa and Africa's biggest banks with various banking divisions and banking products.
- 2.2 On 5 January 2014 the domain name standardbankmobi.co.za was registered by the Registrant.
- 2.3 Several other TLD's have STANDARRD BANK domains registered by parties unrelated to the parties in this adjudication.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant has registered STANDARD BANK as a word mark and the word STANDARD together with the bank's logo as a device mark worldwide.
- b) The Complainant has built up a considerable reputation and goodwill in the STANDARD BANK trade mark and at common law through its widespread, consistent and intensive use of the mark and through various advertising, marketing and other promotional activities.
- c) The Complainant also registered standardbank.co.za as its South

African domain name which it has been using since 1996.

- d) The Complainant has in the past successfully disputed abusive domain name registrations of the trade mark STANDARD BANK or variations. Amongst these are the domain names:

standeredbank.co.za;

standardsbanks.co.za; and

standardbanklifeinsurance.co.za.

- e) The Complainant contends that the disputed domain name, standardbankmobi.co.za is confusingly similar to its trade mark STANDARD BANK. Firstly the Complainant contends that the dominant and memorable element of the domain name in dispute is the first element, namely “STANDARD BANK”. The Complainant also avers that this dominant element of the disputed domain name is phonetically identical and visually similar to the Complainant’s trade mark STANDARD BANK.

The Complainant contends that the addition of the non-distinctive or generic word “mobi” with the word “standardbank” will not have any impact on the overall impression of the dominant part of the disputed domain name namely, STANDARD BANK .

The Complainant contends that the addition of the word “mobi” is legally inconsequential and does not prevent a finding of confusing similarity, nor does it reduce the risk of confusion. The combination of STANDARD BANK with the word “mobi” creates a domain name that can only be regarded as confusingly similar to the Complainant’s registered and well-known STANDARD BANK trade mark.

- f) Complainant alleges that there is a substantial likelihood of confusion

that Internet users and consumers will be confused into believing there is an association between the Registrant and the Complainant when, in fact, no such relationship exists. The Complainant notes that the disputed domain name standardbankmobi.co.za may, for example, mislead a consumer to believe that it is the mobile version of the Complainant's web site www.standardbank.co.za.

- g) Complainant submits that the domain name in the hands of the Registrant is an abusive registration in terms of Regulation 3(1)(a) as the registration and the continued use of the disputed domain name is abusive.
- h) The Complainant states that the identical or similar domain name is not being used for any bona fide offering of goods or services and instead indicates that it has been parked and advertises financial services and products of third parties.
- i) The Complainant states that the Registrant has no legitimate interest in the disputed domain name and that it is suspicious as to the motives of the Registrant in registering the disputed domain name. The Complainant states that it can only reasonably infer that the Registrant intends to extort money from it or to imitate the Complainant's business.
- j) A letter of demand was sent to the Registrant on 17 April 2014 via email. The Complainant advised the Registrant that the disputed domain name infringes upon the Complainant's intellectual property rights. The Complainant requested the immediate "shut down" of the web site and the transfer of the disputed domain name. According to the Complainant the Registrant rejected the Complainant's demands

and stated that he did not believe that the Complainant could assert rights in and to the trade mark STANDARD BANK.

- k) Complainant also indicates that trade marks of other businesses have been registered as domain names by the Registrant such as
- rmbonlinebanking.co.za;
 - sasolcareer.co.za; and
 - sasollearnership.co.za.

The Complainant thus submits that the Registrant is engaged in a pattern of making abusive registrations in terms of sub-regulation 4(1)(c).

- l) The Complainant further submits that sub-regulation 4(i)(a)(ii)-(iv) is applicable to the Dispute as follows:
- (i) The Complainant is barred from registering or using the disputed domain name which it may well reasonably require to do in order to offer its services on a mobile device; and
 - (ii) the existence of the disputed domain name has the potential to erode the distinctive character of the STANDARD BANK trade mark and it may divert Internet users away from the Complainant to the services offered by the Complainant's competitors which may unfairly disrupt the Complainant's business.

3.2 Registrant

- a) The Registrant submitted a Response to the complaint. However, the Response does not comply with Regulation 18(1)(a) read together with the supplementary procedure which provides that a Registrant must respond to the statements and allegations contained in the Dispute in the form of a Response. It has also not been

commissioned before a commissioner of Oaths.

In addition, such a Response must detail any grounds to prove the domain name is not an abusive registration. In other words the Response must, in addition to the formal requirements, make out a bona fide prima facie case that the domain name registered by it is not abusive.

- b) In the interest of justice we exercise our discretion in favour of the Registrant and admit the Registrant's deficient Response into evidence. The Registrant's deficient Response purported to provide a justification for the adoption of the disputed domain name and he disputes the similarity between the disputed domain name and the Complainant's registered trade mark.
- c) He notes that "standardbankmobi" is not registered as a trade mark and that it is clearly distinctive and means something else than "STANDARD BANK".
- d) Registrant also argues that there are a number of entities that have no relationship with "standardbank" and they can happily co-exist without causing any damages to the Complainant. The Registrant provides a small sample of the alleged entities that "happily co-exist" with the Complainant, namely:

standardbankpa.com

standardbanks.com

standardbanking.com

<https://www.facebook.com/StandardBanks>

standardbankbd.com

Standard Life Bank Device registration in 1999 under registration number UK00002146819 in classes 35 36 and 42

see <http://www.ipo.gov.uk/tmcase/Results/1/UK00002146819>.

- e) Lastly, the Registrant explains why he chose to register the disputed domain name. He notes:

“The use of the word is clearly to mean ‘the standard of banking in the era of mobile technology world’ and this is how the shorten meaning of standardbankmobi came about. Mobiles are becoming increasingly common place as technology takes over the standard ways of banking. Customers from all parts of the world have increasingly adopted mobile technology and the idea of this name is to attract these consumers.”

4 Discussion and Findings

4.1 Complainant's Rights

4.1.1 The cornerstone of the Complainants’ case is proof on a balance of probabilities that it had rights in the trade mark STANDARD BANK at the time of the registration of the domain name, and that this trade mark is similar to the disputed domain name.

4.1.2 The Complainant has submitted proof that STANDARD BANK is registered as a word mark and the word STANDANRD together with the bank’s logo is registered as a device mark in several classes in South Africa, including the following:

Registration Number: 1978/01181

Registration Number: 1978/01182

Registration Number: 1978/01183

Registration Number: 1978/01184

Registration Number: 1978/01185

Registration Number: 2008/14473

Registration Number: 2008/14472

Registration Number: 2010/29403

4.1.3 The Complainant has registered rights in respect of the trade mark STANDARD BANK that date back to 1978. Prima facie, the Complainant is the proprietor of validly registered trade marks that comprise of, or incorporate, the trade mark STANDARD BANK.

4.1.4 The Registrant does not dispute the evidence submitted by the Complainant and the Adjudicator finds on such evidence that STANDARD BANK is indeed a well-known trade mark within the meaning of Section 34(1)(c) of the Trade Marks Act 194 of 1993.

4.1.5 It is a well-established legal principle that a domain name that comprises of a trade mark coupled with a generic term is confusingly similar to the trade mark. In this regard, the Adjudicators agree with the findings in the SAIPL decisions ZA2007-0003 (Telkom SA Limited v Cool Ideas 1290 CC) and ZA2007-0004 (Telkom SA Limited and TDS Directory Operations (Pty) Ltd v The internet Corporation).

Registrant's addition of the generic term "mobi" to the registered trade mark STANDARD BANK does not reduce confusion (see also ZA2013-0135 AB Electrolux v Johan Van Zyl and ZA2012-0117 South African Revenue Services v. Antonie Goosen where the Registrant registered the Complainant's mark and added the generic term "tax").

Therefore we find that the disputed domain name which consists of

the Complainant's trade mark coupled with the generic suffix "mobi" is confusingly similar to the trade mark STANDARD BANK.

4.2 Abusive Registration

4.2.1 An abusive registration means a domain name which either:

(i) 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 Complainant's rights; or

(ii) Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

4.2.2 The Complainant alleges that the disputed domain name is a blocking registration as it was registered primarily to intentionally block the registration of a name/mark in which the Complainant has rights (Regulation 4(1)(a)(ii)).

The Adjudicator in ZA2007-0003 (Telkom SA Limited v Cool Ideas 1290 CC) held that a blocking registration has two critical features. The first is that it must act against a name or mark in which the Complainant has rights. The second feature relates to an intent or motivation in registering the domain name in order to prevent a Complainant from doing so.

The Registrant was aware of the Complainant's rights at the time of the disputed domain name registration and his registration of the disputed domain name prevents the Complainant from reflecting its trade mark in a corresponding domain name in the .co.za registry.

The Adjudicators find, on a balance of probabilities, that the Registrant registered the disputed domain name primarily to block

intentionally the registration of a name in which the Complainant has rights.

4.2.3 The Complainant alleges that the disputed domain was registered primarily to disrupt unfairly the business of the Complainant. In ZA2007-0003 (Telkom SA Limited v Cool Ideas 1290 CC) it was confirmed that the disruption of the business of a Complainant may be inferred if the Registrant has registered a variation of the Complainant's mark by merely adding a generic word. The Registrant registered the Complainant's mark and added the generic term "mobi". The disputed domain name resolves to a web site at www.standardbanklifemobi.co.za where the Registrant offers links to the financial services offered by third parties. The Complainant correctly pointed out that Internet traffic that should reach the Complainant's website is being diverted to the Registrant's, and to the competitors of the Complainant, which is prejudicial to the Complainant.

Accordingly, the Adjudicators find, on a balance of probabilities, that the Registrant registered the disputed domain name primarily to disrupt unfairly the business of the Complainant.

4.2.4 Was the disputed domain registered primarily to prevent the Complainant from exercising its rights (Regulation 4(1)(a)(iv))? Two issues must be considered here. First, whether the disputed domain name prevents the Complainant from exercising its rights i.e. registering "standardbankmobi" as its own domain name in the .co.za registry. Secondly, the question arises whether the Registrant had acted in good faith or otherwise in registering the disputed domain name (see ZA2007-0003 (Telkom SA Limited v Cool Ideas 1290 CC)).

The disputed domain name registration prevents the Complainant from exercising its rights i.e. registering standardbank.co.za as its own domain name in the .co.za registry.

As noted above, a Response must detail any grounds to prove that the domain name is not an abusive registration. The Response must make out a bona fide prima facie case that the domain name registered by it is not abusive. The Registrant's failure to submit a proper Response is particularly relevant to the issue of whether the Registrant registered the disputed domain name in bad faith (see D2000-0325 Kabushiki Kaisha Toshiba v Shan Computers par 6.4). The Adjudicators conclude that the disputed domain registration was made in bad faith.

The Adjudicator accordingly finds, on a balance of probabilities, that the Registrant registered the disputed domain name primarily to prevent the Complainant from exercising its rights.

Are there circumstances indicating the Registrant is using or has registered the disputed domain in a way that leads people to believe that the domain name is registered to, operated to or authorised by, or otherwise connected with the Complainant (Regulation 4(1)(b))?

As noted above, the disputed domain name resolves to a web site at www.standardbanklifemobi.co.za where the Registrant offers links to the financial services offered by third parties. The Registrant uses the disputed domain name to attract Internet users to his own website and does so for commercial gain, by creating the confusion that he is authorised and or associated with the Complainant's trade mark as to the source of potential banking customers. As the disputed domain name standardbankmobi.co.za is similar to the Complainant's well-

known trade mark, it leads people or businesses to believe that the disputed domain name is registered to, operated or authorized by, or otherwise connected with the Complainant. This may be characterised as opportunistic bad faith (see D2003-0985 Société des Bains de Mer et du Cercle des Etrangers à Monaco v Internet Billions Domains Inc).

Accordingly, the Adjudicators find, 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 the domain name 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 Adjudicators order that the disputed domain name, `standardbankmobi.co.za` be transferred to the Complainant.

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TANA PISTORIUS

SAIIPL SENIOR ADJUDICATOR

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TRAINEE ADJUDICATOR

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