

## Decision

**ZA2015-0227**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2015-0227</b>
DECISION DATE:	<b>18 March 2016</b>
DOMAIN NAME:	<b>carfin24.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Laura Pamieri</b>
REGISTRANT'S LEGAL COUNSEL:	<b>N/A</b>
THE COMPLAINANT:	<b>Carfin 24 (Pty) Ltd.</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Self Representative</b>
2nd LEVEL ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA)</b>

## 1. Procedural History

- 1.1. The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **8 December 2015**. On **9 December 2015**, the SAIPL issued a Dispute Deficiency Notification in respect of an apparent typographical error in the name of the Registrant in the Dispute. The Complainant rectified the error and re-submitted its Dispute. The SAIPL verified that the Dispute (together with the amendment to the Dispute) satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”) and the SAIPL’s Supplementary Procedure. On **5 January 2016**, the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name at issue, and, on **6 January 2016**, ZACR confirmed that the domain name had indeed been suspended.
- 1.2. In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **6 January 2016**. In accordance with the Regulations, the due date for the Registrant’s Response was **3 February 2016**. The Registrant did not submit a Response in accordance with Regulation 18, and accordingly, the SAIPL notified the Registrant of its default on **4 February 2016**.
- 1.3. The SAIPL appointed **Kelly Thompson** as the Adjudicator in this matter on **9 February 2016** and **Somayya Khan** as the Trainee Adjudicator in this matter on **10 February 2016**. The Adjudicators have submitted their 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 Dispute is in respect of the domain name **carfin24.co.za**. The domain name **carfin24.co.za** was registered on 29 October 2013 by Team 6 Investment Holdings (Pty) Ltd. A Whois search report dated 9 April 2014 shows that, on that date, the registrant of the domain name **carfin24.co.za** was “Justin Harrison Marketing”. According to the relevant 2<sup>nd</sup> level domain administrator’s Whois search, the Registrant in these proceedings is Laura Pamieri, with a contact address in Sea Point. According to CIPC records, Mr. Justin Harrison, who traded as “Justin Harrison Marketing” (the prior registrant) and the current Registrant are directors of the company Team 6 Investment Holdings (Pty) Ltd, although her

name on CIPC's records is listed as Laura Palmieri. Annexure 3(4) also reflects the name "Laura Palmieri" and it has been assumed, for purposes of this Dispute, that they are one and the same person.

- 2.2. The Complainant is referred to in paragraph 3.1.1 of the Dispute as Carfin24 (Pty) Ltd (Reg. No. 2006/019865/07). According to the CIPC report (Annexure 2 of the Complaint), the registration number 2006/019865/07 is for the company Carfin (Pty) Ltd. The reference to "24" in the name of the Complainant appears to be a clerical error. The Complainant is Carfin (Pty) Ltd. and this name is consistent with references to the Complainant elsewhere in the Complaint. The Complainant is a company registered in accordance with the laws of the Republic of South Africa, with an address at Lombardy Business Park, Unit 21 & 22, Silver Lakes, Lynnwood Road, Pretoria, 0081.
- 2.3. The Complainant is registered with the National Credit Regulator and with the Financial Services Board and is concerned with the offering of vehicle financing and refinancing services.
- 2.4. The Complainant is the proprietor in South Africa of trade mark registrations nos. 2011/04900-02 **CARFIN logo** in classes 35, 36 and 38 with an effective date of 11 February 2011. It is also the applicant in South Africa in respect of trade mark applications nos. 2013/12539-41 **CARFIN** in classes 35, 36 and 38, and these applications were filed on 13 May 2013.
- 2.5. The domain name *carfin.co.za* is used in respect of the Complainant's primary website and has been registered in the name of Mr. George Simitopaulus, who is also the director of the Complainant and its representative in these proceedings.
- 2.6. The domain name *carfin.co.za* leads to the website [www.carfin.co.za](http://www.carfin.co.za), which provides information on the Complainant and advertises the business of the Complainant in relation to vehicle financial services.
- 2.7. The Complainant has expended a considerable amount of money in relation to its advertising initiatives over the years. The Complainant's business has been advertised through various mediums, including online media, newspapers, pamphlets, radio (Jakaranda FM) and television.

- 2.8. The Complainant's **CARFIN** Adwords hits for the Complainant's **CARFIN** trade mark for the period prior to 29 October 2013, being the date of registration of the disputed domain name, exceeded 150 000 hits. The Complainant's advertising expenditure for that same period exceeded R550 000.
- 2.9. The disputed domain name **carfin24.co.za** redirects to the website [www.getvehiclefinance.co.za](http://www.getvehiclefinance.co.za). The name GET VEHICLE FINANCE.CO.ZA appears in prominence on the website. The website [www.getvehiclefinance.co.za](http://www.getvehiclefinance.co.za) offers services in relation to vehicle financing.

### 3. Parties' Contentions

#### 3.1. Complainant

The contentions set out in the founding evidence in this Dispute can be summarised as follows:

- 3.1.1. The Complainant has been trading under the name **CARFIN** for 9 years in relation to vehicle financing, refinancing and related services.
- 3.1.2. The name and trade mark **CARFIN** is an invented word and not common in the English language. The name and trade mark was created for the purposes of the Complainant's business and has become "synonymous" with the Complainant over the years.
- 3.1.3. The Complainant claims that it is an industry leader in vehicle finance and re-finance and that it has been proactive and has carried out extensive marketing and advertising initiatives under the trade mark **CARFIN** over the years. It contends that it is unlikely that the Registrant, who is in the business of marketing websites, was unaware of it and its use of the name and trade mark **CARFIN** in relation to its business.
- 3.1.4. The Complainant contends that the domain name **carfin24.co.za** incorporates the dominant element of its company name, being **CARFIN**, and is identical or confusingly similar to its **CARFIN** and **CARFIN logo** trade marks and the domain name *carfin.co.za*, which was registered for the use and benefit of the Complainant.

- 3.1.5. The addition of the number “24” in the domain name does not distinguish the domain name **carfin24.co.za** from the Complainant’s **CARFIN** name, trade mark and domain name.
- 3.1.6. The Complainant has prior rights in the trade mark **CARFIN**. The registration of its company in June 2006 and its **CARFIN logo** trade mark with effect from 11 February 2011, and the filing of its **CARFIN** trade mark applications on 13 May 2013, all predate the registration of the domain name **carfin24.co.za**.
- 3.1.7. The domain name *carfin.co.za*, which is used for the purposes of the Complainant’s business, was also registered in 2006, being a date 7 years earlier than the date of registration of the domain name **carfin24.co.za**.
- 3.1.8. The Registrant is not associated with the Complainant’s business and the use of the domain name **carfin24.co.za** is likely to cause confusion and to deceive consumers into believing that products or services of the business advertised on the website under the domain name **carfin24.co.za** are associated, endorsed or supplied by the Complainant.
- 3.1.9. The Complainant contends that the Registrant is in the business of cybersquatting brand names by the registration of “similarly confusing” domain names.
- 3.1.10. The Complainant submits further that the registration of the disputed domain name **carfin24.co.za** has the effect that the Complainant is barred from registering or using the disputed domain name for itself.
- 3.1.11. The Complainant contends that when the domain name was registered by the “registrant” in 2013, it took unfair advantage of and was unfairly detrimental to its rights and submits that the domain name is being used in a way that infringes the Complainant’s trade mark rights and well-known company name.

## 3.2. Registrant

- 3.2.1. The Respondent did not formally respond to the Complaint.

#### 4. Discussion and Findings

4.1. The Registrant of the domain name **carfin24.co.za** is referred to in the Dispute as Laura Pamieri and Team 6 Investment Holdings (Pty) Ltd. The Registrant has changed since the initial registration on 29 October 2013. These changes are referred to earlier in paragraph 2.2, having regard to the Whois search reports. It is apparent that although the domain name **carfin24.co.za** was transferred from Team 6 Investment Holdings (Pty) Ltd. to Justin Harrison Marketing and then to the individual, Laura Pamieri, the domain name served and continues to serve the common purpose of those persons (who are all associated) and that purpose is to use the domain name for the furtherance of their business interests.

4.2. The Complainant's case is based on Regulation 3(1)(a), in that it has alleged rights in respect of a name or mark which is identical or similar to the domain name and that, in the hands of the Registrant, the domain name is an abusive registration.

4.3. In order to succeed under Regulation 3(1)(a), the Complainant is required to prove on a balance of probabilities, that:

4.3.1. the complainant has rights in respect of a name or mark;

4.3.2. the name or mark is identical or similar to the domain name; and

4.3.3. the domain name in the hands of the registrant is an abusive registration.

#### 4.4. Complainant's Rights

4.4.1. In terms of Regulation (1), the definition of "*rights*" and "*registered rights*" include "*intellectual property rights, commercial, cultural, linguistic, under South Africa law, but is not limited thereto*".

4.4.2. The Complainant registered its company name Carfin (Pty) Ltd on 29 June 2006.

4.4.3. The Complainant is also the proprietor of the trade mark **CARFIN logo** in classes 35, 36 and 38 dating back to 11 February 2011. The dominant and distinctive feature of the **CARFIN logo** is the word mark CARFIN. The Complainant is also the applicant of the trade mark **CARFIN** in classes 35, 36 and 38 dated 13 May 2013. The domain name *carfin.co.za* was registered by

the director of the Complainant on 5 July 2006 and is used in relation to the Complainant's business.

4.4.4. The Adjudicator is satisfied that the Complainant has established that it has statutory rights in the name and trade mark **CARFIN** and that those rights have been in existence from a date prior to the registration of the disputed domain name.

4.4.5. Although some of the Complainant's evidence was found wanting (the Jakaranda FM media schedules did not specifically mention the CARFIN trade mark, for example) there was sufficient evidence for the Adjudicator to be satisfied that the Complainant's use of its name and trade mark over the past 9 years has been of such a magnitude as to afford it rights at common law as well.

4.4.6. The Adjudicator finds that the Complainant has established that it has rights as contemplated by Regulation 3(1)(a) read with Regulation 3(2).

#### 4.5. **Abusive Registration**

4.5.1. 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.

4.5.2. The Complainant has made an allegation that the Registrant is in the business of cybersquatting. In the view of the Adjudicator, there is no evidence to support this statement and the Adjudicator does not see any merit in this allegation.

4.5.3. The Registrant's use of the domain name **carfin24.co.za** appears to have changed since the registration of the domain name. It no longer leads to the website [www.carfin24.co.za](http://www.carfin24.co.za), which advertised vehicle financing services. The disputed domain name is now being used to redirect web users to the website [www.getvehiclefinance.co.za](http://www.getvehiclefinance.co.za), which advertises services relating to vehicle

financing, being identical to the services of interest to the Complainant under the trade mark **CARFIN** and which website no doubt competes with the Complainant, as the website **www.carfin24.co.za** had done in the past.

4.5.4. Further, the Adjudicator finds that the disputed domain name **carfin24.co.za** is confusingly similar to the Complainant's trade mark, and is almost identical to the domain name *carfin.co.za*, which has been registered for the benefit of the Complainant's business and has had an online presence advertising the Complainant's business since 7 (seven) years prior to the registration of the disputed domain name. This is not an insignificant period for the dissemination of information in the digital world, particularly taking into consideration the advertising and marketing initiatives undertaken by the Complainant over the years.

4.5.5. The addition of the number "24" in the domain name does not distinguish the disputed domain name. If anything, the number "24" may be perceived to be a variation of the Complainant's trade mark or perceived by consumers to be a "round the clock" 24 hour services business.

4.5.6. The fact that the disputed domain name has been used for identical services of interest to the Complainant and now redirects to the website of [www.getvehiclefinance.co.za](http://www.getvehiclefinance.co.za) suggests that there is bad faith on the part of the Registrant and that the disputed domain name has been used to facilitate confusion and deception with the business of the Complainant. In the Adjudicator's view, the disputed domain name is likely to lead internet users who wish to view the Complainant's website, to the Registrant's website.

4.5.7. In the circumstances, the Adjudicator finds that the disputed domain name is an abusive registration.

## 5. Decision

5.1. For the foregoing reasons, the Complaint is upheld and the Adjudicator orders the transfer of the domain name **carfin24.co.za** to the Complainant.



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