

## Decision

**ZA2016-0248**  
**.ZA ALTERNATE DISPUTE RESOLUTION**  
**REGULATIONS (GG29405)**

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2016-0248</b>
DECISION DATE:	<b>7 December 2016</b>
DOMAIN NAME	<b>timeslives.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Malkhaz Kapanadze</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>Times Media (Pty) Ltd</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Moore Attorneys</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA)</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **12 October 2016**. 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.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **19 October 2016**. In accordance with the Regulations the due date for the Registrant's response was **16 November 2016**. [The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on 17 November 2016.
- c) The SAIPL appointed **Reinard Michau** as the Adjudicator in this matter on **25 November 2016**. 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 In 2007 the Complainant established a daily newspaper (published and distributed from Mondays to Fridays) called THE TIMES. It is a sister paper of the well-known SUNDAY TIMES newspaper and has a daily readership of 137 054.
- 2.2 THE TIMES newspaper is the first totally interactive newspaper in South Africa and is published in conjunction with the websites [www.thetimes.co.za](http://www.thetimes.co.za) and [www.timeslive.co.za](http://www.timeslive.co.za).
- 2.3 An on-line version of the newspaper is located on the website [www.timeslive.co.za](http://www.timeslive.co.za). Just like any other traditional printed newspaper,

various advertisements occur on this website.

- 2.4 The Complainant is also the registered proprietor of various trade marks for TIMESLIVE and TIMES LIVE in classes 9 and 38.
- 2.5 The aforesaid trade marks are registered for, *inter alia*, "downloadable electronic publications" (the class 9 trade mark) and "telecommunications, communication services; exchange and dissemination of information via the internet; news agency and news broadcasting services; services ancillary to all of the aforementioned" (the class 38 trade marks).
- 2.6 A perusal of the registrant's website (annex "TIM7") it contains links to various news items.
- 2.7 The Registrant, it is alleged, has in the past engaged in a pattern of making abusive registrations. Apart from the details of the alleged abusive registrations, no further information is provided. Given my conclusion it is not necessary to investigate this further.
- 2.8 Given the extent of the use by the Complainant of its TIMES LIVE website, I have little doubt that it can, at common law, claim to have a reputation in the trade mark TIMES LIVE (whether spelled as one word, or two).

### 3 Parties' Contentions

#### 3.1 Complainant

- a) The Complainant contends that the [timeslives.co.za](http://timeslives.co.za) registration in the name of the registrant is "*identical or similar to a name or mark in which the Complainant has rights*"; and
- b) is "*an abusive registration*" in the name of the registrant.

#### 3.2 Registrant's contentions no response

No opposition papers were filed.

## 4 Discussion and Findings

### 4.1 Complainant's Rights

For the reasons which follow below, it is my view that the domain name registration in the name of the registrant is contrary to the rights of the Complainant and is also an abusive registration.

- 4.1.1 Regulation 1 defines "*rights*" to include intellectual property rights.
- 4.1.2 The above definition is broad and "*rights*" is 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 294 of 1993 ("*the Act*") or the requirements at common law for passing-off. Such rights must, however, find recognition in law. See ZA2007-008 (privatesale.co.za).
- 4.1.3 The Complainant is the proprietor of various trade mark registrations for TIMESLIVE and TIMES LIVE. As a result of the undisputed evidence set out earlier, there is no doubt that there is a reputation and goodwill in the aforesaid trade marks. They are protected by the Act as well as at common law.

### 4.2 Abusive Registration

- 4.2.1 "*Abusive Registration*" is defined in the Regulations to mean, *inter alia*, a domain name which was registered in a manner which, at the time the registration took place, took unfair advantage of or is unfairly detrimental to the Complainant's rights.
- 4.2.2 The disputed domain name includes the Complainant's mark TIMESLIVE in its entirety. It only has an added letter "s" at the end.

- 4.2.3 The incorporation of the letter "s" does not assist to distinguish the disputed domain name from the TIMESLIVE trade mark. Reference is made to a similar case in the South African Domain Dispute Matter of 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.
- 4.2.4 In the foreign decision of Wipo / D2002-0367, the Panel concluded that: *"The disputed domain name contains Complainant's EXPERIAN trade mark in its entirety. The addition of the generic term 'automotive' does not distinguish the Respondent's domain name from the Complainant's mark"*.
- 4.2.5 Reference is also made to foreign case 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.
- 4.2.6 The Adjudicator accordingly finds that the domain name [timeslives.co.za](http://timeslives.co.za) is a domain name which will lead to deception and confusion and will unfairly disrupt the business of the Complainant. It also takes unfair advantage thereof. There is no doubt that the public would associate it with the Complainant. The contentions of the Complainant as set out in paragraph 3.1 above carry considerable weight and the Adjudicator finds those contentions to have been proved. They are incorporated in the Adjudicator's findings.

## 5. Decision

- 5.1 For the foregoing reasons the complaint is upheld and the Registrant is ordered that the disputed domain name <timeslives.co.za> is to be transferred to the Complainant.

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**R MICHAU SC**

SAIIPL SENIOR ADJUDICATOR

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