

Decision

[ZA2017-0281]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0281
DECISION DATE:	16 November 2017
DOMAIN NAME	anglo-ashantigold.co.za
THE DOMAIN NAME REGISTRANT:	Sengani Richard Mulaudzi
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	AngloGold Ashanti Limited
COMPLAINANT'S LEGAL COUNSEL:	Moore Attorneys – Tyrone Walker
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 "SAI IPL") on **14 September 2017**. On **26 September 2017** the SAI IPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **26 September 2017** ZACR confirmed that the domain name had indeed been suspended.
- b) In accordance with the Regulations, the SAI IPL formally notified the Registrant of the commencement of the Dispute on **27 September 2017**. In accordance with the Regulations the due date for the Registrant's Response was **25 October 2017**. The Registrant did not submit any response, and accordingly, the SAI IPL notified the Registrant of its default on **26 October 2017**.
- c) The Complainant did not submit any formal Reply, as none was necessary.
- d) The SAI IPL appointed **NOLA BOND** as the Adjudicator, assisted by Trainee Adjudicator **ROBIN RICHARDSON**, in this matter on **03 November 2017**. The Adjudicator and the Trainee Adjudicator have submitted the Statements of Acceptance and Declaration of Impartiality and Independence, as required by the SAI IPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Complainant is AngloGold Ashanti Limited. The Complainant was formed in April 2004 following the merger between AngloGold Limited and Ashanti Goldfields Company Limited. According to the Complainant's uncontested facts the Complainant is third largest gold producing mining company in the world, with a geographically diverse portfolio of operations and projects in nine countries namely, Argentina, Australia, Brazil, Ghana, Guinea, Mali, the

Democratic Republic of Congo, South Africa and Tanzania.

2.2 The Complainant is the proprietor of the following South African trade mark registrations and application:

- Trade Mark No. 1997/11814 **ANGLOGOLD** in class 35,
- Trade Mark No. 1997/11815 **ANGLOGOLD** in class 36,
- Trade Mark No. 1997/11816 **ANGLOGOLD** in class 37,
- Trade Mark No. 1997/11817 **ANGLOGOLD** in class 40,
- Trade Mark No. 1997/11818 **ANGLOGOLD** in class 42,
- Trade Mark No. 1998/19913 **ANGLOGOLD LOGO** in class 14,
- Trade Mark No. 1999/16160 **ANGLOGOLD LOGO** in class 37,
- Trade Mark No. 1999/16161 **ANGLOGOLD LOGO** in class 40,
- Trade Mark No. 2008/00072 **ANGLOGOLD ASHANTI** in class 14,
- Trade Mark No. 2008/00073 **ANGLOGOLD ASHANTI** in class 37,
- Trade Mark No. 2008/00074 **ANGLOGOLD ASHANTI** in class 40,
- Trade Mark No. 2008/00075 **ANGLOGOLD ASHANTI** in class 41,
- Trade Mark No. 2008/00076 **ANGLOGOLD ASHANTI** in class 42,
- Trade Mark No. 2008/00078 **ANGLOGOLD ASHANTI LOGO** in class 14,
- Trade Mark No. 2008/00079 **ANGLOGOLD ASHANTI LOGO** in class 37,
- Trade Mark No. 2008/00080 **ANGLOGOLD ASHANTI LOGO** in class 40,
- Trade Mark No. 2008/00081 **ANGLOGOLD ASHANTI LOGO** in class 41,
- Trade Mark No. 2008/00082 **ANGLOGOLD ASHANTI LOGO** in class 42,

- Trade Mark No. 2008/10854 **ANGLOGOLD ASHANTI** in class 35,
- Trade Mark No. 2008/10855 **ANGLOGOLD ASHANTI** in class 36,
- Trade Mark No. 2008/10856 **ANGLOGOLD ASHANTI LOGO** in class 35,
- Trade Mark No. 2008/10857 **ANGLOGOLD ASHANTI & LOGO** in class 36,

The Complainant provided satisfactory evidence of the validity and rights existing in the above trade mark.

2.3 According to the Complainant's evidence, the Complainant is the proprietor of the following domain names:

- anglogold.co.za (since 04 December 1997),
- anglogold-ashanti.co.za (since 20 May 2003),
- anglogoldashanti.co.za sine (20 May 2003),
- ashanti-anglogold.co.za (since 07 August 2003).
- anglogoldashantlprocure.co.za (since 16 April 2016),
- anglogoldashanti.com.

From its primary website located at www.anglogoldashanti.com, the Complainant provides information regarding its products, services and details of its operations in various countries throughout the world.

2.4 On or about February 2017, it was brought to the Complainant's attention that the Registrant had registered the domain name anglo-ashantigold.co.za. The Complainant proceeded to investigate the Registrant's website and determined that the Registrant had copied the Complainant's website and was using the Complainant's trade mark on the domain name.

2.5 On 15 February 2017, the Complainant, through its attorneys, addressed a

letter of demand to the Registrant. This was followed up by additional letters which were sent on 08 March 2017 and 15 August 2017. To date, however, no response has been forthcoming from the Registrant.

The Complainant did not contact the Registrant further and moved forward with the current domain name dispute.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant contends that the Registrant's domain name is identical to the Complainant's registered trade mark ANGLOGOLD ASHANTI, as the domain name wholly incorporates the Complainant's registered trade marks.
- b) The Complainant contends that as a result of its extensive use, reputation and registered rights in its trade marks, the registration of the domain name by the Registrant constitutes an abusive registration in terms of Regulation 3(1)(a) in that the Registrant has registered the domain name primarily to:
 - i) Takes unfair advantage of, or be unfairly detrimental to the Complainant's rights;
 - ii) Block intentionally the registration of a name or mark in which the Complainant has rights [Regulation 4(1)(a)(ii)];
 - iii) Disrupt unfairly the business of the complainant by preventing the Complainant or its authorised users from operating a website from the domain [Regulation 4(1)(a)(iii)];
 - iv) Mislead people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant [Regulation 4(1)b]
 - v) Prevent the Complainant from exercising its rights; [Regulation

4(1)(a)(iv)]

- c) The Complainant further submits that the registration of the domain name was abusive in that the Registrant failed to provide complete contact details [Regulation 4(1)(d)].
- d) The Complainant contends that as the disputed domain name is identical to the Complainant's registered trade marks, the onus of showing that the registration of domain name is not abusive shifts to the Registrant. The Complainant contends that as the Registrant has failed to provide a response or defence to its allegations, it may be presumed that the registration is abusive.

3.2 Registrant's response

- a) The Registrant failed to submit any response to the Complainant's contentions.

4 Discussion and Findings

4.1 Complainant's Rights

4.1.1 In the Adjudicators view, the focus of the present matter revolves primarily around the registered trade mark ANGLOGOLD ASHANTI. Whilst the Adjudicators do take cognisance of the registered trade mark ANGLO GOLD and the corresponding logo, the primary inquiry will be into the similarity between the disputed domain name and the trade mark ANGLOGOLD ASHANTI. The Complainant is the proprietor of the registered trade marks for ANGLOGOLD ASHANTI and ANGLOGOLD ASHANTI logo, as listed above. The Complainant's statutory rights in the trade marks predate the registration of the domain name, ANGLO-ASHANTIGOLD.CO.ZA, on 19 September 2016.

4.1.2 The Complainant in its papers refers to the decision of *Forever New*

Clothing Vs Malkhaz Kapanadze [ZA20160231] wherein it was stated at paragraph 4b(iii) and (v):

"The circumstances relating to the registration of the disputed domain name which incorporates the trade mark of the Complainant in the name of the Registrant are unknown and since the Registrant has failed to respond to the Complaint; the only conclusion that can be drawn is that the Registrant was never within his rights to register the disputed domain name in its own name. Thus in terms of Regulation 5(c) the burden to show that the registration was not abusive shifts to the Registrant; who as stated previously failed to respond and has not discharged that burden. "

"Thus, under the circumstances there is sufficient evidence indicating that the Registrant has registered or otherwise acquired the domain name in an abusive manner in accordance with Regulation 4(1) as contended by the Complainant."

It is clear in the Complainant's papers that the Complainant is of the view of that Regulation 5(c) is applicable in the present matter.

- 4.1.3 Regulation 5(c) states "the burden of proof shifts to the registrant to show that the domain name is not an abusive registration if the domain name (not including the first and second level suffixes) is identical to the mark in which the complainant asserts rights, without any addition."

The question that must be asked in the present matter is whether the re-ordering of the words in the Complainant's trade mark, namely ANGLOGOLD ASHANTI to ANGLO-ASHANTI GOLD is sufficient to distinguish the domain name such that it is no longer identical to the Complainant's trade mark without any addition.

The definition of "identical" according to Collins Dictionary is "exactly alike, equal, or agreeing; things that are identical are exactly the same."

When the trade mark ANGLOGOLD ASHANTI and the domain name ANGLO-ASHANTI GOLD are compared, it cannot be said that they are identical. The re-ordering of the words does serve to render the two names different to a certain extent.

In recent cases ZA2017-0262 (MOZILLA.CO.ZA) and ZA2015-0215 (AGILENT.CO.ZA), as well as the case referred to by the Complainant namely *Forever New Clothing Vs Malkhaz Kapanadze* [ZA20160231], the Adjudicators found fit to shift the onus to the Registrant as the domain names were in all respects identical to the Complainant's trade marks. However, given that the disputed domain name is not identical to the registered trade mark ANGLOGOLD ASHANTI, the onus in the view of the Adjudicators remains with the Complainant to show that the registration of the domain name is abusive.

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 Complainants' rights;

or

ii) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainants' rights.

The Complainant is required to prove, on a balance of probabilities, that the required elements in Regulation 3(1)(a) are present namely:

- i) the Complainant has rights in respect of a name or mark;
- ii) the domain name is identical or similar to a name or mark in respect of which the Complainant has rights;
- iii) the domain name in the hands of the Registrant is an abusive registration.

The Complainant has by virtue of its registered rights in the trade mark ANGLOGOLD ASHANTI established that it has rights in respect of the mark and may prevent persons from using identical or confusingly similar marks.

In *Plascon-Evans Paints Ltd v Van Riebeeck Paints (Pty) Ltd* 1984 3 SA 623 (A) 640 the Court stated:

"In an infringement action the onus is on the plaintiff to show the probability or likelihood of deception or confusion. It is not incumbent upon the plaintiff to show that every person interested or concerned (usually as customer) in the class of goods for which his trade mark has been registered would probably be deceived or confused. It is sufficient if the probabilities establish that a substantial number of such persons will be deceived or confused. The concept of deception or confusion is not limited to inducing in the minds of interested persons the erroneous belief or impression that the goods in relation to which the defendant's mark is used are the goods of the proprietor of the registered mark, i.e. the plaintiff, or that there is a material connection between the defendant's goods and the proprietor of the registered mark; it is enough for the plaintiff to show that a substantial number of persons will probably be confused as to the origin of the goods or the existence or non-existence of such a connection."

In the case of *Bata Ltd v Face Fashion CC and Another* 2001 1 SA 844 (SCA) at 850 paragraph 9, the Court held that the approach adopted in *Sabel BV v Puma AG, Rudolf Dassler Sport* [1998] RPC

199 (ECJ) at 224 was in accordance with South African law. In the case of Sabel BV v Puma AG, Rudolf Dassler Sport the ECJ said that the likelihood of confusion must “be appreciated globally and that the global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components” (see Webster & Page at paragraph 6.11)

Taking into account the above well-known principles, the Adjudicators find that the Complainant has shown on a balance of probabilities that the domain name ANGLO-ASHANTIGOLD.CO.ZA, whilst not identical, is confusingly similar to a name or mark in respect of which the Complainant has rights and that it is likely that a substantial number of persons when entering the Registrant’s website will be confused or be deceived into believing that the Registrant’s website and domain name are associated or connected in some manner with the Complainant.

As such, what remains is to determine whether the domain name in the hands of the Registrant is an abusive registration on the grounds submitted by the Complainant, namely Regulations 4(1)(a)(ii); 4(1)(a)(iii), 4(1)(a)(iv); 4(1)(b) and 4(1)(d).

4.2.2 In terms of Regulation 4(1), factors which may indicate that the domain registration is abusive include, *inter alia*, circumstances indicating that the registrations were primarily to:-

- i) intentionally block the registration of a name or mark in which the complainant has rights [Regulation 4(1)(a)(ii)];
- ii) disrupt unfairly the business of the complainant [Regulation 4(1)(a)(iii)];
- iii) prevent the complainant from exercising his, her or its rights [Regulation 4(1)(a)(iv)];

- iv) circumstances indicating 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 [Regulation 4(1)(b)];
- v) false or incomplete contact details provided by the registrant in the WHOIS database [Regulation 4(1)(d)]

4.2.3 Regulation 4(1)(a)(ii)

No evidence was submitted that the registration of the domain name was done with the primary intention of preventing the Complainant from registering a name or mark in which it has rights.

However, the effect of the registration of the domain name by the Registrant is that the Complainant is unable to register a domain name in which it has a legitimate interest.

The Adjudicators refer to the earlier domain name decisions of DRS00583 and DRS01378 which hold that such “barring” or “blocking” are indicative of an abusive registration.

The Adjudicators find that as the Registrant is preventing the Complainant from exercising its legitimate rights, the registration of the domain name is abusive in terms of Regulation 4(1)(a)(ii).

4.2.4 Regulation 4(1)(a)(iii) & (iv)

The Adjudicators have already found that the Registrant has registered a domain name which is confusingly similar to the Complainant’s trade mark ANGLOGOLD- ASHANTI.

In the cases of WIPO/D2000-0777, NAF/FA94942, NAF/FA9496 3 and NAF/FA95402, ZA2007–0003, and 2009-0035, the adjudicators found that disruption of a business may be inferred if the Registrant has registered a variation of the Complainant’s mark. The aforementioned

cases were referred to with approval in the case of ZA2010-0053.

The Complainant has furthermore submitted evidence that the Registrant hosted a website which was identical to its own website on the domain name, ANGLO-ASHANTIGOLD.CO.ZA.

The registration of a domain name which is confusingly similar to the Complainant's trade mark, together with the hosting and use of an identical website, logically will lead to the unfair disruption of the Complainant's business as it will result in deception and confusion arising in the marketplace and in the misdirection of business inquiries which were intended for the Complainant.

The resultant confusion and deception furthermore prevents the Complainant from freely exercising the rights which it has obtained in its registered trade mark ANGLOGOLD- ASHANTI.

The Adjudicators find that as the Registrant is unfairly disrupting the Complainant's business and the Complainant is being prevented from freely exercising its legitimate rights. As such, the registration of the domain name is abusive in terms of Regulation 4(1)(a)(iii) & (iv).

4.2.5 **Regulation 4(1)(b)**

Regulation 4(1)(b) states "factors which may indicate that the domain name is an abusive registration includes circumstances indicating 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 Complainant is the proprietor of the following domain names:

- anglogold.co.za (since 04 December 1997),
- anglogold-ashanti.co.za (since 20 May 2003),

- anglogoldashanti.co.za sine (20 May 2003),
- ashanti-anglogold.co.za (since 07 August 2003).
- anglogoldashantlprocure.co.za (since 16 April 2016)
- anglogoldashanti.com

From the Complainant's uncontested evidence, the Registrant hosted a website on the domain name, which was, for all intents and purposes, a replica of the Complainant's own website.

In case no. ZA2007/0003, it was held that actual confusion is not necessary and that the potential or likelihood of confusion would be sufficient. In this regard the Adjudicator therein referred to, with approval, the foreign decisions in WIPO/D2000-0777, WIPO/D2000-878, NAF/FA95033 and NAF/FA95402.

It is likely that a substantial number of persons when entering the Registrant's website hosted on the disputed domain name will be confused or be deceived into believing that the Registrant's websites and domain names are associated or connected in some manner with the Complainant.

In light of the above, the Adjudicators find that in terms of Regulation 4(1)(b) the Registrant has both registered the domain name and is using the domain name in such a manner that it is likely to lead people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

4.2.6 Regulation 4(1)(d)

Where a Registrant has failed supplied false or incomplete contact details, the circumstances may indicate that the registration of the domain name is abusive. This has been found in the cases of ZA2017-0265; ZA2016-00254; ZA2007-0003; WIPO/D2000- 0501 and

NAF/FA92016.

According to the Complainant, the Registrant provided an incorrect email address and all letters and correspondences which were sent to the email address were returned undelivered.

The Adjudicators find that although the emails sent to the email address were returned undelivered, the fact that the email address does not appear to function is not sufficient to infer that the email address is false or that the Registrant intentionally supplied a non-functional email address. There are numerous external factors which may have contributed to the non-functional nature of the email address which was supplied.

With regards to Regulation 4(1)(d), the Adjudicators refer with approval to the case of ZA2016-00254, which involved the Complainant, and the facts surrounding this dispute. In this case, it was clear that the Registrant had supplied false information, namely the registrant name Siphon Pityana, when registering the domain name and as such Regulation 4(1)(d) was applicable.

As the Complainant's contentions regarding Regulation 4(1)(d) centred solely on the non-functional email address and an email address was supplied by the Registrant, the Adjudicators find that the registration is not abusive in terms of Regulation 4(1)(d).

5. Decision

- 5.1 Whilst it is found that the domain name registration was not abusive in terms of Regulation 4(1)(d), the Adjudicators find that on a balance of probabilities the domain name in the hands of the Registrant is an abusive registration.
- 5.2 In accordance with Regulation 9, the Adjudicators order that the domain name, ANGLO-ASHANTIGOLD.CO.ZA, be transferred to the Complainant.

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Nola Bond

SAIIPL SENIOR ADJUDICATOR

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Robin Richardson

SAIIPL TRAINEE ADJUDICATOR

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