

Decision

ZA2017-0282

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0282
DECISION DATE:	6 November 2017
DOMAIN NAME	sa-absa.co.za
THE DOMAIN NAME REGISTRANT:	Emeka Awa
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	ABSA Bank Limited
COMPLAINANT'S LEGAL COUNSEL:	Moore Attorneys Inc, Muhammed Patel
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 **15 September 2017** the SAI IPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **15 September 2017** ZACR confirmed that the domain name had indeed been suspended. The SAI IPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAI IPL's Supplementary Procedure.
- b) In accordance with the Regulations, the SAI IPL formally notified the Registrant of the commencement of the Dispute on **18 September 2017**. In accordance with the Regulations the due date for the Registrant's Response was **17 October 2017**. The Registrant did not submit any response, and accordingly, the SAI IPL notified the Registrant of its default on **18 October 2017**.
- c) The SAI IPL appointed **Vanessa Lawrance** as the Adjudicator in this matter on **19 October 2017**. The Adjudicator has submitted the Statement 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 ABSA Bank Limited, a company listed on the Johannesburg Stock Exchange, that was established in 1991. It is one of Africa's major financial services providers. The Complainant is one of South Africa's largest retail banks.
- 2.2 The Complainant's active website is situated at www.absa.co.za.
- 2.3 The Complainant is the registered proprietor of the trade mark ABSA, which

it has registered in various classes in South Africa.

- 2.4 The Complainant has used the ABSA trade mark in respect of, inter alia, banking/financial services since at least 1996.
- 2.5 In April 2017, the Complainant became aware of the Registrant's registration of the domain name sa-absa.co.za. At that time, the attached website was dormant and had a suspension notice.
- 2.6 The Complainant, through its attorneys, addressed correspondence to the Registrant advising it of the Complainant's rights, and demanding transfer of the domain name to the Complainant. Two items of correspondence elicited no response.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant is the proprietor in South Africa of the trade mark ABSA.
- b) The Complainant has expended considerable resources in the promotion of the trade mark since 1986, and it is impossible that the Registrant was unaware of the Complainant's rights in the ABSA trade mark.
- c) The Complainant holds statutory and common law rights in the mark ABSA in South Africa. In fact, the ABSA trade mark is well known in respect of banking and financial services in South Africa.
- d) The dominant and memorable feature of the www.sa-absa.co.za website comprises the Complainant's website. The mere addition of the abbreviation "SA" does not serve to distinguish the domain name from the Complainant's trade mark ABSA.

- e) Registration of the domain name will lead to confusion or deception: members of the public will believe that the domain name is that of or is endorsed by the Complainant.
- f) The domain name in the name of the Registrant is an abusive registration.

3.2 Registrant

- a) The Respondent did not respond to the Complainant's contentions.

4 Discussion and Findings

- a) Regulation 3(1)(a) provides that an abusive domain is one that, in the hands of the Registrant, was either:
 - i) 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) used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.
- b) The complainant only needs to make out a prima facie case, which, in the absence of evidence by the Registrant, will be enough for a finding in favour of the Complainant.

4.1 Complainant's Rights

- 4.1.1 It is accepted that the Complainant holds statutory and common law rights in the mark ABSA in South Africa.
- 4.1.2 In the absence of any argument to the contrary, it is also accepted that the ABSA trade mark is well known in respect of banking and financial services in South Africa.

4.1.3 The Complainant may prevent unauthorised use of its trade mark.

4.2 Abusive Registration

4.2.1 The domain name was registered in January 2017. At the time that it was registered, the Complainant held statutory and common law rights in the ABSA trade mark, and the ABSA trade mark was well known. It was highly unlikely that the Registrant was unaware of the Complainant's rights when it registered the disputed domain name.

The mere addition of the geographic term "SA" (commonly identified as a reference to South Africa) to the Complainant's ABSA trade mark appears to indicate that the domain name sa-absa.co.za is somehow linked to the Complainant.

There is a slew of caselaw supporting the premise that, where a domain name consists of a trade mark in conjunction with a descriptive prefix (such as "SA-", that domain name is confusingly similar to the trade mark. Cases include ZA2016-00247, where "rememberingmadiba" was found to be similar to "MADIBA", 2016-00250, where "sundaytimeslive" was found to be similar to "SUNDAY TIMES", and 2017-00265, where "reedexpo" and "reedexhibitions" were found to be similar to "REED"

It is therefore inescapable to find that the domain name sa-absa.co.za was registered with a view to take unfair advantage of the ABSA trade mark. In other words, the domain name was registered in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights.

5. Decision

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

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VANESSA LAWRENCE
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za