

ADJUDICATOR DECISION

CASE NUMBER:	ZA2021-0419
DECISION DATE:	19 October 2021
DOMAIN NAME	<thedonpizza.co.za>
THE DOMAIN NAME REGISTRANT:	Don Millar
REGISTRANT’S LEGAL COUNSEL:	Steve Raney, D’Archy-Herrman Raney Inc
THE COMPLAINANT:	Khan’s Chemical Industry CC
COMPLAINANT’S LEGAL COUNSEL:	Somayya Khan, Adams & Adams
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZACR

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1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAI IPL") on **9 April 2021**. On **12 April 2021** the SAI IPL transmitted by email to ZACR a request for the registry to suspend the domain name(s) at issue, and on **13 April 2021** 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 **14 April 2021**. In accordance with the Regulations the due date for the Registrant's Response was **13 May 2021**. On **11 May 2021** the Registrant requested a one day extension, which the SAI IPL granted. The Registrant submitted its Response on **14 May 2021**, and the SAI IPL verified that the Response satisfied the formal requirements of the Regulations and the SAI IPL's Supplementary Procedure. The SAI IPL forwarded a copy of the Response to the Complainant on **17 May 2021**.
- c. In accordance with the Regulations the due date for the Complainant's Reply was **24 May 2021**. The Complainant submitted its Reply on **24 May 2021**.
- d. The SAI IPL referred the case to ZADNA for informal mediation on **25 May 2021**. Through no fault of the SAI IPL or the Parties, the informal mediation had not been initiated by **23 June 2021**, despite much follow up correspondence from the SAI IPL. On that date, the Complainant, understandably frustrated by the delays, requested that the case proceed to adjudication despite mediation not having been initiated. On **24 June 2021** the SAI IPL issued a notice to the Parties confirming that it was referring the matter to adjudication, indicating that ZADNA also agreed that the matter could move to adjudication.
- e. The SAI IPL appointed **Jeremy Speres** as the Adjudicator and **Zama Buthelezi** as the Trainee Adjudicator in this matter on **30 June 2021**. The Adjudicators have submitted Statements of Acceptance and Declaration of Impartiality and

Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

- f. On **15 July 2021** the Adjudicators issued a procedural order, attached to the end of this Decision, ordering that the case be referred back to ZADNA for informal mediation given the peremptory language of the informal mediation provisions. The SAIPL proceeded to do so on **16 July 2021**.
- g. On **27 September 2021** ZADNA contacted the SAIPL indicating that despite ZADNA's efforts, it was not possible to find a date for the mediation that was suitable to both parties' representatives, and recommending that the matter be referred to adjudication.
- h. On **28 September 2021** the SAIPL enquired with the Adjudicators whether they would now be prepared to proceed with the adjudication, and this was confirmed by the Adjudicators on the same day. The Adjudicators note that the informal mediation provisions of Regulation 19A in essence merely require ZADNA to attempt informal mediation using means within its sole discretion, and if those efforts have not led to settlement within five days, ZADNA is obliged to refer the matter to adjudication with the SAIPL. As ZADNA would appear to have attempted mediation, despite that the parties' representatives could not find a suitable date for the discussion, the Adjudicators consider the matter ripe for adjudication.

2) Factual Background

- a. The Complainant, Khan's Chemical Industry CC, was established in 1998 and has various commercial interests in various industries. Relevant for the purposes of this matter, the Complainant's commercial premises are situated at a BP filling station in Crown Mines, Johannesburg. At those premises, the Complainant operates a bakery, café and pizzeria under the KRUSTIES mark, as well as a pizza restaurant under the mark THE DON PIZZERIA. Both outlets share a single, commercial space.
- b. The Complainant has used the following logo in relation to its pizza restaurant:



- c. The Complainant owns South African trade mark registration no. 2012/30507 THE DONS PIZZA & CONES, consisting of the device depicted below, bearing an application date in 2012 in class 43 covering, amongst others, restaurants, cafes and fast food outlets:



- d. The foregoing registration was assigned to the Complainant by a third party, Exavax CC, with the assignment having been recorded with the trade marks registry on 3 May 2021, after the Complaint was filed.
- e. The Applicant also owns South African trade mark application no. 2020/16201 THE DON in class 30 covering pizzas, amongst others, filed in July 2020, as well as application no. 2021/08148 THE DON in class 43 covering services for providing food and drink, amongst others, filed in March 2021. Neither trade mark application is registered as at the date of drafting of this Decision.
- f. The Registrant is an individual, Don Millar, who is a director and founding shareholder of The Don Pizza Company Proprietary Limited ("**Registrant's Company**"). The Registrant's Company operates two pizza restaurants – one in Linden and one in Parktown North, Johannesburg – under the mark THE DON PIZZA CO.
- g. The disputed domain <thedonpizza.co.za> (the "**Domain Name**") was registered by the Registrant on 5 October 2020 and has been used for a website relating to the Registrant's Company's pizza restaurants.

- h. The Registrant's Company's restaurants have, on the website to which the Domain Name has resolved as well as on its social media accounts, billboards and other marketing material, used the following logo:



3) Parties' Contentions

a. Complainant

- i. The Complainant contends that it has traded as a pizza restaurant under the THE DON / THE DON PIZZERIA marks since June 2020 and that it therefore enjoys common law rights in those marks, in addition to its statutory rights in its THE DONS PIZZA & CONES mark, all of which predate registration of the domain name in October 2020.
- ii. The Complainant contends that there exists a likelihood of confusion and deception between the Registrant's business and that of the Complainant and that the Domain Name was registered and has been used with the intention of misleading the public into believing that the Registrant is the Complainant, or is associated with the Complainant's business. The Complaint contends that the Registrant's business name is calculated to ride on the coattails of the Complainant's goodwill and reputation.
- iii. The Complainant submits that the Registrant's registration of the Domain Name disrupts unfairly the business of the Complainant, preventing it from entering certain delivery platforms, for example Uber Eats.
- iv. The Complainant contends that the Domain Name blocks intentionally the registration of a name or mark in which the Complainant has rights.

b. Registrant

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- i. The Registrant contends that he and his fellow directors in the Registrant's Company had, as early as February 2020, considered launching a restaurant. Circa July 2020 they decided on a pizza restaurant as two of the directors are of Italian descent, and they landed on DI ORIGINALE NAPOLI ("the original Napoli" in Italian), which they then abbreviated to the acronym DON, which was particularly appealing given that the Registrant's first name is "Don" as well as the connection of the term to the Mafia.
 - ii. The Registrant contends that various company name and internet searches for establishments, including in the food sector, were conducted for names incorporating DON prior to launching the Registrant's Company's restaurants. It was found that many such establishments existed and that DON, THE DON and variations are widely used. The Registrant and his fellow directors therefore proceeded to incorporate the Registrant's Company and launched their Linden and Parktown North stores in August and September 2020 respectively.
 - iii. The Registrant contends that neither he nor the Registrant's Company were aware of the Complainant at the time of launching their restaurants and registering the Domain Name, and only became aware of the Complainant and its trade marks when the Registrant received the Complainant's letter of demand dated 24 December 2020, thus there was no unfair advantage taken of, or detriment to, the Complainant's rights.
 - iv. The Registrant effectively contends that DON and THE DON are commonplace, including in the food sector, and that they are more likely to call to mind the Mafia or other concepts and not the Complainant.
 - v. The Registrant contends that the Complainant has not substantiated its claim of prior common law rights and that no such rights exist.
 - vi. The Registrant contends that it has used the Domain Name for a good faith offering of goods and services prior to becoming aware of the Complainant's cause for complaint.

4) Discussion and Findings

a. Complainant's Rights

- i. The Complainant's trade mark registration no. 2012/30507 THE DONS PIZZA & CONES incorporates, as its first and dominant element, THE DONS, which is clearly similar to the first and dominant element of the Domain Name "thedon".
- ii. It is trite that trade marks and domain names under the Regulations should be compared with their dominant and most memorable elements in mind. Where a dominant element of a complainant's mark is recognisable within a domain name, the latter will generally be considered similar under the Regulations. See SAIPL case no. ZA20110093 and WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0") at paragraph 1.7.
- iii. The Complainant therefore has statutory rights in respect of a mark that is similar to the Domain Name.
- iv. The Complainant also claims common law rights based on goodwill and a reputation flowing from its usage of THE DON / THE DON PIZZERIA since June 2020. Apart from undated photographs of its storefront bearing the KRUSTIES and THE DON PIZZERIA logos, and undated photographs of pizza boxes bearing the THE DON PIZZERIA logo, the Complainant did not adduce any evidence sufficient to substantiate a) that it in fact began trading under the THE DON PIZZERIA mark in June 2020; and b) the existence of any reputation in that name.
- v. It is trite that a complainant in this forum, in order to rely on common law rights, must show, on balance of probabilities, that it has goodwill and a reputation protectable by way of a passing-off action (SAIPL case no. ZA2007-0009).
- vi. None of the usual evidence required to prove a reputation was provided in the Complaint (WIPO Overview 3.0 at paragraph 1.3). Apart from the undated photographs, no evidence as to the extent of the Complainant's use of its

mark, e.g. sales figures, marketing spend or examples of advertising, was provided. The undated photographs of the Complainant's store front and pizza boxes do not, in and of themselves, establish any reputation, merely that the Complainant, at some indeterminate point, began using the mark THE DON PIZZERIA.

- vii. Given the intervention of the pandemic and the fact that the Complainant would appear to trade from a single store at a filling station under joint brands (where KRUSTIES is at least as prominently displayed as THE DON PIZZERIA), it seems unlikely that the Complainant could have traded to the extent necessary to generate the requisite reputation in the mere four months between June 2020 and registration of the Domain Name in October 2020. This assumes that the Complainant did indeed begin trading in June 2020, an assertion for which the Complainant has provided no evidence besides a bald statement claiming as much.
- viii. Adjudicators are permitted to undertake limited factual research into matters of public record, especially if this is in the interests of justice. See SAIPL case no. ZA2015-0193. The Adjudicators have conducted Google searches for "the don pizzeria", both limited to South African websites and without such limitation. None of the results on the first three pages of results relate to the Complainant. Rather, the Registrant's Company's restaurants feature prominently, as well as numerous other restaurants with names incorporating DON in South Africa and further afield (discussed further below).
- ix. The Registrant made reference to the Complainant's Instagram account. The Adjudicators have viewed that account (@thedonpidza) and it appears that the first post was made on 1 October 2020, four days before the Domain Name was registered. Five posts in total have been made, with little engagement, and three of the five were posted on the same day – 1 October 2020. The remaining two were posted in April and May 2021. At the time of viewing, the account had 132 followers, but no information has been provided as to a) the geographic location of the followers; or b) the number of followers at the times relevant to this decision.

- x. Accordingly, on balance of probabilities, the Complainant did not enjoy any common law rights in THE DON / THE DON PIZZERIA, either at the date of registration of the Domain Name or at the date that the Complaint was lodged.

b. Abusive Registration

- i. There is no evidence in this matter that the Registrant was aware of the Complainant's mark at the time of registration of the Domain Name or at any time prior to the Complainant's letter of 24 December 2020. The Registrant has denied that it was so aware, under oath, and apart from bald statements to the contrary, the Complainant has produced no evidence indicating that the Registrant was so aware. The Registrant's explanations for how he and the Registrant's Company's other directors decided on the mark THE DON PIZZA CO. and the Domain Name are, on balance of probabilities, convincing. There is also nothing in the way in which the Registrant has used the Domain Name, or the way in which the Registrant's Company has traded, that would suggest any familiarity with the Complainant's offering or mark or any targeting of them. Apart from the shared THE DON element, which as discussed below is somewhat diluted in the relevant industry, there are no obvious similarities in the get-up or trading styles of the parties.
- ii. Awareness of the Complainant's mark also cannot be imputed to the Registrant based on any reputation or goodwill in the hands of the Complainant, as addressed above.
- iii. Accordingly, bearing in mind that the Complainant bears the onus, the Complainant's reliance on Regulations 4(1)(a)(ii) – (iv) must be rejected. The provisions of Regulation 4(1)(a) clearly require intent on the part of the Registrant, which cannot have been present in the absence of awareness of the Complainant's mark. The express language of the provisions of Regulation 4(1)(a) makes this clear, including the use of the word "primarily". See also the decision in ZA2007-0007, where the Adjudicator stated (emphasis added):

"The circumstances of the Registrant's initial use of the domain...do not, in the adjudicator's view, evince an intention to primarily act as contemplated by Section 4(1)(a)."

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- iv. This has long been accepted under the UK's Dispute Resolution Service (DRS) Policy, the relevant wording of which is virtually identical with and was the source of the wording of the South African ADR Regulations. See the UK DRS appeal decision in DRS 04331 at paragraph 8.13:
- "...'knowledge' and 'intention' are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge."*
- v. In the circumstances, and in the absence of any registered or common law rights in respect of its trading name THE DON / THE DON PIZZERIA at the relevant times for establishing abusiveness (the registration date of the Domain Name and the date of commencement of use of the Domain Name), the remainder of the Complainant's case would appear to be based on a likelihood of confusion with the Complainant's trade mark registration no. 2012/30507 THE DONS PIZZA & CONES (the "**2012 registration**").
- vi. The Complainant provides no information concerning the previous owner of the 2012 registration nor any use that the Complainant or the previous owner might have made of the mark. The Adjudicators' internet searches for the mark reveal nothing indicating that the mark has ever been used or that it enjoys any reputation.
- vii. The Complainant's case is therefore one of innocent trade mark infringement; innocent in the sense that the Registrant has registered and used a Domain Name that may or may not be confusingly similar to a registered trade mark, without any knowledge of the Complainant's mark let alone any intention to target it, and without the Complainant's mark enjoying any reputation which could impute knowledge to the Registrant. The Complainant relies in this respect on Regulation 4(1)(b).
- viii. The relevant times for assessing abusiveness are the date of registration of the Domain Name and the date that the Registrant commenced using the Domain Name in the forms complained about. Neither the Complainant nor the Registrant have indicated when the Registrant began using the Domain Name in the form complained about by the Complainant. However, given that the Domain Name was registered in October 2020, and the Registrant launched its

Facebook and Instagram accounts in September and October 2020, it is reasonable to assume that the website also went live around the same time. Regardless, what is clear is that the Registrant was already operating the website when it received the Complainant's letter of 24 December 2020. Thus, at the time that the Registrant commenced use of the Domain Name in the form complained about by the Complainant, and bearing in mind the discussion above, the Registrant was not, on balance of probabilities, aware of the Complainant's mark.

- ix. The Complainant is required to establish abusiveness in the sense that the Domain Name was registered or has been used in a manner which takes unfair advantage of or was unfairly detrimental to the Complainant's rights. The test is not one of statutory trade mark infringement but one of abusiveness. Of course there is much overlap – trade mark infringing conduct can also amount to abusiveness in the right circumstances, but the two are not synonymous. See the UK DRS appeal decision in DRS 04962:

"The Complainant asserts that the Respondent is infringing the Complainant's trade mark rights and that, because the Policy is intended to represent a quick and economic alternative to litigation, the Panel should follow the courts and direct transfer of the Domain Name.

While it is true that the Policy is intended to represent a quick and economic alternative to litigation, not all acts of infringement constitute an Abusive Registration under the Policy and not all Abusive Registrations within the terms of the Policy constitute trade mark infringement or passing off. Moreover, the members of this Panel are by no means certain how a court would react to a case of this kind. Most of the domain name authorities to date have involved domain names which were registered to take advantage of the claimant's rights. If infringement were found, the court might content itself with suitably worded injunction rather than transfer of the Domain Name."

- x. Under the UK DRS, it has long been the consensus view that knowledge, whether actual or imputed (due to, for instance, the complainant's mark being well-known), of the complainant's mark is a pre-requisite for a finding of abusiveness. The consensus view on knowledge and intent was originally set out by the Appeal Panel in DRS case no. DRS 04331 at paragraphs 8.13 – 8.14 and bears repeating in full here:

"8.13. In this Panel's view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

- (1) First, some knowledge of the Complainant and/or its brand/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant's Rights.
- (2) Secondly, 'knowledge' and 'intention' are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.
- (3) Thirdly, 'intention' is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.
- (4) Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.
- (5) Fifthly, when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.

8.14. Accordingly, in the view of this Panel, for this complaint to succeed, the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name."

- xi. The references to Paragraph 3 of the DRS Policy are to an older version of that Policy (available at https://nominet.uk/wp-content/uploads/2018/09/13132527/DRS_Policy.pdf), however, the relevant provisions are identical in the new DRS Policy and virtually identical to the corresponding provisions in Regulation 4(1) of the ADR Regulations.

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- xii. The abovementioned position has been consistently affirmed by DRS Appeal Panels and full decision Experts and continues to be so. See the decisions of the Appeal Panels in DRS case no.s D00023374 (2021); D00022793 (2021); D00022003 (2020); and DRS 07066 (2009), and the decisions of the Experts in D00019313 (2017) and DRS 4769 (2007). There are many others.
- xiii. This consensus view is echoed in Version 3 of the Nominet DRS Experts' Overview at paragraph 2.4, however, it is acknowledged that that position (requiring that the registrant had knowledge of the complainant's rights) may not be applicable to new domainer practices (e.g. automated bulk transfers of domain names).
- xiv. The Adjudicators in this case are in respectful agreement with the DRS decisions cited above: generally, some level of knowledge of a complainant's rights at the time of registration or offending use of a domain name is required for a finding of abusiveness. This does not require proof of actual knowledge; imputed knowledge due to, for instance, the complainant's mark being well-known, may be sufficient in the right circumstances. The Adjudicators agree that it may be fair and appropriate in certain cases, particularly where a complainant's mark is well-known or highly specific, to apply the concepts of "should have known" and "wilful blindness" already well established in UDRP jurisprudence (see WIPO Overview 3.0 at paragraph 3.2.2 and 3.2.3).
- xv. The words of the Expert in DRS case no. D00019313 are particularly fitting to the facts of this case:

"At the heart of the Policy, is the requirement to prove unfairness and thus for a registration to be considered 'abusive' there should be something unfair in the object or effect of the respondent's behaviour. It is perfectly possible for a respondent to make fair use of a domain name that incorporates a Complainant's trade mark and which also, for that matter, causes confusion. Knowledge of a Complainant and/or its rights is a crucial element in most cases, but particularly so where, as in this case, the domain name constitutes an expression or combination of words in fairly wide use, as the Google search described earlier shows."

- xvi. Insofar as the Complainant in this case relies on Regulation 4(1)(b), the following was stated by the Appeal Panel in DRS 03733 in relation to the corresponding and virtually identical provision in the DRS Policy

"Interestingly, paragraph 3a.ii of the Policy, which deals with this basis for complaint (confusing use of a domain name), does not expressly call for abusive intent on the part of the Respondent, but plainly, such knowledge/intent has to be present. For a domain name to qualify as an Abusive Registration, there has to be an element of abusive behaviour on the part of the Respondent."

- xvii. Although not relied upon by either party in this case, the Adjudicators are aware of the dictum of the Adjudicator in SAIPL case no. ZA2007-0007 at paragraph 4.9 as follows:

"In the adjudicator's view, the nature of "abusiveness" as contemplated by the Regulations does not require a positive intention to abuse the Complainant's rights, but that abuse was the effect of the use or registration."

- xviii. That dictum has been applied in subsequent cases under the ADR Regulations. However, that dictum is not at odds with the position under the DRS set out above. Firstly, "intention" (as per the dictum in ZA2007-0007) is different to "knowledge" (as required in terms of the DRS position) – the former requires the latter but does not necessarily follow from the latter; it is possible for a registrant to be aware of a complainant's mark but have no intention to abuse it. Accordingly, the Adjudicator's reference to "*positive intention*" in ZA2007-0007 does not rule out knowledge as a pre-requisite.

- xix. Secondly, in substantiating the dictum, the Adjudicator in ZA2007-0007 immediately went on, at paragraph 4.10, to quote from the decision in DRS 00658 in support. The quotation from DRS 00658 that the Adjudicator relies upon sets up a factual scenario in which the domain name "*is exclusively referable to the complainant*" because the complainant's mark is well-known, and where there is no obvious justification for the Respondent registering the domain name, amongst other cumulative conditions. The quotation goes on to state that in those circumstances, "*it will ordinarily be reasonable for an expert to infer first that the Respondent registered the domain name for a purpose and secondly that that purpose was abusive.*"

- xx. As far as we can tell, all subsequent reliance upon the dictum in cases under the ADR Regulations has been in cases where the complainant's mark was either well-known prior to registration or use of the domain name, or there

were other facts indicating that the registrant was aware of the complainant's mark at the relevant time.

- xxi. Thus it is clear that the Adjudicator in ZA2007-0007 did not mean that it was sufficient for a finding of abusiveness for the registrant to be merely engaged in innocent trade mark infringement in circumstances where it had no knowledge of the complainant's mark and where the complainant's mark has not been used let alone enjoys any reputation. The first-come, first served nature of the DNS and the plain meaning of the words "abusive" and "unfair", implying some conduct that is morally problematic, support this conclusion.
- xxii. Our view is that neither the Domain Name nor the subsequent use to which the Registrant has put it can be said to be abusive. There is no evidence that the Registrant had any knowledge of the Complainant or its mark at any time prior to receipt of the Complainant's letter of 24 December 2020. Once it received that letter, the Registrant did not alter its usage of the Domain Name in any way to a) suggest targeting of the Complainant; b) cause confusion with the Complainant's business; or c) otherwise take unfair advantage of or be unfairly detrimental to the Complainant's rights.
- xxiii. The Registrant's evidence as well as the Adjudicator's own Google searches show that there are numerous entities, including restaurants and even Italian restaurants, that either use DON as part of their trading names or as the names of menu items. DON is therefore significantly diluted in the relevant industry. Thus, even if we are incorrect in our adoption of the DRS consensus view stated above, we are not convinced, on balance of probabilities, that the public would associate the Domain Name and the use to which it has been put with the Complainant, as opposed to just another Italian restaurant making use of a word that is common in the trade due to its links to Italy and the Mafia.
- xxiv. The Complainant presented a single affidavit from a business associate of the Complainant who indicated that he had assumed that one of the Registrant's restaurants was associated with the Complainant when he encountered it in November 2020. This affidavit is not particularly helpful to the Complainant's case, even if innocent trade mark infringement without knowledge of the

complainant's mark is sufficient for a finding of abusiveness (which we do not believe is the case). Firstly, the deponent is a business acquaintance of the Complainant, and by virtue of that fact would have greater exposure to and knowledge of the Complainant than the ordinary consuming public, not necessarily because of any reputation enjoyed by the Complainant's mark but merely due to his business dealings with the Complainant. The fact that one business associate of the Complainant was confused does not mean that the consuming public is likely to be.

xxv. Secondly, the deponent claims to have been confused in November 2020, after the Domain Name was registered and after the Registrant commenced trading and using the Domain Name in its current form. The affidavit therefore cannot speak to the presence of any goodwill in the hands of the Complainant at any relevant time, nor to the likelihood of confusion at any relevant time.

xxvi. Thirdly, there is nothing in the affidavit that indicates that the Registrant was aware of the Complainant or had any abusive intent at any relevant time. The deponent to the affidavit does not indicate exactly why he would have been confused, apart from the heavily diluted shared DON element, in circumstances where the logos, get-up and trading style of the Registrant's restaurant in Linden were very different to that of the Complainant's establishment in Crown Mines with which he was familiar.

xxvii. We are satisfied that the Registrant has made out a case under Regulation 5(a)(i).

5) Decision

For all the foregoing reasons, the Dispute is refused.

.....
JEREMY SPERES
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za

.....

ZAMA BUTHELEZI
SAIPL TRAINEE ADJUDICATOR
www.DomainDisputes.co.za

SAIIPL DOMAIN NAME DISPUTE

PROCEDURAL ORDER

Case no. ZA2021-0419

Domain name: <thedonpizza.co.za>

Based on the case file, it would appear that the informal mediation process in this matter was not followed in accordance with Regulation 19A.

The language of Regulation 19A(1) is peremptory through use of the word “*will*”. The full provision is quoted below (emphasis added):

*“(1) Within two days of being informed by the provider as contemplated in regulation 19(3), the Authority **will** begin to conduct informal mediation. Informal Mediation will be conducted in a manner which the Authority, in their sole discretion, considers appropriate. No informal mediation will occur if the Registrant does not file a response.”*

The discretion given to the Authority in that provision relates to the manner in which the mediation is to be conducted, not to whether the mediation will be conducted in the first place.

The informal mediation process was introduced for a good reason, specifically with a view to resolving disputes without the costs and time periods of formal adjudication, through the intervention of an impartial third party.

Of course it is open to the parties to elect not to engage in the mediation process, once commenced, however, mediation has to at least have been attempted otherwise the purpose of this peremptory provision is undermined.

We note from the case file that the Registrant has, via his attorney, objected to the matter proceeding to adjudication without informal mediation, thus the question of whether the parties may, by consent or waiver, renounce informal mediation need not be decided. The parties are however put on notice that we are inclined to rule, if required and without here deciding the point, that parties to such disputes are not able to validly renounce informal mediation through consent or waiver. Peremptory provisions of a statute may not be renounced by a party for whose benefit they have been enacted where such provisions have also been introduced for some public benefit (see *Suider-Afrikaanse Kooperiewe Sitrusbeurs Bpk. v Direkteur-Generaal Handel en Nywerheid and Another* (323/95) [1997] ZASCA 6 at page 12 onwards). There is undoubtedly some public interest to be served by the informal mediation provisions, namely an interest in the expeditious and efficient resolution of disputes which, given the nature of domain name disputes, often turn on a likelihood of public confusion.

Should the matter proceed to adjudication at this juncture, without informal mediation having been attempted (as required by the Regulations), our decision would be open to review and the integrity of the dispute resolution system undermined accordingly. We sympathise with the Complainant, who has incurred unnecessary delays in this matter, delays which are not of the parties' nor SAIPL's making. These delays are nevertheless not as prejudicial to the Complainant as the consequences of our decision being set aside on review.

Our ruling is that the matter must be referred to the Authority for informal mediation in terms of Regulation 19A. Given the delays experienced to date, we ask for this to proceed expeditiously.

JEREMY SPERES

SAIIPL Senior Adjudicator

ZAMA BUTHELEZI

SAIIPL Trainee Adjudicator