

Decision

ZA2021-0432

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2021-0432
DECISION DATE:	23 February 2022
DOMAIN NAME:	lphc.org.za
THE DOMAIN NAME REGISTRANT:	Koriney Kgolane
REGISTRANT'S LEGAL COUNSEL:	S.Twala Attorneys
THE COMPLAINANT:	Tshepiso Samuel Mogolo Ntjele Modise
COMPLAINANT'S LEGAL COUNSEL:	Hahn & Hahn
2 nd LEVEL ADMINISTRATOR:	ZACR

1. Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **16 November 2021**. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **19 November 2021**. The SAIPL verified that the amended Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIPL’s Supplementary Procedure. On **29 November 2021**, the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name at issue.
- 1.2 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **30 November 2021**. In accordance with the Regulations, the due date for the Registrant’s Response was **3 January 2022**. The Registrant submitted its Response on **14 January 2022**, having sought and having been granted condonation for the late filing of the response on good cause shown. The SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL’s Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on **17 January 2022**.
- 1.3 In accordance with the Regulations, the due date for the Complainant’s Reply was **24 January 2022**. The Complainant submitted its Reply on **20 January 2022**.
- 1.4 The matter was then referred to ZADNA for informal mediation in terms of Section 19A of the Regulations and regulation 14(b) of the SAIPL’s Supplementary Procedure but, since more than five days passed without any mediation process commencing, SAIPL referred the matter to the appointed adjudicator, **Kelly Thompson**, on **3 February 2022**. 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 There is little that is not in dispute in this matter and it is apparent that this Domain Name Dispute is but one aspect of a much larger conflict between the Complainant, the Registrant and other individuals who are not parties to the Dispute.
- 2.2 What is not in dispute is that the Complainant is, according to extracts from the Register of Trade Marks, recorded as the registered proprietor of the trade marks INTERNATIONAL PENTECOST HOLINESS CHURCH and IPC in relation to, inter alia, "*personal and social services rendered by others to meet the needs of individuals*" (which would include religious and spiritual services of the type provided by churches). The Registrant, however, disputes the chain-of-title in respect of these trade mark registrations and therefore the Complainant's lawful proprietorship of them.
- 2.3 The parties are in agreement that the International Pentecost Holiness Church is well-known as the IPC or IPHC and that these names are used interchangeably. This is also borne out by the constitution of the International Pentecost Holiness Church, annexed to the response as annexure "KG1".
- 2.4 The Registrant is the current registrant in respect of the domain name iphc.org.za and it was initially registered on 1 September 2017. On a date not mentioned in the Complaint, the Complainant sent a letter of demand through its attorneys, Hahn & Hahn, calling on the Registrant to relinquish the disputed domain name and the Registrant responded by advising that, in its view, the Complainant has no rights to the domain name. The Registrant accordingly refused to relinquish the domain name.

3. Parties' Contentions

3.1 Complainant

3.1.1 The Complainant states that he is the registered proprietor of trade mark registrations nos. 2004/22504 INTERNATIONAL PENTECOST HOLINESS CHURCH and 2004/22502 IPC, both in class 45. Extracts from the Trade Marks Register supporting this statement were annexed to the Complaint.

3.1.2 The Complainant further alleges that IPHC is a well-known abbreviation for INTERNATIONAL PENTECOST HOLINESS CHURCH and that it has become well-known and associated with International Pentecost Holiness Church, the Complainant and his predecessor-in-title, the Complainant's father, Reverend Modise Glayton Modise. The Complainant states that because he is the proprietor of the trade mark INTERNATIONAL PENTECOST HOLINESS CHURCH, he owns the common law rights in the shortening IPHC.

3.2 Registrant

3.2.1 The Registrant alleges that he is a member in good standing of the International Pentecost Holiness Church and that the church is a voluntary association with its own constitution. He states that the church conducts its business dealings through different legal entities. The Registrant states that he has brought this case to the attention of the church and that the church will be intervening as its interests are threatened by the complaint. As far as the Adjudicator is aware, there was no attempt at such an intervention.

3.2.2 The Registrant disputes that the Complainant is the lawful owner of the trade marks INTERNATIONAL PENTECOST HOLINESS

CHURCH and IPC. He points out that the Complainant acquired the registered trade marks from his father, Comforter Modise, in terms of a deed of assignment dated 2 March 2020 and that Comforter Modise was incapable of signing any deed of assignment on that date since he had passed away some four years earlier, on 9 February 2016. Furthermore, the signature appended to the document for Comforter Modise was clearly not his.

3.2.3 The Registrant states that he purchased the domain name on 1 September 2017 as it was available for registration and that it has been used by the church since then.

3.2.4 The Registrant disputes that the Complainant is the successor-in-title to his father, Reverend Modise Glayton Modise. He states that, since Reverend Modise's passing, a multitude of disputes have developed as to who the new ordained Comforter of the Church, and successor-in-title to Comforter Modise, is. These issues are the subject of court proceedings pending in the High Court. Furthermore, the Registrant refers to, and attaches, the minutes of a special general meeting of the elders of the International Pentecost Holiness Church at which it was unanimously voted that the Complainant is not recognised as the Comforter of the Church. The Registrant goes on to state that the Complainant is misrepresenting himself as the successor-in-title of Comforter Modise and a representative of the church. He says that a fraud case is under investigation at the Johannesburg Central Police Station in this regard.

3.2.5 The Registrant furthermore attaches a court order in terms of which the Western Cape High Court declared the church to be the beneficial owner of 100% of the issued share capital of IPHC Property Holdings (Pty) Limited, of which the late Comforter Modise

was the sole director.

3.2.6 The Registrant alleges that while the INTERNATIONAL PENTECOST HOLINESS CHURCH and IPC trade marks were initially registered in the name of the late Comforter Modise, those trade marks were at all times held solely for the benefit of the Church and the businesses through which it operates and that the Church had at all times used the trade marks with the consent of Comforter Modise.

3.2.7 The Registrant points out that it was the Church which used the trade marks even prior to their formal registration in 2004 as well as for years thereafter.

3.2.8 The Registrant claims that the Complainant is non-suited and that this forum has no jurisdiction to adjudicate on the credence of the claim by the Complainant to be the successor-in-title to his late father as this is pending in the High Court. Furthermore, the documents on which the Complainant relies are being investigated by the police.

3.2.9 The Registrant also states that the domain name iphc.org.za is not an abusive registration because:

3.2.9.1 the domain name is used by the Church and is not detrimental to the Complainant's rights;

3.2.9.2 the domain name is not being used in a way that infringes the Complainant's rights;

3.2.9.3 there is no evidence that the Registrant was aware of the complainant's mark at the time of registration of the domain name. All of the trade marks belong to the Church and continue to be used by the church;

- 3.2.9.4 the Registrant has used or made demonstrable preparations to use the domain name in connection with the church activities;
- 3.2.9.5 the Registrant has made legitimate non-commercial or fair use of the domain name;
- 3.2.9.6 the Registrant has used the domain name generically or in a descriptive manner and the registrant is making fair use of it; and,
- 3.2.9.7 the Registrant has demonstrated fair use.

4. Discussion and Findings

4.1 Jurisdiction

4.1.1 As a point *in limine*, the Adjudicator will first deal with the Registrant's contention regarding this forum's lack of jurisdiction. The Registrant submitted, in his response, that legal proceedings relating to the disputed domain name are pending in the Pretoria High Court and in the Companies Tribunal. While copies of various court orders were annexed to the Response, and it is apparent that there are ongoing legal proceedings relating to control of the Church, none of the court orders provided included any reference to the disputed domain name. In its Reply, the Complainant confirmed this.

4.1.2 The Adjudicator agrees that she cannot adjudicate on the Complainant's claim that he is the successor-in-title to his late father or on any issue relating to the control or leadership of the Church. That is far beyond the ambit of this dispute. She also cannot rule on the validity or otherwise of the assignment of the relevant trade mark registrations to the Complainant. It was held by the Appeal Panel in *seido.co.za* (ZA2009-00030) and *sonnenkraft.co.za* [ZA2013-0126] that it is not for Adjudicators to decide questions on the validity of registrations under the Trade Marks Act. The Adjudicator pauses to

mention that, in its reply, the Complainant explains that the assignment agreement was signed on behalf of Comforter Modise by the executor of his estate.

4.1.3 This forum derives its powers and authority from statute, specifically the provisions of the Electronic Communications and Transactions Act, 25 of 2002 ("ECTA") as read with the Regulations and SAIPL's Supplementary Procedure.

4.1.4 Chapter 10 of the ECTA regulates all matters concerning domain name authority and administration. The Minister must make regulations for an alternative mechanism for the resolution of disputes in respect of domain names in the .za domain name space. These regulations were promulgated under the Alternative Dispute Resolution Regulations, published under Government Notice R1166 in Government Gazette 29405 on 22 November 2006, and as amended by GN 1228 in GG 39504 of 11 December 2015, and GN 1246 in GG 41237 of 10 November 2017.

4.1.5 Regulation 2(1), in turn, provides that the application of the Regulations may include everything provided for under section 69(3) of the ECTA, in connection with a domain name dispute between a complainant and a registrant over the registration and use of an internet domain name registered in specific second level domains in the .za domain name space.

4.1.6 The Complaint which has been placed before this forum concerns an adjudication on whether the Disputed Domain Name constitutes an abusive domain name registration as defined. This dispute falls squarely within the powers of adjudication conferred on this forum and the Adjudicator is obliged to consider it on the basis of what has been submitted in the Complaint, the Response and the Reply and on the basis of the requirements set out in the Regulations and the

Supplementary Procedure. In short, the Adjudicator finds that this forum has the necessary jurisdiction to consider this matter.

5. Abusive Registration

5.1 In order to make a finding that the disputed domain name is an abusive registration, the Adjudicator is required to find that the Complainant has proven, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present, ie.:

5.1.1 that the Complainant has rights in respect of a name(s) or mark(s);

5.1.2 that is identical or similar to the disputed domain name; and

5.1.3 that, in the hands of the Registrant, the disputed domain name is an abusive registration.

5.2 An abusive registration is defined in the definitions of Regulation 1, to mean a domain name(s) which either:

5.2.1 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

5.2.2 has been used in a manner that takes unfair advantage of, or is unfairly detrimental to, the Complainant's rights.

5.3 An indication is given in the Regulations as to what could be considered an abusive registration. In terms of Regulation 4(1), such factors include:

5.3.1 circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to:

5.3.1.1 sell, rent or otherwise transfer the domain name to a complainant or to a competitor of the complainant, or any third

party, for valuable consideration in excess of the registrant's unreasonable out-of-pocket expenses directly associated with acquiring or using the domain name;

- 5.3.1.2 block intentionally the registration of a name or mark in which the complainant has rights;
- 5.3.1.3 disrupt unfairly the business of the complainant; or prevent the complainant from exercising his, her, its rights;
- 5.3.1.4 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;
- 5.3.1.5 evidence, in combination with the other circumstances indicating that the domain name in dispute is an abusive registration, that the registration is engaged in a pattern of making abusive registrations;
- 5.3.1.6 false or incomplete contact details provided by the registrant in the Whois database; or
- 5.3.1.7 the circumstance that the domain name was registered as a result of a relationship between the complainant and the registrant, and the complainant has:
 - 5.3.1.7.1 been using the domain name registration exclusively; and;
 - 5.3.1.7.2 paid for the registration or renewal of the domain name registration.

5.3.2 An indication is also given as to what would *not* be an abusive registration. In terms of Regulation 5, factors which may indicate this include:

- 5.3.2.1 before being aware of the complainant's cause for complaint, the registrant has:

5.3.2.1.1 used or made demonstrable preparations to use the name in connection with a good faith offering of goods or services;

5.3.2.1.2 been commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name; or

5.3.2.1.3 made legitimate non-commercial or fair use of the domain name;

5.3.2.2 the domain name is used generically or in a descriptive manner and the registrant is making fair use of it; and

5.3.2.3 that the registrant has demonstrated fair use, which use may include websites operated solely in tribute to or fair criticism of a person or business: Provided that 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.

6. Complainant's Rights

6.1 In terms of Regulation 1, the term “rights” is widely defined. The Regulation states that “rights” and “registered rights” include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law, but is not limited thereto.

As has been decided in the South African appeal decisions of *seido.co.za* (ZA2009-00030) and *xnets.co.za* (ZA2011-00077), the

notion of “rights” for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. The threshold in this regard should be fairly low. It is also a matter of locus standi in order to make sure that the person who lodges the Complaint is someone with a proper interest in that Complaint.

6.2 The Complainant has proven that it is the registered proprietor of the marks INTERNATIONAL PENTECOST HOLINESS CHURCH and IPC. The Registrant has disputed the chain-of-title but, as mentioned, this is not for the Adjudicator to determine. In terms of Section 51 of the Trade Marks Act 194/1993 –*“In all legal proceedings relating to a registered trade mark ... the fact that a person is registered as the proprietor of the trade mark shall be prima facie evidence of the validity of the original registration ...”* The Complainant has provided extracts from the Trade Marks Register evidencing that it is the registered proprietor of the marks INTERNATIONAL PENTECOST HOLINESS CHURCH and IPC.

6.3 Insofar as common law rights are concerned, the parties agree that the abbreviation IPHC is used interchangeably with the marks INTERNATIONAL PENTECOST HOLINESS CHURCH and IPC. Does it follow, however, that the Complainant is the owner of the common law rights in the unregistered mark IPHC? Beyond a bald assertion to this effect, the Complainant has provided no evidence that these common law rights accrue to him exclusively, ie that members of the public associate the mark IPHC with the Complainant. He himself alleges that IPHC has become well-known and associated with “International Pentecost Holiness Church, the Complainant and his predecessor-in-title, the Complainant’s father, Reverend Modise Glayton Modise”.

The evidence provided by both the Complainant and the Registrant

is scant but what has been provided indicates clear use of the mark IPHC by the International Pentecost Holiness Church, and not by or in connection with any individual. The Church is a body which, according to the constitution provided by the Registrant, has an independent legal persona. The mark has also seemingly been used by the Church since long before the registration of the trade marks INTERNATIONAL PENTECOST HOLINESS CHURCH and IPC or even the date on which the Complainant claims to have become his father's successor-in-title. On the Complainant's own version, therefore, the common law rights in the mark IPHC seemingly vest in the Church.

The mark IPHC is not itself a registered trade mark such that use of the mark under licence by the Church would accrue to the registered proprietor. The Complainant also did not allege this to be the case. The Complainant bears the burden of proof in this regard and has failed to discharge it.

- 6.4 The Adjudicator therefore finds that the Complainant has rights only in the registered trade marks INTERNATIONAL PENTECOST HOLINESS CHURCH and IPC.
- 6.5 The second step of the enquiry is whether these marks are identical or similar to the Disputed Domain Name. Clearly, they are not identical. However, IPHC is an abbreviation of INTERNATIONAL PENTECOST HOLINESS CHURCH and similar, differing by only a single letter, to the mark IPC. The parties have also agreed that these names and marks are used interchangeably.
- 6.6 Therefore, the Adjudicator finds that the Complainant has proven rights in a name or mark similar to the Disputed Domain Name.

7. Abusive Registration

7.1 There is no clarity from the papers regarding if and how the Disputed Domain Name has been used. The Complainant says that it is not used and has shown that there is no active website linked to the domain name. However, both parties have adduced copies of the letterhead of the Church which bears the email address info@iphc.org.za. The Complainant claims to have created this letterhead in 2003, yet the domain name was only registered in 2017. It is not clear what happened in the intervening years, but it is difficult to understand how registering the domain name some fourteen years later was done primarily to block the registration of the identical name by the Complainant when he could have done that at any stage in the intervening period.

7.2 The Registrant states that the domain name is used by the church but does not say how. The only evidence provided is the letterhead bearing the email address info@iphc.org.za. The Registrant also does not provide any evidence as to his authority to register and hold the domain name on behalf of the Church. He only says that he is a member of the church in good standing. The Complainant stresses this fact in his reply. While that is so, it is for the Complainant to prove, on a balance of probabilities, that the Disputed Domain Name is an abusive registration. It is not for the Registrant to prove his title to it. The Adjudicator does not believe that the Complainant has met the necessary burden of proof in this regard.

Although the Complainant states that the Registrant's passive holding of the domain name is "undoubtedly primarily for the purpose of blocking the registration of the identical name" by the Complainant, there is absolutely no evidence of this. It is not sufficient for the Complainant to show that this is the effect of the

registration of the domain name. He must show that it was the Registrant's intent (see Nominet decision DRS 02736 *Manorgate Ltd. t/a Direct Flooring v Ian Moffat*). It does not follow that it was the Registrant's intention to block the Complainant from registering and using the domain name simply because the Complainant has rights in a similar name or mark.

- 7.3 Furthermore, the Registrant's contentions in the Response, deficient as they may be, do offer a possible set of facts that would refute the Complainant's allegation. If it is so that the Church is using or has made preparations to use the domain name in connection with its activities, as the existence of the email address would seem to indicate, a finding that the domain name is abusive and should be transferred to the Complainant would seriously disrupt what is seemingly a legitimate offering under the domain name.

Although the Complainant is correct when he asserts, in his reply, that there is no time limit on the lodging of a Domain Name Dispute, there is also a distinct lack of any explanation or evidence regarding why the Complainant was not concerned sooner that the registration of the Disputed Domain Name was "leading people or businesses to believe that the disputed domain name is registered to, operated or authorised by, or otherwise connected with, the Complainant." In light of the fact that the mark IPHC is associated with the Church, as both parties agree, it also seems that the domain name could only, correctly, lead people or businesses to believe that the domain name is connected with the Church, and not the Complainant.

- 7.4 Although the Adjudicator has some sympathy for the Complainant as he has been found to have rights in the marks INTERNATIONAL PENTECOST HOLINESS CHURCH and IPC, and the mark IPHC is seemingly used interchangeably with that, the Regulations are not

the appropriate mechanism to secure a transfer of the Disputed Domain Name from the Registrant unless there is appropriate evidence of an Abusive Registration. If such evidence becomes available, a further complaint may be lodged in terms of the Regulations. If not, the Complainant may be able to seek relief in the other fora where the greater dispute between the Complainant and the Church is being heard.

8. Decision

8.1 For all the foregoing reasons, the dispute is refused.

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KELLY THOMPSON
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za