



DISPUTE RESOLUTION SERVICE

D00022473

D00022474

Decision of Independent Expert

Bidvest Industrial Holdings (Proprietary) Limited

and

BidBank LTD

1. The Parties:

Complainant: Bidvest Industrial Holdings (Proprietary) Limited
Bidvest House
18 Crescent Drive
Melrose Arch, Melrose
Johannesburg
Gauteng, 2196
South Africa

Respondent: BidBank LTD
Moat House
54 Bloomfield Avenue
Belfast
Northern Ireland
BT5 5AD
United Kingdom

2. The Domain Name(s):

bidvestbank.co.uk (D00022473)
bidvestbank.uk (D00022474)

3. Procedural History:

I can confirm that I am independent of each of the Parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of such a nature as to call in to question my independence in the eyes of one or both of the Parties.

18 March 2020, the Disputes were received.

19 March 2020, the Complaints were validated.

19 March 2020, the Notifications of the Complaints were sent to the Parties.

09 April 2020, the Response reminders were sent.

14 April 2020, no Responses were received.

14 April 2020, the Notifications of no Response were sent to the Parties.

16 April 2020, the Expert decision payment was received.

17 April 2020, it was agreed to consolidate disputes D00022473 and D00022474.

4. Factual Background

- 4.1 The Complainant is a subsidiary of *The Bidvest Group Limited*, which is an international services, trading and distribution company listed on the Johannesburg Stock Exchange, South Africa.
- 4.2 The Complainant has registered various domain names including *bidvest.com* (1998) and *bidvestbank.com* (2006), which it uses to advertise and provide its financial and banking services.
- 4.3 The Domain Names *bidvestbank.co.uk* (D00022473) and *bidvestbank.uk* (D00022474) were both registered in August 2017 (10 and 4 August respectively). The Respondent was incorporated as *BidBank LTD* (Company Registration No. NI667222) on 23 January 2020.
- 4.4 The Complainant is the registered proprietor of UK (UK Registration No. UK00002371451, 2005), European (EUTM No. 004010261, 2005), South African (2004/10557) and other country trade marks for the name 'BIDVEST.' The Complainant is also the registered proprietor of South African trade marks (2007/12920, 2012/05220) and other country trade marks for the name 'BIDVEST BANK' (collectively the 'Marks').

5. Parties' Contentions

The Complaint

For the purposes of this section of the Decision, the Expert has summarised the submissions of the Complainant, including Annexures, but only insofar as they are relevant to the matters that the Expert is required to determine under Nominet's Dispute Resolution Service ('DRS') Policy (the 'Policy').

5.1 In summary, the Complainant submitted that the Complaint should succeed for the reasons below:

The Complainant's Rights

- It has Rights in the Domain Names based on its Marks, and the goodwill and reputation it holds in the names.
- In support of it having goodwill and reputation in the names, the Complainant explained that it was established in 1988, has more than 106,000 employees worldwide, and its business operations extend to *“four continents, operating in a variety of sectors within the retail, distribution and service industries, including the banking sector.”*
- Bidvest Bank, which forms part of the Complainant’s financial services operation, is a *“leading second tier bank operating in”* South Africa and is *“licensed as a “locally-controlled bank” by the Reserve Bank of South Africa (national banking regulator).”*
- It trades under the name BIDVEST BANK, operates over 90 branches throughout South Africa as well as in Botswana, Malawi and Namibia, and a significant part of its services is selling foreign exchange for countries including the UK, European Union and the U.S.

Abusive Registration

- The Domain Names are confusingly similar to the “BIDVEST” Mark/name and identical to the “BIDVEST BANK” Mark/name.
- It is *“highly likely that the Respondent would have been aware of the Complainant’s marks, considering that the Complainant is one of the largest South African banks [and] is well established in both the UK and Australia, countries where the Respondent is domiciled or has a commercial presence.”*
- The Respondent registered the Domain Names primarily for the purpose of unfairly disrupting the business of the Complainant and *“potentially for committing fraud and/or for ransoming the Domain Name.”*
- After registering the Domain Names, the Respondent set up a connected website providing pay-per-click advertising links for competing financial and banking products and services.
- The Respondent has used the Domain Names to redirect Internet users to a website featuring links to third-party (i.e. not the Complainant’s) websites, and

by doing so the Respondent would “most likely [have] derived click-through revenue each time visitors click on the corresponding hyperlinks.”

- The Respondent has “a track record of targeting so-called ‘second-tier banks’ [such as Bidvest] as is apparent from the ccTLD domain names it has registered”, with the Complainant referencing various domain name registrations by the Respondent which include the Bulgarian First Investment Bank “fibank” name.
- The Respondent’s registration of the Domain Names constitute a blocking registration and an unfair disruption to the Complainant’s business under the Policy, with a view to it benefitting commercially from its unauthorised and unlawful use of the Marks and associated goodwill.
- Noting the above, there can be no possible legitimate basis for the Respondent registering and/or using the Domain Names incorporating the Complainant’s BIDVEST and BIDVEST BANK trade marks.
- The Complainant also described its correspondence with the Respondent since August 2017 relating to its protection of its trade marks.

The Respondent’s Response

5.2 The Respondent did not submit a response to either of the Complaints.

6. Discussions and Findings

General

6.1 To succeed in the Complaints, the Complainant has to prove that, pursuant to paragraph 2 of the Policy, on the balance of probabilities:

- i. [it] has Rights in respect of a name or mark which is identical or similar to the Domain Name[s]; and*
- ii. The Domain Name[s], in the hands of the Respondent, [are] Abusive Registration[s].*

6.2 Addressing each of these limbs in turn:

i Rights in respect of a name or mark which is identical or similar to the Domain Name

6.3 The Expert considers that, for the reasons below, the requirement set out in paragraph 2 i of the Policy is met.

6.4 Paragraph 1 of the Policy defines ‘Rights’ as:

[...] rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning;

6.5 Given the Marks, and noting the evidence presented as to the Complainant's goodwill and reputation in the names, the Expert considers that, at the time of the Complaints, the Complainant had Rights in respect of the name/Marks which are similar (BIDVEST) and identical (BIDVEST BANK) to the Domain Names.

6.6 In concluding the above, the Expert has disregarded each Domain Name suffix "co.uk" and ".uk".

ii Abusive Registration

6.7 For the reasons set out below, the Expert considers that the requirement set out in paragraph 2 ii of the Policy is met.

6.8 Paragraph 1 of the Policy defines "Abusive Registration" as 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 Complainant's Rights; or

ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;

6.9 In relation to the definition of Abusive Registration in sub paragraph (i), the Policy, at paragraph 5, sets out a non-exhaustive list of factors which may be evidence that the Domain Names are an Abusive Registration.

6.10 Specifically, the Expert considers that the factor set out at paragraph 5.1.1.3 of the Policy, as referenced by the Complainant (*registered for the purpose of unfairly disrupting the business of the Complainant*), is relevant.

6.11 Noting in particular the Complainant's evidence as to the length of its service provision and its goodwill and reputation, a simple Internet search prior to registration of the Domain Names would have pointed the Respondent to the Complainant.

6.12 Therefore, the Expert considers that the Respondent would have been well aware of the Complainant, and the Marks/names, prior to registering the Domain Names.

6.13 Indeed, on the balance of probabilities, the Expert is satisfied that the Respondent specifically chose to register the Domain Names at that time with the intention of benefitting from the Complainant's names/Marks and general goodwill and reputation.

- 6.14 For the reasons set out above, the Expert considers that the registration of the Domain Names took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.
- 6.15 So far as the definition of Abusive Registration in sub paragraph (ii) is concerned, the Expert considers that the Domain Names were and are Abusive Registrations as a result of their manner of use by the Respondent, for the reasons explained below.
- 6.16 Specifically, the Expert considers that the factor set out at paragraph 5.1.2 of the Policy, that *(the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant)*, is relevant.
- 6.17 As evidenced by the Complainant, the homepage of the websites attached to the Domain Names contained third-party advertising links provided by *dynadot*, a domain name registrar and web hosting company, to: "*Forex Trading South Africa*", "*Forex Currency Exchange Rates*" (.co.uk – 14 August 2017); and, "*Sending Money*", "*Banking Account*" (.uk – 9 February 2020).
- 6.18 The use of the Domain Names by the Respondent in this way is referred to as domain name parking. In such cases, the domain name registrant is usually paid based on how many users click through the provided links to the other companies' websites (referred to by the Complainant as "*click-through revenue*").
- 6.19 Paragraph 8.5 of the Policy sets out that the sale of such "*click-through*" traffic is not of itself objectionable. However, in such circumstances, the Expert when deciding whether there has been an Abusive Registration will take into account:
- a) the nature of the Domain Name;
 - b) the nature of the advertising links on any parking page associated with the Domain Name; and
 - c) that the use of the Domain Name is ultimately the Respondent's responsibility.
- 6.20 The Expert notes that the homepages of the websites linked to the Domain Names included references to services in the similar subject area as the Complainant's services (i.e. finance and banking related).
- 6.21 Given this, the Expert considers that anyone accessing those websites would likely be confused, at least initially (see paragraph 3.3 of the DRS Experts' Overview (version 3)), into thinking that the linked websites and the '*parked*' services offered therein are the Complainant's or are somehow connected with the Complainant, with the Complainant potentially losing business opportunities by such confusion.

- 6.22 The Expert is not persuaded by the argument that a person accessing those websites would soon realise their mistake, and that they are not linked to the Complainant, as the damage to the Complainant's business would already have been done. Indeed, the Expert considers that it is likely that at least some persons accessing those websites would have done so only because of the Complainant's general goodwill and reputation in the names and/or Marks.
- 6.23 Further, the Expert is not persuaded by the argument that the Respondent has no control over or responsibility for the links that are provided by virtue of a parked page, and therefore cannot be held to account for the content of those links. As referenced in the DRS Experts' Overview (version 3), where the domain name is connected to a parking page operated on behalf of the respondent by a third party, the respondent is "*unlikely to be able to escape responsibility for the behaviour of that third party.*"
- 6.24 The Expert has considered whether there is any other evidence before him to demonstrate that the Domain Names are not Abusive Registrations, including whether the Respondent is making fair use of the Domain Names, but does not consider there is.
- 6.25 In particular, the Expert notes that the Domain Names are in fact identical to the Complainant's name/Marks (BIDVEST BANK), registration of the Domain Names by the Respondent post-dates the Complainant's reputation, and the Respondent uses the linked websites as a parking page which has links to services some of which are in the similar subject-area as the Complainant's services.
- 6.26 For the reasons set out above, the Expert considers that the use of the Domain Names by the Respondent took unfair advantage of, and was unfairly detrimental to, the Complainant's Rights.

7. Decision

- 7.1 The Expert finds that, on the balance of probabilities, the Complainant has Rights in respect of a name or mark which is identical to the Domain Names (BIDVEST BANK) and that the Domain Names, in the hands of the Respondent, are Abusive Registrations. Therefore, the Expert directs that the Domain Names be transferred to the Complainant.

Signed: Dr Russell Richardson

Dated: 13 May 2020