

ADMINISTRATIVE PANEL DECISION

The Trustees for the Time Being of the Baker Street Trust v. Goodwill Dumezweni Masuku, Prototype Glass Windscreen
Case No. D2023-1361

1. The Parties

The Complainant is The Trustees for the Time Being of the Baker Street Trust, South Africa, represented by Moore Attorneys Incorporated, South Africa.

The Respondent is Goodwill Dumezweni Masuku, Prototype Glass Windscreen, South Africa.

2. The Domain Name and Registrar

The disputed domain name <pgwindscreen.com> (the “Domain Name”) is registered with Diamatrix C.C. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 29, 2023. On March 29, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 30, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Redacted) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 12, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 14, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 24, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 14, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 15, 2023.

The Center appointed Jeremy Speres as the sole panelist in this matter on May 23, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant and its associated group entities comprise The PG Group. Established in 1897 in South Africa, The PG Group has grown to become one of the largest integrated glass companies in South Africa. The PG Group trades under various PG-incorporating trade marks, including PG GLASS, which focuses on the fitment, repair and replacement of auto glass, including windscreens, as well as glass within businesses and homes. The Complainant's PG GLASS division has over 110 fitment centres and mobile units across South Africa.

The Complainant and its group entities own numerous PG-incorporating trade mark registrations in numerous African jurisdictions, including South African Trade Mark Registration No. 1986/05878 PG in class 6 with registration date December 15, 1988, in the name of the Complainant. The Complainant, which appears to own the majority of The PG Group's PG-incorporating trade mark registrations, licenses those trade marks to the various entities comprising The PG Group, including the PG GLASS division.

The Respondent is an individual residing in South Africa, and the Respondent's organisation is a South African registered company - Prototype Glass Windscreen (Pty) Ltd. Based on the unrebutted evidence filed by the Complainant and the Panel's own independent research, the Respondent appears to trade as an auto windscreen repairer in South Africa.

The Domain Name was registered on July 13, 2019, and has been used to resolve to a website for the Respondent's business, headed "Prototype Glass WINDSCREEN" and referring to "PG windscreen" in the website text.

5. Parties' Contentions

A. Complainant

The Complainant contends that the Domain Name is confusingly similar to its well known PG mark, that the Respondent has no rights or legitimate interests in it, and the Domain Name was registered and used in bad faith given that the Complainant's mark is well known and the Domain Name is calculated to deceive users into believing some association with the Complainant.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant's PG mark is wholly contained within the Domain Name as its first element with the addition of the term "windscreen". Where the trade mark is recognisable within the disputed domain name, as in this case, the addition of other terms (including descriptive terms) does not prevent a finding of confusing similarity (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)) at section 1.8). The Complainant has satisfied the requirements of paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

UDRP panelists may take judicial notice of the repute of a trade mark within their personal knowledge where it cannot reasonably be contested (see section 4.8 of the [WIPO Overview 3.0](#); and *Société des Produits Nestlé S.A. v. Sonia de Ferrero*, WIPO Case No. [D2016-1300](#)). The Panel, having been a resident of South Africa (the Respondent's country) for many years prior to registration of the Domain Name, takes judicial notice of the immense repute of the Complainant's PG mark in South Africa predating the registration date of the Domain Name by many years in the glass, and in particular the auto glass, industry.

The Complainant's PG mark was registered and well known long prior to registration of the Domain Name. The Domain Name is confusingly similar to the Complainant's mark and the Complainant has certified that the Domain Name is unauthorised by it.

The evidence in the record, and the Panel's own independent research, indicates that the Respondent's company was registered in 2018 as "Prototype Glass Windscreen (Pty) Ltd"; the Respondent appears to have traded as "PG Windscreen Company" since at least 2019; and the Domain Name appears to have been used since at least December 2020 for the Respondent's business. Thus, paragraphs 4(c)(i) and (ii) of the Policy are potentially in favour of the Respondent.

However, as per the discussion below in relation to bad faith, it is highly likely that the Respondent sought to capitalise on the repute of the Complainant's PG mark when it sought to register a domain name incorporating the Complainant's well known mark plus a term descriptive of the Complainant's business, and in fact did use the Domain Name for a business that competes directly with the Complainant. The Respondent appears to use the Domain Name for an existing business, and the fact that the Respondent has not sought to defend the Domain Name in circumstances where it could reasonably be expected to if it had rights or legitimate interests in the Domain Name is telling.

The Respondent's registered company name, Prototype Glass Windscreen (Pty) Ltd, which is repeated in part in the header of the Domain Name's website as "Prototype Glass WINDSCREEN", is clearly contrived. The ordinary meaning of "prototype" is an early sample, model or release of a product built to test a concept or process. The Respondent seemingly offers standard, replacement windscreens and windscreen repairs for standard motor vehicles, and there is nothing suggesting that the Respondent offers prototypes of any kind. Given the foregoing and the Complainant's extensive repute in the same industry, it is likely that the Respondent's company name was contrived so as to provide some justification for using an abbreviated form identical to the Complainant's PG mark.

The Respondent's usage of the Domain Name to take advantage of the Complainant's trade mark plainly cannot represent a *bona fide* offering of goods or services and cannot confer rights or legitimate interests under the Policy (*Sistema de Ensino Poliedro Vestibulares Ltda., Editora Poliedro Ltda. v. Anonymize, Inc. / STANLEY PACE*, WIPO Case No. [D2022-1981](#)). The Policy would be self-defeating if bad faith use of a domain name could simultaneously confer rights or legitimate interests.

The Complainant has satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

UDRP panels have consistently found that registration of a domain name that is confusingly similar (particularly domain names incorporating the mark plus a descriptive term, as in this case) to a famous or well known trade mark by an unaffiliated entity can by itself create a presumption of bad faith ([WIPO Overview 3.0](#) at section 3.1.4).

Having regard to the immense prior reputation of the Complainant's PG mark in the very industry pursued by, and in the country of, the Respondent, it is inconceivable that the Respondent was not aware of the Complainant's mark and it is highly unlikely that the Respondent adopted the PG mark, in competition to the

Complainant, without seeking to capitalise on the Complainant's reputation. Paragraph 4(b)(iv) of the Policy is eminently applicable.

The Panel draws an adverse inference from the Respondent's failure to take part in the present proceeding where an explanation is certainly called for ([WIPO Overview 3.0](#) at section 4.3).

The Complainant has satisfied paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name, <pgwindscreen.com>, be transferred to the Complainant.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: June 6, 2023