DomainDisputes.co.za
SAIIPL Alternate Dispute Resolution

SAIIPL Decision

[ZA2014-00177]

.ZA ALTERNATE DISPUTE RESOLUTION REGULATIONS

(GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	**ZA2014-00177**
DECISION DATE:	**22 August 2014**
DOMAIN NAME:	**KEMPSTONTRUCKHIRE.CO.ZA**
THE DOMAIN NAME REGISTRANT:	**Rene Busche**
REGISTRANT'S LEGAL COUNSEL:	**N/a**
THE COMPLAINANT:	**Vincemus Investments (Pty) Ltd**
COMPLAINANT'S LEGAL COUNSEL:	**Adams & Adams (Delene Bertasso)**
THE 2nd LEVEL DOMAIN NAME ADMINISTRATOR:	**ZA Central Registry**

1) Procedural History

a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **24 June 2014**. On **25 June 2014** the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **25 June 2014** UniForum SA confirmed that the domain name had indeed been suspended. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIIPL's Supplementary Procedure.

b. In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **26 June 2014**. In accordance with the Regulations the due date for the Registrant's Response was **23 July 2014**. The Registrant did not submit any response, and accordingly, the SAIIPL notified the Registrant of its default on **24 July 2014**.

c. The SAIIPL appointed **Deon Bouwer** as the Adjudicator in this matter on **13 August 2014**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2) Factual Background

a. The Complainant trades under the name, The Kempston Group, and has various trading divisions, including the Kempston Truck Hire division. The Kempston Group was established in 1973 under the name Kempston Truck Hire and has traded actively in South Africa since that time.

b. The Complainant operates eight Kempston Truck Hire branches countrywide and offers a variety of vehicle hire solutions ranging in

duration from 24 hours to 24 months. Qualified, certified drivers are available for hire with its vehicles.

c. The Complainant has used the trade marks referred to above extensively in South Africa, which has not been disputed by the Registrant and which the adjudicator accepts as fact.

3) Parties' Contentions

a. **Complainant**

i. The Complainant trades under the name, The Kempston Group, and has various trading divisions, including its Kempston Truck Hire division.

ii. The Kempston Group was established in 1973 under the name Kempston Truck Hire and has traded actively in South Africa since that time.

iii. The Complainant operates eight Kempston Truck Hire branches countrywide and offers a variety of vehicle hire solutions ranging in duration from 24 hours to 24 months.

iv. The Complainant claims to be the proprietor of goodwill in the trade marks KEMPSTON, KEMPSTON HIRE and KEMPSTON TRUCK HIRE of common law by virtue of the fact of having used the trade mark for some 40 years.

v. The Complainant further claims to be the proprietor of trade mark registrations nos. 1985/06889 KEMPSTON HIRE and 1985/06890 KEMPSTON HIRE logo both in class 39, as well as the kempston.co.za domain name, which incorporates the KEMPSTON trade mark and was registered on 10 December 1999.

vi. The Complaint also submits that the disputed domain name wholly incorporates the Complainant's KEMPSTON, KEMPSTON HIRE and KEMPSTON TRUCK HIRE trade marks and is phonetically and visually identical to the Complainant's aforementioned trade marks.

vii. The Complainant further submits that as a result of the above, there is a substantial likelihood that internet users and consumers will be confused into believing that there is some affiliation, connection, approval or association between the Complainant and the Registrant , when in fact, there is no such relationship.

viii. The Complainant further argues that where the disputed domain name includes the complainant's entire mark the likelihood of confusion cannot be avoided by adding descriptive or non-distinctive matter to it.

ix. The Complaint contends that the domain name in the hands of Registrant is an abusive registration as it was registered to disrupt unfairly the business of the complainant or to prevent the Complainant from exercising its rights, namely to register and use the disputed domain name.

x. The Complainant accordingly requests that the disputed domain name must be transferred to it.

b. **Registrant**

i. The Registrant did not respond to the Complainant's contentions.

4) Discussion and Findings

a. Regulation 3(1)(a) requires that a Complainant proves each of the following elements in order for the Disputed Domain Name to be transferred:

i) That the Complainant has established rights in respect of a name or mark which is identical or similar to the Disputed Domain Name; and

ii) That in the hands of the Registrant, the Disputed Domain Name is an abusive registration.

b. The adjudicator will draw such inferences from the Registrant's default as he considers appropriate. This will include the acceptance of plausible evidence of the Complainant, which has not been disputed.

4.1 Complainants' Rights

a) Regulation 1 defines "rights" to include intellectual property rights, commercial, cultural, religious and personal rights protected under South African law, but are not limited thereto. The definition is broad and "rights" is not restricted to rights founded on the principles of trade mark law, but recognises rights going beyond those in terms of the Trade Marks Act No. 194 of 1993 or the requirements at common law for passing off. Such rights must, however, find recognition in law. See ZA2007-0008 (privatesale.co.za).

b) The Complainant claims that it is the proprietor of trade mark registrations nos. 1985/06889 KEMPSTON HIRE and 1985/06890 KEMPSTON HIRE logo both in class 39, as well as the kempston.co.za domain name, which incorporates the KEMPSTON trade mark and was registered on 10 December 1999. However, the evidence submitted by the Complaint in support of the aforementioned claims, namely Annexures "B" and "C",

respectively, does not support the Complainant's submissions. The aforementioned documents reflect that the respective registrations are registered to Vincemus Investments Ltd whereas the Complainant is Vincemus Investments **(Pty)** Ltd. As such, it appears that, *prima facie,* the Complainant is not entitled to rely on the respective registrations to support its claims to rights in the KEMPSTON trade mark.

c) The Complainant further submit that it has built up common law rights in the KEMPSTON, KEMPSTON HIRE and KEMPSTON TRUCK HIRE trade marks by virtue of having used the trade marks, continuously, for some 40 years.

d) The Complainant has not submitted extensive documentary evidence in support of the claim that it has used the KEMPSTON, KEMPSTON HIRE and KEMPSTON TRUCK HIRE trade marks for some 40 years. However, the nature of the evidence submitted by the Complainant and absence of any contrary statements by the Registrant convince the adjudicator that the Complainant has, indeed, acquired suitable rights in respect of the KEMPSTON, KEMPSTON HIRE and KEMPSTON TRUCK HIRE trade marks, resulting from its use of the KEMPSTON, KEMPSTON HIRE and KEMPSTON TRUCK HIRE trade marks.

e) The adjudicator consequently finds that the Complainant has discharged the onus in showing that it has established suitable rights in respect of, particularly, the KEMPSTON, KEMPSTON HIRE and KEMPSTON TRUCK HIRE trade marks.

f) The adjudicator also finds that the Disputed Domain Name is identical to the Complainant's KEMPSTON TRUCK HIRE trade mark and also similar to the Complainant's KEMPSTON HIRE and KEMPSTON trade marks but, as required in terms of Regulation 3(a).

4.2 Abusive Registration

a) Regulation 4(1) provides for a number of grounds (non-exhaustive) on which the Complainant can rely in showing that the Disputed Domain Name is an abusive registration. For purposes of this dispute, the Complainant relies on Regulations 4(1)(a)(iii) and 4(1)(a)(iv), namely that the Registrant:

i) disrupts unfairly the business of the Complainant; and

ii) prevent the Complainant from exercising its rights.

b) In the absence of any evidence to the contrary, the Adjudicator finds that the Registrant has registered the Disputed Domain Name, primarily, with an intention to disrupt, unfairly, the business of the Complainants and prevent the Complainant from exercising its rights.

5) Decision

a. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name kempstontruckhire.co.za be transferred to the Complainant.

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DEON BOUWER

SAIIPL SENIOR ADJUDICATOR

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