

Decision

[ZA2015-0204]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0204
DECISION DATE:	18 August 2015
DOMAIN NAME	advtechsa.co.za
THE DOMAIN NAME REGISTRANT:	Liese le Roux
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Advtech Limited
COMPLAINANT'S LEGAL COUNSEL:	Lerato Mofokeng - Moore Attorneys
2 nd LEVEL ADMINISTRATOR:	ZACR

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **19 June 2015**. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **23 June 2015**. The SAIPL verified that the Dispute [together with the amendment to the Dispute] satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIPL’s Supplementary Procedure. On **23 June 2015** the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name at issue, and on **23 June 2015** ZACR confirmed that the domain name had indeed been suspended.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **25 June 2015**. In accordance with the Regulations the due date for the Registrant’s Response was **23 July 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **27 July 2015**.
- c) The SAIPL appointed **Tana Pistorius** as the Adjudicator in this matter on **30 July 2015**. 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 The Complainant is Advtech Limited, a company duly incorporated with limited liability according to the company laws of the Republic of South Africa and having its principal place of business at 364 Kent Avenue,

Femdale, Randburg, 2194.

- 2.2 The disputed domain name, advtechsa.co.za was registered by Lise le Roux on 8 February 2012.
- 2.3 The Complainant was founded in 1990 operates in three divisions, namely schools, tertiary education and resourcing. The Complainant is a JSE (Johannesburg Stock Exchange) listed company.
- 2.4 On 3 February 2015 the Complainant sent the Registrant a letter of demand regarding the disputed domain name.
- 2.5 The Complainant is a successful company. In 1998, the Complainant was the top performer in the Electronics sector of the JSE and featured in the Forbes Global Business and Finance magazine as one of the Top 300 small companies globally. In 2010, the Complaint was featured in the winners list of the Financial Mail's Top Companies for the 3 (three) consecutive years and was ranked 16th in the Business Times' Top 100 Companies.
- 2.6 In 2013, the Complainant spent R74 million on corporate social investments. A major portion of the Complainant's budget is spent on bursaries and scholarships on a merit basis to previously disadvantaged students.
- 2.7 The Complainant is the owner of a number of successful companies, including: Brent Personnel; Cassel & Company; Abbots College; Crawford Schools; Trinity House; Centurus College; Rosebank College; The Design School Southern Africa and the Forbes Lever Baker Educational Institute for Accountancy and Management.

3 Parties' Contentions

3.1 Complainant

- a) According to the relevant 2nd Level Domain Administrator's Whois information the Registrant is Liese le Roux. A copy of the printout of the Whois search that was conducted on 09 April 2015 was provided marked "Annexure TW1".
- b) The Complainant avers that it has registered the following trade marks:
"ADVTECH" trade mark registration numbers 1990/00932-33 in respect of classes 09 & 41;
"ADVTECH" trade mark registration numbers 1999/08161-3 in respect of classes 16, 35 and 42' and
"ADVTECH" in a stylised form trade mark registration numbers 2011/26535-9 for the in classes 09, 16, 35, 41 and 42.
- c) The Complainant also promotes its "ADVTECH" trade mark in print media, including in pamphlets and in advertisements placed in newspapers and other publications. The Complainant provided proof of its marketing efforts by attaching copies of the pamphlets in "Annexure TW3".
- d) The Complainant notes that it has used ADVTECH in its domain name for its web site www.advctech.co.za since 2000 as is evidenced by the screenshots from the "Wayback Machine" (Internet Archive available at [https.archive.org](https://archive.org)) (as is depicted in "Annexure TW4").
- e) The Complainant avers that it enjoys extensive common-law rights in respect of the mark "ADVTECH". The Complainant notes that it has spent a considerable amount of time, money and effort in advertising

and promoting its products and services under the "ADVTECH" trade mark. The Complainant notes that it advertises the mark "ADVTECH" extensively in all forms of media including radio, television and in printed media publications. More particularly, it contends that its "ADVTECH" trade mark is a widely recognised brand. The Complainant contends that due to its extensive exposure in the market place it has become a well-known brand in South Africa.

- f) The Registrant's disputed domain name advtechsa.co.za is either identical or confusingly similar to the Complainant's "ADVTECH" trade marks as it visually and phonetically similar and wholly incorporates the Complainant's trade marks. The disputed domain name contains the mark or word "ADVTECH" which is the dominant and memorable part of the domain name.
- g) The Complainant avers that it has domain name rights based on its prior registration of its advtech.co.za domain name, registered on 02 April 1997. It also notes that the disputed domain name was only registered in February 2012.
- h) The Complainant avers that the purpose of registering the disputed domain name is to confuse members of the public into believing that it is linked to, associated with the Complainant or that of the Complainant's.

The Complainant alleges that the disputed domain name in the hands of the Registrant is an abusive registration. In support of this contention, the Complainant has submitted that in terms of Regulation 4, the disputed domain name is a blocking registration.

The Complainant also points out that the disputed domain name 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.

The Complainant submits that it is clear that the Registrant has deliberately registered the disputed domain name to possibly confuse members of the public believing that the disputed domain name is in fact the Complainant's domain name.

The Complainant alleges that the domain name has been used in a manner that is unfairly detrimental to the Complainant's rights as it is visually and phonetically similar to the Complainant's "ADVTECH" trade mark.

3.2 Registrant

- a) Regulation 18(1)(a) provides that a Registrant must respond to the statements and allegations contained in the Dispute in the form of a Response. In such a Response, the Registrant must detail any grounds to prove the domain name is not an abusive registration.
- b) The Registrant failed to submit a Response and the Adjudicator must decide the matter on the Dispute (see Regulation 18(3)).
- c) Regulation 28(2) provides that in the absence of exceptional circumstances, an Adjudicator shall draw such inferences, as she considers appropriate, from the failure of a party to comply with a provision or requirement of the Regulations.
- d) The Adjudicator draws the following two inferences:
 - (i) the Registrant does not deny the facts that the Complainant asserts, and

(ii) the Registrant does not deny the conclusions that the Complainant draws from these facts.

- e) Notwithstanding these inferences, the Adjudicator has analysed Complainant's version in order to satisfy herself that the allegations contained in its Complaint are acceptable and probably true (see ZA2007-0010 (*Multichoice Subscriber Management v JP Botha*)).

4 Discussion and Findings

- a) Regulation 3 provides that a Complainant is required to prove, on a balance of probabilities, that the following three elements are present in order to succeed in a domain name dispute based on an alleged abusive registration: (a) that the Complainant has rights in respect of a name or mark; (b) that the name or mark is identical or similar to the domain name; and (c) that the domain name, in the hands of the Registrant, is an abusive registration.

4.1 Complainant's Rights

- 4.1.1 The cornerstone of the Complainants' case is proof on a balance of probabilities that it has rights in the trade mark ADVTECH and that this trade mark is identical or similar to the disputed domain name. The Complainant notes that its trade mark is registered. The Complainant attaches extracts of the CIPC's electronic register as proof of the trade-mark registrations. A complete schedule of the Complainants trade marks are also listed in "Annexure TW9" (once again a print-out of the information displayed on the CIPC web site). The Adjudicator does not regard this as adequate evidence of the Complainant's trade-mark rights. As a rule, only copies of official

certificates of registration issued by registration authorities are apt to demonstrate trade mark rights (see D2001-0709 *Red Bull GmbH v Ian Andrew*).

4.1.2 The Complainant asserts common-law rights in respect of the mark ADVTECH. The Registrant does not dispute the evidence submitted by the Complainant and the Adjudicator finds on such evidence that ADVTECH is indeed a well-known trade mark within the meaning of Section 34(1)(c) of the Trade Marks Act 194 of 1993.

4.1.3 The disputed domain name is advtechsa.co.za. The Adjudicator finds that neither the addition of “sa” to ADVTECH nor the suffix “.co.za” influences the consideration of similarity (see D2002-0810 *Benetton Group SpA v Azra Khan*).

4.1.4 It follows that the Complainant has rights in respect of the mark ADVTECH and that this mark is similar to the disputed domain name.

4.2 Abusive Registration

4.2.1 An abusive registration is defined as a domain name, which either:
(a) when the Registrant registered the domain name took unfair advantage of or was unfairly detrimental to the Complainant's rights;
or (b) a domain name that is being used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

4.2.2 The Complainant asserts that the disputed domain name is likely to lead people and businesses to believe that such a domain name is associated to the Complainant. In ZA2007/0003 and ZA2014-0164 it was held that it is not necessary to prove actual confusion and that the potential or likelihood of confusion would be sufficient. It was also

held that confusion may be inferred in situations where the Registrant registered a domain name containing the Complainant's name or mark together with a generic term.

4.2.3 Regulation 5 sets out various non-exhaustive factors that may indicate that the disputed domain name is not an abusive registration. By not submitting a Response, Registrant has failed to rely on any of these factors to demonstrate that she did not register and use the domain name in bad faith (see D2002-0810 *Benetton Group SpA v Azra Khan*).

4.2.4 The Registrant has not made any use of the disputed domain name. The Complainant has shown in Annexure "TW5" that the disputed domain name did not resolve to an active web site but merely displayed the following message:

"Almost done ... www.advtechsa.co.za Has been registered and is under construction".

Passive use could amount to use in bad faith. Many foreign decisions have held that the "use" requirement includes both positive action and inaction (D2000-0059 *Barney's Inc v BNY Bulletin Board*; D2000-0400 *CBS Broadcasting Inc v Dennis Toepfen*). The Adjudicator must examine all the circumstances of the case to determine whether Registrant's non-use amounts to bad faith. Other panels have held non-use amounted to bad faith where a Complainant had rights in a well-known trade mark, where the Registrant failed to respond to the Complaint and where it was impossible to conceive a good faith use of the domain name (see D2000-0574 *Jupiters Limited v Aaron Hall*; D2002-0131 *Ladbroke Group Plc v Sonoma International LDC*).

4.2.5 The Complainant has rights in a well-known mark, ADVTECH. The

Registrant failed to respond to the Complaint. It is also impossible to conceive a good faith use of the domain name advtechsa.co.za by the Registrant. Adjudicator finds, on a balance of probabilities that the Registrant's passive use of the disputed domain name amounts to use in bad faith.

4.2.6 By way of summary, the Adjudicator finds that the above factors indicate, on a balance of probabilities, that the disputed domain name is an abusive registration.

5. Decision

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

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TANA PISTORIUS
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