



# Decision

(ZA2015-0219)

.ZA ALTERNATE DISPUTE RESOLUTION  
REGULATIONS (GG29405)

## ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0219
DECISION DATE:	14 December 2015
DOMAIN NAME	fluor.co.za
THE DOMAIN NAME REGISTRANT:	Dennis Levy
REGISTRANT' S LEGAL COUNSEL:	Unrepresented
THE COMPLAINANT:	Fluor SA (Pty) Ltd
COMPLAINANT' S LEGAL COUNSEL:	CSC Digital Brand Services AB
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	ZA Central Registry (CO.ZA )

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL” ) on **20 October 2015**. On **22 October 2015** the SAIPL transmitted by email to the **ZA Central Registry (ZACR)** a request for the registry to suspend the domain name(s) at issue, and on **27 October 2015** ZACR confirmed that the domain name had indeed been placed in the suspension queue. The SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations” ), and the SAIPL’ s Supplementary Procedure.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **27 October 2015**. In accordance with the Regulations the due date for the Registrant’ s Response was **24 November 2015**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **25 November 2015**.
- c) The SAIPL appointed **Victor Williams** as the Adjudicator in this matter on **2 December 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 Fluor Corporation (Fluor) was founded as a construction company in 1912, and has grown to be one of the largest publicly owned construction, procurement, engineering, maintenance, and project companies in the

world. Fluor employs over 40 000 employees over 6 continents, and is a Fortune 500 company.

2.2 Fluor executed its first project in South Africa in 1960, and in 1979 established a permanent office in Johannesburg., and in 1980 a training centre in Secunda.

2.3 Fluor is widely recognized globally, and had been awarded a number of awards worldwide (see Annexure 9).

2.4 Fluor operates a number of websites, chief among them www.fluor.com. This website attracts over 41 000 visitors per month. (see Annexure 4).

2.5 The Fluor brand is well-recognised by consumers, industry and its peers, and a considerable reputation and goodwill has been established in the Fluor brand and trademark.

### **3 Parties' Contentions**

#### **3.1 Complainant**

a) Fluor owns numerous trademark registrations across the world, and the FLUOR trademark is world famous.

b) Fluor is the sole owner of the FLUOR trade mark at the U.S Patent and Trade mark office, and the European Union OHIM Trade mark office.

c) In South Africa the FLUOR trade mark has been registered for services in connection with design construction and repair; design, construction and repair of steam electrical power generating plants; design, construction and repair of nuclear power generating plants;

design and erection of coolers, furnaces, drying, refrigerating and ventilating equipment; design and erection of crushing, grinding and screening plants; installation of pumps and compressors; design and construction of tunnels, canals, bridges and railroads; design and construction of piers, wharves and docks; construction and laying of submarine pipelines; design and construction of caissons; design and construction of seawalls and jetties, marine petroleum well drilling, maintenance repair and operation of marine petroleum wells; marine subsea and surface completion and operation of petroleum wells; marine core drilling; design and erection of petroleum marine production and drilling platforms; design, construction and repair of petroleum, petrochemical and chemical plants (Republic of South Africa Reg. No. number 72/0002), for design and erection of coolers, furnaces, drying, refrigeration and ventilating equipment for petroleum, ore, water and material treatment; design and construction of solvent extraction or exchange;, and acid production plants, and design and construction of uranium processing and manufacturing plants (Republic of South Africa Reg. No. 72/0003), for engineering services (Republic of South Africa Reg. No. 79/0031).

### **3.2 Registrant**

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

## **4 Discussion and Findings**

- a) 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 proved, on a balance of probabilities, in terms of Regulation 3(2), that the required elements in terms of Regulation 3(1)(a) are present namely:

- i) the Complainant has rights in respect of a name or mark
- ii) which is identical or similar to the disputed domain name; and
- iii) in the hands of the Registrant the disputed domain name is an abusive registration.

An abusive registration is defined, in Regulation 1, to mean a domain name which either -

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

Turning to the substantive aspects of this Dispute, the Adjudicator has carefully perused the dispute filed herein.

#### **RIGHTS IN RESPECT OF A NAME OR MARK**

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 appeal decisions [www.seido.co.za](http://www.seido.co.za) (ZA2009-0030) and [www.xnets.co.za](http://www.xnets.co.za) (ZA2011-0077), that the notion of "rights" for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence.

It is a matter of locus standi in order to make sure that the person who complains is someone with a proper interest in the complaint. The threshold in this regard should be fairly low.

In the first place, the Adjudicator needs to determine whether, as set out above, in terms of Regulation 3(1) (a), the Complainant has rights in respect of the name or mark FLUOR. The Complainant claims that it enjoys such

rights in this name or mark.

### **A NAME OR MARK?**

The first part of the present enquiry is to determine whether the Complainant has locus standi in the sense of being the proprietor of a name or mark that is unique or distinctive of it and its activities (and that is not merely descriptive, general or generic, for example).

### **DOES THE COMPLAINANT HAVE RIGHTS?**

Accordingly, the first element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has rights in respect of the name or mark FLUOR .

The Complainant asserts that it has rights in and to the name and mark FLUOR.

Under statute law, the Complainant has shown that it is the proprietor of registered rights in respect of the name and trade mark FLUOR in South Africa that date back to 1972.

The trade mark FLUOR was clearly registered prior to the disputed domain name, and such registrations, as set out above, are prima facie valid and enforceable. This clearly provides the Complainant with rights in terms of section 34 of the (South African) Trade Marks Act no 194 of 1993. Infringement would take place in terms of that section if a person used a mark which is identical or similar to the registered trade mark FLUOR in respect of the various services for which the trade mark is registered.

The Complainant has also submitted that its registered trademark FLUOR has become a well known trade mark in South Africa, and it has submitted evidence to support this submission.

Accepting this submission, infringement would take place if a person used a mark which is identical or similar to the registered trademark FLUOR in respect of any services, in terms of section 34(1)(c).

Hence the Complainant prima facie has the aforementioned registered trade mark rights in South Africa, and accordingly it has the necessary locus standi to bring this dispute.

Under the common law, the Complainant asserts that, by virtue of promotion and extensive use of its name and trade mark FLUOR, it has developed a considerable repute or reputation therein, and hence goodwill as an asset of its business in South Africa. In fact it goes further and claims that its name and trade mark is well-known (to use the term recognized in the Trade Marks Act). Such goodwill, or more particularly reputation, in terms of the common law could be damaged by means of unlawful competition or specifically passing off under the common law by another party wrongly representing that it is, or is associated with, the Complainant. It was pointed out in ZA2007-0003 that the registration and adoption of a domain name being a name or mark that enjoys a reputation, of another person, could readily amount to passing off under the common law.

The Complainant therefore claims to have justifiable and justiciable rights under the common law in respect of its name and trade mark FLUOR viz rights that can be enforced against others who infringe such rights. This also provides the Complainant with the necessary locus standi to bring this dispute.

The Adjudicator therefore finds that the Complainant has proved, on a balance of probabilities, that it has both registered trade mark rights for FLUOR, and unregistered rights (namely common law rights in its reputation and goodwill) in the name and trademark FLUOR.

#### **NAME OR MARK IDENTICAL OR SIMILAR TO DOMAIN NAME**

The second element that the Adjudicator needs to establish is whether, on a balance of probabilities, the Complainant has proved that its name or mark, in which it has rights as set out above, is identical or similar to the disputed

domain name.

The Complainant asserts that the disputed domain name is confusingly similar to its name and mark FLUOR.

The Complainant's name or mark (in which it has rights) is FLUOR, while the disputed domain name is fluor.co.za.

If one ignored the suffix .co.za, the names are identical.

The word FLUOR is not generic or descriptive.

The Complainant has acquired substantial rights in the word FLUOR which predate the registration of the disputed domain name by more than 40 years.

Accordingly the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that its name and mark FLUOR is similar to the disputed domain name.

#### **IS THE DOMAIN NAME AN ABUSIVE REGISTRATION?**

The third element that the Adjudicator needs to establish is whether, on a balance of probabilities, the domain name, in the hands of the Registrant, is an abusive registration.

The Complainant asserts that the disputed domain name is an abusive registration. This means that the Adjudicator needs to determine whether the disputed domain name is an abusive registration as defined in the definition section of the Regulations namely in Regulation 1, and as set out above.

According to the definition, and to various Nominet decisions, there are two potential abuses (or two types of abuse) namely:

a) Registration with an abusive intent; and/or

b) Use in an abusive manner.

The Adjudicator refers to DRS 02464 (Aldershot Car spares v Gordon); and to DRS 00658 (Chivas Brothers Ltd v David William Plenderleith) in which the Expert found that: “Where a Respondent registered a domain name

- 1) which is identical to a name in which the complainant has rights;
- 2) where that name is exclusively referable to the complainant;
- 3) Where there is no obvious justification for the Respondent having that name for the domain name;
- 4) Where the Respondent has come forward with no (reasonable) explanation for having selected the domain name; it will ordinarily be reasonable for an expert to infer first that the Respondent registered the domain name for a purpose and secondly that such purpose was abusive.”

Regulations 4 and 5 provide a list of (non-exhaustive) factors which may indicate that the disputed domain name is, or is not, an abusive registration, respectively.

The Complainant has asserted some of these factors that will be discussed below namely:

- aa) That the Registrant has registered the disputed domain name in a manner, at the time when the registration took place, that took unfair advantage of or was unfairly detrimental to the rights of the Complainant;
- bb) That the domain name has been used in a manner which has taken unfair advantage of the rights of the Complainant.

The registration of the trade marks of the Complainant predate the registration of the disputed domain name by more than 40 years.

The disputed domain name is, save for the suffix .co.za, identical to the registered trademark FLUOR of the Complainant.

The registration of the disputed domain name blocks the Complainant from

registering a domain name that is identical to its registered trade mark FLUOR.

The Registrant is not commonly known by the disputed domain name.

The disputed domain name is likely to cause confusion in the minds of reasonable users of the internet.

Taking all the above factors into account, the Adjudicator finds, on a balance of probabilities, that the disputed domain name is an abusive registration.

## 5. Decision

- 5.1 Taking all of the above into consideration, the Adjudicator, in terms of the provisions of Regulation 9, orders that the disputed domain name <fluor.co.za> be transferred to the Complainant.

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**VICTOR WILLIAMS**

SAIPL SENIOR ADJUDICATOR

[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)