

Decision

ZA2014-0191

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-0191
DECISION DATE:	8 February 2015
DOMAIN NAME	GAME-TRADERSA.CO.ZA
THE DOMAIN NAME REGISTRANT:	Willie Viljoen
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Hendrik Petrus Hermanus Pistorius
COMPLAINANT'S LEGAL COUNSEL:	Advocate P A Jonker
2 nd 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 "SAI IPL") on **10 December 2014**. On **11 December 2014**, the SAI IPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **11 December 2014**. UniForum SA confirmed that the domain name had indeed been suspended. The SAI IPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAI IPL's Supplementary Procedure.
- b) In accordance with the Regulations, the SAI IPL formally notified the Registrant of the commencement of the Dispute on **17 December 2014**. In accordance with the Regulations the due date for the Registrant's Response was **19 January 2015**. The Registrant did not submit any response, and accordingly, the SAI IPL notified the Registrant of its default on **20 January 2015**.
- c) The SAI IPL appointed **Deon Bouwer** as the Adjudicator in this matter on **26 January 2015**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAI IPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

- 2.1 The Complainant registered the gametradersa.co.za domain on 21 October 2014.
- 2.2 The Registrant registered the game-tradersa.co.za domain ("Disputed Domain Name") on 10 November 2014.
- 2.3 The Complainant and the Registrant both use their respective domain names to promote and conduct game sales online.

- 2.4 The Complainant was aware that, by 13 November 2014, the Registrant had been using the Game Trader SA name, including on Facebook, to promote its services and that the Registrant had registered the Disputed Domain Name.
- 2.5 On 13 November 2014, the Complainant called upon the Registrant to change the Disputed Domain Name, which the Registrant refused to do.
- 2.6 The Complainant now objects to the registration of the Disputed Domain Name.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant submits that the Disputed Domain Name is an abusive registration.
- b) The Complainant further submits, by implication at least, that it holds common law trade mark rights to the GAME TRADER SA name and that its rights, predate the rights of the Registrant.
- c) The Complainant also submits that the following renders the Disputed Domain Name abusive:
- i. registration of the Disputed Domain Name has, unfairly, disrupted the business of the Complainant;
 - ii. registration of the Disputed Domain Name will have the effect of routing internet traffic which would have come to the Complainant's website www.gametradersa.co.za;
 - iii. registration of the Disputed Domain Name restricts the exercise of the rights established by the Complainant; and
 - iv. the Registrant is mis-representing the services which it offers through the website www.game-tradersa.co.za as those offered by the Complainant.

- d) The Complainant further contends that the Registrant's actions amount to unlawful competition and passing-off. It also contends that it holds "rights" in the GAME TRADER SA name by virtue of the gametradersa.co.za domain registration and that these "rights" are sufficient for the Complainant to object to the registration of the Disputed Domain Name.

3.2 Registrant

- a) The Registrant did not respond to the Complainant's contentions in the manner provided for in the Regulations, but did make certain submissions after the deadline within which to submit a Reply to the Complaint. As these submissions do not comply with the Regulations, they are not taken into account, presently.

4 Discussion and Findings

- a) The Registrant did not submit any response to the Complaint and the Adjudicator must therefore accept *prima facie* the veracity of the Complainant's allegations. The Adjudicator must, however, analyse the Complainant's version in order to satisfy himself that the allegations contained in the Complaint are acceptable and probably true (see ZA2007/0010 Multichoice Subscriber Management vs J P Botha and ZA2012/0117 Antonie Goosen vs SARS).
- b) Regulation 3(1)(a) requires a Complainant to prove the following elements on a balance of probabilities in order for the Disputed Domain Name to be transferred, namely that:
- i) The Complainant has established rights in respect of a name or mark which is identical or similar to the Disputed Domain Name; or
 - ii) In the hands of the Registrant, the Disputed Domain Name is an abusive registration.

- c) Regulation 1 defines “rights” and “registered rights” to “include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law, but are not limited thereto”.
- d) The above 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 common law trade mark rights. Such rights must, however, find recognition in law (see ZA2007-0008 privatesale.co.za).

4.1 Complainant's Rights

- 4.1.1 The Disputed Domain Name is, for all intents and purposes, identical to the Complainant’s domain gametradersa.co.za and the GAME TRADER SA name.
- 4.1.2 It is further clear from the evidence submitted by the Complainant that the Complainant does not hold any statutory trade mark right in the GAME TRADER SA name or gametradersa.co.za domain.
- 4.1.3 The Complainant did not to submit any evidence illustrating that it had used the GAME TRADER SA name or gametradersa.co.za domain prior to the date on which the Registrant registered the Disputed Domain Name i.e. 10 November 2014, or, 13 November 2014, the date by which the Complainant, on its own version, was already aware of the Registrant’s use of the GAME TRADER SA name and the Disputed Domain Name. In fact, the Complainant does not even allege that it had used the GAME TRADER SA name or gametradersa.co.za domain prior to the date on which the Registrant registered the Disputed Domain Name i.e. 10 November 2014, or the date on which it first became aware of the Registrant’s use of the GAME TRADE SA name i.e. 13 November 2014. It is also not clear when the Complainant commenced use of the GAME TRADER SA

name and/or gametradersa.co.za domain.

- 4.1.4 It is trite in trade mark law that a mark which is purely descriptive cannot be registered as a trade mark unless such a mark has been used to such an extent that, as a matter of fact, the mark has acquired a "secondary meaning", that is, have become capable of distinguishing the goods or services of the proprietor (see, for instance, Truck and Car Co Limited vs Kar-N-Truck Auctions 1954 (4) SA 552 (A), Capital Estate and General Agencies (Pty) Limited and Others vs Holiday Inns Inc. and Others 1977 (2) SA 916 (A), Van der Walt vs Humansdorp Marketing CC 1993 (4) SA 779 (SE), Judy's Pride Fashions (Pty) Limited vs Registrar of Trade Marks 1997 (2) SA 87 (T), Peregrine Group (Pty) Limited and Others vs Peregrine Holdings Ltd and Others 2000 (1) SA 187 (W), ZA2007-001 mrplastic.co.za and ZA2007-0005 whitepages.co.za).
- 4.1.5 The Supreme Court of Appeal in the Bergkelder case (supra) held that the mere use and a reputation does not necessarily equate with distinctiveness of a trade mark as it must be shown that the consequence of the use and reputation is that the name or mark has acquired a "secondary meaning" which, as a matter of fact, denotes one trader and no other. To get over this hurdle, cogent and extensive evidence is required, including details of the use of the trade mark, sales figures, the extent and size of the business, supporting evidence from members of the public or the trade and the like.
- 4.1.6 Turning to the GAME TRADER SA name, the name comprises two words both of which describe aspects of the relevant business as well as the abbreviation SA. There is very little, if any, unusual or inventive about the name which, inherently, gives it a degree of capability of distinguishing the Complainant's business or website

from those of others. Exactly the same considerations apply, of course, to the Disputed Domain Name.

- 4.1.7 Bearing in mind the legal requirements briefly summarised above, can it be said that the Complainant has put forward evidence to establish that it has trade mark rights in the GAME TRADER SA name? In the absence of any evidence to the contrary, it must be accepted, not only, that the Complainant did not use the GAME TRADER SA name prior to the date on which the Disputed Domain Name was registered and/or the Registrant first used the GAME TRADERS SA name (and therefore did not establish any reputation or goodwill in the GAME TRADER SA name), but also that the GAME TRADER SA name has not become capable of distinguishing the services of the Complainant from those of its competitors through use of the name.
- 4.1.8 In view of the above, the Adjudicator finds that the Complainant holds no common law or statutory trade mark right on which it can rely in support of the Complaint, presently.
- 4.1.9 The question next arises as to whether the Complainant has established the existence of any other legally recognised right, for instance, of a commercial or other nature which might bring it within the scope of the requirements of Regulation 3(1)(a). If so, has the Registrant acted unfairly in relation to it?
- 4.1.10 Commercial or personal rights which the Complainant may have, obviously, include, inter alia, the right to trade freely without unlawful interference or competition from anyone.
- 4.1.11 The Complainant submits that by virtue of his gametradersa.co.za domain registration, he holds rights to the name GAME TRADER SA, and that these rights are, based on the "*legal principle*" *qui prior est tempore poter est iure*, stronger than the "rights" which result from

the Registrant's registration of the Disputed Domain Name, some 20 days after the registration of the Complainant's gametradersa.co.za domain.

- 4.1.12 The grounds on which a party may rely upon to object to the registration of a domain name are specific and set out in Regulation 3 and the rights in a name which the complainant is required to prove to succeed with a complaint, are set out in the definition of "rights" and "registered rights". The aforementioned leaves no doubt that a registrant is required to submit evidence confirming the nature of the intellectual property rights, commercial, cultural, linguistic, religious and/or personal rights which it enjoys, which evidence must also prove that the complainant *"has rights in respect of a name or mark which is identical or similar to the domain name"*. The aforementioned also leaves no doubt that something more than a mere registration of a domain name is required for the purpose of proving rights in a name, especially, where a name is purely descriptive or generic.
- 4.1.13 The Adjudicator, accordingly, finds that the gametradersa.co.za domain registration, on its own, does not provide the Complainant with any relevant right in the name GAME TRADER SA which will assist the Complainant to object to the registration of the Disputed Domain Name.
- 4.1.14 The Adjudicator further finds that there is no evidence which support the allegation that the Registrant is *"mis-representing the services offered through www.game-tradersa.co.za as those offered by the Complainant"* or that the Registrant has copied the *"way in which the Complainant marketed their website"*. If anything, the evidence on which the Complainant relies suggests that, rather than attempting to confuse consumers, the Registrant is, pertinently, advising consumers to be aware of the two competing parties and distinguish

between the services of the Registrant and the Complainant. In any event, the Complainant holds no right to the GAME TRADER SA name.

4.15 Finally, in the absence of evidence confirming that the Complainant had used the GAME TRADER SA name or the gametradersa.co.za domain prior to the Registrant, there is no support for the Complainant's submissions that the Registrant must have been aware of the services which the Complainant rendered under the GAME TRADER SA name prior to the Registrant commencing use of this name and registering the Disputed Domain Name and that the Registrant registered the Disputed Domain Name to, unfairly, disrupt *"the operations of the Complainant's website"*.

4.2 **Abusive Registration**

4.2.1 In view of what is set out above, and on a balance of probabilities, the Adjudicator finds that the Complainant failed to prove that it holds any relevant right to the name GAME TRADER SA. As such, the Complainant's objection on the basis that the Disputed Domain Name constitutes an abusive registration, must fail.

5. **Decision**

5.1 For all the foregoing reasons, the Dispute is refused.

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DEON BOUWER
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za