

Decision

ZA2014-0188

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-0188
DECISION DATE:	9 December 2014
DOMAIN NAME	LIFECAREMEDIC.CO.ZA
THE DOMAIN NAME REGISTRANT:	Webmail International (Pty) Limited
REGISTRANT'S LEGAL COUNSEL:	None
THE COMPLAINANT:	Life Healthcare Group (Pty) Limited
COMPLAINANT'S LEGAL COUNSEL:	Edward Nathan Sonnenbergs, Sandton
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 "SAIIPL") on **7 October 2014**. On **8 October 2014** the SAIIPL transmitted by email to ZA Central Registry a request for the registry to suspend the domain name(s) at issue, and on **10 October 2014** ZACR confirmed that the domain name had indeed been suspended. The SAIIPL 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 SAIIPL's Supplementary Procedure.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **13 October 2014**. In accordance with the Regulations the due date for the Registrant's Response was **10 November 2014**. The Registrant did not submit any response, and accordingly, the SAIIPL notified the Registrant of its default on **11 November 2014**. The Registrant failed to submit a Response thereafter.
- c) In the absence of a response from the Registrant, the Complainant did not submit any reply.
- d) The SAIIPL appointed **Mr Andre van der Merwe** as the Adjudicator in this matter on **24 November 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.
- e) In the Adjudicator's Statement of Acceptance and Impartiality he disclosed to the Administrator that his law firm had acted for and against a company

that appears to be related to the Complainant. This disclosure and conditional acceptance statement was transmitted to both parties, inviting them to object to his appointment within 3 (three) days, failing which it would be assumed that they have no objections to the appointment of the Adjudicator. Neither of the parties lodged any objection, and the Adjudicator was therefore duly appointed.

2 Factual Background

- 2.1 The Complainant is the proprietor of 8 trademark registrations in classes 5, 10, 16, and 44 dating from 2003, and 5 trademark registrations dating from 2011 in the same classes, that variously include the words LIFE, HEALTH and CARE in either a word form or a logo/device form. Its trademark portfolio includes about 13 trademark applications for the word-device LIFE and other LIFE HEALTHCARE trademarks in these classes. The specifications of services of the class 44 registrations and applications include “medical services” or medical and healthcare services” The above registrations are in full force and effect.
- 2.2 The Complainant and its predecessor in title have operated hospitals in South Africa for more than 25 years. In 2005 its predecessor in title changed its name from AFROX HEALTHCARE to LIFE HEALTHCARE and it has been using the LIFE and LIFE HEALTHCARE name and trademarks since that date.
- 2.3 Presently the Complainant has an extensive hospital network In South Africa that includes 63 hospitals. These include high technology, multi-disciplinary hospitals, community hospitals, and specialized stand-alone facilities to provide a broad spectrum of medical services. These services include services relating to traditional hospital services, rehabilitation, mental health,

renal dialysis, frail care, and other specialist medical and health services. The Complainant has used its above name and trademarks extensively, including a colour combination of red and blue lettering, in respect of these services.

- 2.4 The Complainant had registered its domain name <lifehealthcare.co.za> on 6 September 2004.
- 2.5 The Complainant's LIFE name and trademark was recently listed by Brand Finance as one of South Africa's top 40 brands by brand value.
- 2.6 On 11 March 2013, the Registrant registered the disputed domain name <lifecaremedic.co.za>
- 2.7 The Registrant and Life Care Medics, on the website hosted at the disputed domain name, offers services relating to ambulance services, emergency medical support services at events, and first aid kits.
- 2.8 On 15 April 2013 the Complainant's attorneys addressed a letter of demand to Life Care Medics, the entity whose company website is hosted at the disputed domain name, calling on them to cease any and all use of their trademark LIFE CARE, including use of their red and blue lettering, in relation to ambulances and related services, including in respect of the disputed domain name and its corresponding website. On 11 June Life Care Medics wrote to the Complainant's attorneys advising that it was in the process of rebranding and changing its company name to one that is not confusingly similar to the Complainant's name and trademarks. To date, however, no such change or changes have been made in spite of the above indication that it would change these. Hence the Complainant has lodged the present dispute.

Parties' Contentions

3.1 Complainant

- a) The Complainant contends that it has registered rights iro its name and trademarks LIFE, HEALTH and CARE (in various forms and combinations), and that Life Care Medics is infringing such registered rights by using the disputed domain name, in terms of the Trademarks Act.
- b) The Complainant contends (in its latter of demand) that, through extensive use of its name and trademarks, it has developed a reputation and hence it also enjoys common law rights, and that Life Care Medics is passing off its services as being associated with the Complainant.
- c) The Complainant further contends that its name and trademarks have acquired the status of well-known trademarks in terms of the Trademarks Act.
- d) The Complainant contends that the disputed domain name is confusingly similar to the Complainant's trademarks.
- e) Accordingly the Complainant contends that the disputed domain name was registered in bad faith and is an abusive domain name in the hands of the Registrant as an agent for/of Life Care Medics.

3.2 Registrant

- a) The Respondent did not respond 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 viz:
- 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 the definition section viz 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.

SUBSTANTIVE ASPECTS

Turning to the substantive aspects of this complaint, the Adjudicator has carefully perused the Complaint filed herein and fully considered the facts and contentions set out therein (as well as the lack of response from the Registrant).

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 by the appeal decisions in [seido.co.za](#) (ZA2009-0030) and [xnets.co.za](#) (ZA2011-0077), the notion of “rights” for the purposes of

Regulation 3(1)(a) is not trammelled by trademark 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/trademarks LIFE and LIFECARE. The Complainant claims that it does enjoy such rights.

A NAME OR MARK?

The first part of the present enquiry is to determine whether the Complainant has *locus standi* in the sense 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?

The first element that the Adjudicator needs to determine is whether, on a balance of probabilities, the Complainant has rights in respect of the name/trademarks LIFE and LIFE HEALTHCARE and LIFE HEALTH AND/ CARE. The Complainant contends that it has such rights.

Firstly, under statute law, the Complainant has shown, as set out above, that it is the proprietor of registered rights in respect of the above trademarks that date back to 2003. These trademarks were registered prior to the date of registration of the disputed domain name registration viz 2013, and such trademark registrations are in force and are *prima facie* valid and enforceable.

This clearly provides the Complainant with enforceable rights in terms of section 34 of the Trade Marks Act no 194 of 1993. Infringement would take place in terms of that section if a person used a mark, without authority, which is identical or similar to the above registered trademarks in respect of

the services for which the trademarks are registered, such as medical or healthcare services. Hence the Complainant has validly claimed the aforementioned registered rights in South Africa.

In support of the above see the textbook Webster and Page: South African Law of Trade Marks, Fourth Edition, paragraphs 12.5 and 12.6, and the South African and foreign decided cases cited therein.

Whether the Complainant's name and trademarks have assumed the status of well-known trademarks in terms of the Trade Marks Act, as alleged by the Complainant, is an open question. This may well be the case. However, in the Adjudicator's view not sufficient evidence has been submitted to support this contention. *In casu* the Adjudicator in any event does not need to make a finding in this regard.

Secondly, under common law in South Africa, the Complainant asserts that, by virtue of extensive use and promotion of its name and trademarks set out above in South Africa, it has developed a considerable repute or reputation therein, as an asset of its business in South Africa. In fact it claims that its name and trademarks are well known in South Africa.

Such reputation, or more particularly goodwill stemming from that reputation, in respect of its name and trademarks, 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, or part of, the Complainant and its business.

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 trademarks viz rights that can be enforced against others who infringe or would be likely to damage such rights.

In support of the above, see ZA2007-0003 at page 9; and the textbook

Webster and Page *op cit*, at paragraphs 15.5 and 15.7 and the South African and foreign decided cases cited therein.

The Adjudicator therefore finds that the Complainant has proved, on a balance of probabilities, that it has both registered trademark rights and unregistered rights viz common law rights in respect of its name and trademarks as set out above. Hence the Complainant has also established that it has the necessary *locus standi* to bring this Complaint.

NAME OR MARKS IDENTICAL OR SIMILAR TO DOMAIN NAME?

The second element that the Adjudicator needs to determine is whether, on a balance of probabilities, the Complainant has proved that its name and trademarks, in which it has rights as set out above, are identical or similar to the (disputed) domain name. The Complainant asserts that the disputed domain name is similar to its name and trademarks as set out above.

The Complainant's trademarks (in which it has rights) are LIFE and LIFE HEALTHCARE, and LIFE AND HEALTH AND/& CARE while the disputed domain name is lifecaremedic.co.za.

Firstly, the Complainant's registered trademark LIFE is incorporated in its entirety within the disputed domain name. Secondly, ignoring the word "medic" in the disputed domain name, which is purely descriptive or generic, the remaining words are "life" and "care" which form a prominent part of the Complainant's name and registered trademarks. Because of the above and their common elements there appears to be an overall similarity between the respective trademarks and the domain name.

See for example the decisions WIPO/D2000-1598 in which niketravel and nikesportstravel were found to be similar to NIKE; DRS04601 in which nikestore was found to be similar to NIKE; and DRS01493 in which nokia-ringtones was found to be similar to NOKIA.

See also the following South African domain name decisions – in ZA2007-0003 telkommedia was found to be similar to TELKOM; in ZA2007-0010 mwebsearch was found to be similar to MWEB; in ZA2008-0025 suncityshuttle was found to be similar to SUN CITY; in ZA2009-0034 absapremiership was found to be similar to ABSA; in ZA2010-0048 etravelmag was found to be similar to ETRAVEL; and in ZA2013-00149 autotraderauction was found to be similar to AUTOTRADER.

Accordingly the Adjudicator finds that the Complainant has proved, on a balance of probabilities, that its name and trademarks as set out above are similar to the disputed domain name.

IS THE DOMAIN NAME AN ABUSIVE REGISTRATION?

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

The Adjudicator is required to determine whether the disputed domain name is an abusive registration as defined in the definition section of the Regulations viz 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) viz:

- a) Registration with an abusive intent; and/or
- b) Use in an abusive manner.

Although not on all fours with the present complaint, 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; and

- 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.”*

See also ZA2007-007 (FIFA v X Yin) in this regard. The Adjudicator concurs with the view that the nature of “abusive” in the Regulations does not necessarily require a positive intention to abuse the Complainant’s rights but that such abuse is the effect or consequence of the registration or use of the disputed domain name.

Regulations 4 and 5 provide a list of (non-exhaustive) factors which may indicate that a disputed domain name is, or is not, respectively, an abusive registration. More particularly, Regulation 4 lists circumstances that indicate that the Registrant has registered the disputed domain names primarily to achieve certain objectives. The Complainant has for the record listed all these factors or circumstances which indicate that the Registrant has registered or otherwise acquired the (disputed) domain name primarily to –

- (i) Block intentionally the registration of a name or mark in which the Complainant has rights;
- (ii) Disrupt unfairly the business of the Complainant;
- (iii) Prevent the Complainant from exercising his/her or its rights; and/or
- (iv) Circumstances indicating that that the Registrant is using, or has registered, the (disputed) domain name in a way that leads people or businesses to believe that the (disputed) domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

The Complainant has not motivated all the above factors but has submitted argument in respect of the last-mentioned factor only. The Complainant has

shown that it has significant rights in and to its name and trademarks that date from 2003. These rights must have been known to the Registrant and to Life Care Medics prior to 2013 when the Registrant registered the disputed domain name. In view of the above factors and facts, the Complainant therefore submits that registration of the disputed domain name was done in bad faith. In support thereof, the Complainant cites the decided WIPO case D2005-0866 Encyclopedia Britannica v LaPorte Holdings in which it was found that the registration and use of domain names “so obviously connected with such a well-known product ... by someone with no connection with the product suggests opportunistic bad faith.”

As set out above, the Complainant’s name and trademarks are distinctive of the Complainant. The disputed domain name is confusingly similar to the Complainant’s name and trademarks, and by using it to offer medical and related services, when there is no connection with or to the Complainant, indicates further that the disputed domain name was registered in bad faith. In addition, the Registrant, through Life Care Medics, has sought to somehow connect or associate itself with the Complainant and/or its business, which is in fact not the case.

The Complainant asserts that, because of the extensive reputation of its name and trademarks, it is highly likely that people and/or businesses will be confused and will believe that the disputed domain name is somehow associated or linked with the Complainant.

Such unauthorized use of the (similar) disputed domain name by the Registrant, or by Life Care Medics, in view of the statutory and common law rights of the Complainant, amounts respectively to trademark infringement and to passing off (under the common law) by the Registrant.

In this regard, it should also be mentioned that a plaintiff in infringement and passing off proceedings does not have to show actual damages suffered but it will be sufficient to show a likelihood of confusion or deception, and hence likely damages, or prejudice to its reputation or goodwill. See Webster and Page *supra*.

The Complainant has contended, and this is accepted in the circumstances of this Dispute by the Adjudicator, as set out in the discussion dealing with passing off above, that use by the Registrant of the disputed domain name will mislead and deceive consumers in to believing or thinking that there is some connection or association between the disputed domain name and the Complainant and its business, which is not the case. See the relevant above-cited South African and foreign decided domain name cases in this regard.

Hence the Adjudicator comes to the conclusion that this is a real and present factor in this dispute, and that this factor indicates that the domain name is an abusive registration.

4.2 Abusive Registration

4.2.1 Accordingly the Adjudicator finds, on a balance of probabilities, 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; and/or

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

5. Decision

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

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Andre van der Merwe
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za