

## Decision

**[ZA2016-0233]**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2016-0233</b>
DECISION DATE:	<b>20 May 2016</b>
DOMAIN NAME	<b>sasolholdings.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Gregory Walker</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>SASOL LIMITED</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Daniel Greenberg - Lexsynergy</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA)</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **30 March 2016**. On **30 March 2016** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name(s) at issue, and on **31 March 2016** the ZACR confirmed that the domain name had indeed been suspended. 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 **5 April 2016**. In accordance with the Regulations the due date for the Registrant’s Response was **5 May 2016**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **6 May 2016**.
- c) The SAIPL appointed **Mike du Toit** as the Adjudicator in this matter on **9 May 2016**. 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 an international petroleum, chemical, mining and technology company that was formed in 1950 under the name South African Coal, Oil and Gas Corporation Limited, later adopting the invented acronym SASOL. The complainant was registered as a public company under the name SASOL LIMITED on 25 June 1979. It conducts business in over 149 countries worldwide, specialising in the manufacture and supply of chemicals, fuels and oils. In addition, it has numerous petrol station franchises across South Africa. The Complainant's head office is situated in Johannesburg, Rosebank, South Africa.

- 2.2 The Complainant has filed the SASOL word mark and stylized mark in over 149 countries worldwide, including but not limited to Botswana, Canada, China, Egypt, France, Germany, Hong Kong, Japan, Lesotho, Malaysia, Namibia, Nigeria, South Africa, Swaziland, United States, Australia, New Zealand, United Kingdom and Zimbabwe. One of the Complainant's earliest trademarks is UK trade mark 746664 dated 5 October 1955 for the word mark SASOL in class 4 "All goods listed in class 4". The Complainant has set-up offices in North America, Italy, Germany, Netherlands, China, Spain, United Kingdom, France, Japan, Poland, Qatar, Slovakia, Belgium, Malaysia, New Zealand, United Arab Emirates and South America.
- 2.3 The Complainant has also registered over 1,750 domain names that are identical or incorporate its SASOL trademark. The Complainant registered <sasol.com> on 4 March 1996 and <sasol.co.za> (South African ccTLD) on 1 January 1995. The Complainant has also registered the domain names <sasol.net> (2 May 2002), <sasol.org> (2 May 2002), <sasol.info> (11 October 2001) and <sasol.biz> (12 November 2001). The Complainant launched its website <www.sasol.co.za> on 28 December 1996 and <www.sasol.com> on 23 December 1996. The Complainant's main website <www.sasol.com> generates a large number of visits per year and in 2015 alone it had over 91 000 000 visitors from across the world.
- 2.4 In 2014, the Complainant's turnover was R202 million (A correct reading of the financial statements reveals a turnover of R 202.6 billion- Adjudicator). Between 2003 and 2014 the Complainant spent approximately R 54 553 million on marketing. The Complainant's website is ranked as the top result on the search engines Google.com and Yahoo.com for the search term SASOL. The Complainant has generated extensive press coverage.
- 2.5 The Disputed Domain Name was registered on 20 August 2015 and as of 27 November 2015, this website directed to a server error page.
- 2.6 On 30 November 2015 the Complainant's representative sent a cease and desist email to which no response was received. On 8 December 2015, the

Complainant's representative sent a chaser email, to which also no response was received.

### 3 Parties' Contentions

#### 3.1 Complainant

a) **The domain name is identical or similar to a name or mark in which the Complainant has rights. Regulation 3(1) (a)**

The Disputed Domain Name is similar to the Complainant's "SASOL" trade mark. The Complainant relies on its registered trademarks and common law rights. The dominant and distinctive part of the Disputed Domain Name is SASOL. The suffix "holdings" is a word that describes a holding company. A holding company is usually created to buy and own the shares of other companies, which it then controls. The word "holdings" does not add distinctiveness to the Disputed Domain Name but, in fact, adds to the confusion that the Registrant is the Complainant and/or a holding company of the Complainant.

The Complainant has successfully established its trade mark rights in thirteen UDRP.

The Complainant avers that the Disputed Domain Name is similar to a trade mark in which the Complainant has rights.

b) **The domain name in the hands of the Registrant is an abusive registration, Regulation 3(1) (a).**

The Disputed Domain Name is an abusive registration because it was registered in a manner that, at the time the registration took place, took unfair advantage of and was unfairly detrimental to the Complainant's rights and because it has been used in a manner that takes unfair advantage of and is unfairly detrimental to the Complainant's rights.

The Registrant could only have registered the Disputed Domain Name to disrupt the Complainant's business. Furthermore, it prevents the Complainant from using the domain name for its own legitimate business use.

The Complainant contends that the Registrant's only true interest in the Disputed Domain Name is:

- to disrupt the Complainant's business;
- to cause confusion in the mind of people and/or businesses (including the Complainant's clients and/or potential clients) into believing that the Disputed Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant; and
- Is to maliciously prevent the Complainant from using the domain name for a legitimate business purpose.
- Is to use the confusion described above to potentially profit from fraudulent acts.

The Complainant's registered trade mark rights predate the Disputed Domain Name by at least 65 years.

- c) In the circumstances, the Complainant submits that they have shown on a balance of probabilities that the Complainant has rights in a trade mark which is similar to the Disputed domain name.

### **3.2 Registrant**

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

## **4 Discussion and Findings**

### **4.1 The domain name is identical or similar to a name or mark in which the Complainant has rights. Regulation 3(1) (a)**

#### **4.1.1 Complainant's Rights**

The domain name is identical or similar to a name or mark in which the Complainant has rights. Regulation 3(1) (a)

The Complainant has proven extensive registered rights in its SASOL trademark, not only in South Africa, but also worldwide. In addition, it has proven extensive common law rights in its trademark SASOL.

The registered rights pre-date the date of registration by at least 65 years.

The Disputed Domain Name wholly incorporates the SASOL trademark of the Complainant. The dominant and distinctive part of the Disputed Domain Name is SASOL. The suffix "holdings" is a word that describes a holding company. A holding company is usually created to buy and own the shares of other companies, which it then controls. The word "holdings" does not add distinctiveness to the Disputed Domain Name but, in fact, adds to the confusion.

See **Dr. Ing. h.c. F. Porsche AG v. Vasilij Terkin, 02003-0888 (WIPO January 6, 2004)** finding that:

*"In numerous cases, it has been held that a domain name that wholly incorporates a Complainant's registered mark may be sufficient to establish confusing similarity for purposes of the UDRP. The Panel further agrees with Complainant's contention that such descriptive component added to Complainant's trademark even adds to the confusion by leading users to believe that Complainant operates the web site associated to the disputed domain name ... "*

See **Telkom SA Limited v Cool Ideas 1290 CC SAIPL ZA2007-0003 (July, 13 2007)** finding that:

*"It appears to the Adjudicator that the disputed domain name contains the Complainant's name and mark TELKOM in its entirety. This is undeniably the first and dominant feature of the domain name and is the feature well-known to the public. The Registrant has merely added a descriptive/generic word MEDIA to the distinctive TELKOM name/mark. The Registrant cannot escape the inevitable conclusion that the Complainant's name and mark TELKOM is similar to the Disputed domain name (and curiously that the Disputed domain is identical to the name of the Complainant's subsidiary, Telkom Media (Pty) Ltd)."*

This Adjudicator finds that the Complainant has established that the Complainant has rights in a trade mark which is similar to the Disputed Domain Name.

4.2 **The domain name in the hands of the Registrant is an abusive registration, Regulation 3(1) (a)**

The Disputed Domain Name is an abusive registration because it was registered in a manner that, at the time the registration took place, took unfair advantage of and was unfairly detrimental to the Complainant's rights.

The Registrant has made use of the Complainant's SASOL trade mark with the potential to create confusion by setting up email addresses from that the Disputed Domain Name such as info@sasolholdings.co.za. An email received from that email address would create the impression that the email is associated with, endorsed, authorized and/or is part of the Complainant's business, when it is clearly not.

**5. Decision**

- 5.1 This Adjudicator finds that the Complainant has shown, on a balance of probabilities, that the Complainant has rights in a trade mark which is similar to the Disputed Domain Name and that the domain name is an abusive registration in the hands of the Registrant. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name **sasolholdings.co.za**, be transferred to the Complainant.

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**Mike du Toit**

SAIIPL SENIOR ADJUDICATOR

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