

## Decision

**[ZA2014-0189]**

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

### ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-0189
DECISION DATE:	23 January 2015
DOMAIN NAME	sasollearnership.co.za sasolcareer.co.za
THE DOMAIN NAME REGISTRANT:	<b>JAMES SAI</b>
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	<b>SASOL LIMITED</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Lexsynergy Limited</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 **5 November 2014**. On **6 November 2014** 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 **6 November 2014** ZACR confirmed that the domain name had indeed been suspended. 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.
- b) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **7 November 2014**. In accordance with the Regulations the due date for the Registrant's Response was **5 December 2014**. The Registrant submitted its Response on **2 December 2014**. The SAIPL forwarded a copy of the Response to the Complainant on **4 December 2014**.
- c) In accordance with the Regulations the Complainant's Reply was submitted on **5 December 2015**.
- d) The SAIPL appointed **MIKE DU TOIT** as the Adjudicator in this matter on **18 December 2014**. 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 was formed in South Africa in 1950 and in 1979 was

registered as a public company. It is an international petroleum, chemical, mining and technology company that conducts business in over 149 countries worldwide, specialising in the manufacture and supply of chemicals fuels and oils. In 1953 it opened an office in Dusseldorf Germany and in 1982 listed on the NASDAQ Stock market and in 2003 moved over to the New York Stock Exchange.

- 2.2 It filed and registered the SASOL trademark in over 149 countries worldwide and the oldest registrations date back to 1964 in South Africa and 1955 in the UK. It registered over 700 domains that are identical or incorporate its SASOL trademark, such as sasol.com in 1996, sasol.co.za in 1995, sasol.net in 2002 sasol.org in 2002, sasol.info in 2001 and sasol.biz in 2001. The Complainant had 7 537 082 hits on its website in 2011, 8 400 999 in 2012 and 8 385 089 in 2013. Its website is ranked as the top result on the Google and Yahoo search engines for the term SASOL.
- 2.3 The complainant established regional companies and supporting businesses in 18 international countries. The total turnover for 2009-2012 was R 571 974 million. It spent R 40 728 million on marketing between 2003-2013.
- 2.4 On or about 8 January 2014 the Complainant discovered that the Registrant had registered the Disputed Domain Names which forwarded to a website comprising of affiliate advertising links to various job search service providers, which compete with the Complainant's learnership programme. Affiliate advertisement providers monetize direct navigation traffic on undeveloped domains allowing registrants to earn commission on a pay - per-click basis for directing traffic to advertisers' websites.
- 2.5 The Complainant directed a cease and desist letter to the Registrant but the Registrant disputed the basis of the complaint. The Complainant's attempt to

resolve the matter was not successful.

### **3 Parties' Contentions**

#### **3.1 Complainant**

- a) The Complainant relies on its registered rights and common law rights in the trademark SASOL. It alleges that it acquired a substantial reputation and goodwill in the SASOL mark. Any consumer would assume that any product or service being sold or offered including the word SASOL in the name, is associated with, endorsed or being supplied by the Complainant. It alleges that the disputed domains are similar to the SASOL trademark in that the dominant and distinctive part of the Disputed Domain Names is SASOL. The suffixes LEARNERSHIP and CAREER do not add to the distinctiveness, in fact adds to the confusion that the Registrant is the Complainant.
- b) The Complainant is also the registrant of the domain names sasollearnerships.com, sasolcareers.co.za and sasolcareers.com, all of which pre-date the registration of the Disputed Domain Names.
- c) The Complainant has successfully established its trademark rights in 11 previous UDRP complaints.
- d) The Complainant alleges to have established that the Disputed Domain Names are similar to a trademark in which the Complainant has rights and accordingly argues that the domain names in the hands of the Registrant are abusive registrations. The Complainant avers that the Registrant registered the Disputed Domain names in a manner that, at the time of registration, took unfair advantage of and

was unfairly detrimental to the Complainants rights.

- e) The Registrant's websites were set up exclusively for commercial gain by means of affiliate /sponsored links and advertising. It claims that at least one of the Registrant's websites purpose was to attract and profit from internet users seeking the Complainant's website. By using the Complainant's SASOL trademark the Registrant diverted traffic to its website intending to create confusion that the website is associated with, endorsed, authorised and/or being part of the Complainant's business.
- f) The contention is that the Registrant's only true interest in the Disputed Domain names is to benefit commercially from the unauthorised and illegitimate use of the Complainant's brand and goodwill in a way that has confused people and/or businesses into believing that the Disputed Domain Name is registered to, operated or authorised or otherwise connected with the Complainant.
- g) The Complainant alleges that the Registrant is engaged in a pattern of registering domain names that infringe upon the rights of trademark owners, to which the Registrant has no apparent rights.
- h) The Complainant submits that it has established on a balance of probabilities that it has rights in a trademark which is similar to the Disputed Domain Names and that these domain names are abusive registrations in the hands of the Registrant.

### 3.2 Registrant

- a) The Registrant contends that SASOL CAREER or SASOL LEARNERSHIP are not registered trademarks and that the

Complainant's rights in SASOL are with regard to goods in cl 4.

- b) The Disputed Domain Names are not competing in the same industry and accordingly there can be no infringement.
- c) The Registrant contends that the domain names were simply abbreviated to refer to the region of Sasolburg and to target audiences in the job industry in the Sasolburg area. The shortening of names of regions is a common practice and is informally used in everyday speech and writing. Examples such as Malaysia abbreviated as Malay, Britain for Great Britain, America for United States of America, hence SASOL for Sasolburg.
- d) Using the example of America the rock band, the Registrant argues that regional names can take different meanings and both can exist happily together.
- e) Transferring the domains would be an injustice to the people of Sasolburg because they would be deprived of opportunities which does not help with the high unemployment rates in South Africa.
- f) By disallowing the use of the disputed domains, the people of Sasolburg are denied the rights to opportunities that the people might not find elsewhere.

#### **4 Discussion and Findings**

- a) The Complainant filed a reply which I have ruled will be accepted. The content will be addressed in the following discussion.

##### **4.1 Complainant's Rights**

4.1.1 Complainant has rights in respect of a name or mark which is identical or similar to the domain names in dispute.

4.1.2 The Complainant proved extensive registered rights in the SASOL trademark in South Africa and in several countries across the world. The registration dates of these trademarks pre-date the registration date of the Disputed Domain Names by several decades. The Complainant also alleged and has proven extensive common law rights in the SASOL trademark, on a worldwide basis. The turnover figures, advertising spent, worldwide business presence all add to the proven reputation and goodwill. The Complainant relies on the decision of Drr.Ing.h.c.F Porsche AG v Vasily Terkin , D2003-0888(WIPO January 6. 2004. Applying the principles as laid down in this ruling, I find that the Disputed Domain Names wholly incorporate the registered and common law trademark of the Complainant. The addition of descriptors such as LEARNERSHIP and CAREER is insufficient to allay any deception or confusion.

4.1.3 The Complainant also proved rights in a number of domain which all incorporate the SASOL trademark and which all pre-date the registration of the Disputed Domain Names.

4.1.4 I accordingly find that the Complainant has established that the Disputed Domain names are similar to the SASOL trademark, whether registered or at common law.

## 4.2 Abusive Registration

4.2.1 The Disputed Domain names were registered in a manner which, at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights in that the

Complainant had at that time acquired registered and common law rights on an extensive international scale.

4.2.2 It has since been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights. The Registrant's use of the Complainant's SASOL trademark in and on its website was clearly only for commercial gain, exploiting the rights of the Complainant. It benefitted commercially from the unauthorised and illegitimate use of the Complainant's trademark in such a manner that will confuse people into believing that the Disputed Domain names are registered to or operated or authorised by or otherwise connected to the Complainant when it clearly was not.

4.2.3 The Registrant's response is disputed by the Complainant in its reply. It alleges that the Complainant's rights in its SASOL qualifies as a well-known trademark. It further contends that its trademark rights extend beyond cl 4 based on the fact that it is one of the largest employers in South Africa with a work force of approximately 34 000. This evidence was not submitted in the founding complaint and accordingly the Complainant cannot establish its case now in reply. I accordingly rule that this evidence is not admissible.

4.2.4 The Complainant describes the Registrant's examples of abbreviated names for as nonsensical. I agree. Following the argument of the Registrant, as highlighted by the Complainant, the domains sasolburgcareer.co.za and sasolburglearnership.co.za should have been the more sensible option. Once again, I agree. I find the arguments raised by the Registrant as disingenuous and is rejected. I find that the Disputed Domain Names are abusive in the hands of the Registrant and that the Complainant has proven on a balance of

probabilities that it has rights in the SASOL trademark

## 5. Decision

- 5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain names, sasolcareer.co.za and sasollearnership.co.za be transferred to the Complainant.

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**Mike du Toit**  
SAIIPL SENIOR ADJUDICATOR  
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