

Decision

[ZA2011-0064]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0064
DECISION DATE:	8 April 2011
DOMAIN NAME	Maxdupreez.co.za
THE DOMAIN NAME REGISTRANT:	N/A
THE DOMAIN NAME REGISTRANT:	Praag – Daniel Roodt
THE COMPLAINANT:	Mr Max Du Preez
THE COMPLAINANT'S LEGAL COUNSEL	Warren Weertman Bowman Gilfillan Attorneys
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **5 January 2011**. On **5 January 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **7 January 2011** UniForum SA 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 **13 January 2011**. In accordance with the Regulations the due date for the Registrant’s Response was **14 February 2011**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **14 February 2011**.
- c) The SAIPL appointed Charles Webster as the Adjudicator in this matter on **15 February 2011** and Herman Blignaut as Trainee Adjudicator on **17 February 2011** in this matter. The Adjudicators have submitted their Statements of Acceptance and Declarations of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.
- d) The Adjudicator had finalised but not yet formally submitted the ruling when an answer from the registrant was received on **1 March 2011**. The answer was filed out of time and does not comply with the procedural requirements.
- e) A reply was subsequently filed by the complainant on **23 March 2011**.

2 Factual Background

- a) Mr Max du Preez (hereinafter referred to as the Complainant) is the

founding editor of the Vrye Weekblad, was a former executive editor of the television programme Special Assignment on SABC 3, and currently writes for a number of South African newspapers.

- b) Mr Daniel Roodt has registered the domain names maxdupreez.co.za in the name of Praag- Daniel Roodt. Such registration was not authorised by the Complainant.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant alleges that he is a well known South African journalist and political commentator, and as such cannot conceive that the Registrant could have registered the offending domain name without having prior knowledge of the Complainant. The Complainant maintains that the Registrant is infringing upon his personality rights in terms of section 10 of the Constitution, which states that everyone has inherent dignity and the right to have their dignity respected and protected. The Complainant maintains that the Registrant's registration of the offending domain name constitutes a breach of the co.za agreement in terms of Clause 5.1.5 of the Registrant's domain name registration agreement which states that the Registrant, as Applicant for the domain name is not seeking to use the domain name for any unlawful purpose whatsoever, including, without limitation, unfair competition, defamation, passing off or for the purpose of confusing or misleading any person. The Complainant maintains that the Registrant's registration of the offending domain name is an abusive registration in terms of the ZADRR in that the Complainant has rights in respect of a name which is identical and/or similar to the offending domain name and that the offending domain name was registered in a manner which takes unfair advantage of or was unfairly detrimental to the Complainant's rights, and the use of the offending domain name is in a manner which takes unfair

advantage of or was unfairly detrimental to the Complainant's rights. Further, the Complainant maintains that the offending domain name was registered in bad faith in terms of the ICANN Uniform Dispute Resolution Policy in that the offending domain name is identical and/or confusingly similar to the Complainant's name and that the Registrant has no legitimate interest or right in and to the use of the offending domain name, and such use is a wilful and deliberate attempt to take unfair advantage of the Complainant's reputation or to disadvantage the Complainant by blocking his use of this domain name for furtherance of his business.

- b) In the reply the Complainant made it clear that he does not object to the domain name maxdupreezsucks.co.za.

3.2 Registrant

- a) The Registrant responded to the Complainant's contentions, but did not comply with the procedural requirements and the answer was filed out of time. Despite the aforementioned irregularities in the answer, the adjudicator considered the contents thereof. The Registrant submitted that, inter alia, the name "du Preez " is common, "max" is not distinctive and could be the abbreviation for several names and maxdupreez is not a trademark like Coca-Cola or Volkswagen and stressed that his use was non-commercial use. The Registrant also submitted that, as the Complainant does not have registered trade mark rights in his name, he consequently does not have rights in the Disputed Domain Name. A form of delay defence was also raised.

4 Discussion and Findings

- a) It is perhaps worthy of note that at the time of considering this complaint, there is no website linked to the domain name MAXDUPREEZ.CO.ZA. Any website that may previously have been accessible through this domain (or a

link that existed between them), which according to the complaint was for the general public to “post their ad hominem comments about the Complainant”, has been suspended. It is alleged that the majority of the comments which appeared on the website were defamatory of the Complainant. Whilst the Complainant fails to adduce evidence of such alleged defamation, this is not decisive on whether the complaint stands to succeed or be dismissed. What matters is that the Complainant’s (exact) name has been taken and registered without his permission.

- b) Of further significance is the fact that the Registrant seemingly wishes to obtain financial benefit from the Complainant in selling him his own name (this after the Complainant has explained to the Registrant in earlier correspondence his rights and title therein). The Registrant has indicated he will transfer the domain to the Complainant in return for payment in an amount of R10,000.00. This price is considerably higher than what the Complainant would have paid had he been the first to register the domain. The Registrant has also indicated that he is the proprietor of the domain MAXDUPREEZ.COM and that he is similarly agreeable to transferring this domain to the Complainant at a price to be negotiated. All of this suggests a lack of bona fides on the part of the Registrant and an intention to financially gain from these registrations despite the fact that they appear to have been registered to enable a platform for public debate on the Complainant. The registration of both domain names also suggests that the Registrant may have engaged in a pattern of making abusive registrations as contemplated by Section 4(1)(c).
- c) The Complainant has rights in respect of a name which is identical to the domain name in dispute. It is accepted that the Complainant’s name is well known. In addition to the rights which the Complainant’s name MAX DU PREEZ has acquired as trade mark, it is also worthy of protection as a personality item. The Complainant relies on his name to promote and sell his books. It is quite reasonable for him to want to promote himself and his publications through a website to be accessible under his name, e.g.

MAXDUPREEZ.CO.ZA. The Complainant equally has the right to protect his name from any confusion which may arise when the domain is used in relation to content which is harmful to his reputation.

- d) Whereas statutes (e.g. the Trade Marks Act, 1993) and public policy make it possible for a person to protect his name / trade mark, it naturally follows that not only can unauthorised persons be stopped from misappropriating such name / trade mark but also (and even more importantly) from using it in a manner causing the owner thereof harm.
- e) The Registrant has not indicated why he registered the domain. Certainly he could have used a myriad of other words or terms to achieve the desired result. Yet, he chose to register the Complainant's exact name presumably to obtain an unfair advantage therefrom, alternatively to cause detriment to the Complainant. To quote from the ruling in *Automobiles Citroën v Mark Garrod* (citroen.co.za / case number ZA2008-0014):

Furthermore, what of the following considerations? If the Registrant did want to convey to the web-browser his genuine tribute website, why could he "not, through the use of a few words, convey the true facts...."? The Registrant himself postulated <ilovecitroen.co.za> as a possibility for the domain name, but offers no explanation as to why this would not be appropriate. He instead avers that <citroen.co.za> "would be the best domain to pay tribute to the Complainant". The Adjudicator has difficulty understanding why, and it is not explained

Another corollary of the aforementioned principle is that, prima facie, a trade mark owner - at least, particularly a registered trade mark owner - ought to be able to register a domain name comprising his trade mark, and nothing but his trade mark. In the modern world of e-commerce, this is de rigeur. Why should a trade mark proprietor be held to ransom (metaphorically speaking) because he was not quick enough?

- f) Whilst the Complainant has not shown his name to be a registered trade mark in the Republic, it undeniable remains his mark which is equally protectable. I consider the following dicta from Knights Letting Ltd v Mr Lyndon Watkins (Nominet) DRS 4285 to lend support for the views set out above and my decision generally:

Registering as a domain name, the name of another (without any adornment), knowing it to be the name of that other and without the permission of that other is a high risk activity insofar as the DRS Policy is concerned. Ordinarily, it would be tantamount to impersonating the person whose name it is.

Rarely will it be the case that deliberate impersonation of this kind will be acceptable under the DRS Policy. Various decisions under the DRS Policy have condemned such practices including the following:

In the view of the majority of the Panel, in the context of a tribute site, the vice is in selecting a domain name, which is not one's own name, but which to one's knowledge is identical to the name of another, which one has selected precisely because it is the name of that other and for a purpose which is directly related to that other. For a tribute or criticism site, it is not necessary to select the precise name of the person to whom one wishes to pay tribute or criticise. In this case the domain name could have been 'ilovescoobydoo.co.uk', for example.

- g) In light of the above, I conclude that the domain 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 has been used in a manner that takes unfair

advantage of, or is unfairly detrimental to the Complainant's rights.

5. Decision

- a) For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, MAXDUPREEZ.CO.ZA, be transferred to the Complainant.

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CHARLES WEBSTER

SAIIPL SENIOR ADJUDICATOR

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