

Decision

[ZA2011-0076]

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

ADJUDICATOR DECISION

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| CASE NUMBER: | ZA2011-0076 |
| DECISION DATE: | 03 August 2011 |
| DOMAIN NAME | multilock.co.za & multlock.co.za |
| THE DOMAIN NAME REGISTRANT: | Multi Locking Siyavikela |
| REGISTRANT'S LEGAL COUNSEL: | Berdou Attorneys |
| THE COMPLAINANT: | Mul-T-Lock Limited |
| COMPLAINANT'S LEGAL COUNSEL: | Adams and Adams |
| 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 **20 May 2011**. On **27 May 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **27 May 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 **30 May 2011**. In accordance with the Regulations the due date for the Registrant's Response was **29 June 2011**. On **21 June 2011**, the Registrant requested an extension of the term within which to submit its Response and, on **29 June 2011**, the Registrant was advised that the new deadline for filing its Response was **14 July 2011**. On **29 June 2011**, Berdou Attorneys, the attorneys purportedly instructed by the Registrant to respond to the Complaint in this matter, sent correspondence to the attorneys representing the Complainant requesting a 30 day extension of time in this matter. On **11 July 2011**, this request was repeated. On **14 July 2011**, the attorneys representing the Complainant advised that the Complainant neither agreed to nor refused the extension of time, but would abide by the decision of the South African Institute of Intellectual Property Law in this regard. On **13 July 2011**, the Administrator advised the Registrant's attorney that it would request the Adjudicator to make a decision in this regard.
- c) The purpose of this type of proceeding is to obtain speedy justice. The Registrant was aware of the Complaint at least by 21 June 2011. Since that date, although extensions have been requested, more than one month has passed, and, accordingly, the Adjudicator finds that, if the Registrant had truly wished to respond to the Complaint, it would have done so in the period

provided therefore.

- d) The SAIPL appointed **Vanessa Lawrance** as the Adjudicator in this matter on **25 July 2011**. 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

- a) The Complainant is the proprietor worldwide of the trade mark MUL-T-LOCK, which is registered, inter alia, in South Africa.
- b) The Complainant claims to have acquired strong common law rights as a result of an extensive reputation that it has acquired through use of its MUL-T-LOCK in this country. It proceeds to claim that the MUL-T-LOCK trade mark qualifies as a well known trade mark as contemplated in Section 35 of the Trade Marks Act. As none of this evidence has been disputed, and reasonable substantiation has been submitted, the Adjudicator accepts it for purposes of this decision.
- c) The Registrant sells products emanating from the Complainant, but is not an officially appointed distributor.
- d) The Complainant and Registrant have had a history of conflict, the details of which are unimportant. What is important is that, during 2007, Mr Trousdale (in his personal capacity and in the capacity of member, director, manager or any other capacity) gave an undertaking to never again register any domain name that was confusingly similar to the Complainant's MUL-T-LOCK trade mark. Mr Trousdale is the party that first corresponded with SAIPL in respect of this domain name (requesting an extension).

3 Parties' Contentions

3.1 Complainant

- a) The Complainant submits that registration of the domain names multlock.co.za and multilock.co.za is in breach of the undertaking provided by Mr Trousdale in 2007.
- b) The Complainant submits that the disputed domain names were registered with a view, primarily, to intentionally block a name or mark in which the Complainant has rights.
- c) The Complainant further submits that the Registrant registered the disputed domain names primarily to disrupt unfairly the business of the Complainant.
- d) The Complainant proceeds to submit that the Registrant registered the disputed domain names primarily to prevent the Complainant from exercising its rights.
- e) The Complainant has also provided evidence of one instance of customer confusion which, it alleges, has resulted from the Registrant's unauthorised registration of the domain names complained about.

3.2 Registrant

- a) The Registrant has failed to provide a substantive response to the complaint.

4 Discussion and Findings

- a) In order to succeed in its complaint, the Complainant must prove that:
 - i) it has rights in respect of a name or mark;
 - ii) the domain name complained of is identical or similar to the name or mark in which the Complainant has rights; and
 - iii) the domain name is an abusive registration in the hands of the

Registrant.

4.1 Complainant's Rights

- a) It is accepted that the Complainant has rights in the trade mark MUL-T-LOCK, and, particularly, that the trade mark MUL-T-LOCK is well known.

4.2 Abusive Registration

- a) The domain names complained of are virtually identical to the MUL-T-LOCK trade mark of the Complainant.
- b) In the WIPO case D2000/0766 Red Bull GmbH v. Harold Gutch, to which the Adjudicator was referred, it was found that the mere registration of a domain name that contains the well known mark of another, is considered trade mark infringement, because it effectively prevents the trade mark owner from using its distinctive and well known mark in the corresponding domain name.
- c) Furthermore, Mr Trousdale, who seems to be somehow connected to the Registrant has, in the past, registered the domain name mul-t-lock.co.za, the domain name corresponding to the Complainant's trade mark.
- d) All the above seems to indicate that the domain names complained of are abusive.

5. Decision

- a) For the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain names multlock.co.za and multilock.co.za be transferred to the Complainant.

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VANESSA LAWRENCE
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za