

## Decision

**[ZA2019-0383]**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2019-0383</b>
DECISION DATE:	<b>06 January 2020</b>
DOMAIN NAME	<b>petportsa.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Estelle Fourie</b>
REGISTRANT'S LEGAL COUNSEL:	<b>Rademeyer Attorneys – Clinton van Niekerk</b>
THE COMPLAINANT:	<b>Transpet CC Trading as Petport</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Witz inc – Callyn Datnow</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZACR (CO.ZA )</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law ("the SAIPL") on **09 September 2019**. On **10 September 2019** the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name at issue, and on **10 September 2019** 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 **17 September 2019**. In accordance with the Regulations the due date for the Registrant's Response was **16 October 2019**. The Registrant submitted its Response on **16 October 2019**, and the SAIPL verified that the Response satisfies the formal requirements of the Regulations and the SAIPL's Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on **21 October 2019**.
- c) In accordance with the Regulations the due date for the Complainant's Reply was **28 October 2019**. The Complainant submitted its Reply on **28 October 2019**.
- d) The SAIPL appointed **Ms Kelly Thompson** as the Adjudicator in this matter on **15 November 2019**. The Adjudicator 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.
- e) In terms of Regulation 26, and because the Complainant's Reply had contained certain new matter, the Adjudicator deemed it necessary to afford the Registrant an opportunity to answer the new allegations. The Registrant was accordingly sent a copy of the Reply and afforded until **23 December**

**2019** to file a supplementary response. The Registrant filed its Supplementary Response on **20 December 2019**.

## 2 Factual Background

- 2.1 The Complainant was incorporated under the name Transpet CC in 2011. The Complainant's business includes services relating to the transport of animals and specifically pets. It conducts this business under the name PETPORT which it claims is an invented word which it coined as a portmanteau of the words "pet" and "transport".
- 2.2 On 13 February 2012, the Complainant registered the domain name petport.co.za. It alleges that it has used this domain name for the past seven years and that a significant number of the Complainant's clients are referred through its website.
- 2.3 In 2012, the Complainant also filed a trade mark application for the registration of its trade marks PETPORT – ITS NOT JUST BUSINESS, ITS PERSONAL together with a logo. However, the Complainant had filed the application itself and, having allegedly heard nothing further from the Trade Marks Office, assumed that the application had proceeded to registration. It only learned in May 2018, from its current attorneys, that the application had not been completed. The Complainant's attorneys accordingly filed a fresh application for the mark PETPORT in July 2019, which application has yet to proceed to registration.
- 2.4 The Registrant registered the domain name petportsa.co.za on 16 August 2017. The Registrant is one of two members of an entity called Animal Travel CC which is one of the Complainant's major competitors in the animal transport industry. The Registrant also registered the domain name petportsa.com.
- 2.5 Upon receiving this Complaint, the Registrant gave an instruction to

terminate or delete the disputed domain name. However, because the Complaint was pending and the domain name had been suspended in terms of the Regulations, it has not yet been deleted.

### **3 Parties' Contentions**

#### **3.1 Complainant**

- a) The Complainant alleges that, as a result of its extensive use of the word PETPORT over the last eight (8) years, it has acquired a substantial goodwill and reputation in that mark, particularly in relation to the provision of animal transport services. It alleges that it has acquired common law rights in the word PETPORT.
- b) The Complainant alleges that the disputed domain name is almost identical, and therefore substantially similar, to the Complainant's domain and trading name, with the only difference being the addition of the letters "sa" which does not distinguish the disputed domain name from the Complainant's name in any meaningful way.
- c) In addition, the Complainant advises that the disputed domain name leads a user to the website for Animal Travel Services CC at the address <https://www.animal-travel.com/> and is therefore being used in relation to identical services to those of the Complainant.
- d) The Complainant contends that it is being severely and unfairly prejudiced as a result of the intentional confusion which the Registrant has created in that its potential clients are diverted to one of its biggest competitors. It alleges that the Registrant's intention was misleading and to unfairly disrupt and take advantage of the Complainant's business, goodwill and reputation.
- e) The Complainant's contention is that the domain name took unfair advantage of and is unfairly detrimental to the Complainant's rights, that it infringes the Complainant's common law rights and is an abusive

registration in the hands of the Registrant.

- f) In its Reply, the Complainant also submitted that the fact that the Registrant sought to terminate the domain name upon the complaint being filed is an indication that the Registrant herself believes the domain name to be an abusive registration. The Complainant also alleged that the parties had a historical relationship and that the Registrant was well aware of the Complainant's alleged rights in the name PETPORT from 2012. The Registrant had no legitimate reason to register the domain name *petportsa.co.za* and, the Complainant points out, has proffered no explanation for registering this domain name and pointing it to its own website.
- g) Finally, the Complainant contends that, because the Registrant has instructed the deletion of the domain name and clearly no longer considers herself as holding title to the disputed domain name, the Adjudicator is at liberty to order the transfer of the domain name to the Complainant.

### 3.2 Registrant

- a) As a preliminary point, the Registrant states in her response that, despite her view that the Complainant has no standing to bring the Complaint and that the domain name is not an abusive registration, she has "*already cancelled her registration of the domain name in an attempt to prevent further conflict between the parties*". She claims that, despite this, the Complainant has refused to withdraw the complaint and has also demanded an exorbitant contribution towards her legal costs. The Registrant alleges that this matter is not fit for adjudication because the Registrant cannot transfer the domain name, which has already been deleted, nor can the Complainant claim any form of costs under the Regulations.
- b) The Registrant alleges that the Complainant has filed the complaint prematurely and without merit. She alleges that the Complainant only

recently (in 2019) filed a trade mark application for the mark PETPORT and that this application will not be finalised for several years. She contends that the Complainant may not rely on this application because the trade mark is not registered and that, in any event, this trade mark application is likely to be opposed by the Registrant and others in the animal logistics field. Furthermore, when the Registrant registered the disputed domain name, this application had not yet been filed and, as such, the Registrant could not have been infringing any rights when it registered the domain name

- c) The Registrant goes on to allege that the Complainant is relying on a trade mark application for the mark PETPORT – IT’S NOT JUST BUSINESS, IT’S PERSONAL which is not the same as the mark which is the subject of the disputed domain name, ie. PETPORT.
- d) The Registrant also alleges that the Complainant has failed to adduce evidence of its alleged use of the mark PETPORT and the subsequent common law rights.
- e) It is also the Registrant’s position that the Complainant has failed to prove that the disputed domain name is an abusive registration because the Complainant has not shown that the Registrant obtained any unfair commercial advantage through the use of the domain name.
- f) As mentioned, in light of the Complainant’s Reply containing certain new matter, the Adjudicator afforded the Registrant an opportunity to file a Supplementary Response dealing with that matter. The Registrant did not, however, confine itself to answering the new matter and filed a fairly comprehensive reply which itself contains certain new matter. Nothing in the Supplementary Response affected the finding that the Adjudicator makes below, however. As such, rather than protract the dispute unnecessarily and afford the Complainant a further right of reply, the Adjudicator has disregarded the contents of the Supplementary Response. The Adjudicator does wish to note for the

Complainant's benefit, however, that while the Registrant maintains that the disputed domain name is not an abusive registration, it has tendered transfer of the disputed domain name to the Complainant upon request.

#### 4. Discussions and Findings

##### a) Preliminary points

According to the Registrant, the disputed domain name has already been cancelled and the Complainant cannot claim costs in terms of the Regulations. As such, the Registrant alleges, the Complaint cannot be adjudicated. The issue of costs is something of a red herring since the Complainant did not purport or attempt to claim costs in the Complaint. It is also not so that the domain name has already been cancelled and that the Complaint may therefore not proceed. Annexure "R2" to the Response appears to be a print-out from a domain name service provider. It indicates that the status of the domain name is "termination period". This does not mean that the domain name has been cancelled, although it may be an indication that the Registrant has instructed its service provider to delete the domain name.

Regulation 12(1) provides that a Registrant may not transfer, or delete, or refuse to renew a domain name registration whilst proceedings under the Regulations are ongoing, except as a result of a written settlement agreement between the parties.

As set out under the Procedural History section above, the disputed domain name was, in terms of the Regulations, suspended after the Complaint was filed. As such, even if the Registrant had instructed its provider to delete the domain name, the domain name would still be registered. There is accordingly no reason why this matter should not be fit for adjudication.

On the other hand, the Complainant alleges that because the Registrant

already considers the domain name to have been deleted and does not claim any title in it, the Adjudicator is at liberty to order the transfer of the domain name to the Complainant. This is not so, however, and the Adjudicator is obliged, in terms of the Regulations, to decide the dispute, to determine the weight, admissibility and relevance of the evidence and to ensure that the parties are treated with equality and given a fair opportunity to present their cases. As such, the Adjudicator is obliged to consider the merits of the dispute.

### Merits

It is trite that the Complainant must prove, on a balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the disputed domain name and that, in the hands of the Registrant, the domain name is an abusive registration [Regulation 3]. It is the Complainant who bears the burden of proof [SAIPL Decision APZA2009-0030 (*seido.co.za*)].

#### **4.1 Complainant's rights**

4.1.1 Regulation 1 defines "rights" to include, without limitation, intellectual property, commercial, cultural, religious and personal rights protected under South African law. In SAIPL Decision ZA2008-0020 (*mixit.co.za*), the Adjudicator held:

*"The definition is broad and rights are not restricted to rights founded on the principles of trade mark law, but recognises rights going beyond those in terms of the Trade Marks Act No. 194 of 1993 or the requirements at common law for passing-off. Such rights must, however, find recognition in law. See ZA2007-0008 (*privatesale.co.za*)."*

4.1.2 The cornerstone of the Complainant's case is its alleged common law rights in the word or mark PETPORT. Before dealing with those alleged rights, however, it is convenient first to deal with the fact that the Complainant also owns the domain name *petport.co.za* and

references its pending trade mark application for PETPORT – ITS NOT JUST BUSINESS, ITS PERSONAL logo. The Registrant also points out that the Complainant recently applied to register the word mark PETPORT, which application is still pending. Although the Complainant does not appear to be relying on either the domain name or the pending trade mark applications (contrary to the Registrant’s assertions), the Adjudicator wishes to point out, for the avoidance of doubt, that a domain name is not considered an intellectual property right nor any other right on which a domain name dispute can be founded [ZA2008-0020 *supra*]. Similarly, a trade mark application confers no rights on the applicant for registration [SAIIPL decision ZA2015-0211 (*adrienneherschproperties.co.za*)] and cannot form the basis of a Complaint either.

- 4.1.3 Turning to the Complainant’s allegation of common law rights, what is required in order to succeed is for the Complainant to prove *“that the mark has acquired a reputation, such that it has become symbolic of the Complainant’s goodwill”* [SAIIPL decision ZA2016-0243 (*worldsportsbet.co.za*)] and that the relevant mark is distinctive of it and that *“the trade or the public necessarily connects its trading activities to these marks”* [SAIIPL decision ZA2007-005 (*phonebook.co.za, whitepages.co.za*).
- 4.1.4 In SAIPL case ZA2016-0243, the Complainant alleged that it had used the name WORLD SPORTS BETTING in connection with bookmaking and betting services since 2002 and that the mark had become synonymous with its business. However, the only proven use of the mark was on a copy of a single advertisement annexed to the Complaint which was seemingly in circulation in 2005, some six years prior to the registration of the disputed domain name *worldsportsbet.co.za*. The Adjudicator found that the Complainant had failed to prove that it had acquired common law rights in the mark WORLD SPORTS BETTING.

4.1.5 In SAIPL case ZA2015-0211 (*supra*), the Adjudicator held:

*"4.1.4 In order to establish common law rights in a mark it must be shown that the consequence of the use and reputation has brought about a situation where the name or mark has acquired a "secondary meaning" which in fact denotes one trader, and no other.*

*4.1.5 In Nyama Catering Limited / Francois Wessels (ZA 2011-0092) the Adjudicator noted that although the Allstates Global Karate Do, Inc / Sais Karate (APZA2009-0030) decision held that the threshold in establishing the existence of a right in a domain name dispute is "fairly low", there is nevertheless a threshold. The height of the bar will be influenced by the nature and meaning (if any) of the word or mark relied on.*

*4.1.6 Unsubstantiated allegations will not suffice. Allegations of "secondary meaning" must be bolstered by relevant evidence. Relevant evidence may include evidence related to the length and amount of sales under the mark; the nature and extent of the advertising; consumer surveys and media recognition (see *Uitgeverij Crux v W Frederic Isler Skattedirektoratet / Eivind Nag D2000-0575; Amsec Enterprises, LC / Sharon McCall D2000-1314; Australian Trade Commission / Matthew Reader D2001-0083; and Imperial College / Christophe Dessimoz D2004-0322;*))"*

In that case, despite the Complainant having attached print-outs from its web pages which contained a company profile, information on media marketing and an indication that the company had advertised on social media since 2010, as well as examples of its advertisements and business stationery bearing its name, the Adjudicator found that the Complainant had failed to adduce sufficient evidence of its alleged reputation and goodwill.

4.1.6 The evidence contained in the Complaint in this matter is unfortunately even more inadequate than some of the earlier cases in which Adjudicators were compelled to find that claims of alleged

common law rights were unsupported. Not a single advertisement, website print-out or other document showing use of the mark PETPORT by the Complainant is annexed to the Complaint. There is no indication of sales figures, turnover or the duration and nature of any marketing activities. The Adjudicator has nothing but the Complainant's say-so in respect of its alleged use of the mark since 2012 and the alleged common law rights that have ensued.

4.1.7 In light of the Registrant pointing out the inadequacy of the evidence in its Response, the Complainant made a half-hearted attempt to introduce new evidence of its use of the PETPORT name in its Reply. This new evidence consisted of allegations regarding the Complainant's membership of IPATA (International Pet Animal Transport Association) and ATA (Animal Transportation Association) and allegations regarding the Complainant's business having been featured in local radio shows, television talk shows and magazine articles. The documentary evidence required to back up these allegations is, however, again frustratingly absent. To the Reply are attached print-outs from the Complainant's website (made on 28 October 2019 and therefore irrelevant); a single, undated magazine article; an undated print-out from the IPATA website and a copy of the Complainant's IPATA membership application form from 2012. Unfortunately, none of these annexures, either alone or in combination, support the Complainant's allegation of extensive use of the mark PETPORT and of this use having led to the creation of common law rights. They also fall far short of showing that the mark PETPORT has acquired secondary meaning and denotes one trader, and no other.

4.1.8 In SAIPL Decision ZA2017-0259 (*winblock.co.za*), the Adjudicator held:

*"Although previous ADR Decisions ..... point out that the notion of "rights" for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence, it is beyond the Adjudicator's ability to*

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*extrapolate the existence of rights where insufficient evidence is provided and such evidence is decisive on whether the Dispute stands to succeed or be dismissed.”*

4.1.9 Weighing up all relevant considerations, and having considered the papers filed in this matter, the Adjudicator finds that the Complainant has failed to discharge the onus of showing, on a balance of probabilities, that it has rights in the name or mark PETPORT as required by Regulation 3(1)(a).

## **4.2 Abusive Registration**

4.2.1 In light of the finding above, there is no need for the Adjudicator to find whether the 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.

## **5. Decision**

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Dispute is refused.

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**Kelly Thompson**  
SAIIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)