

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0201
DECISION DATE:	27 July 2015
DOMAIN NAME:	sasolrewards.co.za
THE DOMAIN NAME REGISTRANT:	Deal4Two
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Sasol Limited
COMPLAINANT'S LEGAL COUNSEL:	Lexsynergy Limited
2 nd LEVEL ADMINISTRATOR:	ZA Central Registry

1. Procedural history

- 1.1 The domain in issue is <sasolrewards.co.za> registered on 8 March 2014. The Registrant is Deal4Two.
- 1.2 The Complainant is Sasol Limited, hereinafter referred to as “the Complainant”.
- 1.3 This dispute was filed with the South African Institute of Intellectual Property Law (“SAIPL”), on **1 June 2015**. On **2 June 2015** SAIPL emailed a request to ZA Central Registry (ZACR) for the registry to suspend the domain name, and on the same day the ZACR confirmed the suspension.
- 1.4 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **3 June 2015**. The due date for the Registrant’s Response was **2 July 2015**. This date came and went, and on Monday **6th July 2015** the Administrator issued a Notification of Default. Consequently, a Mr Sean Houzet emailed the Adjudicator as follows:-

“With reference to our earlier telephonic conversation. I would like to apply for an extension on this matter. As discussed, I wanted to contact you first to find out what this matter is all about. Please see communication below. You only got back last week which is why I called you. I provide rewards to Sasol and therefore feel that my domain name “sasolrewards.co.za” is justified. You have now explained to me what this is all about and therefore I can now make an educated and informed response to this request.

I look forward to hearing from you.”

- 1.5 The Administrator replied advising that the request would be forwarded to the Case Adjudicator to decide whether or not to accept or reject the request for an extension.

- 1.6 On **7th July 2015**, the Complainant's representative wrote to the Administrator objecting to the grant of an extension to the Registrant. The email states:-

"The Registrant has had ample time to respond. His request was made four days after the response deadline had passed. The obligation is on the Registrant to ensure they meet the specified deadlines and not blame the SAIPL or any other party for the delay. The Registrant could have called or chased the SAIPL for a response, if in fact that was the reason for the delay.

In light of the above we request that any response received from the Registrant after the response deadline, not be considered in the matter. The decision to the contrary would lead to an abuse of the strict deadlines, which make the ZA ADR an expeditious and cost effective recovery solution for trade mark owners."

- 1.7 On **10 July 2015 Adv Owen Salmon SC** was invited to adjudicate this matter, and he duly submitted the Statement of Acceptance and Declaration of Impartiality and Independence. Subsequently Adv Salmon was appointed as the Adjudicator.
- 1.8 On **13th July 2015**, the Adjudicator considered the issue and ruled as follows:-

"The Registrant has asked for an extension of the term to file a response. The Complainant opposes the extension. The decision is due on 27 July 2015.

I am prepared to allow the Registrant until close of business on Wednesday 15 July 2015 to respond. If the Registrant does not respond by that deadline I will proceed to adjudicate on the basis that he is in default. If he does respond, the Complainant can file its reply by Monday 20th July 2015."

1.9 This met with the following response from the Complainant's legal representative:-

We refer to the email below and note that only the Case Administrator can grant extensions in an ADR. We refer in particular to section 11(a) and (b) of the Supplementary Procedure.

The Adjudicator does have the power to determine the admissibility, relevance, materiality and weight of the evidence but there is no mention of the power to grant extensions.

This is consistent with the fact that the Adjudicator is only appointed after the procedural aspects of the Complaint, Response and Reply have been concluded.

Section 28 states:

28.(1) If a party does not comply with any of the time periods established by this procedure or the adjudicator, the adjudicator must proceed to a decision on the dispute.

(2) If a party does not comply with any provision of or requirement under this procedure or any request from the adjudicator, the adjudicator may, in the absence of exceptional circumstances, draw such inferences therefrom, as he or she considers appropriate.

Furthermore, Section 18(3) of the Regulations states: "If the registrant does not submit a response, the adjudicator must decide the matter based on the dispute contemplated in regulation 16(1)".

Section 28 and 18(3) confirms that the Adjudicator has no authority to grant an extension of time.

In addition we received an email on 6 July 2015 from "The Administrator" stating:

"This serves to confirm that the Provider has not received a Response from the////Registrant as required by the provisions of Regulation 18.

Regulation 18 Clearly stipulates the formal requirements for a

Response. The Provider has no option but to regard the Registrant in Default and must therefore proceed with the appointment of an Adjudicator to adjudicate this Dispute. If the Registrant has indeed submitted a proper Response, please immediately contact the Provider.

On 7 July 2015 [the Administrator] stated that "we will forward your request to the case adjudicator, he or she will decide on whether to accept or reject the request".

On 13 July 2015, the Adjudicator granted an extension outside the ambit of his authority and contrary to the ADR procedure.

The Response deadline was 2 July 2015 and the request for an extension was made on 6 July 20015 and granted without following the correct procedures on 13 July 2015.

This has the effect that the Registrant would have, in fact, had a total of 31 days to prepare a response as opposed to the strict limit of 20 days. This unreasonable extension prejudices the Complainant.

The correct procedure would have been for the Case Administrator to make a decision on the grant of the extension and for the Adjudicator to then determine admissibility, relevance, materiality and weight.

In light of the above we ask that the registrant not be afforded the extension that was granted by the Adjudicator, alternatively if the grant of the extension is upheld we ask that the Adjudicator recuse himself on the basis of a conflict of interest by virtue of acting as the Case Administrator and Adjudicator in this matter or alternatively for the Adjudicator to disregard the Response."

1.10 On **14th July 2015** the Administrator responded to the Complainant's legal representative recording that:-

"The Administrator will accept the Adjudicator's ruling in allowing the Registrant to file its response by Wednesday 15th

July 2015, as this would in any event have been the administrative course of action.”

- 1.11 The Complainant’s objection has overlooked the provisions of Regulation 24, which oblige an Adjudicator to give each party a fair opportunity to present his case. Regulation 28 contemplates that the Adjudicator can establish time periods and in the Adjudicator’s view there are obvious and good reasons for this provision. Fairness postulates a balancing of interests, in which prejudice plays an important role. Notwithstanding the representations by the legal representative for the Complainant, it will not be prejudiced in the Adjudicator’s grant of the extension and this was a material consideration in the assessment. The reason for this is that the adjudication date is 27th July 2015 and the regime put in place would not affect that. If the Complainant was to be at a difficulty in addressing any timeous response from the Registrant, a request for an extension would similarly be considered, taking into account the same constitutionally-entrenched fundamentals.
- 1.12 In the Adjudicator’s view, the request from the Complainant’s representative that he recuse himself was without foundation and the request was declined.
- 1.13 It serves to conclude this overview of the procedural history by recording that, before expiry of the extended response period, Mr Houzet sent an email to the Administrator. He subsequently confirmed that this was his “response”. It does not comply with the provisions of Regulation 18, in particular because the averments incorporated in the email are not made under oath. The Administrator’s position is that the Registrant, accordingly is in default, but the “deficient” response is nevertheless referred to the Adjudicator for consideration as to its admissibility and merit.
- 1.14 This, to a certain extent, raises the following quandary. Regulation 18.3 requires that the Adjudicator must decide a matter based on the dispute as lodged by the Complainant where the Registrant is in default. However, in

embassytravel.co.za,¹ a response lacking in compliance with Regulation 18 was in issue. It was held, by the Adjudicator in that matter, that less than perfect compliance with the regulations does not result in a nullity, so that the response could be taken into account. The real issue is what weight was to be attached to the letter. A similar situation arose in gardenmaster.co.za.²

1.15 The Adjudicator's decision is not to turn a blind eye to what Mr Houzet has said. Its probative value is another matter.

2 The Facts

2.1 The Complainant is Sasol Limited, a public company with its principal place of business and head office at 1 Sturdee Avenue, Rosebank, Johannesburg, South Africa. Sasol, as is well known, 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.³ It has 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, and operates approximately 200 franchised petrol stations throughout South Africa under the trade mark SASOL.

2.2 The Complainant has also registered over 700 domain names that are identical or incorporate its SASOL trade mark - the domain <sasol.com> was registered on 4 March 1996 and <sasol.co.za> on 1 January 1995. It launched its main website at <www.sasol.com> on 7 January 1997. In 2013

¹ <embassytravel> ZA2008-0024, paragraph 2.

² <gardenmaster> ZA2009-0028, paragraph 1.4.

³ The Dispute documentation sets out a commendably thorough exposition, with numerous annexures, of Sasol, its status, and the basis of its claim to rights in the mark SASOL. What follows in the text of this adjudication is a very-much condensed extract. In the Adjudicator's view, in cases of such obviously well-known marks, consideration should be given to proving just the essentials, reserving the right to supplement in Reply in the event of dispute. This should alleviate potentially unnecessary bulk.

alone, it attracted over 61 million visits. The Complainant has registered the trade mark in numerous countries worldwide, with a registration in the United Kingdom dating back to 1955.

- 2.3 The Complainant discovered the disputed Domain Name and on 19 July 2014 its representative sent a demand to the Registrant. A response was received, in which Mr Houzet stated that he is *“in the business of registering suitable domain names for various programmes in possible future marketing operations”*, and alleged that the Domain Name was a justifiable acronym for *“South African Society of Linguists”*. (According to the Complainant, no such society exists; the Linguistics Society of Southern Africa does exist but is abbreviated as LSSA.) However, he added:-

“We do understand your predicament and interest in our property and are not adverse to disposal thereof for monetary consideration.”

- 2.4 The Complainant’s representative replied, recording that SASOL is a well-known trade mark within South Africa, and that the justification was far-fetched. The Registrant responded to this, accusing the Complainant of attempting to hijack his domain name, again adding:-

“My business connections for the site have not as yet come to fruition. Therefore without prejudice to my rights and in view of your predicament, I shall allow your company right of pre-emption for the domain name.

Such right will expire in 4 days calculated from today – South African time.

I await to hear from you. And further illegal attempts to take my property will be dealt with, if needs be, in the strongest terms.”

- 2.5 The Complainant’s representative responded by asking the Registrant to explain what he meant by a “right of pre-emption?” but it appears that no response was forthcoming. This formal dispute followed.

3 The Complainant's contentions

3.1 Sasol bases its dispute on the following grounds:-

- 3.1.1 The domain name is identical or similar to a name or mark in which it has rights;
- 3.1.2 The disputed domain name is similar to the Complainant's "SASOL" trade mark;
- 3.1.3 The Complainant has acquired a substantial reputation and goodwill in the mark SASOL such that it is recognized by the public as distinctive of the Complainant's petroleum and chemical goods and services. A consumer would assume that any product or service being sold or offered on a website including the word "SASOL" was associated with, endorsed, or supplied by the Complainant;
- 3.1.4 The dominant and distinctive part of the disputed domain is SASOL. The suffix "REWARDS" is a descriptive word used by organisations, such as the Complainant, to promote customer loyalty and incentive programs. The word "REWARDS" does not add distinctiveness to the disputed domain name but, in fact, adds to the confusion that the Registrant is the Complainant. Reference is made to Dr Ing hcF Porche AG v VAsilly Terkin, D2003-0888 (WIPO January 6, 2004), and Telkom SA Limited v Cool Ideas CC SAIPL_ZA2007-0003; and
- 3.1.5 The Complainant has successfully established its trade mark rights in twelve previous UDRP complaints and the ADR complaint Sasol Limited v James Sai CC SAIPL ZA204-0189.

3.2 It is further alleged that the domain is an abusive registration for the following reasons:-

- 3.2.1 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, use of the domain name would take unfair advantage of and be detrimental to the Complainant's rights; and, use of the domain name would take unfair advantage of and be detrimental to the Complainant's rights.
- 3.2.2 The Registrant is actually located at <http://mylifestyleclub.co.za>. The home page of this website contains three links to various forms that allow a user to redeem an online voucher for a reward. The legitimacy of the website is suspect, in that the user needs to pay a fee to redeem a voucher while referring to terms and conditions that are not located on the website. (In addition, the "Central Reservations" number advertised on the site rings with no answer.) The Complainant's representative completed the form located on the webpage <http://mylifestyleclub.co.za/page2.html> by entering random information except for a valid email address. After submitting the form online the webpage directs to another page instructing the user to access a link to "*view all of the available holiday and travel benefits*". (An email confirmation is also sent with a similar instruction.) The link then directs to another page with various offers while prompting the user to "PAY NOW" for a holiday booking;
- 3.2.3 There is also no logical reason to register a domain name incorporating the well-known South African SASOL trade mark allied to a descriptive term such as "REWARDS" for a legitimate purpose other than to use it in a bad faith and for an illegitimate purpose;
- 3.2.4 The acronym argument raised by the Registrant is implausible - why would a linguistic society need a domain name to promote a rewards program? Such fanciful arguments, contends the Complainant, are often employed by domain name squatters to

justify their unlawful acts and to frustrate the recovery of infringing domain names. The Registrant's actions in this matter clearly fall within the ambit of an abusive registration;

3.2.5 Furthermore, the use of the word "REWARDS" by domain name squatters, such as the Registrant, is common as is evident by the list of 40 UDRP decisions that contain the word "rewards";

3.2.6 The Complainant contends that the Registrant's only true interest in the disputed domain name is to benefit commercially from the unauthorised and illegitimate use of the Complainant's brand and goodwill in a way which could confuse people and/or business (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;

3.2.7 The Complainant contends that the Registrant is engaged in a pattern of registering domain names that infringe upon the rights of other trade mark owners, to which the Registrant has no apparent rights, and the disputed domain name is part of that pattern. In this respect, the Registrant has registered the following domain names:-

caltextrwards.co.za	woolworthsrewards.co.za
bprewards.co.za	engenrewards.co.za

3.2.8 As far as the Complainant is aware, the Registrant has no trade mark or other rights to the disputed domain name; and

3.2.9 The Registrant is clearly well versed in optimising domain names and websites for commercial gain and knows that members of the public may be confused as to the source and affiliation of the disputed domain name. The confusion could generate significant volumes of traffic for the Registrants rewards scheme.

- 3.3 In the circumstances, the Complainant submits that it has shown 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.

4 The Respondent's contentions

- 4.1 The Registrant's response states:-

"... I am really battling to understand why an overseas company feels that they have any rights to my domain, which at the date and time of registration was available for purchase in SA. From what I can understand they have certain rights to the name "Sasol" and Sasol.uk.com. What I am failing to understand is what rights they assume to have over my South African registered domain sasolrewards.co.za. I have been providing rewards to various Sasol sites throughout South Africa for over 5 years now (please see attachment) and feel that their constant bullying tactics to try and hi-jack my domain is a direct infringement on my business intellect. I therefore blatantly refuse to give in to their imperialistic "greater than thou" attitude."

- 4.2 The "attachment" is annexed to this decision. It does not, in the Adjudicator's view, support the allegation.

5 Discussion and Findings

- 5.1 It is clear that the Complainant has rights in the mark SASOL, and in the Adjudicator's view, the name <sasolrewards> is similar.
- 5.2 Mr Houzet's indignation, it seems, stems from a misunderstanding of the nature and quality of the domain he claims is his. The problem is that he has appropriated a (registered and famous) trade mark of another for his

domain, and it is trite that, without more, this is (at least, *prime facie*) abusive. Nothing Mr Houzet has said counters the validity, in my view, of the Complainant's contentions.

6 Decision

For the foregoing reasons the Adjudicator finds that the domain is abusive. In accordance with Regulation 9 the Adjudicator orders that the domain <sasolrewards.co.za> be transferred to the Complainant.

.....
ADV OWEN SALMON SC
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za

ANNEXURE

it is cashback time...

*support us by purchasing
40 Litres or more of
Sasol turbodiesel ULS
(50ppm sulphur) TM*

and you will receive...

A R60 MEAL VOUCHER

(valid at over 80 participating restaurants in the Western Cape)

(terms & conditions apply, only one per visit)

Excludes all commercial vehicles (trucks and taxis)

please call us for details

offer available only at:

Sasol Modderdam

Cavallier Retail Centre, Modderdam Rd, Belhar
Tel: 021 934 1145

sasol

reaching new frontiers

