

ADJUDICATOR DECISION

CASE NUMBER:	ZA2008-0025
DECISION DATE:	5 March 2009
DOMAIN NAME	Suncityshuttle.co.za
THE DOMAIN NAME REGISTRANT:	Peter Britz
REGISTRANT'S LEGAL COUNSEL:	J Percival
THE COMPLAINANT:	Sun International (South Africa) Limited
COMPLAINANT'S LEGAL COUNSEL:	Mr A Smith of Adams & Adams
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **15 December 2008**. On **15 December 2008** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **15 December 2008** 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 **15 December 2008**. In accordance with the Regulations the due date for the Registrant's Response was **16 January 2009**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **16 January 2009**. The Registrant thereafter did not file a proper response as required by the Regulations. The Registrant did, however, submit a letter which appears to be wrongly dated **25 February 2009**, in terms of which certain allegations are made. The admissibility of the Registrant's letter is dealt with below. On **5 February 2009**, the Complainant's legal representatives requested that the matter be suspended pending settlement discussions between the parties. It appears that nothing came of the settlement discussions and as a result the Complainant requested that the matter proceed to adjudication.
- c. The Complainant submitted a reply to the Registrant's letter dated **25 February 2009** (which, as indicated, appears to be a wrong date) on **13 February 2009**.
- d. The SAIPL appointed **Advocate Gavin Morley SC** as the Adjudicator in this matter on **13 February 2009**. 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.

- e. The Adjudicator gave consideration as to whether the "response" dated 25 February 2009 should be admitted at all. It is simply a letter from the Respondent's representative and has not been certified as contemplated by Regulation 18. It also does not contain all the information specified in Regulation 18. As will be seen below, the letter is written in vague terms and in the judgment of the Adjudicator does not carry much weight in advancing the Registrant's case. The Adjudicator was tempted to disregard the letter in its entirety. It appeared to the Adjudicator that the Registrant had made no effort to comply with Regulation 18 and the "response" contained no "certification" as contemplated by Regulation 18, unlike the situation in the case of [**<embassytravel.co.za>**ZA2008-0024]. Even applying the principles in the aforementioned decision, there must be a stage reached where because no effort is made to comply with Regulation 18 at all, the so-called "response" should be disregarded and not admitted. Should the failure of a Registrant to comply with the provisions of Regulation 18 be prejudicial to a Complainant, then in the respectful opinion of the Adjudicator, this would be grounds for not admitting the defective "response". In the **<embassytravel.co.za>** adjudication (supra) the Adjudicator held [paragraph 2(f)] that less than perfect compliance does not result in a nullity. While the adjudicator agrees with this view, there is a difference between less than perfect compliance and no compliance at all. I do not read the adjudication in **<embassytravel.co.za>** to be read as requiring a "response" to be admitted in a situation where there is no compliance with Regulation 18, or indeed no attempt at compliance with the Regulation. In such circumstances, it appears to me that an Adjudicator may well be justified in not admitting the so-called "response", particularly where a Complainant is prejudiced. Although referred to in **<embassytravel.co.za>**, I do not read Regulation 27 as precluding an Adjudicator from excluding a response submitted under the Regulations

where no attempt has been made to comply with such Regulations and the document is wholly defective as a result. In the respectful judgment of the Adjudicator, Regulation 27 simply provides that there will be no oral hearing and the decision is to be made on the basis of the documents submitted in the proceedings. Documents in this context must refer to those documents, which are properly submitted in terms of the Regulations and are thereby admissible in terms of the Regulations. The Adjudicator is not bound by Regulation 27 to consider those documents submitted where they are not in accordance with the Regulations. In the judgment of the Adjudicator, it is Regulation 29(1) that sets out the material to which an Adjudicator must have regard. I note that a reference to "further statements or documents" in Regulation 29(1) appears to be a reference to "statements or documents" other than the "dispute, response and reply" referred to earlier in the Regulation and there is a distinction between what might be termed the pleadings and evidence (which are submitted together) and other statements and documents. To the extent that the views of the Adjudicator differ from those of the Adjudicator in <**embassytravel.co.za**>, he has the misfortune of disagreeing with those views.

- f. In the present case, the Adjudicator sees no prejudice to the Complainant in having regard to the letter of 25 February 2009 (sic), but as will be seen hereafter, the contents of the letter carry little weight, having regard to the paucity of information contained therein.
- g. The Adjudicator gave consideration as to whether a further statement from the Respondent should be requested in terms of Regulation 26 to supplement the defective "response" but considered that this would not be appropriate in the present circumstances. In the judgment of the Adjudicator, the Registrant was afforded a proper opportunity to file a proper response and he must bear the consequences of failing to deliver such a response in terms of Regulation 18. To hold otherwise would set a

dangerous precedent and open the door to a potential abuse of the Regulations.

2) Factual Background

- a. The following facts were not disputed by the Registrant.
- b. The Complainant is the proprietor in South Africa of approximately eighty SUN CITY and SUN CITY variant trade mark registrations. The earliest of these registrations dates from 1978. For example trade mark No. 78/5182 SUN CITY is registered in class 39 in respect of "transportation and storage" services.
- c. The Complainant has made extensive use of its SUN CITY and variant trade marks in South Africa. It's SUN CITY Resort and Entertainment World is one of South Africa's main tourist attractions and is extremely well-known.
- d. The Complainant's venue is visited by large numbers of local and international tourists all year and offers a variety of accommodation at the Palace of the Lost City, the Cascades, the Sun City Cabanas and its Sun City Hotel. Each hotel has its own style, character and ambiance.
- e. The Complainant offers a variety of activities to entertain visitors of all ages, including sporting and recreational facilities, encompassing two world class golf courses and the Valley of the Waves. The mark SUN CITY is used in relation to those services and facilities. The Complainants Welcome Centre is known as the 1-Stop Shop offering a variety of services, from booking and confirming bus tickets, flights, car hire, game drives and other adventure activities.
- f. The Complainant's resort offers a range of conference venues, banqueting facilities and world class entertainment. Its venues have been used for extremely high profile events, meetings and conferences. These include

those on a political front, in entertaining prominent local and international political leaders, celebrities and the like.

- g. Amongst the variety of services offered by the Complainant, is a daily scheduled SUN CITY bus service to its SUN CITY Resort, operating from the OR Tambo Airport in Johannesburg and Menlyn Park Shopping Centre in Pretoria. Within the resort, the Sky Train Monorail links a large day visitor parking area at Sun City's entrance with the entertainment centre situated in the centre of the resort. A 24 hour shuttle bus is also available to and from the entrance of the resort and to each hotel within the complex. Shuttles are arranged from and to the local air strip to the SUN CITY Resort.
- h. The Complainant's SUN CITY Resort has been awarded gold classification from the Heritage Programme for its commitment to sustainable and responsible environmental practice and it was awarded the Invelo Responsible Tourist Award in South Africa in 2007, in an initiative relating to the continuing hospitality industry campaign to encourage industry members to accept voluntary guidelines by promoting responsible tourism.
- i. The mark SUN CITY is associated with the Complainant and its business.
- j. The Complainant has expended a considerable amount of time, money and effort in marketing and promoting its SUN CITY and associated trade marks in South Africa.
- k. According to the CO.ZA "Whois" server, the domain name <suncityshuttle.co.za> is operational with effect from 10 January 2007 when it was registered in the name of Peter Britz, the present Registrant.
- l. In 2007, the Complainant became aware of the registration of the domain name <suncityshuttle.co.za>.
- m. The domain name <suncityshuttle.co.za> leads to the website of the business "Sun City Shuttle". The website offers a shuttle/chauffeur

transport service to the Complainant's Sun City Resort and Entertainment World. Images of the Complainant's resort and events held at the Complainant's resort feature on this website. Some of the sub-headings on the website are "book a trip with us", "what we offer", "useful links", "about us", "contact us" etc.

- n. Under "useful links", the Complainant's SUN CITY logo appears. If a user clicks on the SUN CITY logo he/she will be redirected to an "error" route of the Complainant's Sun International.com website.
- o. Under "contact us", the Registrant's email address is listed as "info@suncity.co.za".
- p. The Registrant is not a licensee of the Complainant and has not been authorised by the Complainant to register the domain name <suncityshuttle.co.za> or to use the Complainant's SUN CITY trade mark and images of its resort on its website and in advertising, marketing and promotion or in furtherance of the business of Sun City Shuttle.
- q. The Complainant and the Registrant both offer a shuttle service with reference to the mark SUN CITY, the Registrant using it in his domain name.

3) Parties' Contentions

a. Complainant

- i. The Complainant contends that the domain name is identical or similar to a mark in which the Complainant has rights [Regulation 3(1)(a)].
- ii. As the proprietor of its registered trade marks, the Complainant is afforded statutory protection against any third party making use of an identical or confusingly similar mark in the course of trade.

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- iii. The mark SUN CITY is associated with the Complainant and its business. The Complainant's use of its SUN CITY and associated trade marks in South Africa affords it common law protection.
 - iv. The dominant feature of the domain name <suncityshuttle.co.za> is Sun City. This is practically identical to the Complainant's trade mark SUN CITY.
 - v. The Complainant submits that the Registrant's use of its SUN CITY trade mark in registering the domain name <suncityshuttle.co.za>, in the e-mail address info@suncity.co.za and on the website is intended deliberately to mislead, deceive and confuse members of the public into believing that the Registrant's business is that of the Complainant or a branch of the Complainant's business [Regulation 4(1)(b)].
 - vi. As the Complainant and the Registrant both offer a shuttle service with reference to the mark SUN CITY, the Registrant using it in his domain name, members of the public on accessing the internet and searching for the Complainant's shuttle service will be led to believe that the Registrant is the Complainant.
 - vii. The Complainant submits that there is no reason why the Registrant had to adopt the Complainant's trade mark in its business name and domain name other than to piggy-back on the already existing goodwill and reputation of the Complainant's business and thereby attract custom and derive a benefit without expending labour, effort and incurring the cost of a name that does not conflict with the Complainant's trade mark.
 - viii. Any adverse publicity attracted by the Registrant could negatively impact upon the Complainant's business.
 - ix. The Complainant submits further that the Registrant registered the domain name in a way that leads people or businesses to believe

that the domain name is registered, operated or authorised by or otherwise connected with the Complainant.

- x. The Complainant submits further that the registration of the domain name <suncityshuttle.co.za> was intended to disrupt unfairly the business of the Complainant and prevent the Complainant from exercising its rights [Regulation 4(1)(a)(iii)].
- xi. The Complainant seeks a decision for the transfer of the domain name to it.

b. Registrant

- i. As the Adjudicator has stated above, the Registrant's "response" is in the form of a letter addressed by one J Percival to the provider.
- ii. It is perhaps appropriate to quote the salient parts of the letter-

"We confirm that Mr Peter Britz has requested that we direct this correspondence to you in reply to the dispute placed against the web name Sun City Shuttle.

We confirm that Mr Britz has traded under this name for a number of years and has grown a commercially successful business under this website name. At all times Sun International were aware that Mr Britz has traded under this name and styling and has in fact rendered services to Sun International under this name and styling. It is thus highly irregular that a dispute is mane (sic) against this domain name. In our opinion this dispute is an attempt to circumvent purchase of the domain name duly purchased and registered by Mr Britz without payment.

The success of Mr Britz's business is dependant (sic) upon this name and he has become known in the industry under the name and styling of the website. Mr Britz has further spent a considerable amount of monies promoting his business through the website design and business stationary (sic) and in the event of a

dispute being success (sic) Mr Britz stands to lose a considerable investment into the name of the business that he has already spend (sic) several years growing and developing.

It is further submitted that the website itself promotes the best interests to and in the complainant as it would ensure speedy efficient and effective transport of guests to the Sun City resort thereby raining (sic) the good name and standing of the complainant and thus Mr Britz denies that the complainant (sic) could suffer any harm or even potentially suffer any harm."

- iii. It is important to note that Mr Britz does not say when his website first came into being but this could not have been before 10 January 2007.

c. Complainant's Reply

- i. In reply the Complainant has stated that on 14 February 2008, it became aware of the Registrant's registration of the close corporation Sun City Shuttle CC (CK 2007/063603/23). The Complainant lodged a formal objection with the Registrar of Close Corporations to the name of the corporation. On 24 July 2008, the Registrar decided that the name of the corporation was undesirable and ordered the corporation to change its name.
- ii. The Complainant on later becoming aware of the Registrant's registration of the domain name <suncityshuttle.co.za> addressed a letter of demand to the Registrant on 27 August 2008 informing him of the Complainant's rights in the mark SUN CITY. The Registrant was asked to de-register the domain name <suncityshuttle.co.za>, cancel his e-mail address info@suncity.co.za and stop making use of the Complainant's mark SUN CITY.
- iii. The Registrant did not respond to this letter.

- iv. The Complainant submits that the Registrant's contention that "Sun International were aware that Mr Britz has traded under this name" is misleading in that it wrongly creates the impression that the Complainant allowed the Registrant to carry on business under the name Sun City Shuttle and did not take any steps to stop his use of the mark SUN CITY.
- v. The Complainant has conducted internal investigations and is not aware of any services conducted by the Registrant on its behalf although it is aware that the Registrant transport members of the public to the Complainant's SUN CITY resort as a business for his own benefit. The Complainant denies that the services conducted by the Registrant are on behalf of the Complainant or with its mandate or that the Registrant has been in operation for a "number of years" in the manner indicated in his response. The domain name and close corporation name were only registered in 2007.
- vi. Members of the public intending to visit the Complainant's resort by any public or private means may be transported to the Complainant's resort by the Complainant's shuttle or by others. The Registrant is not a branch of the Complainant or associated with the Complainant or its business and his business is not authorised. The two are independent of one another.
- vii. The Complainant submits that the Registrant's contention that the Complainant's dispute "is an attempt to circumvent purchase of the domain name duly purchased and registered by Mr Britz without payment" is unfounded. The Complainant has expended considerable amounts of money in this matter, including lodging a dispute with the administrator and formally objecting to the Registrant's registration of the close corporation Sun City Shuttle CC with the Registrar of Close Corporations. It should not be required to pay for access to its own rights.

- viii. The Complainant submits that the Registrant's use of the mark SUN CITY in the domain name <suncityshuttle.co.za> on his website advertising his business and in his e-mail address info@suncity.co.za is intended to deceive and mislead members of the public into believing that he is associated with the Complainant. The Complainant denies that the Registrant's success is due to his own effort and submits that the Registrant's success is derived from deliberate misrepresentation of his alleged business relationship with the Complainant.
- ix. The Registrant was made aware of the Complainant's objection to his registration of the domain name <suncityshuttle.co.za> and the use of the mark SUN CITY. Notwithstanding this the Registrant still carried on business under the name Sun City Shuttle in total disregard of the Complainant's rights. It is submitted by the Complainant that it has expended considerable amounts of time, money and effort in advertising, marketing, promoting and protecting its SUN CITY and associated trade marks. The Registrant has not been authorised by the Complainant to register the domain name <suncityshuttle.co.za> or use the mark SUN CITY. Furthermore the Registrant is not a licensee of the Complainant and the Complainant is not liable for any loss incurred by the Registrant as a result of the Registrant's failure to take the necessary steps to avoid conflict with the Complainant.

4) Discussion and Findings

a. Complainant's Rights

- i. By way of introduction, Regulation 29(1) requires an Adjudicator to decide a dispute "in accordance with the principles of law, on the basis of the dispute, response and reply, if any, and further

statements or documents submitted in accordance with these Regulations”.

- ii. Regulation 13(1) requires that an Adjudicator must consider and be guided by previous decisions made in terms of these Regulations, hereinafter referred to as “national decisions”, and decisions by foreign dispute resolution providers, hereafter referred to as “foreign decisions”. Regulation 13(2) further requires that an Adjudicator must be guided by “national, foreign and international law”.
- iii. Regulation 3(1)(a) provides that a Registrant must submit to proceedings under the Rules if a Complainant asserts, in accordance with the procedure, that –

“the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name and, in the hands of the Registrant the Domain Name is an abusive registration ...”

- iv. The definition of “rights” and “registered rights” includes-

“intellectual property rights, commercial, cultural, linguistic, religious, and personal rights protected under South Africa Law, but is not limited thereto”.

- v. The Complainant in the present case relies on its registered trade marks in respect of SUN CITY and also its common law rights in SUN CITY, which signifies its goodwill and reputation in the business its conducts at the SUN CITY resort.
- vi. Regulation 3(2) requires that a Complainant prove, on a balance of probabilities, that –
 - (a) the Complainant has rights in respect of a name or mark;
 - (b) the name or mark is identical or similar to the domain name;

- (c) the domain name, in the hands of the Registrant is an abusive registration.
- vii. It is not disputed that the Complainant has registered rights in respect of the trade mark SUN CITY. These rights date back to 1978. In the judgment of the Adjudicator, the Complainant has proved that it is the proprietor of validly registered trade marks that comprise of, or incorporate, the trade mark SUN CITY.
- viii. In addition the Complainant has provided undisputed evidence, proving, on a balance of probabilities, that it had common law rights in the SUN CITY trade name and mark at the time of the registration of the domain name.
- ix. In the judgment of the Adjudicator, the Complainant has proved that it had the relevant intellectual property rights in SUN CITY to found its complaint.
- x. The domain name at issue is <suncityshuttle.co.za>. The Adjudicator finds that the suffix .co.za has no bearing on the consideration of similarity (see ***Bikeandleisuretrader.co.za*** [ZA2008-0018] and ***sunglasshut.co.za*** [ZA 2008-00015]).
- xi. In the judgment of the Adjudicator, the word "shuttle" is a word that is generic to the travel and tourism industry in question. The word "shuttle" is not a distinguishing feature (see: WIPO decisions ***www.zonediet.com*** [D2007-0286]; ***www.fryelectronic.com*** [D2006-1435] and Nominate Decisions ***allianceandleicesterbankplc.co.uk*** [DRS2006-3280] and ***mirauk.co.uk*** [DRS 2006-3727]). In the judgment of the Adjudicator, the inclusion of the word "shuttle" is not sufficient to distinguish the disputed domain name from the Complainant's SUN CITY trade mark.

- xii. The Adjudicator is accordingly satisfied that the Complainant has the requisite rights in respect of the mark SUN CITY, and that the disputed domain name has the requisite identity or similarity sufficient to found the complaint.
- xiii. The Adjudicator considers that the only real issue in the proceedings is whether the domain name registration constitutes an "abusive registration".

b. Abusive Registration

- i. The Regulations define "abusive registration" as-

"a domain name which either-

- (i) 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; or*
- (ii) has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.*

- ii. Regulation 4 lists a non-exhaustive list of factors which may be evidence that the domain name is an abusive registration. The factors which are of relevance to the present dispute are-

"4(1) factors, which may indicate that the domain name is an abusive registration include –

- (a) circumstances indicating that the Registrant has registered or otherwise acquired the domain name primarily to – (iii) disrupt unfairly the business of the complainant;*
- (b) circumstances indicating that the Registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.*

- iii. The present complaint relates to both the registration and use of the domain name <suncityshuttle.co.za>. It was held in the case of <**suncityvacation.co.za**> [ZA2008-0023] that the use of the similar domain name in the face of the well-known and registered trade mark SUN CITY will inevitably lead the public into believing that the Registrant is associated with the Complainant. It was further held that that would also take advantage of the Complainant's rights and that such advantage would be unfair as it was unfair to take advantage of the reputation of another, built-up over a long period as the result of considerable effort and expense without contributing in any significant way to that reputation. The same principles apply in the present case. In the judgment of the Adjudicator the registration and use of <suncityshuttle.co.za> in the face of the well-known and registered SUN CITY trade mark will inevitably lead the public into believing that the Registrant is associated with the Complainant and it will also take unfair advantage of the Complainant's rights. It is also significant that the use of the domain name <suncityshuttle.co.za> has been in conjunction with a website that seeks to take advantage of the business and reputation of the SUN CITY resort. The overwhelming inference to be drawn from the conduct of the Registrant is that he sought to create an association with the Complainant when in fact no such association existed.
- iv. Although the Adjudicator cannot find that the Registrant or otherwise acquired the domain name primarily to disrupt unfairly the business of the Complainant, the circumstances are such that the Adjudicator finds that the Registrant is indeed using, or has registered, the domain name in such a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant [Regulation 4(1)(b)].

- v. The main point made by the Registrant is that he has traded under the name Sun City Shuttle “for a number of years” and has grown a “commercially successful business” under this website name. Unfortunately, this allegation is without the necessary particularity. The Adjudicator simply does not know for how long Mr Britz has traded and no details are provided of Mr Britz’s commercial success. As the Adjudicator has observed the use of the domain name could only have commenced after 10 January 2007. This was at a time when the Complainant already had established its rights. Mr Britz’s allegations that he has spent a considerable amount of monies promoting his business through the website design and business stationery do not impress the Adjudicator, more particularly as it appears that Mr Britz did not take the Adjudicator into his confidence by disclosing that he had registered a close corporation name Sun City Shuttle CC, the name of which the Registrar of Close Corporations had ordered him to change. Mr Britz’s submission that the website promotes the best interests of the Complainant as it would ensure speedy, efficient and effective transport of guests to the SUN CITY resort carries no weight whatsoever. As was stated in the decision in *<suncityvacation.co.za>* [ZA2008-0023] it is not a defence to a claim of an abusive registration that the present use of the domain name for the purposes of a website will benefit the Complainant. The fact of the matter is that the Complainant has no control over that website and its content. Furthermore the submission does not take cognisance of the principle that an abusive registration begins with the registration of the domain name in itself and the content of a website does not have a bearing on this issue.
- vi. It was open to the Registrant to conduct its business through a domain name that did not include the Complainant’s trade mark.

vii. It would seem to the Adjudicator that the adoption and the use of Sun City Shuttle was contrary to the Complainant's statutory and common law rights. The use that is being made is to denote the origin of the services that the Registrant is offering i.e. trade mark use of the domain name. Accordingly, the Adjudicator finds that the use made by the Registrant cannot be said to be either fair or *bona fide* use of the domain name. In this regard it cannot be said to be fair use where the use is misleading or takes unfair advantage of the reputation and goodwill of the trade mark in issue. Accordingly, the Adjudicator finds that the Registrant has not brought himself within the ambit of Regulation 5(a)(i) or (ii) of the Regulations which provide that although not exclusive, factors, which may indicate that a domain name is not an abusive registration include –

"(a) *before being aware of the Complainant's cause for complaint, the Registrant has-*

(i) used or made demonstrable preparations to use the domain name in connection with a good faith offering of goods or services;

(ii) being commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name..."

viii. Consequently, the Adjudicator finds that the disputed domain name, in the hands of the Registrant is an abusive registration as the disputed domain name has been registered (and subsequently used) in such a way that leads people or businesses to believe that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

5) Decision

- a. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, <suncityshuttle.co.za. be transferred to the Complainant.

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ADVOCATE GE MORLEY SC
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za