

Decision

ZA2011-0067

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0067
DECISION DATE:	28 March 2011
DOMAIN NAME	suncityhotels.co.za and suncityreservations.co.za
THE DOMAIN NAME REGISTRANT:	African Dreams
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANTS:	Sun International (South Africa) Limited Sun International Management Limited
COMPLAINANT'S LEGAL COUNSEL:	Adams and Adams
2 nd LEVEL ADMINISTRATOR:	UniForum SA (CO.ZA)

1 Procedural History

- a) The Registrant, African Dreams, registered the domain names <suncityhotels.co.za> and <suncityreservations.co.za> on **11 March 2004**.
- b) This dispute was lodged with the South African Institute of Intellectual Property Law (the "SAIPL") on **25 January 2011**. On the same day the SAIPL emailed a request to UniForum SA for the registry to suspend the domain name at issue, and on **31 January 2011** UniForum SA confirmed that the domain name had been suspended.
- c) In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **2 February 2011**. In accordance with the Regulations, the due date for the Registrant's Response was **3 March 2011**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **4 March 2011**. Nothing has been lodged or served by the Registrant.
- d) The SAIPL appointed **Adv Owen Salmon** as the Adjudicator in this matter on **10 March 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 following allegations of fact (made by the Complainants) are to be taken as undisputed, there being none which are so far-fetched or palpably untenable.
- b) The Complainants are Sun International (South Africa) Limited ("Sun International") and Sun International Management Limited ("Sun International Management"), companies incorporated under the laws of

South Africa of Fredman Drive, Sandton.

- c) According to the relevant 2nd Level Domain Administrator's Whois facility, the Registrant in these proceedings is African Dreams, a business with an address at 104 MSK House, 15 Buitengracht Street, Cape Town.
- d) Sun International is the proprietor in South Africa of the registered trade mark SUN CITY and of approximately 80 trade mark registrations incorporating the mark SUN CITY. The resort bearing this name is operated by Sun International, but does not need further introduction and is internationally famous.
- e) Sun International Management is a management and associated company. It has been authorised to register the following domain names on behalf of Sun International, and which it holds for the benefit of and use by Sun International:-

- <suncityhotel.co.za>
- <suncity-reservations.co.za>
- <suncitysouthafrica.co.za>
- <suncity-southafrica.co.za>
- <suncityresorts.co.za>
- <suncityvacation.co.za>
- <suncityshuttle.co.za>
- <suncitybookings.co.za>

These domain names are active and redirect web browsers to the main website of the First Complainant, being <suninternational.com>. This website advertises the Sun City resort, and the services in its regard.

- f) The Registrant's domain names lead to the websites www.suncityhotels.co.za and www.suncityreservations.co.za respectively. Both websites appear to have identical web content. They make extensive reference to the Sun City resort; actually, the entire websites feature the resort.

- g) The headers on the websites are centralised and consist of pictures of the Sun City resort. Above the pictures, the words “Sun City Resort South Africa” appear. Below the headers there are telephone numbers for South Africa and the United Kingdom. There is an “Online Enquiry” link. The Registrant’s name African Dreams, and what appears to be its logo, feature (less prominently) in the top left corner on both the websites. This logo is inactive; it is not a link to an African Dreams web-page, for example.
- h) There are, however, several links which appear on the websites: “Sun City Home”, “The Sun City Hotels”, “Sun City Video Clips” and “Driving Directions”. On each, the website leads to pages providing information on the Sun City Resort. For example, by clicking on the link “The Palace”, the website leads to pages providing information on The Palace Hotel. The trade marks and logos belonging to Sun International also feature.
- i) The “Online Enquiry” link leads to an “Accommodation Request Form” page. Here, the SUN CITY logo prominently features above the words “Accommodation Request Form”, and it is alleged that this gives the impression that it is the First Complainant’s official booking form.

3 Parties’ Contentions

- a) The contentions set out in the founding papers of the dispute can be summarized as follows.
- b) The domain names <suncityhotels.co.za> and <suncityreservations.co.za> incorporate the SUN CITY trade mark, are almost identical to the Complainants’ domain names <suncityhotel.co.za> and <suncity-reservations.co.za>, and are accordingly confusingly similar to the domain names indicated in paragraph 2.5 above.
- c) The Registrant is not a licensee of the trade marks, nor of the First Complainant’s images, and the manner in which use of such material has been made (including by prominent use of the SUN CITY and associated

trade marks) is likely to deceive and confuse members of the public into believing that there is an association between the websites, their operators, and Sun International.

- d) The Registrant is using and has registered the domain names `suncityhotels.co.za` and `suncityreservations.co.za` mala fide, and 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 Complainants. Moreover, the Registrant is using the domain names unlawfully and rides on the goodwill, reputation and good name of SUN CITY to attract trade and custom.
- e) As a result of the misleading association, the Registrant attracts custom and benefits financially, and seeks to acquire rights in a trade mark without any entitlement to it. In addition, adverse publicity attracted by the Registrant will negatively impact on the First Complainant's business. Poor service by the Registrant will place the Complainants in a negative light.
- f) The Complainants accordingly submit that the registrations are intended unfairly to disrupt the business of Sun International, and prevent the Complainants from exercising their rights, and that they are abusive registrations.

4 Discussion and Findings

- a) The SUN CITY name and trade mark is registered in the name of the First Complainant, and is a recognized name and brand. The Second Complainant is the proprietor of several domain registrations incorporating the mark SUN CITY (together with other generic matter).
- b) The Adjudicator further finds that the domain names in question are similar to the Complainants' SUN CITY name and trade mark, and also to the domain names as contemplated by Regulation 3(1)(a).
- c) The Adjudicator finds that the Complainants have established rights as

contemplated by Regulation 3(1)(a) read with Regulation 3(2).

- d) An abusive registration means 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 Complainants' rights;
 - or
 - (ii) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainants' rights.
- e) The Complainants are required to prove, on a balance of probabilities, that the required elements are present.

In terms of Regulation 4(1)(a), factors which may indicate that the domain name is an abusive registration include circumstances indicating that the registration was primarily to:-

- (i) transfer the domain name to a complainant for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring the domain name;
 - (ii) block intentionally the registration of a name or mark in which the Complainant has rights;
 - (iii) disrupt unfairly the business of a Complainant;
 - (iv) prevent a Complainant from exercising its rights.
- f) In particular, additionally, Regulation 4(b) provides that:-
- “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”

may also indicate that the domain name is an abusive registration.

- g) In the view of the Adjudicator, the Registrant must have been aware of the Complainants' rights and interests in the name SUN CITY; no evidence has been tendered to gainsay the Complainants' allegations in this regard. Moreover, although non constant that the onus is changed, or the Adjudicator's responsibility alleviated, it is not without significance that no allegations or contentions have been advanced to counter the Complainants' case.
- h) What weighs against the Registrant, in the Adjudicator's view, are two, at least, features which bring the registrations within forbidden territory:-
- (i) the existence of the Complainants' famous mark SUN CITY in the domain names, coupled with the fact that it cannot be said that the use that is resultingly made of generic or descriptive nature;
 - (ii) The manner in which the domains operate presents an association with SUN CITY as if, almost, they are the official SUN CITY sites.
- i) Accordingly, the Adjudicator finds that the registrations are abusive and upholds the Complainants' Dispute.

5. Decision

- a) For the foregoing reasons the Adjudicator orders that the domain names be transferred to the Second Complainant.

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