

Decision

ZA2011-0069

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0069
DECISION DATE:	20 April 2011
DOMAIN NAME	samed.co.za
THE DOMAIN NAME REGISTRANT:	Saints Web Design
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	South African Medical Devices Industry Association
COMPLAINANT'S LEGAL COUNSEL:	Edward Nathan Sonnenbergs
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 **18 February 2011**. On **20 February 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **20 February 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 **23 February 2011**. In accordance with the Regulations the due date for the Registrant's Response was **24 March 2011**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **25 March 2011**.
- c) The SAIPL appointed **Mariëtte Viljoen** as the Adjudicator in this matter on **4 April 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 was established in 1985 and is the representative association of the South African medical device industry. The Complainant was founded as an association in 1985 and was incorporated as a Section 21 company in 2002.
- (b) The Complainant has, since it was established, used the acronym and trade mark SAMED. The Complainant focuses on health care matters and promotes, represents and safeguards the interests of its members in the

South African medical device and in-vitro diagnostics industries and represents members in both the private and public sectors.

- (c) The Complainant has over 140 members, comprising South African companies involved in the manufacture and supply of products and services to the healthcare fraternity industry. The Complainant has made extensive use of its SAMED trade mark in South Africa since 1985. Some of the services offered by the Complainant to its members over the years include:
- (i) providing a forum for discussion of matters affecting the manufacturers and distributors of medical and surgical products in South Africa;
 - (ii) promoting and encouraging amongst its members ethical principles and practices, voluntarily agreed upon and publishing a Code of Marketing Practice;
 - (iii) co-operating with Government and regulatory authorities, whether national or international;
 - (iv) working towards harmonisation of standards and regulatory requirements within the area of medical devices, manufacture and supply;
 - (v) working towards harmonisation of standards and regulatory requirements within the area of medical devices, manufacture and supply;
 - (vi) promoting a spirit of co-operation and shared responsibility among public and private healthcare professionals and providers, including the State and other relevant sectors, within the context of effective, efficient and transparent healthcare delivery;
 - (vii) providing periodic updates on issues and details of Government Gazette notices published in the medical industry, as well as information on local and international trade enquiries.

- (d) The Complainant's trade mark has been used on, inter alia, letterheads and business cards, its application forms for membership, its quarterly newsletter, its constitution, letters to members, its brochures and in advertisements placed in various medical journals.
- (e) According to the .co.za WHOIS server, the domain name samed.co.za was registered in the name of Saints Web Design, the present Registrant, on 5 February 2009.
- (f) The Complainant first became aware of the Registrant's registration of the samed.co.za domain name during August 2010. At the time, the domain name samed.co.za did not resolve to a website, but instead redirected internet traffic to the website located at www.medschool.co.za, a medical information services website.
- (g) The Complainant filed applications to register the trade mark SAMED in logo format under application nos. 2010/19944-6 in classes 5, 10 and 44 on 7 September 2010, which are still pending.
- (h) For a period of time, both the Complainant and the Registrant offered or advertised services of interest to the medical industry. After the Complainant's attorneys had sent a letter of demand to the Registrant, the domain name was redirected to a website located at <http://saints.co.za>.

3 Parties' Contentions

3.1 Complainant

- (a) The Complainant has made extensive use of its SAMED trade mark since 1985 and has acquired common law rights in the mark.
- (b) The Complainant registered the domain samed.co.za and used it until 2008.
- (c) Certain members and clients of the Complainant still try to access the Complainant's website previously located at www.samed.co.za,

- believing the domain belongs to the Complainant.
- (d) In addition, the Complainant is the registrant of the domain samed.org.za.
 - (e) The Complainant contends that it established common law rights in the SAMED name and trade mark before the Registrant registered the domain samed.co.za and that the domain is identical or similar to its SAMED trade mark [Regulation 3(1)(a)].
 - (f) The Complainant submits that the Registrant's use of the SAMED trade mark in registering the domain name samed.co.za and diverting it to the website <http://www.medschool.co.za>, was to attract customers that would ordinarily be intended for the Complainant, to its Med School website. Accordingly, the Complainant submits that the Registrant used the domain name in a way that could lead members of the public to believe that the domain name is connected with the Complainant [Regulation 4(1)(b)].
 - (g) Furthermore, the Med School website provides students, lecturers and professionals in the medical industry with information relating to the medical and health services industry. The services offered on the Med School website are services which are similar to those offered by the Complainant.
 - (h) The Complainant submits that the domain name was registered or acquired in a manner which, at the time when the registration took place, took unfair advantage of, or was unfairly detrimental to the Complainant's rights [Definition of "abusive registration" – Regulation 1(a)].
 - (i) The Complainant submits further that members and clients of the Complainant still access the samed.co.za domain name, believing that the domain name belongs to the Complainant, due to the fact that it was previously the primary domain and website address of the

Complainant.

- (j) The Complainant submits further that the Registrant's registration of the `samed.co.za` domain name unfairly disrupts the Complainant's business and is preventing the Complainant from exercising its rights in the SAMED trade mark, as the Registrant has threatened to oppose the Complainant's trade mark applications. The Complainant submits that the relevant manner of use to be considered by the Registrant is the use at the time when the domain name was registered or acquired [Regulations 4(1)(a)(iii) and 1(a)].
- (k) The Complainant submits further that the Registrant, only after receiving a letter of demand from the attorneys of the Complainant, redirected the domain name to another website and that the Registrant's refusal to transfer the domain name voluntarily, is indicative of its mala fide intention when it registered the `samed.co.za` domain name initially.
- (l) The Complainant submits that the domain name in the hands of the Registrant is an abusive registration and seeks a decision for the transfer of the domain name to the Complainant.

3.2 Registrant

- a) The Registrant did not reply to the Complainant's contentions.

4 Discussion and Findings

4.1 Complainant's Rights

- (a) The Complainant in the present case relies on its common law rights in the trade mark SAMED, which it has acquired as a result of its use of the name and trade mark since 1985.
- (b) Regulation 3 requires that the Complainant prove, on a balance of probabilities that –

- (i) the Complainant has rights in respect of a name or mark;
 - (ii) the name or mark is identical or similar to the domain name; and,
 - (iii) the domain name, in the hands of the Registrant, is an abusive registration.
- (c) The Complainant has provided undisputed evidence proving, on a balance of probabilities, that it had common law rights in the SAMED name and trade mark at the time of the registration of the domain name by the present Registrant.
- (d) The domain name at issue is samed.co.za. The Adjudicator is satisfied that the Complainant has the requisite rights in respect of the trade mark SAMED and that the disputed domain name has the requisite similarity sufficient to found the complaint.
- (e) The Adjudicator considers that the only real issue in the proceedings is whether the domain name registration constitutes an “abusive registration”.

4.2 **Abusive Registration**

- (a) Regulation 1 defines an “abusive registration” as
- “a domain which either –
 - (i) was registered or otherwise acquired in a manner, which at the time when the registration 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”.
- (b) In Regulation 4(1) a non-exhaustive list of factors is provided, which may be taken into account to establish that the domain name is an abusive registration. The factors which are relevant to the present

dispute are –

- (i) Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to –
 - (ii) disrupt unfairly the business of the complainant; or
 - (iii) prevent the complainant from exercising his/her or its rights;
 - (iv) 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”.
- (c) In light of the use of the SAMED trade mark by the Complainant since 1985, the registration and use of the samed.co.za domain by the Registrant will lead the public to believe that the Registrant is associated with the Complainant and it will also take unfair advantage of the Complainant’s rights and reputation in the SAMED trade mark. This is particularly so, in view of the fact that the Complainant first registered and used the samed.co.za domain name for many years, before more recently registering the domain name samed.org.za.
- (d) The Adjudicator further finds that the Registrant used the domain name, in such a way that led people or businesses to believe that the domain name was registered to, operated or authorised by, or otherwise connected with the Complainant. This use only ceased after the letter of demand by the Complainant’s attorneys, was received. [Regulation 4(1)(b)].
- (e) The Adjudicator further finds that the Registrant used the domain name, in such a way that led people or businesses to believe that the domain name was registered to, operated or authorised by, or

otherwise connected with the Complainant. This use only ceased after the letter of demand by the Complainant's attorneys, was received. [Regulation 4(1)(b)].

- (f) In conclusion, the Adjudicator finds that the disputed domain name, in the hands of the Registrant, is an abusive registration. As the Registrant did not submit an answer, this is the only conclusion that can be drawn. The fact that the Registrant, after receiving the letter of demand from the Complainant's attorneys, redirected the domain to an unrelated website, does not change this conclusion.

5. Decision

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

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M VILJOEN
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za