



Decision

[ZA2012-0107]

.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA 2012 - 0107
DECISION DATE:	15 May 2012
DOMAIN NAME	sterkinikor.co.za
THE DOMAIN NAME REGISTRANT:	DMF Industries
REGISTRANT' S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Primedia (Pty) Ltd
COMPLAINANT' S LEGAL COUNSEL:	Ms. M du Plessis, Adams & Adams
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 “SAIIPL”) on **16 March 2012**. On **19 March 2012** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **22 March 2012** 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 **22 March 2012**. In accordance with the Regulations the due date for the Registrant’ s Response was **24 April 2012**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **25 April 2012**.
- c) The SAIPL appointed **Victor Williams** as the Adjudicator in this matter on **30 April 2012**. 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.

2 Factual Background

The Complainant, Primedia (Pty) Ltd, is the registered proprietor of various trade marks in South Africa which consist of and contain the name STER-KINEKOR. Ster-Kinekor Theatres, a division of the complainant, is the licensee of the trade marks. Ster Kinekor is also the registrant for the sterkinekor.co.za and sterkinekor.com domain names. The Registrant is DMF Industries, which has an address in the Grand Cayman.

3 Parties' Contentions

3.1 Complainant

- 3.1.1 The domain name is identical or similar to a name or mark in which the Complainant has rights [Regulation 3(1)(a)]
- 3.1.2 The complainant is the proprietor in South Africa of numerous registered trade marks consisting of or incorporating STER-KINEKOR in South Africa.
- 3.1.3 The complainant contends that the STER-KINEKOR trade mark has been used extensively in South Africa and that it has become a well-known trade mark in terms of the Trade Marks Act 194 of 1993. The Complainant further contends that such extensive use has resulted in it acquiring substantial common law rights in the STER-KINEKOR trade mark.
- 3.1.4 The mark 'sterkinikor' is wholly contained in the disputed domain and is virtually identical and confusingly similar to the Complainant's registered STER-KINEKOR trade mark(s).
- 3.1.5 Accordingly, the Complainant contends that the disputed domain name offends against the provisions of Regulation 3(1)(a) and is an abusive registration.
- 3.1.6 The domain name in the hands of the Registrant is an abusive registration [Regulation 3(1)(a)]
- 3.1.7 The Complainant submits that the disputed domain was registered in full knowledge of the Complainant's rights and with the object of taking advantage of the goodwill and reputation which inheres in the Complainant's common law and statutory rights.
- 3.1.8 The Complainant contends that the fact that the disputed domain

resolves to a website at www.sterkinikor.co.za which contains an image of a movie reel and which contains a link to the Complainant's website at www.sterkinikor.com, creates an impression that it is associated with the Complainant.

3.1.9 The Complainant contends that it was an obvious tactic on the part of Mr. Sicard, being the initial registrant of the disputed domain, to take advantage of members of the public, who may mistype the Complainant's STER-KINEKOR trade mark while trying to visit the Complainant's website at www.sterkinikor.co.za, directing them to the wrong website.

3.1.10 The Complainant submits that it was concerned that the Registrant may elect to sell the domain name at an exorbitant price. The Complainant therefore approached the Registrant directly with a view to resolve the matter on the basis that the disputed domain be transferred to the Complainant against the reasonable out of pocket expenses for registering and maintaining the disputed domain.

3.1.11 Mr. Sicard's representative responded with a counter offer of \$25,000 (Australian Dollars), which is roughly R204 000. The Complainant submits that this is an exorbitant amount.

3.1.12 The Complainant has submitted evidence of the existence of factors, which in terms of Regulation 4(1) serve to indicate that the disputed domain name is an abusive registration. These factors are namely:-

- The Registrant has indicated that it intends selling the disputed domain for an exorbitant price. [Regulation 4(1)(a)(i)]
- The Registrant is using, and has registered the disputed domain in a way that leads people to believe that the disputed domain is registered to, operated or authorised by, or otherwise connected with the Complainant. [Regulation

4(1)(b)]

- The Registrant has provided false and incomplete contact details in the whois database [Regulation 4(1)(d)]

3.2 Registrant

The Registrant did not reply in terms of Regulation 18 to the Complainant's contentions and has not disputed the Complainant's contentions as set out above.

4 Discussion and Findings

4.1 Complainant's Rights

4.1.1 The Complainant is the proprietor of numerous registered trade marks consisting of or incorporating STER-KINEKOR in South Africa.

4.1.2 As evidence of its trade mark rights, the Complainant attached copies of the certificates of registration for the following trade marks:-

- a. Trade Mark No. 1980/3409 STER-KINEKOR logo in class 9.
- b. Trade Mark No. 1980/3414 STER-KINEKOR logo in class 33.
- c. Trade Mark No. 2007/20022 STER-KINEKOR in class 9.
- d. Trade Mark No. 2007/20023 STER-KINEKOR in class 16.
- e. Trade Mark No. 2007/20024 STER-KINEKOR in class 41.
- f. Trade Mark No. 2007/20025 STER-KINEKOR in class 43.

4.1.3 The disputed domain name is virtually identical to the Complainant's STER-KINEKOR trade mark.

4.2 Abusive Registration

4.2.1 The disputed domain name was registered on 2 April 1998.

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- 4.2.2 The Complainant and its predecessors in title have however been using STER-KINEKOR since the early 1970' s. The Complainant has become one of the most prominent movie houses in South Africa.
- 4.2.3 The Complainant has adduced sufficient evidence, including examples of advertising and revenue figures, to establish that it has acquired a substantial reputation in the STER-KINEKOR mark.
- 4.2.4 From the above it must be inferred that that Registrant was familiar with the Complainant, and furthermore that the Registrant registered the disputed domain name for the sole purpose of misleading the public into believing that the disputed domain name was registered to or associated with the Complainant.
- 4.2.5 As stated above, the disputed domain name resolves to a website which contains an image of a movie reel as well as a link to the Complainant' s website at www.sterkinekor.com. Although this link was subsequently removed, the overall impression of the website is still one which suggests that it is associated with or registered to the Complainant.
- 4.2.6 In the premises, and in the absence of any explanation by the Registrant to the contrary, the latter' s conduct in registering the disputed domain name may properly be described as 'typo-squatting' i.e. where the Registrant has registered a domain name which is virtually identical to a trade mark or mark in which the Complainant has rights.
- 4.2.7 Such conduct has, in the WIPO administrative panel decision of Letbuyit.com v Stephen Ward, as also Surepayroll. Inc v Web Advertising, Corp. been found to amount to an abusive registration. The SAIPL decision under case no. ZA2007-0006, which turned on

substantially similar facts to the present case also confirms this view.

- 4.2.8 The disputed domain name accordingly falls within the ambit of Regulation 4(1)(b).
- 4.2.9 The Complainant has further adduced evidence that the Registrant intends selling the disputed domain name at an exorbitant price. Such conduct falls within the ambit of Regulation 4(1)(a)(i).
- 4.2.10 Finally, the Registrant has provided incomplete and false contact information according to the whois registration information. Such conduct falls within the ambit of Regulation 4(1)(d).
- 4.2.11 The Adjudicator is satisfied that the Complainant has proved on a balance of probabilities that the required elements of Regulation 3(1)(a) are present. Consequently, notwithstanding the Registrant's failure to reply, the Adjudicator finds that the disputed domain name is an abusive registration in terms of Regulation 3(1)(a).

5. Decision

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

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VICTOR WILLIAMS
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za