

## Decision

[ZA2017-0290]

.ZA ALTERNATE DISPUTE RESOLUTION  
REGULATIONS (GG29405)

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2017-0290</b>
DECISION DATE:	<b>19 December 2017</b>
DOMAIN NAME	<b>officepro.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Lindie van der Walt</b>
REGISTRANT'S LEGAL COUNSEL:	<b>Kruger &amp; Okes</b>
THE COMPLAINANT:	<b>Tandem Paper cc TA Office Pro</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Self Representing (Marcel Bommeli)</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA )</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **1 November 2017**. On **1 November 2017** the SAIIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **2 November 2017** the ZA Central Registry confirmed that the domain name had indeed been suspended. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIIPL's Supplementary Procedure.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **3 November 2017**. In accordance with the Regulations the due date for the Registrant's Response was **1 December 2017**. The Registrant did not submit any official Response, and accordingly, the SAIIPL notified the Registrant of its default on **4 December 2017**.
- c) The SAIIPL appointed **Gérard du Plessis** as the Senior Adjudicator and **Kareema Shaik** as the Trainee Adjudicator in this matter on **11 December 2017**. The Adjudicator and Trainee Adjudicator have both submitted the Statements of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.
- d) The Registrant's attorneys, Kruger & Okes, sent, by email, a letter dated **4 December 2017**, to the SAIIPL concerning the Dispute. The letter does not constitute an official Response in accordance with the Regulations and statements made therein were not made under oath. However, the statements made in the letter are relevant in adjudicating the Dispute. More on this will be said below.

## 2 Factual Background

- 2.1 The factual background appears from the Dispute lodged by the Complainant. As no official response to the Dispute was filed, there is no dispute on factual issues and the Adjudicators may accept the allegations of fact by the Complainant, as generally correct.
- 2.2 The contested domain name <officepro.co.za> was registered on 16 May 2003. The Registrant is Lindie van der Walt of 2 Station Road Nigel, Johannesburg, 1491, ZA. The Registrant is the CEO of The East Rand Chamber of Commerce & Industry (Chamberlink). The relevance of this will become apparent below.
- 2.3 The Complainant is Tandem Paper CC t/a Office Pro of 113 Rietfontein Road, Boksburg. According to its website, the Complainant sells "*a wide range of desks, chairs, cabinets and office accessories*".
- 2.4 The contested domain name was registered by the Complainant in 2003 and appears to have been acquired by the Registrant in about February 2017.
- 2.5 The Complainant was approached in 2016 by Chamberlink with an offer to "*host the domain and to upgrade the website, free of charge*". The Complainant accepted the offer and the parties entered into an agreement, the details of which have not been provided. Annexure C of the Dispute is a letter from the Complainant to its erstwhile domain hosting company, Triponza Trading 376 CC, in which the Complainant terminates its relationship with the former hosting company and instructs it to transfer its "*hosting account*" to Chamberlink.
- 2.6 In June 2017, the Complainant decided to upgrade its website. It was then that the Complainant became aware that the domain name was registered in the name of the Registrant. The Complainant contacted Chamberlink requesting the transfer of the domain name. Annexed to the Complaint as Annexure D is a copy of an email dated 19 July 2017 from the Registrant to

the Complainant's representative, Mr. Marcel Bommeli, (presumably in response to the request) refusing to transfer the domain name to the Complainant. The Registrant indicated that an amount of R45 000 was incurred in the development of the website and that she did not wish "to part with the domain". The Registrant, in the email, offered to "upload" the Complainant's website onto the contested domain name and to "have the DNS settings" point to the website in exchange for the payment of the R45 000.

2.7 The Complainant's attorneys, Galloway Van Coller & Griessel, then wrote a letter to Chamberlink demanding that the "website" (presumably the domain name) immediately be released to the Complainant's representative, Mr. Bommeli. A copy of the letter, dated 11 September 2017, is annexed to the Dispute as Annexure B.

2.8 The Registrant did not comply with the Complainant's demand.

2.9 The contested domain name currently resolves to the Complainant's website. It appears from the case history that there was a brief disruption in services after the Dispute was filed (caused by a hack, according to the Registrant) but that appears to have since been resolved.

### 3 Parties' Contentions

#### 3.1 Complainant

- a) The Dispute is based on Regulation 3(1)(a) which requires a complainant to assert that:
  - i. it has rights in respect of a name or mark which is identical or similar to the domain name; and
  - ii. in the hands of the registrant the domain name is an abusive registration.
  
- b) Regulation 3(2) requires the Complainant to prove on a balance of

probabilities that the elements in paragraph 3.1(a) are present.

- c) An abusive registration is defined in Regulation 1 as being a domain name that:
- “(a) 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*
- (b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the complainant's rights”.*
- d) The Complainant submits that is traded as OFFICE PRO since 2003 and has used the contested domain name in relation to its business for the same amount of time.
- e) The Complainant submits that it never approved or requested the domain name to be transferred to the Registrant and that it only intended for Chamberlink to host the domain and to upgrade its website.
- f) The Complainant contends that the Registrant/Chamberlink exploited the agreement between the parties by acquiring ownership of the contested domain name without the permission or knowledge of the Complainant. The Registrant then used the domain name against the Complainant to extract payment of the alleged outstanding fees for the development of the Complainant's website. Such conduct is detrimental to the Complainant's business (which relies heavily on internet marketing) and the refusal to transfer the domain name to the Complainant unfairly disrupts the way it can do business. As such, the domain name is an abusive registration.

### **3.2 Registrant**

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

contentions.

- b) However, in their letter dated 4 December 2017 to the SAIPL, the Registrant's attorneys Kruger & Okes indicated that their client "*does not dispute that the domain is the domain of your client*" (referring to the Complainant).
- c) The letter from Kruger & Okes also refers to the outstanding fees and indicates that the matter "*will be dealt with in the relevant Magistrates Court*".

## 4 Discussion and Findings

### 4.1 Complainant's Rights

- 4.1.1 We find that the Complainant has established rights, on a balance of probabilities, in respect of the name or mark OFFICE PRO as contemplated by Regulation 3(1)(a). The Complainant has traded as OFFICE PRO since 2003 i.e. before the domain name was acquired by the Registrant, and has used the contested domain name in relation to its business since then as well. The Complainant's allegations in this regard are uncontested and have been admitted by the Registrant's attorneys in their letter to SAIPL. The threshold for establishing a right in terms of the Regulations is fairly low. Reference is made to the appeal decision of [xnets.co.za ZA2011-0077](#) which stated at paragraph 5(d) that "*the main point of the test is to make sure that the person who complains is someone with a proper interest in the complaint. The notion of "rights" for the purposes of Regulation 3(1)(a) is not trammelled by trade mark jurisprudence. By definition, rights include "intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African Law, but is not limited thereto*".

## 4.2 Abusive Registration

4.2.1 The Complainant does not rely on any particular factors set out in Regulation 4(1) indicating abusiveness.

4.2.2 However, although not referred to in the Complaint, the *proviso* to Regulation 5(c) provides that abusiveness shall be presumed where the domain name is identical to a mark in which a Complainant asserts a right. The burden of proof shifts to the Registrant to show that the domain name is not abusive. The presumption applies to this Dispute and has not been rebutted.

4.2.3 In the circumstances, we find that the contested domain name is an abusive registration. Accordingly, we uphold the Complainant's complaint.

## 5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, we order that the domain name <officepro.co.za> be transferred to the Complainant.

.....  
**GÉRARD DU PLESSIS**

SAIIPL SENIOR ADJUDICATOR

[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)

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**KAREEMA SHAIK**

SAIIPL TRAINEE ADJUDICATOR

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