



Decision

[ZA2022-0445]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2022- 0445
DECISION DATE:	28 July 2022
DOMAIN NAME:	Eastlondonairport.co.za Georgeairport.co.za Kimberleyairport.co.za Upingtonairport.co.za
THE DOMAIN NAME REGISTRANT:	Excelsior Digital (Pty) Ltd
REGISTRANT'S LEGAL COUNSEL:	T Giyapersad Incorporated - Warren Ramiah
THE COMPLAINANT:	The Airports Company SA Soc Ltd
COMPLAINANT'S LEGAL COUNSEL:	Dentons South Africa - Muhammad Patel
2 nd LEVEL ADMINISTRATOR:	ZACR

1) Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **11 April 2022**. On **19 April 2022** the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name(s) at issue, and on **19 April 2022** ZACR confirmed that the domain name had indeed been suspended. The SAIPL verified that they 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 **19 April 2022**. In accordance with the Regulations the due date for the Registrant’s Response was **19 May 2022**. The Registrant did not submit any response. On **24 May 2022** the Registrant requested an extension on the deadline for the response. The administrator acceded to the request and granted the Registrant a 2 (two) weeks extension up until the **7 June 2022**. The Registrant submitted its Response on **6 June 2022**, and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL’s Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on **7 June 2022**.
- c) In accordance with the Regulations the due date for the Complainant’s Reply was **14 June 2022**.
- d) The SAIPL appointed **Vanessa Lawrance** as the Adjudicator on **12 July 2022**, and **Sizwe Snail ka Mtuze** as Trainee Adjudicator in this matter on **15 July 2022**. The Adjudicators have submitted Statements of Acceptance and Declarations of Impartiality and Independence, as required by the SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2) Factual Background

- 2.1 The Complainant in this domain name dispute is The Airports Company South Africa SOC LTD which was formed under the Companies Act of 1973 as a public company as well as The Airports Company Act of 1993. It’s a state owned company, the majority shareholder of the same is the South African government.

The sole purpose of the Airport Company South Africa is to run and administer the Airports belonging to the South African government. As of 2020, the Airports Company has nine (9) Airports. The Airport Company has two (2) income streams namely aeronautical income as well as commercial undertaking and flows from retail operations, car parking, car rental concessions, advertising, property leases and hotel operations.

2.2 It is common cause that the Complainant is the registered proprietor in South Africa of the following trade marks;

TM number 2010/ 04144 EAST LONDON AIRPORT in class 39;

TM number 2010/ 04148 GEORGE AIRPORT in class 39;

TM number 20104/04150 KIMBERLEY AIRPORT in class 35:

TM number 2010/04151 KIMBERLEY AIRPORT in class 39; and

TM number 2010/04410 UPINGTON INTERNATIONAL AIRPORT in class 39.

2.3 In March 2022 the Complainant discovered that the Registrant had registered the kimberlyairport.co.za domain name. It also is evident from the papers that the Complainant's attorneys submitted a Takedown Notice on the 28 March 2022. It is apparent from the papers that the said takedown notice was not successful.

2.4 It also appears from the papers that the Registrant in opposing the said Takedown also put a notice or a disclaimer on its website stating the following: "Please note this website is not the ACSA website and is not owned by ACSA". Despite demand by the Complainants' attorneys that the Registrant cease to use its trade mark and the domain name the Registrant has refused to do so.

2.5 Subsequent to discovering the domain name kimberleyairport.co.za, the Complainant's attorneys further discovered that the Registrant had also registered the following domain names with active websites.:

www.eastlondonairport.co.za;

www.georgeairport.co.za; and

www.upingtonairport.co.za

It appears from the Who-Is information that the above-mentioned websites were registered on 25 April 2018, which is the same date on which www.kimberleyairport.co.za was registered.

The Complainant alleges that the above-mentioned websites are an infringement of its registered trade marks, and that it has used the marks substantially over the years, giving rise to a reputation in the marks. The Registrant denies this and raises several defenses.

3) Parties' Contentions

3.1 Complainant

- a) It is the Complainant's assertion that the domain names currently under the control of the Registrant are identical or similar to a mark or name in which the Complainant has rights in terms of regulation 3 [1] [a]

In support of its contention the Complainant lists its registered South African trade marks (I refer to par 2.2 above). The Complainant attached register extracts in respect of its trade marks.

The Complainant's trade mark rights date back to 2010.

- b) The Registrant also alleges that the disputed domain names are visually and phonetically similar and wholly incorporate the Complainant's trade marks. As a result, according to the Complainant, the disputed domain names are not distinguishable or cannot be differentiated from EAST LONDON AIRPORT, GEORGE AIRPORT, KIMBERLEY AIRPORT and UPINGTON INTERNATIONAL AIRPORT trade marks.
- c) It appears from the Complainant's papers that the Complainant also seeks to rely on its common law trade mark rights to the said names, as it claims to have had use and reputation in the marks over the years. The Complainant also asserts that it is associated with the well known marks by the public, and its marks are also internationally renowned. As a result, the Complainant not only complains of the infringement of the trade mark but

also complains that the Registrant's actions of registering the domain names similar to its common law trade marks could lead to passing off and harm the Complainant's reputation and goodwill in respect of its EAST LONDON AIRPORT, GEORGE AIRPORT, KIMBERLEY AIRPORT and UPINGTON AIRPORT trade marks.

- d) It is also important to mention that East London Airport has now had a name change and is known, as of February 2021, as King Phalo International Airport. The adjudicator will further deal with this aspect in the discussion and findings of this ruling.
- e) The Complainant also complains that the registration of the said domain names by the Registrant misleads members of the public to believe that the said domain names are part of, endorsed and/or approved by the Complainant, which the Complainant vehemently denies. According to the Complainant, the Registrant's conduct amounts to passing off as well as unlawful competition.

The Complainant concludes by stating that the domain names in the hands of the Registrant amount to an abusive registration and that the said abusive registration will also confuse members of the public into believing that the domain names in dispute are those of the Complainant. The Complainant has, in addition, raised a case of Typo squatting which, according to the Complainant, is intended to result in legitimacy in the eyes of the unsuspecting reader being gained, based on the reputation of the Complainant and its airports.

The Complainant alleges that the domain names in question advance the Registrant's business interests of car hire and flight and does so by using the Complainant's registered trade marks or airport names in an unlawful manner. The Complainant claims that the Registrant does not offer the actual goods or services suggested by its domain names; websites attached to the disputed domain names go beyond listing of car hire and flights to include reference to accommodation and parking tariffs.

The Complainant also complains that the Registrant has hidden its identity in the Who-is database and that it seeks to damage the Complainant's brand.

It is the Complainant's submission that the effect of these actions is that regulations 4 [1] [a] [ii] to [iv] and 4 [b] and [d] have been contravened, and that there is therefore abuse.

- f) It is also the Complainant's case that the disputed domain names in the hands of the Registrant is an abusive registration in terms of regulation 3 [1] [a].

Complainant contends that it was the Registrant's intention to block the name or mark of the Complainant by registering the disputed domain names. It is also the Complainant's contention that the Registrant registered the domain names to unfairly disrupt the business of the Complainant.

The Complainant furthermore alleges that the Registrant has prevented the Complainant from exercising its rights to the domain names in dispute. The Complainant also makes the case that people and all businesses may believe that the domain names are registered to, operated or authorized by or otherwise connected to the Complainant. And lastly the Complainant complains that the domain names take unfair advantage or are detrimental to the Complainants rights and that they said internet websites attract commercial gain for the Registrant that it is not entitled to.

3.2 Registrant

- a) Before the adjudicator considers the Registrant's case before it, the adjudicator wishes to point out that the Registrant is legally represented by both an attorney and an advocate. It is most disturbing to note that in the finalization of the Registrant's response that the commissioner's certificate of oath has not been completed correctly. It is trite in the case of in S v Munn 1973 (3) SA 736 (NCD) that non-compliance with the regulations does not per se invalidate an affidavit.

The regulations direct only that non-compliance with the regulations would not invalidate an affidavit if there is substantial compliance with the formalities in such a way as to give effect to the purpose of obtaining a deponent's signature to an affidavit. Obtaining the deponent's signature to an affidavit is primarily to obtain irrefutable evidence that the relevant deposition was indeed sworn to. That a commissioner of oath is merely required to have substantial compliance with the regulations pertaining to commissioners of oath. (Supra at 737F-H)

Fortunately for the Registrant this is not a court of law but an administrative forum that does not apply the law as strictly as the courts do. This view has also been stated in several decisions of the SAIPL domain disputes over the years.

As much as the Adjudicator will proceed to consider the Registrants response herein the adjudicator must state that it is not impressed by the fact that the Registrant who is legally represented by an attorney as well as an advocate has failed to comply with such a basic requirement, which the average attorney and advocate should know and ensure is done.

The Registrant's submissions will now be considered.

The Registrant is Excelsior Digital (Pty) Ltd a private company with business address in KwaZulu Natal. It has been involved in the digital industry for many years and owns a network of car hire and flight booking websites, which it uses to provide travel-related information and services pertaining to a particular area in South Africa.

The Registrant claims that these services are operated from the four airports mentioned in this domain name dispute. The Registrant also states that its core objective is to provide travelers with useful information and necessary amenities to facilitate their trips that arrive at or depart from the four airports referred to in this domain name dispute.

The Registrant claims that its services are offered in good faith and fulfilled via third party affiliate partners. These services relate *inter alia* to flight bookings, car hire and accommodation services. The Registrant claims that it chose the specific domain names, which are names of cities coupled with the word “Airport”, as they are geographical names and that the word “airport” is generic and / or descriptive.

The Registrant also claims that no individual or legal entity can claim any exclusive use “of the English language that is merely descriptive in nature and bears no attachment to the entity claiming certain rights”. It is accepted that the Registrant intends to claim that no party can claim exclusive rights in descriptive terms in the English language. The Registrant persists that the domain name registrations do not infringe any registered domain name or any other statutory rights.

- b) The Registrant then also points out that the Complainant has thrown in the common law remedy of passing off as a belated afterthought. The Registrant points out that the test for passing off is whether use would lead to confusion in the mind of the public, not merely one individual.

The Registrant points out that the Complainant has the onus to prove the existence of the elements listed in the Regulations.

- c) It appears then that the Registrant intends to rely on three defenses namely:
- (a) it was unaware of the Complainant’s registered marks;
 - (b) it is utilizing the registered domain names in promoting good faith services and
 - (c) it has fair use of the said domain names in terms of regulation 5(b) in that the disputed domain names are generic or descriptive.
- d) The adjudicator will now outline the submissions made by the Registrant in further detail.
- (a) The Registrant was unaware of the Complainant’s registered marks, and it registered the domain names to promote its good faith services.

The Registrant, in addition, avers that he was using the disputed domain names in line with the fair-use principles as set out in regulation 5 of the ADR regulations.

- (b) The Registrant claims that the disputed domain names are generic or descriptive.

The Registrant states in its defence that the disputed domain names have been used generically and that they are descriptive. The Registrant also claims that the use of the word "airport" is, by its very nature descriptive as the word is a generic noun. The Registrant goes further to state that it uses the word "airport" to indicate the type of place wherein the Registrant's services are offered and this should in no manner or fashion be confused with a government owned entity, like the Complainant. The Registrant suggests that the Oxford dictionary defines the word airport as a complex of runways and buildings for the takeoff landing and maintenance of civil aircraft, and facilities for passengers.

- (c) The Registrant denies that there is passing off because the reasonable consumer will not be confused.

The Registrant in its defense states that there is no passing off and the domain names are not identical / similar and that there is no confusion caused to the average consumer. The Registrant repeats that the use of the word airport in relation to the provision of its services is not meant to create any association with the Complainant, but rather to indicate to potential customers that such services are in fact airport based and revolve around airports in a generic manner. Such use of the word airport should be akin to other examples such as airport security. The Registrant then goes on to state that the domain names contain words that are descriptive of the cities in which the Registrant offers the airport-centric services.

- (d) The Registrant denies that the Complainant has shown a pattern of abusive registrations.

The Registrant repeats that the registrations of the domain names were solely for the purposes of conducting its business and in no way are abusive. It further points out that there have been no other instances where the Registrant was deemed to have made an abusive registration.

- (e) The Registrant denies that the domain names in its hands are abusive.

The Registrant specifically states in its reply that the domain names were not registered to disrupt the business of the Complainant in any manner. The Registrant also states that the Complainant has failed to prove that it has received complaints pertaining to the alleged incorrect parking tariff.

Dismissal of the complaint is sought because, according to the Registrant, the Complainant has failed to set out and to show the circumstances as contemplated by regulation 4(1)(a).

4) Discussion and Findings

- a) In terms of Regulation 3, in order to succeed in a domain name dispute based on an alleged Abusive registration, a Complainant is required to prove, on a balance of probabilities that the following three elements are present:
1. the Complainant has rights in respect of a name or mark;
 2. the name or mark is identical or similar to the domain name; and
 3. the domain name, in the hands of the Registrant, is an abusive registration.

4.1 Complainant's Rights

- 4.1.1 Regulation 1 states that "'rights" and "registered rights" envisaged include intellectual property rights, commercial, cultural, linguistic, religious and

personal rights protected under South African law, but is not limited thereto” (also see *Mxit Lifestyle (Pty) Ltd v Andre Steyn* [ZA2008-0020, 30-9-2008]). This broad approach is advantageous and it follows that business names will also fall within the list of "rights" (reference is made to T Pistorius -za Alternative Dispute Resolution Regulations: The First Few SAIPL Decisions, 2008(2) Journal of Information, Law & Technology (JILT).

4.1.2 Section 36(1) of the Trade Marks Act protects continuous and bona fide prior use of what would otherwise amount to trade mark infringement. It provides that:

‘Nothing in this Act shall allow the proprietor of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in respect of goods or services in relation to which that person or a predecessor in title of his has made continuous and bona fide use of that trade mark from a date anterior –

- (a) to the use of the first mentioned trade mark in relation to those goods or services by the proprietor or a predecessor in title ...; or
- (b) to the registration of the first mentioned trade mark in respect of those goods or services in the name of the proprietor or a predecessor in title of his; whichever is the earlier...’

The underlying purpose of this section is to prevent a proprietor of a trade mark from exercising rights merely on the basis of priority of registration and it preserves whatever common-law rights there may be antecedent to the rights of the registered proprietor (see the case of *Nino's Coffee Bar & Restaurant CC v Nino's Italian Coffee & Sandwich Bar CC & another; Nino's Italian Coffee & Sandwich Bar CC v Nino's Coffee Bar & Restaurant CC* 1998 (3) SA 656 (C) par 63) .

A party relying on this defence must establish bona fide and continuous use of the mark, either by itself or by its predecessor in title, from a time prior to the use or registration of the registered mark by the proprietor thereof (see the case of *Etraction (Pty) Ltd v Tyrecor (Pty) Ltd* [2015] ZASCA 78 at par 11.

In this case the adjudicator is not convinced that the Registrant has made out a case of prior use, nor may the Registrant rely on the same in defence of the Complainant's claim.

The Registrant has also failed to make out a case that it has made fair use of the said domain names in terms of regulation 5(b).

It is accepted that geographical names may be protected if a party has shown that he or she has acquired rights to the use of such a geographical name. (See the case of Century City Apartments Property Services CC and Another v Century City Property Owners Association (57/09) [2009] ZASCA 157).

The reason that no one is entitled to claim trade mark rights in a geographic indicator is so that no party can prevent others from making use of the geographical indicator as a descriptive term. Where a geographic indicator is linked to another term (which may also be descriptive, when read on its own), the combination may be registrable as a trade mark, and protected as such. The Complainant is not attempting, by registering its various trade marks, to prevent others from using wither the name of the city, or the word "airport", but rather the combination of the various city names with the word airport, because rather than a common noun, these are now proper nouns; they refer to specific airports or specific places.

This accords with the fact that the trade marks are factually registered in the name of the Complainant.

- 4.1.3 The Adjudicator finds that the Complainant has rights in the marks or names and is the bona fide owner of the trade marks EAST LONDON AIRPORT, GEORGE AIRPORT, KIMBERLEY AIRPORT, and UPINGTON AIRPORT, marks identical to the domain names in dispute.

4.2 Abusive Registration

- 4.2.1 The domain names in question are identical to the Complainant's trade marks. The Adjudicator therefore finds that the elements listed in Regulation 3(1)(a) have been proven. The question then is whether the registration in the hands of the Registrant is an abusive registration. An "abusive registration" is defined in Regulation 1 as a domain name which either took "unfair advantage of or was unfairly detrimental to the Complainant's rights at the time when the domain name was registered; or a domain name which has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights" (see Embassy Travel v Nu-com System [ZA2008-0024]).
- 4.2.2 In the Adjudicator's view, there can be no doubt that the registration and/or acquisition of the registration by the Registrant is detrimental to the Complainant's rights. Members of the public will be drawn to the sites because they want official information about the airports in question. The Registrant's advertisements will be seen by these unsuspecting browsers. Members of the public will be likely to believe that the advertisement on the websites attached to these domain names is somehow linked to or endorsed by the Complainant. This is particularly so because the Complainant's contact details and information about its parking tariffs appears on the websites. The Registrant is likely to gain a springboard advantage in the marketplace as a result of its use of the domain names. In addition, no matter what the Registrant's intention is, the fact that it has registered the domain names prevents the Complainant from doing so.
- 4.2.3 The said domain names were used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights the view that the Complainant has been successful with proving the same.
- (a) In the case of Mr Plastic Mining and Promotional Goods v. Mr Plastic CC [ZA2007-0001] at pp 13-17 it was decided that a claim of passing off will only succeed if the Complainant's trade marks are distinctive of it and that trade or the general public necessarily connect its trading activities to a particular mark.

(b) The Adjudicator is of the view that the Registrant has passed off his own businesses off as being associated and/or affiliated with that of the Complainant to channel business to his own business or mala fide commercial competition; (see the case of Telkom SA Limited v. Cool Ideas 1290 CC [ZA2007-0003] at pp 20) The Adjudicator also refers to the case of Times Media (Pty) Ltd v Private Registrant [ZA2016-0249] as referred to by the Registrant with approval:

“The disputed domain name has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant’s rights. Apart from the grounds as set out in the Complainant’s contentions, the evidence suggests that the Registrant had every intention to abuse the rights of the Complainant by posting untrue and fictitious news articles on its website, fully utilising the reputation and goodwill of the Complainant, to the detriment of the Complainant. The public would, on all probabilities be confused into believing that the website of the Registrant is that of the Complainant, due to the confusing similarity of the disputed domain name to the Complainant’s domain names and trademarks.”

(c) No case however has been made out by the Complainant for typo-squatting and this part of the Complaint is rejected.

(d) It is impossible not to find that registration of the said domain names unfairly disrupts the business of the Complainant (see the case of Telkom SA Limited v. Customer Care Solutions (Pty) Ltd[ZA2007-0004] at pp 20 -22). The Adjudicator is also in agreement with the Complainant’s submissions that this case is a case akin to the facts of the case of The Himalaya Drug Company (Pty) Ltd (First Complainant) Himalaya Global Holdings (Second Complainant) vs Goodibox [ZA2021-0431] where it was held that:

“As for the grounds in terms of Regulation 4(1)(1)(b), it is the Adjudicator’s view that it is likely that the average member of the

public will assume that the business of the Registrant, conducted through the website associated with the domain names, is somehow related or connected with that of the Complainants, or is authorised by the Complainants. The domain names incorporate the Complainants' trademarks. The domain names are being used to attract customers to view and purchase the Himalaya Products. The domain names are registered in the name of the Registrant and its sole member is the party controlling the domain names and the associated websites. The Complainants do not authorise this use. Accordingly, the Adjudicator finds in favour of the Complainants on this ground ..."

- (e) The Adjudicator finds that the use made by the Registrant cannot be said to be either fair or bona fide use of the domain names. 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 marks in issue (see the case of Sun International v Peter Britz [ZA2008-0025]).
- (f) Accordingly, the Adjudicator finds that the Registrant has not brought itself within the ambit of Regulation 5(a)(i) or (ii) of the Regulations which provide examples of factors that may indicate that a domain name is not an abusive registration. These 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...". (Ibid)
- (g) The Adjudicator however accepts that the Complainant did not make out a case to show a pattern of abusive registrations. The rebuttable presumption of abusiveness contained in Regulation 4(3) cannot therefore be applied herein. The Adjudicator refers to the case of Mozilla Foundation & Mozilla Corporation vs See Zhao [ZA2017-0262]

for the applicable test. This presumption is in any event not required in this instance.

(h) Consequently, the Adjudicator finds that the disputed domain names, in the hands of the Registrant are abusive registrations as the disputed domain names have been registered and subsequently used in such a way that leads people or businesses to believe that the disputed domain names are registered to, operated or authorised by, or otherwise connected with the Complainant. The notice put onto the website does not, in the mind of the Adjudicator, save the Registrant in this instance.

(i) The Adjudicator therefore finds that the registration and use of the domain names: eastlondonairport.co.za, georgeairport.co.za, kimberleyairport.co.za and upingtonairport.co.za is contrary to the Complainant's statutory and common law rights.

5) Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the following Domain names:

Eastlondonairport.co.za
Georgeairport.co.za
Kimberleyairport.co.za, and
Upingtonairport.co.za,

be transferred to the Complainant.

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Vanessa Lawrance

SAIPL SENIOR ADJUDICATOR

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Sizwe Snail ka Mtuze
SAIPL Trainee ADJUDICATOR
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