

ADJUDICATOR DECISION

CASE NUMBER:	ZA2009-0029
DECISION DATE:	20 JULY 2009
DOMAIN NAME	weskusmall.co.za, westcoastmall.co.za, westcoastcentre.co.za, westcoastshopping.co.za, weskuscentre.co.za, weskusshopping.co.za
THE DOMAIN NAME REGISTRANT:	Symfony Digital Solutions CC
REGISTRANT'S LEGAL COUNSEL:	Donovan Graham eon Pretorius Inc
THE COMPLAINANT:	Witteklip Mall (Pty) Limited
COMPLAINANT'S LEGAL COUNSEL:	Gideon Pretorius Inc
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

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1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on 29 April 2009. On 30 April 2009 the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain names at issue and on the same day UniForum SA confirmed that the domain name had indeed been suspended.
- b. After seeking clarification on certain deficiencies in the Dispute the SAIIPL was satisfied that the minimum formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIIPL's Supplementary Procedure were met.
- c. In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on 14 May 2009. In accordance with the Regulations the due date for the Registrant's Response was 12 June 2009. The Registrant submitted its Response on 12 June 2009, and the SAIIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIIPL's Supplementary Procedure. The SAIIPL forwarded a copy of the Response to the Complainant on 17 June 2009.
- d. In accordance with the Regulations the due date for the Complainant's Reply was 24 June 2009. This period was extended until 3 July 2009, but no Reply has been received from the Complainant to date.
- e. The SAIIPL appointed Vanessa Lawrance as the Adjudicator in this matter on 8 July 2009. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2) Factual Background

- a. On or about 10 March 2008, Symphony Digital Solutions CC registered the domain names weskusmall.co.za, westcoastmall.co.za, westcoastcentre.co.za, westcoastshopping.co.za, weskuscentre.co.za and weskusshopping.co.za.
- b. On or about 14 May 2009, Witteklip Mall (Pty) Limited lodged a dispute with the SAIIPL's ADR, to which a response was received on 12 June 2009. The relevant allegations made in the representations made by both parties will be dealt with below.

3) Parties' Contentions

a. Complainant

- i. The Complainant claims to be the owner of the Weskus Mall (in Vredenburg on the West Coast).
- ii. The Complainant claims that the Registrant registered the disputed domain names with no intention whatever to "trade under any of the disputed names".
- iii. The Complainant further alleges that the Registrant attempted to sell the domain name to the Complainant, and attaches an invoice in this regard.
- iv. The Complainant claims that the Registrant registered the domain name purely with a view of exhorting a financial benefit from the Complainant and that the registration of the domain name has been disruptive to the Complainant's marketing and trading efforts.

b. Registrant

- i. The Registrant claims that it always had the intention of creating an on-line shopping network that would sell computers and computer-related equipment, to be linked to the domain name weskusmall.co.za.
- ii. The Registrant claims that the offer to sell the domain names was made only after a representative from the Complainant had telephonically approached the Registrant with an offer to purchase the domain names and persuaded the Registrant to sell. It was not the Registrant's intention to sell the domain names at the time of their registration.

4) Discussion and Findings

It is accepted that, in order to succeed in a dispute based on the allegation that the domain name in question is an abusive registration, the following must be proved:

1. The domain names are identical or similar to a name or mark in which the Complainant has rights;
2. The domain names in hands of the Registrant are abusive registrations.

a. Complainant's Rights

In the view of the adjudicator, the Complainant has failed to prove that it has rights in the Trade Mark WESKUS MALL. It was free to prove the existence of any intellectual property rights, commercial, linguistic, religious or personal rights, and it has not done so.

The Complainant merely makes a vague reference to the fact that it is the owner of the Weskus Mall. It claims that it chose to name the mall

Weskus Mall while in the process of building the centre and claims to have marketed the mall as the Weskus Mall.

There is no indication of the date upon which the Complainant commenced use of the name Weskus Mall, nor are there any examples of its use of the name Weskus Mall (in marketing or otherwise) attached to the dispute. There is no evidence of the use required to give rise to common law trade mark rights, nor are there any allegations that the Complainant has filed application to register the mark Weskus Mall as a trade mark.

This is so much more the view of the adjudicator in light thereof that the "West Coast" (Weskus), is a geographical indicator, and the Trade Marks Act prohibits the acquisition of exclusive rights in an indicator of geographic origin. The Complainant would accordingly require extensive substantiating evidence to convince the adjudicator that the Complainant has rights that can be protected.

b. Abusive Registration

In light of the above, the adjudicator finds it unnecessary to decide on this point.

c. Reconsideration of dispute

The Complainant may have done itself a disservice by filing a deficient dispute because, in terms of Regulation 11(5), a dispute may not be reconsidered by the SAIIPL ADR panel. The Complainant will therefore have to apply to the Courts for further relief.

5) Decision

For all the foregoing reasons, the dispute is refused.

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VANESSA LAWRENCE
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za