

Decision

ZA2011-0066

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2011-0066
DECISION DATE:	16 March 2011
DOMAIN NAME	digicert.co.za
THE DOMAIN NAME REGISTRANT:	Mr Alex Griessel
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Digicert Inc.
COMPLAINANT'S LEGAL COUNSEL:	Adams and 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 “SAIPL”) on **6 January 2011**. On **7 January 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **7 January 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 **10 January 2011**. In accordance with the Regulations the due date for the Registrant’s Response was **8 February 2011**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **9 February 2011**.
- c) The SAIPL appointed **Andre van der Merwe** as the Adjudicator in this matter on **16 February 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.
- d) The appointed adjudicator sought an extension of time to file the decision of this dispute until Wednesday, **16 March 2011**, which extension was granted.

2 Factual Background

- a) The factual background appears from the Dispute lodged by the Complainant. As no response to the dispute was filed, there is no dispute in factual issues and the Adjudicator may accept the allegations of fact by the Complainant as generally correct.

-
- b) The dispute relates to the domain name **digicert.co.za**, which was first registered on 22 February 2010
- c) According to the Whois search, the Registrant in these proceedings is the listed .co.za registrant of the domain name in dispute, **Alex Griessel**. The following information is known to the Complainant about the Registrant:
- Postal Address: P O Box 68698
Highveld
Centurion
0169
- Physical address: Postal addressed provided
- Telephone: +27828284638
- Fax: 0866594647
- Email: alexgriessel@gmail.com
- d) The Complainant is a United States-based certificate authority, established in 2003 in Lindon Utah.
- e) The Complainant has made widespread and extensive use of the DIGICERT trade mark, including in South Africa since 2004.
- f) The Complainant is also the applicant in South Africa in respect of trade mark application No 2010/08529 DIGICERT in class 45 in respect of *“authentication issuance and validation of digital certificates; computer security services in the nature of providing an internet trust centre, namely, computer security assurance and administration of digital keys and digital certificates”*. No further particulars are provided for this trade mark application.
- g) The Complainant issues SSL certificates (providing communications security over the Internet) under the DIGICERT trade mark to customers worldwide and is the fifth largest public certificate authority in the world.
- h) The Complainant provides services to entities in South Africa and currently

has 236 customers in South Africa. The Complainant provided example of certificates issued to South African Companies dating back to 2004.

- i) The Complainant advertises its services primarily by way of its website www.digicert.com and receives millions of visitors annually worldwide, including South Africa. The Complainant confirmed that its website, had by way of example received 12,124,991 website hits from South Africa for the period between May 2009 and October 2010.
- j) The Complainant's servers receive approximately 500 000 certificate status checking requests from South Africa daily.
- k) The Complainant's use of the DIGICERT trade mark predates 22 February 2010, the date of registration of the domain name.
- l) The domain name **digicert.co.za** redirects to the website of Webnetix CC at www.digitalcertificates.co.za. The extracts from the website confirms that the Registrant offers virtually identical services to those of the Complainant, namely the provision of SSL certificates. A search of the Companies and Intellectual Property Registration Office confirms that the Registrant, Alex Griessel, is a member of Webnetix CC. The extracts from the website of Webnetix further confirm that it is a reseller of THAWTE digital certificates; Thawte is one of the Complainant's major international competitors. Webnetix provides services which are in direct competition with the Complainant. Webnetix does not use the **digicert.co.za** domain name as its primary web address or the DIGICERT trade mark anywhere on its website.
- m) The Complainant's attorneys, Adams & Adams, addressed a letter of demand to the Registrant on the 29 June 2010, however no response was received at the date of lodgement of the Complaint.

3 Parties' Contentions

3.1 Complainant

- a) The basis of the Complainant's objection is that the domain name

digicert.co.za is an abusive registration [Regulation 3(1)(a)]

- b) The Complainant submits that the Registrant registered the domain name digicert.co.za primarily to block internationally the registration of the DIGICERT name or a mark in which the complainant has rights and to divest customers seeking the Complainant's services to its own website, on which competitive services are offered.

3.2 Registrant

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

4 Discussion and Findings

4.1 Complainant's Rights

- a) Having read the dispute, the Adjudicator is satisfied that
 - i) Complainant has established common law rights, both Internationally and in South Africa, in the DIGICERT trade mark, particularly in relation to the issuance of SSL certificates;
 - ii) The Complainant's common law rights, in the DIGICERT trade mark, predate the Registrant's registration of the **digicert.co.za** domain name; and
 - iii) The **digicert.co.za** domain name is identical to the Complainant's DIGICERT trade mark in which it has acquired common law rights.

4.2 Abusive Registration

- a) In terms of Section 3(1)(a) of the Regulations, to succeed with its Dispute, the Complainant has to prove, on a balance of probabilities, that:
 - i) It has rights in respect of a name of mark which is identical or

similar to the domain name; and

- ii) The domain name, in the hands of the Registrant, is an abusive registration as defined in that it 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.
- b) In terms of Section 1 (a) of the Regulations, an abusive registration means a domain name which
- i) 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...
- c) The provisions of Section 5(c) states that "the burden of proof shifts to the Registrant to show that the domain name is not an abusive registration if the domain name (not including the first and second level suffixes) is identical to the mark which the complainant asserts rights, without addition"
- d) The subject name of the domain name is the mark DIGICERT. This mark is identical to the Complainant's DIGICERT trade mark.
- e) The Complainant has alleged common law rights and I consider the rights established for the purpose of this Dispute.
- f) It is trite that common law rights in and to a trade mark qualify as "rights in respect of a name or mark" in terms of the section 3(1)(a) of the regulations. This was confirmed in the decision in **Mr Plastic Mining & Promotional Goods vs. Mr Plastic CC (ZA2007-0001)**
- g) As a result, the burden of proof has been shifted to the registrant to prove that the registration **digicert.co.za** domain name is not an

abusive registration and, in light of the fact that the Registrant has not responded to the Complainant, the matter has been disposed of.

- h) I am of the view that the domain name amounts to an abusive registration in the hands of the Registrant.

5. Decision

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

.....
ANDRE VAN DER MERWE
SAIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za