

## Decision

**[ZA2011-0079 ]**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2011-0079</b>
DECISION DATE:	<b>01 August 2011</b>
DOMAIN NAME	<b>sapostoffice.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>ZADomain Register</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>South African Post Office Limited</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Hahn &amp; Hahn Inc</b>
2 <sup>nd</sup> LEVEL ADMINISTRATOR:	<b>UniForum SA (CO.ZA )</b>

## 1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on **31 May 2011**. On **1 June 2011** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **1 June 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 **2 June 2011**. In accordance with the Regulations the due date for the Registrant’s Response was **4 July 2011**. The Registrant did not submit a Response, and accordingly, the SAIPL notified the Registrant of its default date on **5 July 2011**.
- c) The SAIPL appointed **Mike du Toit** as the Adjudicator in this matter on **13 July 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.

## 2 Factual Background

- a) The disputed domain name, sapostoffice.co.za, wholly incorporates the name POST OFFICE which the Complainant alleges is protected by the Post Office Act, the Trade Marks Act and common law.
- b) The Complainant further alleges that, until recently, the Registrant was making use of the domain name in relation to a website offering services in competition with the Complainant and the Complainant is of the view that there is a reasonable possibility that the Registrant will continue to do so

again, if the domain name remains in the hands of the Registrant.

- c) The Complainant therefore requests this tribunal to issue a decision for the transfer of the domain name, sapostoffice.co.za, from the Registrant to the Complainant.

### **3 Parties' Contentions**

#### **3.1 Complainant**

- a) The Complainant is South African Post Office Limited, a public company with limited liability established in terms of the Post Office Act 44 of 1958.

#### **3.2 Registrant**

- a) The Registrant is ZADomain Register. No details other than those provided by Uniforum's Whois facility are known in respect of the Registrant.

### **4 Discussion and Findings**

#### **4.1 Complainant's Rights**

- a) In terms of section 99 of the Post Office Act, any person who "without the authority of the [Complainant] places or maintains or suffers to be placed or maintained or to remain in, on, or near any house, premises, wall, door, window, box, post, pillar or other place belonging to him or under his control the words 'Post Office' or any other word or mark which may imply or may give reasonable cause for believing that house, premises, wall, door, window, box, post, pillar or other place to be a post office, shall be guilty of an offence".
- b) Furthermore, the Complainant, being the only entity entitled to conduct postal services in South Africa for decades, has used the trade marks POST OFFICE or SOUTH AFRICAN POST OFFICE

extensively in South Africa and I agree that there can hardly be any individual in South Africa that does not know who the South African Post Office is. The Complainant alleges that the trade marks POST OFFICE, SA POST OFFICE and SOUTH AFRICAN POST OFFICE (“the POST OFFICE trade marks”) are well-known trade marks in South Africa, however, the Complainant has not provided evidence in support of this. In my view, the Complainant has merely proven that it has acquired an enforceable reputation and common law rights in the POST OFFICE, SA POST OFFICE and SOUTH AFRICAN POST OFFICE trade marks.

- c) Having read the Dispute, the Adjudicator is satisfied that:
- i) the Complainant has established statutory (in terms of the Post Office Act) and common law rights in the POST OFFICE trade marks; and
  - ii) the sapostoffice.co.za domain name is identical to the Complainant’s POST OFFICE trade marks.

#### 4.2 Abusive Registration

- a) In terms of section 3 (a) of the Regulations, to succeed with the Dispute, the Complainant has to prove on a balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name; and the domain name in the hands of the Registrant is an abusive registration as defined.
- b) In terms of section 1(a) of the Regulations, an abusive registration means a domain name which 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.
- c) The subject name of the domain name is the trade mark SA POST

OFFICE. This trade mark is, in my view, identical or confusingly similar to the Complainant's POST OFFICE trade marks. The Complainant has alleged statutory and common law rights and I consider the rights established for the purpose of the Dispute.

- d) The Registrant has previously used the domain name in a manner that would lead members of the public to believe that the domain name is associated with, or belongs to, the Complainant.
- e) In light of the above, I am of the view that the domain name in the hands of the Registrant amounts to an abusive registration.
- f) In addition, in terms of the proviso to section 5 of the Regulations, provided the Complainant proves that the domain name registered by the Registrant is identical to its POST OFFICE trade marks, the burden of proof shifts to the Registrant to show that the registration is not abusive.
- g) The burden of proof has been shifted to the Registrant to prove that the registration of the sapostoffice.co.za domain name is not an abusive registration and, in light of the fact that the Registrant has not responded to the complaint, the matter has been disposed of.

## 5. Decision

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

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**MIKE DU TOIT**  
SAIPL SENIOR ADJUDICATOR  
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