

## Decision

**ZA2012-0113**

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

### ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2012-0113</b>
DECISION DATE:	<b>04 September 2012</b>
DOMAIN NAME	<b>stay-cabanassuncity.co.za stay-cascadessuncity.co.za stay-palacesuncity.co.za stay-suncityhotel.co.za suncitytravel.co.za</b>
THE DOMAIN NAME REGISTRANT:	<b>Ascot Solutions</b>
REGISTRANT'S LEGAL COUNSEL:	<b>N/A</b>
THE COMPLAINANT:	<b>Sun International (South Africa) Limited &amp; Sun International Management Limited</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Adams &amp; Adams</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 "SAIIPL") on **4 July 2012**. On **6 July 2012** the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain names at issue, and on **9 July 2012** UniForum SA confirmed that the domain names had indeed been suspended.
- b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **10 July 2012**. In accordance with the Regulations the due date for the Registrant's Response was **7 August 2012**. The Registrant did not submit any formal response, and accordingly, the SAIIPL notified the Registrant of its default on **8 August 2012**. The Adjudicator notes that the Registrant submitted informal responses on **10 July 2012** and **12 July 2012**, and the SAIIPL verified that these responses did not satisfy the formal requirements of the Regulations and the SAIIPL's Supplementary Procedure. The Registrant submitted a further informal response on **8 August 2012** and this response also did not satisfy the formal requirements of the Regulations and the SAIIPL's Supplementary Procedure. Accordingly, the Adjudicator disregarded all the Registrant's responses.
- c) The SAIIPL appointed **Mrs. Nola Bond** as the Adjudicator assisted by Trainee Adjudicator **Andrew Papadopoulos** in this matter on **13 August 2012**. 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

- 2.1 The Complainants are Sun International (South Africa) ("Sun International") and Sun International Management Limited ("Sun International

Management”), companies incorporated under the Laws of South Africa with an address at 27 Friedman Drive, Sandown, Gauteng.

2.2 According to the information contained on the Second Level Administrator’s WHOIS website, the Registrant in these proceedings is Ascot Solutions of 4 Milton’s Way, 11 Bell Crescent, West Lake Business Park.

2.3 Sun International is the proprietor in South Africa of the registered trade mark **SUN CITY** and of approximately 80 (eighty) trade mark registrations incorporating the mark **SUN CITY**. Sun International is also the proprietor in South Africa of registered trademarks **THE PALACE**, **THE PLACE AT SUN CITY** (and variant trade marks), **CABANAS** logo, **CASCADES**, **THE CASCADES HOTEL** logo and **THE SUN CITY HOTEL** logo. Sun International Management is a management and associated company of Sun International. Sun International has authorised Sun International Management to register the below mentioned domain names, which have been registered in the interest, and for the benefit, of Sun International in order to promote and further Sun International’s trade:

- thepalacesuncity.co.za
- sun-city.co.za
- suncitybookings.co.za
- suncityhotels.co.za
- suncityreservations.co.za
- suncity-reservations.co.za
- sun-city-resort.co.za
- suncityresorts.co.za
- suncityshuttle.co.za
- suncitysouthafrica.co.za
- suncity-southafrica.co.za
- suncityvacation.co.za

2.4 The Complainants’ **SUN CITY** trade mark is primarily used in respect of a

hotel and entertainment resort.

2.5 On consideration of the evidence, the Adjudicator accepts that The Complainants have acquired a substantial reputation in and into the business bearing the **SUN CITY** trade mark.

2.6 The Registrant's domain names:

- **stay-cabanassuncity.co.za**
- **stay-cascadessuncity.co.za**
- **stay-palacesuncity.co.za**
- **stay-suncityhotel.co.za**
- **suncitytravel.co.za**

(hereinafter referred to as the "Domain Names") incorporate the marks **SUN CITY**, **SUN CITY HOTEL**, **CABANAS**, **CASCADES** and **PALACE** being Sun International's registered trade marks or, at least, incorporate the dominant element of those trade marks. The addition of the words "stay-" and "travel" are descriptive of the services to which Sun International trade marks are registered, and accordingly do not serve to distinguish the marks incorporated in the Domain Names.

2.7 The Domain Names point to the respective websites:

- **www.stay-cabanassuncity.co.za**
- **www.stay-cascadessuncity.co.za**
- **www.stay-palacesuncity.co.za**
- **www.stay-suncityhotel.co.za**
- **www.suncitytravel.co.za**

These websites contain a similar layout, as well as the identical images of the resort and hotels to that contained on the Complainants' website, and commonly feature the names of Sun International's registered trade marks and the Complainants' hotels "**THE CABANAS**", "**THE CASCADES**", "**THE PALACE**" and "**THE SUN CITY HOTEL**". The Registrant's websites provide information on the Complainants' **SUN CITY** resort and facilities. Furthermore the disclaimer at the bottom of the [www.suncitytravel.co.za](http://www.suncitytravel.co.za) web page read "copyright © 1995-2001 2006 SUN

CITY TRAVEL. All rights reserved.”

It is clear that the Domain Names point to websites providing travel and related services in respect of the Complainants’ **SUN CITY** resort. Furthermore all contact details refer the public viewing the Registrant’s websites to the Registrant.

On at least 7 November 2011 the websites to which the Domain Names point were deactivated and remained deactivated until the launching of this complaint.

### 3 Parties’ Contentions

#### 3.1 Complainant

- a) The Domain Names incorporate Sun International’s registered trade marks and such use has not been authorised by the Complainants.
- b) The Registrant’s use (before deactivation of its websites) and registration of the Domain Names incorporating Sun International’s registered trade marks and the Complainants’ trading name and trading style **SUN CITY** was and is intended to facilitate the likelihood of confusion and deception, and mislead the public into believing that the Registrant is the Complainants or is associated with the Complainants’ business.
- c) As a result of a misleading association, the Registrant benefits financially by attracting custom and trade.
- d) The only reason the Registrant maintains the registrations of the Domain Names is to reactivate the websites to which the Domain Names point, with the intention of promoting this misleading association.
- e) It is alleged that in 2009 the Registrant conducted similar offending

activities against Sun International and its associated company, Transkei Sun International Limited (the proprietor of the trade mark **WILD COAST SUN**) as the Registrant registered the domain names: thepalacesuncity.co.za and stay-wildcoastsun.co.za.

The Registrant allegedly deregistered these two domain names following receipt of a cease and desist letter from Sun International and Transkei Sun International Limited. Accordingly the Complainants' submit that the Registrant is in a pattern of registering domain names in conflict with the Complainants' and its associated company's rights and seeks to acquire rights in the Complainants' trade marks without entitlement.

- f) Any adverse publicity attracted by the Registrant as a result of its unauthorised use of the Complainants' trade marks will negatively impact on the Complainants' business. Poor service by the Registrant will place the Complainants in a negative light.
- g) The Complainants accordingly submit that the Domain Names are intended unfairly to disrupt the business of the Complainants, and prevent the Complainants from exercising their rights, and they are thus abusive registrations.
- h) It is submitted that The Registrant has used and registered the Domain Names unlawfully and to ride on the goodwill, reputation and good name of the Complainants.
- i) It is submitted that The Registrant has used and registered the offending Domain Names in a way likely to mislead people or businesses to believe that the domain names are registered, operated or authorised by, or otherwise connected with, the Complainants.
- j) The Registrant's registrations of the Domain Names block

intentionally the registration of name which the Complainants have rights and prevents the Complainants from exercising their rights.

- k) The Registrant's deactivation of the websites to which the Domain Names pointed, following Sun International's objection, shows bad faith.

## 4 Discussion and Findings

- a) Regulation (16)(2)(f) of the Regulation provides that a domain name complaint may deal with more than one domain name provided that the same registrant registered all the domain names in question. It is accepted in the present proceedings that the Registrant registered all the Domain Names.

### 4.1 Complainant's Rights

- 4.1.1 Sun International's **SUN CITY** trading name and trade mark is registered and a reputation subsists in the business to which this trade mark is applied. Furthermore Sun International has also registered the trade marks **THE PALACE**, **THE PALACE AT SUN CITY**, **CASCADES**, **THE CASCADES HOTEL** logo and **THE SUN CITY HOTEL** logo.

With regard to the "**CABANAS**" mark, it appears from the evidence provided that Sun International has only registered a logo or device mark incorporating the "**CABANAS**" word and it is unclear whether the scope of protection afforded to Sun International in respect of this registration extends to the phonetic and/or conceptual elements of this word. However as the Registrant's relevant domain name: [www.stay-cababassuncity.co.za](http://www.stay-cababassuncity.co.za) also incorporates the **SUN CITY** trade

mark, there does not appear to be a need deal with this issue further.

- 4.1.2. Sun International Management is the proprietor of a number of domain registrations incorporating the name **SUN CITY** (together with additional descriptive matter) and one domain name incorporating the marks **SUN CITY** and **THE PALACE** together.
- 4.1.3 The Adjudicator finds that the dominant elements of the Domain Names are virtually identical to Sun International's trade mark registrations, and as a result the Domain Names are so closely similar to Sun International's trade mark registrations so as to be likely to lead to confusion or deception arising in the market.
- 4.1.4. Furthermore, Sun International Management is the proprietor of a number of domain name registrations which are similar to the Domain Names.
- 4.1.5. The Adjudicator finds that the Complainants hold rights in respect of names and trade marks which are similar to the Domain Names in terms of Regulation 3(1)(a) of the Regulations.

## 4.2 Abusive Registration

- 4.2.1 An abusive registrations means a domain name which either :-
  - (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 Complainants' rights; or
  - (ii) Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainants' rights.

The Complainants are required to prove, on a balance of probabilities, that the required elements are present.

- 4.2.2 In terms of Regulation 4(1), factors which may indicate that the



Domains are abusive registrations include circumstances indicating that the registrations were primarily to:-

- (a)
  - (i) Block intentionally the registration of a name or mark in which the Complainant has rights;
  - (ii) Disrupt unfairly the business of a Complainant;
  - (iii) Prevent a Complainant from exercising its rights.
- (b) circumstances indicating that the registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the complainant

4.2.3 The evidence indicates that the Registrant was fully aware of Complainants' rights and interests and, in particular, because the Registrant had been informed of such rights and interests in a similar dispute in November 2009 (the dispute between Sun International and Transkei Sun International Limited and the Registrant).

4.2.4 In addition to the fact that the Domain Names contain Sun International's trade marks, the manner in which the Registrant's websites utilised the Complainants' trade marks, as well as its layout and images of its famous SUN CITY resort, created an impression that the websites were that of the Complainants or, at least, were associated with the Complainants' business.

## 5. Decision

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

- **stay-cabanassuncity.co.za**
- **stay-cascadessuncity.co.za**
- **stay-palacesuncity.co.za**
- **stay-suncityhotel.co.za**

- **suncitytravel.co.za**

be transferred to the second Complainant Sun International Management Limited.

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**NOLA BOND**

SAIIPL SENIOR ADJUDICATOR

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**ANDREW PAPADOPOULOS**

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