

Decision

ZA2015-0218

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2015-0218
DECISION DATE:	8 JANUARY 2016
DOMAIN NAME	GROWTHPOINTHOLDINGS.CO.ZA
THE DOMAIN NAME REGISTRANT:	ALEX MODISANE
REGISTRANT'S LEGAL COUNSEL:	SNAIL ATTORNEYS
THE COMPLAINANT:	GROWTHPOINT PROPERTIES LTD
COMPLAINANT'S LEGAL COUNSEL:	NORTON ROSE FULLBRIGHT
2 nd LEVEL ADMINISTRATOR:	ZACR (CO.ZA)

1 Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **21 September 2015**. On **22 September 2015** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and ZACR confirmed that the domain name had indeed been suspended. The SAIPL verified that the Dispute [together with the amendment to 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 **5 October 2015**. In accordance with the Regulations the due date for the Registrant's Response was **2 November 2015**. The Registrant requested an extension time within which to submit its Response up to **13 November 2015** and, duly, filed its Response on this date. 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 **17 November 2015**.
- c) In accordance with the Regulations the due date for the Complainant's Reply was **24 November 2015**. The Complainant submitted its Reply on **23 November 2015**.
- d) The SAIPL appointed **Advocate Reinard Michau SC, Professor Tana Pistorius and Mr Deon Bower** as the Adjudicator Panel ("the Panel") in this matter on **4 December 2015**. The members of the Panel 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 is a company registered in South Africa under registration number 1987/004988/07.

2.2 The Complainant is the proprietor of the below trade mark registrations:

(a) trade mark registration number 2007/17204 GROWTHPOINT in class 35 in respect of “*advertising and business services of all kinds and descriptions including on-line advertising and business services, mobile commerce services; accounting; appraisal; assistance; consultancy; information; management; economic forecasting, marketing; completion of information into computer databases; public relations; rental services included in the class, research and investigation; tax; distribution and merchandising services*” with effect from 1 August 2007;

(b) trade mark registration number 2007/17205 GROWTHPOINT in class 36 in respect of “*insurance, assurance, reinsurance and consultancy services of all kinds and descriptions; actuary services of all kinds and descriptions; evaluation, assessment, valuation, loss adjusting, agency, brokerage, exchange, savings guarantee, security, swapping, deposit, clearing houses and underwriting services of all kinds and descriptions; provisions of financial reports and analyses all relating to risk management; estimating insurance risks. losses and liabilities; financial planning, auditing and consultancy services: claims settlement, management and control all relating to insurance claims, investment and investment trust services of all kinds and descriptions; asset acquisition and disposal*”

services of all kinds and descriptions; real estate affairs, consultancy, investment procurement and valuation services, assessment and management of real estate, providing of information and property brokerage services, leasing and renting of real estate, real estate agencies and managers, rental of office space and mortgage banking” with effect from 1 August 2007;

(c) trade mark registration number 2007/17206 GROWTHPOINT PROPERTIES in class 35 in respect of *“advertising and business services of all kinds and descriptions including on-line advertising and business services; mobile commerce services; accounting; appraisal; assistance; consultancy; information; management; economic forecasting; marketing; compilation of information into computer databases; public relations; rental services included in the class, research and investigation; tax; distribution and merchandising services”* with effect from 1 August 2007;

(d) trade mark registration number 2007/17207 GROWTHPOINT PROPERTIES in class 36 in respect of *“Insurance, assurance, reinsurance and consultancy services of all kinds and descriptions, actuary services of all kinds and descriptions; evaluation, assessment, valuation, loss adjusting, agency, brokerage, exchange, savings guarantee, security, swapping, deposit, clearing houses and underwriting services or all kinds and descriptions; provisions of financial reports and analysis all relating to risk management; estimating insurance risks, losses and liabilities; financial planning, auditing and consultancy services; claims settlement, management and control all relating to insurance claims, investment and investment trust services of all kinds and descriptions; asset acquisition and disposal services of all kinds and descriptions; real*

estate affairs, consultancy, investment procurement and valuation services, assessment and management of real estate, providing of information and property brokerage services, leasing and renting of real estate, real estate agencies and managers. rental of office space and mortgage banking” with effect from 1 August 2007;

- (e) trade mark registration number 2007/17208 GROWTHPOINT logo in class 35 in respect of *“advertising and business services or all funds and descriptions including on-line advertising and business services; mobile commerce services; accounting; appraisal; assistance; consultancy; information; management; economic forecasting; marketing; compilation information into computer databases; public relations; rental services included in the class research and investigation. tax, distribution and merchandising services”* with effect from 1 August 2007;
- (f) trade mark registration number 2007/17209 GROWTHPOINT logo in class 36 in respect of *“insurance. assurance, reinsurance and consultancy services of all kinds and descriptions; actuary services of all kinds and descriptions; evaluation, assessment, valuation, loss adjusting, agency, brokerage, exchange, savings guarantee, security, swapping, deposit, clearing houses and underwriting services of all kinds and descriptions; provisions of financial reports and analysis all relating to risk management: estimating insurance risks, losses and liabilities, financial planning, auditing and consultancy services; claims settlement, management and control all relating to insurance claims, investment and investment trust services of all kinds and descriptions; asset acquisition and disposal services of all kinds and descriptions; real estate affairs, consultancy, investment procurement and valuation services, assessment and*

management of real estate, providing of information and property brokerage services, leasing and renting of real estate, real estate agencies and managers, rental of office space and mortgage banking” with effect from 1 August 2007;

(g) trade mark registration number 2007/23343 GROWTHPOINT logo in class 35 in respect of *“advertising and business services of all kinds and descriptions including on-line advertising and business services; mobile commerce services; accounting; appraisal; assistance; consultancy, information; management; economic forecasting; marketing; compilation of information into computer databases; public relations; rental services included in the class, research and investigation; tax; distribution and merchandising services”* registered with effect from 12 October 2007;

(h) trade mark registration number 2007/23344 GROWTHPOINT logo in class 36 in respect of *“insurance. assurance, reinsurance and consultancy services of all kinds and descriptions; actuary services of all kinds and descriptions; evaluation, assessment, valuation, loss adjusting, agency, brokerage, exchange, savings guarantee, security, swapping, deposit, clearing houses and underwriting services of all kinds and descriptions; provisions of financial reports and analysis all relating to risk management: estimating insurance risks, losses and liabilities, financial planning, auditing and consultancy services; claims settlement, management and control all relating to insurance claims, investment and investment trust services of all kinds and descriptions; asset acquisition and disposal services of all kinds and descriptions; real estate affairs, consultancy, investment procurement and valuation services, assessment and management of real estate, providing of information and property*

brokerage services, leasing and renting of real estate, real estate agencies and managers, rental of office space and mortgage banking” registered with effect from 12 October 2007;

- (i) trade mark registration number 2007/23345 GROWTHPOINT logo in class 35 in respect of “*advertising and business services of all kinds and descriptions including on-line advertising and business services; mobile commerce services; accounting; appraisal; assistance; consultancy, information; management; economic forecasting; marketing; compilation of information into computer databases; public relations; rental services included in the class, research and investigation; tax; distribution and merchandising services” registered with effect from 12 October 2007; and*
- (j) trade mark registration number 2007/23346 GROWTHPOINT logo in class 36 in respect of “*insurance, assurance, reinsurance and consultancy services of all kinds and descriptions; actuary services of all kinds and descriptions; evaluation, assessment, valuation, loss adjusting, agency, brokerage, exchange, savings guarantee, security, swapping, deposit, clearing houses and underwriting services of all kinds and descriptions; provisions of financial reports and analysis all relating to risk management: estimating insurance risks, losses and liabilities, financial planning, auditing and consultancy services; claims settlement, management and control all relating to insurance claims, investment and investment trust services of all kinds and descriptions; asset acquisition and disposal services of all kinds and descriptions; real estate affairs, consultancy, investment procurement and valuation services, assessment and management of real estate, providing of information and property brokerage services, leasing and renting of real estate, real estate*

agencies and managers, rental of office space and mortgage banking” with effect from 12 October 2007.

- 2.3 The Registrant obtained registration of the Disputed Domain Name on 12 December 2014.
- 2.4 The Complainant alleges that it uses the GROWTHPOINT trade mark in relation to various financial services and in the property industry and has been doing so, continuously, since 1987.
- 2.5 The Registrant uses the name GROWTHPOINT HOLDINGS as the name of an agency that provides web design and development, graphic designing, photography, illustration and software development, deployment and maintenance services and has been doing so since late 2014.

3 Parties' Contentions

3.1 Complainant

- a) The Complainant submits that trade mark principles apply to domain name disputes and, therefore, that the principle of confusing similarity applies, equally, to the determination of whether or not the Disputed Domain Name is identical or similar to the Complainant's GROWTHPOINT trade marks.
- b) The Complainant further submits that *“GROWTHPOINT is, undoubtedly, the dominant, salient, and striking feature in all the Complainant's marks”* the notional user *“will, inevitably, remember GROWTHPOINT as the name of the organization which offers the services by each of the Complainant's trade mark registrations”* and, also, that GROWTHPOINT is the *“dominant feature of the*

Registrant's domain name" as the word HOLDINGS "is a generic term used by a vast number of corporate entities to indicate that the company "holds" assets (generally shares in a subsidiary)" .

- c) The Complainant further submits that the Registrant had registered the Disputed Domain Name *"in relation to the same services as those of the Complainant"*. In reply, the Complainant also submits that if the Registrant's services are not identical to those covered by the trade mark registrations which the Complainant holds, the Registrant's services are, similar, to that those covered by the Complainant's trade mark registrations.
- d) In view of the above, the Complainant submits that the Disputed Domain Name *"is confusingly similar to the trade mark GROWTHPOINT"* and that the Disputed Domain Name is an abusive registration in the hands of the Registrant.
- e) Although the Complainant admits that there is *"no proof that the Registrant knew of the Complainant's marks when he registered the domain name"*, the Complainant submits that the *"Registrant's continued use of the domain name in these circumstances have the effect of being unfairly detrimental to the Complainant's rights and disrupting unfairly the business of the Complainant"*.
- f) The Complainant also alleges (but without the necessary evidence to support such a contention) that as a result of its use of the GROWTHPOINT trade mark in relation to various financial services and in the property industry, since 1987, it has built up a substantial and extensive reputation in the GROWTHPOINT trade mark.

3.2 Registrant

- a) The Registrant denies that the Disputed Domain Name is an abusive registration.
- b) The Registrant further denies that the goods and services which it renders are *“the same”* as the services which the Complainant renders and/or covered by the Complainant’s trade mark registrations.
- c) The Registrant also submits that he chose the name GROWTHPOINT HOLDINGS *“because (it) is an English word and is a dynamic unit of online verbal thinking”*.
- d) The Registrant furthermore submits that *“my business Growthpoint Holdings does not confuse the average consumer into believing that the services and good I provide are somehow related to the business of the Complainant”*.
- e) The Registrant, however, admits that word GROWTHPOINT is “fancy” whereas the word HOLDINGS is a generic term.
- f) Finally, the Registrant submits that *“the Complainant has failed on the papers before this adjudication to show how the registration of the trademark unfairly takes advantage of its trademark and trade name. A mere allegation has been made but no proof has been supplied to this Adjudication. The Common law rule of he who alleges must prove surely still applies even in lower fori as this one”*.

4 Discussion and Findings

- a) Regulation 3(1)(a) requires that a Complainant proves each of the following elements in order for the Disputed Domain Name to be transferred on the

basis that it constitutes an abusive registration, namely that:

- i) The Complainant has established rights in respect of a name or mark;
- ii) The name or mark is identical or similar to the Disputed Domain Name;
and
- iii) In the hands of the Registrant, the Disputed Domain Name is an abusive registration.

4.1 Complainant's Rights

4.1.1 Complainants' Rights

- a) Regulation 1 defines "rights" to include intellectual property rights, commercial, cultural, religious and personal rights protected under South African law, but are not limited thereto.
- b) The above definition is broad and "rights" is not restricted to rights founded on the principles of trade mark law, but recognises rights going beyond those in terms of the Trade Marks Act No. 194 of 1993 ("the Trade Marks Act") or the requirements at common law for passing off. Such rights must, however, find recognition in law. See ZA2007-0008 (privatesale.co.za).
- c) The Complainant is the proprietor of various trade mark registrations for the GROWTHPOINT trade mark.
- d) The Disputed Domain Name includes the Complainant's mark GROWTHPOINT in its entirety and the GROWTHPOINT trade mark is the dominant feature of the Disputed Domain Name, a fact which the Registrant admits.
- e) The incorporation of the generic word HOLDINGS does not

assist to distinguish Disputed Domain Name from the GROWTHPOINT trade mark. Reference is made to a similar case in the South African domain dispute matter ZA2007/0003, where it was found that the domain name telkommedia.co.za was identical or confusingly similar to the well-known trade mark TELKOM.

- f) In the foreign decision of WIPO/D2002-0367, the Panel concluded that, *“The Disputed domain name contains Complainant’s EXPERIAN trademark in its entirety. The addition of the generic term ‘automotive’ does not distinguish Respondent’s domain name from Complainant’s mark”*.
- g) Reference is also made to foreign cases WIPO/D2000-1598 in which NIKETRAVEL and NIKESPORTSTRAVEL were found to be similar to NIKE; DRS04601 in which NIKESTORE was found to be similar to NIKE; and DRS01493 in which NOKIA-RING-TONES was found to be similar to NOKIA.
- h) The Panel accordingly finds that the Complainant has established rights in the GROWTHPOINT trade mark and, also, that the Disputed Domain Name is similar to the Complainant’s GROWTHPOINT trade mark as is required in terms of Regulation 3(a).
- i) Whilst the Disputed Domain Name incorporates the entire dominant and distinctive portion of the Complainant’s registered trade marks, that is not the end of the enquiry. The test is not one *“in vacuo”*, but regard must be had to the goods and services covered by the registrations (or the ones in which a reputation is purported to reside) and to compare that

with the business of the Registrant and in respect of which it uses the Disputed Domain Name. We revert to this below.

4.2 Abusive Registration

4.2.1 a) “Abusive Registration” is defined in the Regulations to mean a domain name which either -

“(a) 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

(b) has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the complainant’s rights.”

b) Regulations 4(1) and 5 provide a number of grounds (non-exhaustive) which may indicate that the Disputed Domain Name is or is not an abusive registration.

4.2.2 For purposes of the Dispute, the Complainant relies on the provisions of Regulations 4(1)(a)(iii) and 4(1)(b), namely that:

- i. the Registrant has acquired the Disputed Domain Name to disrupt unfairly the business of the complainant; or
- ii. is using or has acquired the Disputed Domain Name in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant’s rights 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 In view of the above, it is necessary to determine if the Disputed Domain Names constitutes an abusive registration.

4.2.4 First ground of objection: *“Registered or acquired the Disputed Domain name primarily to disrupt unfairly the business of the Complainant”*

- i. The Complainant admits that there is *“no proof that the Registrant knew of the Complainant’s marks when he registered the domain name”*. The aforementioned leaves no room to argue that the Registrant’s adoption of the Disputed Domain Name was not bona fide. The admission is the end of the enquiry, in essence, to a complaint under this ground. If the Registrant did not know of the Complainant’s marks he could hardly have registered it to disrupt the business of the Complainant.
- ii. The Complainant further submitted no evidence setting out details of its business or the manner in which it uses the GROWTHPOINT trade mark in its business.
- iii. In view of the above, the Panel finds that there is no evidence, which, on a balance of probabilities, proves that the Registrant had registered or acquired the Disputed Domain Name primarily to disrupt the business of the Complainant.
(emphasis added)

4.2.5 Second ground of objection: *“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”*

- i. Once trade mark rights are in issue (as opposed to, for example, merely a person's name or one of the other bases upon which an objection can be lodged other than trade mark rights) the scope of trade mark law cannot be excluded. Of necessity that have to be taken into account. It is by the measures of trade mark law that the use and appropriation for use by third parties is judged acceptable or not. The basis of this complaint and the wording used (although not identical) has all the characteristics of a statutory trade mark infringement case or a passing off case at common law. These delicts protect, not only a plaintiff in legal cases against harm, but also the general public against confusion. Practically a domain name is used to attract custom and has all the characteristics of a trade mark. Its use either causes people to believe there is an association, or not. The principles of trade mark infringement and passing off cases are therefore of valuable assistance (and should be used as guidelines) in adjudicating a complaint of this nature.
- ii. Where the trade mark of a complainant was known to a substantial sector of the public in South Africa as the name or trade mark of a complainant, prior to the adoption of a domain

name which is similar or identical to the trade mark of the complainant, a registrant's usage of the disputed domain name requires careful scrutiny. The reason for this is that the usage of the disputed domain name registration, may in fact be, or may be likely, to mislead members of the public "*to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the complainant*".

- iii. Presently, there is no evidence illustrating that the Complainant's trade mark was known to a substantial sector of the public in South Africa. There is simply not sufficient evidence forming part of the Complaint that enables the Panel to reach the conclusion that the Complainant has built up a protectable reputation in the trade mark GROWTHPOINT. The mere say-so is insufficient in this regard. Evidence of repute is required, not mere allegations of the existence of a repute.
- iv. The Complainant does, however, allege, without submitting evidence to this effect, that it uses and has used the GROWTHPOINT trade mark in relation to "*various financial services and in the property industry*".
- v. The aforementioned services, clearly, are not identical or similar to and do not compete with the services in relation to

which the Registrant' s use the Disputed Domain Name.

- vi. It is necessary to determine if the Registrant' s use of the Disputed Domain Name i.e. to provide web design and development, graphic designing, photography, illustration and software development, deployment and maintenance services are likely to lead to *“people or businesses to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant”* by virtue of such services being identical or similar to those services covered by the Complainant' s trade mark registrations.
- vii. The Complainant argues, in reply, that “advertising and business services of all kinds and descriptions”, “on-line advertising and business services” and “mobile commerce services” covered by its respective trade mark registrations are identical or similar to the services rendered by the Registrant. These, once more, are mere allegations. There is no evidence of the alleged similarity and that the public would perceive them as similar. In any event, the Adjudicators believe that they are not similar. The absence of evidence only serves to compound the difficulties in this regard.
- viii. The Complainant also argues that its GROWTHPOINT trade mark is well-known in South Africa. However, there is no evidence to this effect. We have dealt with this aspect earlier.
- ix. Finally, and although the word “holdings” is a generic term, use by the Registrant of the word “holdings” as part of the Disputed Domain Name is, for the above reasons, unlikely to create an association in the eyes of the public, between the

Registrant and the Complainant.

- x. In view of the above, the Panel holds that there is no evidence, which, on a balance of probabilities, proves that the Registrant is using, or has registered, the Disputed 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.

4.3 Discussion and findings of Professor Tana Pistorius (dissenting)

- a. The dissenting Adjudicator has read the judgment of her co-panellists, Mr Deon Boucher and Advocate Reinard Michau. As required by Regulation 29(5) read with Regulation 32(1) the dissentient view is set out below. The dissentient view is limited to paragraph 4.2.5(i) *supra*.
- b. The dissenting Adjudicator is ad idem with the Panel that the *"... basis of this complaint and the wording used (although not identical) has all the characteristics of a statutory trade mark infringement case or a passing off case at common law"* (par 4.2.5(i) *supra*).
- c. A dissenting view is expressed on the Panel's views that:
"... once trade mark rights are in issue ...the scope of trade mark law cannot be excluded. Of necessity that have to be taken into account.

...
Practically a domain name is used to attract custom and has all the characteristics of a trade mark. Its use either causes people to believe there is an association, or not. The principles of trade mark infringement and passing off cases

are therefore of valuable assistance (and should be used as guidelines) in adjudicating a complaint of this nature”. (par 4.2.5(i) supra).

- d. The transposition of principles of intellectual property law to a finding for or against an abusive domain name registration should be resisted. Domain names may be used for purposes other than to attract custom – for example the use of a domain name as a private e-mail address or for criticism. Furthermore, the principles to be applied to trade-mark infringement actions and abusive domain name registrations are not synonymous. The fact that the use of a disputed domain name in a particular set of facts may constitute trademark infringement has, of itself, no bearing on the question whether it is an abusive registration or not.
- e. In following the Nominet practice, disputes should be decided by reference to the ADR Regulations, not trade mark law:
“Disputes are decided by reference to the terms of the Policy, not the law, so that the fact that a domain name registration and/or the registrants’ use of it may constitute trade mark infringement, not necessarily lead to a finding of Abusive Registration under the DRS Policy. Nonetheless, if the DRS Policy and the Law are too far apart, the DRS policy will inevitably lose some of its value. Rights owners or domain name registrants (depending on the nature of the dispute) may prefer the expense of litigation to the likely result under the DRS Policy” (see Tony Willoughby, Chair of the Panel of Experts of “Foreword” in Dispute Resolution Service – Experts’ Overview (Version 2)).

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- f. Regulation 4(b) requires the Complainant to show on a balance of probabilities, circumstances indicating that the Registrant is using or has acquired the domain name in a way that leads people or businesses to believe that the Disputed Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The scope of this regulation is broad as it is not necessary to prove “likelihood of confusion” or “commercial gain” (as per the UDRP) but merely “leads persons or businesses to believe”.
- g. The phrase “in a way” connotes the Registrant’s intention in registering the domain name akin to “intentionally attempt to attract” (as per par. 4(b)(iv) of the UDRP). “Attract” has been interpreted to refer to the diversion or re-direction of Internet surfers to a registrant’s website that resolves from a disputed domain name. The test is the objective consequence of the effect of the Registrant’s registration of the Disputed Domain Name, irrespective of the Registrant’s subjective intent (see D2003-0453; D2004-0719; D2008-0642). In particular, the use of a word which is descriptive of the Complainant’s business or field of activity increases the probability of abusiveness under regulation 4(1)(b) (for example the addition of “vacation” to Sun City (ZA2008-0023) and the addition of “cartridges” to Samsung (ZA2008-0022)). Furthermore, the better known the mark is the more likely a finding under regulation 4(1)(b) will follow (see ZA2010-0046).
- h. The outcome of this dispute depends on the circumstances of this case and the evidence the Complainant presents. The Complainant avers that the Disputed Domain Name is an

abusive registration by virtue of regulation 4(1)(b). The Panel has neither been presented with evidence which proves such a contention nor has the Complainant provided any evidence of circumstances where people or businesses will be likely to believe that the Disputed Domain Name is registered to, operated or authorised by or otherwise connected with the Complainant.

- i. In view of the above, the dissenting Adjudicator concurs that there is no evidence, which, on a balance of probabilities, proves that the Registrant is using, or has registered, the Disputed 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.

5. Decision

- 5.1 For all the foregoing reasons, the Panel finds that the Disputed Domain Name was neither registered to disrupt the business of the Complainant nor 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. The Dispute is accordingly refused.

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R MICHAU SC
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za

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PROFESSOR T PISTORIUS
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za

.....
D BOUWER
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za