

ADMINISTRATIVE PANEL DECISION

Sun International (South Africa) Limited v. David Czinczenheim Case No. D2023-0534

1. The Parties

Complainant is Sun International (South Africa) Limited, South Africa, represented by Adams & Adams Attorneys, South Africa.

Respondent is David Czinczenheim, France.

2. The Domain Name and Registrar

The disputed domain name <suncityshuttles.com> is registered with NamePal.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 6, 2023. On February 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 8, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Vusi Dube) and contact information in the Complaint. The Center sent an email communication to Complainant on February 9, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 14, 2023.

The Center received an informal communication from Vusi Dube on February 15, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified Respondent of the Complaint, and the proceedings commenced on February 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 13, 2023. Respondent did not submit any formal response. Accordingly, the Center notified the Parties that it will proceed to Panel Appointment.

The Center appointed Ingrīda Kariņa-Bērziņa as the sole panelist in this matter on March 21, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant is a subsidiary of a major South African resort hotel and casino chain that has traded under the SUN CITY mark since 1979. Complainant employs 10,000 people and states that it enjoys over 40 per cent of the South African casino market. It is the proprietor of several trademark registrations, including the following:

- South African Trade Mark No. 1978/05182 for SUN CITY (word mark), registered on September 26, 1979 for services in class 39 including “transport; packaging and storage of goods; travel arrangement.”
- European Union Trade Mark No. 002371508 for SUN CITY (word mark), registered on September 24, 2002 for services in classes 41 and 42.

Complainant offers transfer and shuttle services in branded vehicles between its various hotels and golf and entertainment facilities. It has registered the domain names <suncity.co.za>, <suncity.africa> and <suncity.club>, and operates its primary business website at the domain name <suninternational.com>.

The disputed domain name was registered on October 7, 2022. The record reflects that it had previously been registered by a person named Vusi Dube and that it had then resolved to a website of a South African tour company operated by an entity unrelated to Complainant. The Complaint was originally addressed to Mr. Dube, to whom Complainant had addressed cease-and-desist letters in October 2021 and again on August 29 and September 26, 2022. Complainant had also prevailed in two complaints against Mr. Dube in respect of South African domains reflecting its SUN CITY marks. At the time of this Decision, the disputed domain name resolved to a website on which it is offered for sale for EUR 599. The record contains evidence that it had earlier been offered for sale for various sums up to EUR 2,499. There is no evidence available to establish a relationship between Respondent and the earlier registrant of the disputed domain name.

5. Parties' Contentions

A. Complainant

Complainant's contentions may be summarized as follows:

Under the first element, Complainant states that its SUN CITY mark is well-known due to the fact that Complainant operates a major tourist attraction that is well-known internationally. The SUN CITY resort includes multiple hotels, casino facilities, bars, restaurants, a timeshare facility, concert and conference venues, golf courses, retail outlets, a maze, and a waterpark. Complainant has invested significantly in promoting and marketing its SUN CITY trademark through advertising and on social media. Complainant's resort has been featured in travel publications and has received awards. The disputed domain name wholly incorporates Complainant's well-known SUN CITY trademark.

Under the second element, Complainant states that it has not authorized Respondent's use of the SUN CITY trademark. There is no relationship between Complainant and Mr. Dube, the previous registrant, or the current Respondent. The disputed domain name previously resolved to a website operated by Mr. Dube. It is being offered for sale for a sum exceeding the out-of-pocket costs despite the demands sent to Mr. Dube and Complainant's successful complaints against the South African domains registered by him. Respondent's intention in acquiring the disputed domain name is to take unfair advantage of the reputation and goodwill in Complainant's well-known trademark.

Under the third element, Complainant states that Mr. Dube was undoubtedly aware of Complainant's rights in the SUN CITY mark. The website to which the disputed domain name resolved at that time clearly depicted Complainant's SUN CITY trademark. The disputed domain name could again be linked or redirected to this website, but is now being offered for sale for an exorbitant sum. Should the disputed domain name be re-directed or sold, Complainant would have no control over the services offered on the website and members of the public would be deceived. The registration of the disputed domain name bars Complainant from registering or using the identical domain name, thereby disrupting Complainant's business. The SUN CITY mark qualifies as a well-known trademark, and any use of it by Respondent will take unfair advantage of and be detrimental to the distinctive character or reputation of Complainant's SUN CITY trademark.

Complainant requests transfer of the disputed domain name.

B. Respondent

Respondent did not reply to Complainant's contentions. Vusi Dube, a previous registrant of the disputed domain name, sent an email reflecting the registration date of the disputed domain name, which post-dated his rights therein.

6. Discussion and Findings

Paragraph 4(a) of the UDRP requires Complainant to make out all three of the following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) Respondent has registered and is using the disputed domain name in bad faith.

Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

A. Identical or Confusingly Similar

Complainant has provided evidence establishing that it has trademark rights in the SUN CITY mark through registrations in South Africa and the European Union. Complainant thereby satisfies the threshold requirement of having trademark rights for the purpose of standing to file a UDRP case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1.

In comparing Complainant's mark with the disputed domain name, the Panel finds that the disputed domain name is confusingly similar to Complainant's SUN CITY mark, as it reflects this mark in its entirety, followed by the word "shuttles". It is the consensus view of UDRP panels that, where a domain name incorporates the entirety of a trademark, the domain name will normally be considered confusingly similar to that mark. Moreover, where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. See [WIPO Overview 3.0](#), sections 1.7 and 1.8.

It is the well-established view of UDRP panels that a generic Top-Level Domain such as ".com" is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. See [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel finds that Complainant has established the first element under paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

The Panel finds that the evidence submitted by Complainant establishes a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain name. Respondent is not authorized by Complainant and has no rights in the “SUN CITY”. The disputed domain name reflects Complainant’s mark together with the word “shuttles,” indicating a connection to services offered by Complainant at its resort facilities. Such a composition may suggest sponsorship or endorsement by the trademark owner and cannot confer rights or legitimate interests. See, for example, [WIPO Overview 3.0](#), section 2.5.1.

Pursuant to [WIPO Overview 3.0](#), section 2.1, and cases thereunder, where Complainant makes out a *prima facie* case that Respondent lacks rights or legitimate interests, the burden of production on this element shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name.

Respondent has not demonstrated rights or legitimate interests. There is no evidence that Respondent is commonly known by the disputed domain name, nor that there are any circumstances or activities that would establish Respondent’s rights therein. At the time of the Decision, the disputed domain name is being offered for sale. There is no evidence to indicate that any of the possible defenses available under Paragraph 4(c) of the Policy would establish Respondent’s rights or legitimate interests in the disputed domain name.

Accordingly, the Panel finds that Complainant has established the second element under paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

Complainant provides evidence to indicate that the previous registrant, Vusi Dube, had used the disputed domain name to redirect to a website of a third-party travel website featuring Complainant’s SUN CITY mark and logo. On such a record, and absent any evidence to the contrary, a Panel would have had little difficulty finding that the disputed domain name was registered and is being used in bad faith.

However, this Complaint is directed not at Mr. Dube, but at an entirely different person. The evidence before the Panel is that the disputed domain name was registered by Respondent (a person with an address in France) approximately two weeks after Complainant’s cease-and-desist letters to the previous registrant in South Africa, where Complainant is also located. There is however no evidence linking Respondent to Mr. Dube, the previous registrant. The disputed domain name does not redirect to any website. It is now being offered for sale.

The practice of registering a domain name for subsequent resale, including for a profit, would not by itself support a claim that Respondent registered the domain name in bad faith with the primary purpose of selling it to Complainant or to its competitor. See [WIPO Overview 3.0](#), section 3.1.1.

The composition of the disputed domain name, which comprises Complainant’s mark together with the term “shuttles”, which is related to Complainant’s area of commercial activity, indicates a connection to Complainant. Complainant’s rights in its SUN CITY mark in the European Union, predate the registration of the disputed domain name over 20 years; its South African trademark rights date to 1979. Complainant has provided sufficient evidence of extensive use and promotion of its trademark during that time, and has demonstrated that its mark has acquired reputation and good will in the industry and market where Complainant operates.

Respondent has provided no explanation for its rationale in selecting the disputed domain name and has not offered any evidence of an independent right to the disputed domain name. The Panel notes the timing of

the registration of the disputed domain name, which took place less than two weeks after Complainant's last cease-and-desist letter to the previous registrant.

Based these circumstances, the Panel finds there is sufficient evidence to support Complainant's contention that the Respondent has registered and is using the disputed domain name in bad faith. The Panel notes in particular that, having obtained the disputed domain name from a party that had, according to the evidence available, had used it to redirect to a website featuring Complainant's name and logo, Respondent has immediately made the disputed domain name available for sale. The disputed domain name is not being used to host any content or redirect users to any website connected to a good-faith use. On these facts, the Panel is unable to find that any good-faith use of the disputed domain name is plausible.

Accordingly, the Panel finds that Complainant has established the third element under paragraph 4(a) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <suncityshuttles.com> be transferred to Complainant.

/Ingrīda Kariņa-Bērziņa/

Ingrīda Kariņa-Bērziņa

Sole Panelist

Date: April 24, 2023