

Decision

ZA2013-0148

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2013-0148
DECISION DATE:	14 October 2013
DOMAIN NAME	OLYMPICSSA.CO.ZA
THE DOMAIN NAME REGISTRANT:	MR DONOVON THORNE
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	COMITE INTERNATIONAL OLYMPIQUE KNOWN AS THE INTERNATIONAL OLYMPIC COMMITTEE (IOC) SOUTH AFRICAN SPORTS CONFEDERATION AND OLYMPIC COMMITTEE (SASCOC)
COMPLAINANT'S LEGAL COUNSEL:	Spoor & Fisher
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 **29 July 2013**. In response to a notification by the SAIPL that the Dispute was administratively deficient, the Complainant filed an amendment to the dispute on **14 August 2013**. On **15 August 2013** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on **20 August 2013** UniForum SA 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 **20 August 2013**. In accordance with the Regulations the due date for the Registrant’s Response was **17 September 2013**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **18 September 2013**.
- c) The SAIPL appointed **Nola Bond** as the Adjudicator assisted by Trainee Adjudicator **Andrew Papadopoulos** in this matter on **1 October 2013**. 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) It is noted that the Registrant made enquiries with the SAIPL as to the Dispute on 20 August 2013.

2 Factual Background

- 2.1 The Complainants are Comite International Olympique (also known as the International Olympic Committee) (“IOC”), a Swiss Association, situated at Chateau de Vidy, 1007 Sausanne, Switzerland (the “First

Complainant”) and South African Sports Confederation and Olympic Committee (“SASCOC”), a non-profit company, situated at Olympic House, James & Ethel Gray Park, Atholl Oaklands Road, Melrose, Johannesburg, Gauteng (the “Second Complainant”).

2.2 According to the relevant 2nd Level Domain Administrator’ s Whois facility, the Registrant in these proceedings is Mr Donovan Thorne of 32 Soetdoering Street, Bracken Downs, Alberton, 1448.

2.3 The First Complainant is the registered proprietor of the following trade marks in South Africa:

- Trade mark registration nos. 93/8665-6 OLYMPIC in classes 38 and 41.
- Trade mark registration nos. 2009/14693-720 OLYMPIC in classes 1, 3, 4, 5, 6, 7, 9, 10, 11, 12, 14, 16, 17, 18, 19, 25, 28, 29, 30, 32, 35, 36, 37, 38, 39, 40, 41, 42, 43 and 44.
- Trade mark application no. 2012/27485 OLYMPIC in class 2.

The Second Complainant uses the OLYMPIC trade mark in South Africa with the permission of, and under licence from, the First Complainant.

The First Complainant has caused its OLYMPIC trade mark and/or derivatives such as THE OLYMPICS, OLYMPIC GAMES to be registered in more than 126 countries of the world. In addition, OLYMPIC and derivatives such as THE OLYMPICS and OLYMPIC GAMES are protected by specific provisions of Law or specific Laws in not less than 90 countries.

2.4 The First Complainant is an international, non-governmental, non-profit organisation whose sole mission is to develop, promote and advance olympism throughout the world and to lead the Olympic Movement. The first OLYMPIC games of modern times were held over a century ago.

In 1914 the OLYMPIC flag was adopted and comprises of the five interlocking rings which represent the union of five continents and the meeting of athletes from throughout the world at the OLYMPIC games.

The First Complainant’ s structure consists of three main constituencies namely, the First Complainant as the mother body, the International Sports Federation (IFC) and the National Olympic Committees (NOC). The

member countries are required to form National Olympic Committees. In South Africa such organisation is the Second Complainant. The mission of the Second Complainant is to promote the Olympic Movement in South Africa.

- 2.5 Organising and conducting OLYMPIC Games is an enormously expensive business and the Complainant's contend, as an example, the cost of the LONDON 2012 OLYMPIC games is estimated at GBP 20 Billion. As a non-profit entity, the First Complainant's main source of revenue is sponsorship by commercial enterprises. The First Complainant acquires and owns intellectual property, including the trade mark OLYMPIC, the use of which it authorises and licenses to sponsors and merchandises in return for paying fees to the First Complainant. The First Complainant is required, in terms of the sponsorship agreements, to protect and enhance the interests of the sponsors.

The support from the business community is crucial for the staging of the OLYMPIC Games and the operations of every organisation within the First Complainant. Revenue generated by commercial partnerships accounts, the First Complainant contends, for more than 40% of the OLYMPIC revenue.

- 2.6 The NOC at country level, the Second Complainant in the instance of South Africa, manage local sponsorship programs in non-competing categories to sponsors that support the sports development activities and OLYMPIC teams. These sponsorship programs grant OLYMPIC marketing rights within the NOC country or territory only. The Complainant contends that Sponsors spend millions of Rands in sponsorship in return for using the First Complainant's OLYMPIC trade marks.

- 2.7 South Africa's first participation in the Olympic Games was in 1904, was barred from participating in 1962 on account of its apartheid policies and was readmitted to the Olympic games in 1992.

It is estimated that the worldwide audience of over one billion watched the London 2012 OLYMPIC Games opening ceremony. Multi-Choice's DSTV

flighted the opening ceremony of the London 2012 OLYMPIC Games having a viewership of 299 016 and the South African Broadcasting Corporation broadcasted the live opening ceremony, with viewership statistics of 1 062 820 and a repeat show, having viewership statistics of 812 980.

2.8 As a result, it is alleged that the Complainants have established considerable goodwill in the OLYMPIC mark. The Adjudicator accepts this as a fact.

2.9 It appears that the Registrant's domain name, OLYMPICSSA.CO.ZA, is not linked to any active website and it is therefore unknown as to the intended purpose of the domain name.

Before the domain name under dispute came to the Complainant's knowledge, the Second Complainant became aware of a Twitter account, under the name Olympics South Africa 2016, belonging to the Registrant. In addition to using, without authority, the trade mark OLYMPIC, a posting of

the First Complainant's Interlocking Rings logo,  also appeared on the registrant's Twitter account. A letter of demand dated 2 April 2013 was dispatched by the Complainants' attorneys to the Registrant.

In response to the letter of demand, the Registrant called the Complainants' attorneys indicating that he had no knowledge of who had posted the infringing material on his Twitter account, but undertook to have it removed. During the course of this conversation, the Registrant revealed that he has registered the domain name, OLYMPICSSA.CO.ZA. The Complainants' accordingly addressed a further letter of demand dated 10 June 2013 regarding the domain name under dispute. No response was received to this letter of demand, which led to the launching of this complainant.

2.10 Finally, the Registrant has failed to put forward any defence to the Dispute, notwithstanding the Registrant been given sufficient opportunity to respond to the Complainants' contentions.

3 Parties' Contentions

3.1 Complainant

- a) The Complainants' contend that the domain name, OLYMPICSSA.CO.ZA, incorporates the First Complainant's OLYMPIC trade mark in its entirety. The additional part of the letters "SA" creates the impression that the domain name belongs to the First Complainant's affiliates or that it is an official South African website of the First Complainant. Furthermore, the offending domain name OLYMPICSSA.CO.ZA is virtually identical to the trade mark OLYMPIC, which has been extensively used in South Africa by both the First and Second Complainant.
- b) In light of this, the Complainants submit that the registration by the Registrant of the domain name is identical to its OLYMPIC trade mark and therefore in terms of the proviso contained in Regulation 5(c), which provides –

"The burden of proof shifts to the Respondent 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 in which the Complainant asserts rights, without any addition."

the burden of proof shifts to the Registrant to show that the registration is not abusive. In support of this submission, the Complainants refer to SAIPL Decision ZA2007-0007, which concerned a dispute over a domain name FIFA.CO.ZA, at paragraph 4.7, wherein the Panel held that:

"The name forming the subject of the domain name in question is the mark FIFA. This is identical to the mark in which the Complainant had alleged registered and common-law rights, and which the adjudicator find established for the purposes of this complaint. This shifting of the burden disposes of the matter, in that the Registrant has not responded to the complaint."

- c) The Complainants further submit that in the circumstances of this dispute and in the case of a trade mark as famous as the OLYMPIC trade mark the registration by the Registrant of a domain name OLYMPICSSA.CO.ZA gives rise to the presumption that the registration is abusive, because it is impossible to infer that it was chosen for any reason other than to impersonate the Complainants. In support of this submission, the Complainant refers to *British Telecommunications Plc & Others v One In A Million Limited & Others [1998] FSR 265*, as well as the Expert' s statement at para 7.6 of Nominet DRS 02201 *Viking Office Products Inc. v Wenda Sparey*. Both the decision in *British Telecommunications* and the Expert' s statement at paragraph 7.6 of *Viking Office Products* were referred to with approval by the Panel in SAIPL Decision ZA2007-0007.
- d) Should the Adjudicator be of the view that the burden remains with the Complainants, the Complainants further address the issue of the offending domain name being an abusive registration in the hands of the Registrant.
- The Complainants' contend that where the Registrant, without any obvious justification and without offering an explanation despite having received a letter of demand from the Complainants, has registered a domain name virtually identical to the Complainants' trade marks, it is difficult to imagine any reason for the Registrant' s choice of domain name other than bad faith intent ultimately to sell the domain name to the trade mark owner, or to use the name to exploit the goodwill associated with the OLYMPIC trade mark. The only reasonable conclusion to be drawn is that the domain name was registered with abusive intent, and that its current use is abusive.
- In the premises, there is simply no plausible reason for the Registrant' s selection of the offending domain name unless it was and is a deliberate attempt to ride on the coat tails of the Complainants' reputation. It is undeniable that the offending

domain name suggests a connection with the Complainants. Thus, in selecting the offending domain name, the Registrant is in effect exploiting the goodwill and reputation of the Complainants' OLYMPIC trade mark, whilst blocking the Complainants' registration of the domain names in South Africa, disrupting the Complainants' business, and preventing the Complainants from exercising its rights in and to its OLYMPIC trade mark.

- e) In the circumstances, the Complainants submit that they have shown at least the following factors, as itemised in Regulation 4(1), which indicate that the offending domain name is abusive registration:
- The Registrant has registered the domain name to block intentionally the registration of a name or mark in which the Complainants have rights;
 - The Registrant has registered the domain name to disrupt unfairly the business of the Complainants;
 - The Registrant has registered the domain name to prevent the Complainants from exercising their rights; and/or
 - The Registrant is using, or has registered, the domain name in a way that leads people or business to believe that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainants. The Registrant has used the domain name to attract web users to a website other than the First Complainant's website, by creating confusion with the Complainant's trade mark as to the source, sponsorship, affiliation or endorsement of the website.
- f) In addition to the above factors, the Registrant's registration and use of the offending domain name amounts to passing-off in terms of South African common law OLYMPIC and the infringement thereof in terms of Sections 34(1)(a), (b) and (c) of the South African Trade Marks Act, 194 of 1993. Furthermore, considering the well-known status of the Complainants' trade mark, the Registrant's use and registration of offending domain names contravenes Section 35 of the

Trade Marks Act.

- g) In the circumstances, the Complainants contend that they have shown on a balance of probabilities that the Complainants have rights in a trade marks which are identical to the offending domain name is that the offending domain names are an abusive registration in the hands of the Registrant.

4 Discussion and Findings

4.1 Complainants' Rights

- 4.1.1 The Complainants' OLYMPIC trade mark is registered and a reputation subsists in the business to which the OLYMPICS trade mark is applied.
- 4.1.2 The Adjudicator finds that, although the dominant element of the offending OLYMPICSSA.CO.ZA domain name is identical to the First Complainant's trade mark registrations, the domain name, as a whole (not including the second level suffixes), is not identical to the mark in which the Complainants assert rights, without any addition, as provided for in terms of the proviso contained in Regulation 5(c).
- 4.1.3 The Adjudicator further finds that the registration by the Registrant of a domain name OLYMPICSSA.CO.ZA does not give rise to the presumption that the registration is abusive, because the Adjudicator believes that it is not impossible to infer that the domain name was chosen for any reason other than to impersonate the Complainants. The basis of this finding is on the basis that the word "OLYMPIC" is not the exclusive property of the First Complainant in respect of every category of goods or services. A brief internet search conducted by the Adjudicator reveals possible third parties using the OLYMPIC name, including OLYMPIC COMMUNICATIONS (www.olympcom.co.za), OLYMPIC AIRWAYS (www.olympicair.com), OLYMPIC PAINTS (www.olympic.com), OLYMPIC SHOES

(www.omnico.co.za) and OLYMPIC CYCLES (www.olympiccycles.co.za). This information was not raised in the pleadings and therefore the Complainants' were not afforded an opportunity to comment on the possible rights (or lack thereof) these parties may have to the OLYMPIC mark, the territories in which such possible rights exist, etc. However, bearing in mind that this is an ADR matter requiring a possibly more flexible approach in considering evidence (bearing in mind that often non-legally qualified persons deal with these complaints without legal representation), the Adjudicator believes that it is entitled to consider this further information when having to deal with the allegation that the First Complainant has exclusive rights to the trade mark OLYMPIC, which has a bearing on the presumption that the registration is abusive. Accordingly, it remains for the Complainants to prove that the domain name is an abusive registration in terms of the Regulations, as held in the Expert's statement at paragraph 7.6 of Nominet DRS 02201 *Viking Office Products Inc. v Wenda Sparey*, with approval by the Panel in SAAIPL Decision ZA2007-0007.

4.1.4 The Adjudicator finds that the additional part of the domain name, being "SA" does not add any more of a distinguishing feature to the OLYMPICS trade mark and is likely to create the impression that the domain name belongs to the First Complainant's affiliates or that it is an official South African website of the First Complainant.

The Adjudicator further finds that the domain name is so closely similar to the First Complainant's trade mark OLYMPIC, which the Adjudicator accepts has acquired a reputation in South Africa, so as to be likely to lead to confusion or deception arising in the market. This finding is on the basis that, if one considers the Registrant's prior conduct in relation to its Twitter account registered under the name Olympics South Africa 2016, on which was a posting of the First

Complainant's Interlocking Rings logo, , in the absence of any suggestion to the contrary, there appears to be an intention by

the Registrant to associate its domain name with the Complainants' business.

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) ...
- (ii) Block intentionally the registration of a name or mark in which the Complainant has rights;
- (iii) Disrupt unfairly the business of a Complainant;
- (iv) Prevent a Complainant form 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.

Although there is no evidence that such blocking has been intended primarily, certainly this is the effect that the disputed domain name has on the business of the Complainants. This factor is undeniably present, and hence the disputed domain name appears to be an abusive registration. In support thereof earlier domain name decisions indicate that such "barring" or "blocking" are

indicative of an abusive registration. See for example, the decisions in DRS00583 and DRS01378.

More particularly, the Complainants have also argued that the disputed domain name unfairly disrupts its business because the disputed domain name is likely to cause confusion in that OLYMPICSSA.CO.ZA is somehow connected to or involved with the Olympic Games.

Regulation 4(1)(a)(iii) includes, as a third factor, that may indicate that the domain name is an abusive registration, the circumstance that the Registrant has registered or otherwise acquired the domain name primarily to disrupt unfairly the business of the complainants.

As discussed above, and if considered on the merits, the Adjudicator finds, on a balance of probabilities, that use of the disputed domain name will likely lead to confusion or deception arising in the market. Given the likelihood of this occurring, and although there is no evidence of an intention primarily to do so, the disputed domain name has such an effect, and hence the disputed domain name appears to be an abusive registration. In addition, various foreign decisions have found that confusion may be inferred where the Registrant registered a domain name containing the First Complainant's trade mark plus a generic element (in this instance, being the abbreviation "SA"). See for example the foreign decisions in WIPO/D2000-0777, WIPO/2000-878, NAF/FA95033 and NAF/FA95402.

Regulation 4(1)(a)(iv) includes as a fourth factor, that may indicate that a domain name is an abusive registration, the circumstance that the Registrant has registered or otherwise acquired the domain name primarily to prevent the complainant from exercising its rights.

This factor is present and relates to, and reinforces the factor discussed under sub-section (ii) above. Although there is no evidence of an intention to do so primarily, the effect is present, and hence the disputed domain name appears to be an abusive registration. See the domain name decisions cited above in support of this factor.

4.2.3 The evidence indicates that the Registrant was fully aware of

Complainants' rights and interests and, in particular, because the Registrant failed to provide any justification for him registering a domain name incorporating the First Complainant's OLYMPIC trade mark, and in circumstances where the Registrant had also registered a Twitter account under the name Olympics South Africa 2016, on which there appeared a posting of the First Complainant's



Interlocking Rings logo,

In the premise, it is clear that the Registrant has no rights in or to the OLYMPICSSA name (or any similar trade mark); and that he is likely to gain an unfair advantage through the disputed domain name, the use of which will undeniably lead to the unlawful dilution of the distinctive character and repute of the First Complainant's trade mark OLYMPIC.

- 4.2.4 In the above circumstances, and on a default basis, the Adjudicator finds, on a balance of probabilities, that the disputed domain name is an abusive registration.

5. Decision

- 5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, OLYMPICSSA.CO.ZA be transferred to the Second Complainant.

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