

ADJUDICATOR DECISION

CASE NUMBER:	ZA2009-0032
DECISION DATE:	4 August 2009
DOMAIN NAMES	elitemodel.co.za; elitemodels.co.za; elitemodelmanagement.co.za
THE DOMAIN NAME REGISTRANT:	Mr Andrew Farr t/a Publicity Works
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	Elite Licensing Company S.A. (Switzerland) & Elite Model Management (France) & Elite Model Management S.A. (Switzerland)
COMPLAINANT'S LEGAL COUNSEL:	Megan Reimers – Spoor & Fisher
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1. Procedural History

- 1.1 The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on 11 June 2009. 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. The SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name and UniForum SA confirmed that the domain name had indeed been suspended.
- 1.2 In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on 11 June 2009. In accordance with the Regulations the due date for the Registrant's Response was 10 July 2009. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on 13 July 2009.
- 1.3 The SAIPL appointed Adv Owen Salmon as the Adjudicator in this matter on 27 July 2009. 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

- 2.1 The Complainants are:-
 - 2.1.1 Elite Licensing Company S.A., a joint stock company duly organized under the laws of Switzerland, incorporated at the Fribourg Trade and Companies Register under No. CH-217-0138776-6 and having its head office at 15, route des Arsenaux, 1700 Fribourg, Switzerland;

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- 2.1.2 Elite Model Management, a limited liability company duly organized under the laws of France, incorporated at the Paris Trade and Companies Register under No. 722.002.110 and having its head office at 21, avenue Montaigne, 75008 Paris, France; and
- 2.1.3 Elite Model Management S A., a joint stock company duly organized under the laws of Switzerland, incorporated at the Fribourg Trade and Companies Register under No. CH-217-0135783-7 and having its head office at 15, route des Arsenaux, 1700 Fribourg, Switzerland.
- 2.2 The Complainants are all part of the Elite Group of companies and run an international model agency. In the USA and Canada, this is done together with the company Elite Model Management Corp.
- 2.3 The Registrant (according to the relevant Whois facility) is Publicity Works (Andrew Farr), of PO Box 32309, Camps Bay, Cape Town, South Africa.
- 2.4 There is no dispute raised as to the veracity of the factual allegations deposed to on behalf of the Complainants. The Adjudicator finds them proved for purposes of the matter. Relevantly, these facts are the following.
- 2.5 The ELITE model agency is regarded as the No. 1 model agency worldwide with an estimated 45% market share in the US and Europe. The Group's direct total revenue for the 2007 Financial Year was in the region of €33 million. It is present internationally on all five continents, with model agencies in almost 40 countries.
- 2.6 Every year the International Model Look contest is held worldwide. It is organized and run by the Complainants. The contest has on average 350 000 participants, and takes place in

(at least) 50 different countries. It is the most famous and important of its kind throughout the world. Almost all current supermodels have been discovered through this competition.

2.7 The Complainants are the owners of numerous trade marks incorporating the word ELITE. These are registered in approximately 100 countries, notably designating model and model agency services, and the organization of competitions.

2.8 These trade marks are well-known in many countries of the world. The notoriety of the Complainants' trade marks has also been recognized by many national Courts and administrations, and copies of some of the relevant verdicts or decisions are tendered. This has also been recognized by the WIPO Arbitration Centre, notably in:-

- Case No. D2006-0297 where it is stated that *"trademarks for or including ELITE are well known in relation to modeling services"*;
- Case No. DCC 2007-0004 where reference is made to *"the undisputed worldwide reputation of the Complainants' business"*;
- Case No. D2007-1179 where it is stated that *"the Complainants have put substantial evidence before the Panel to demonstrate that for a long time the Complainants and their Elite modeling agency have been very well-known internationally as one of the leading modeling agencies in the world"*;
- Case No. D2007-1334 where reference is made to *"the undisputed worldwide reputation of the Complainants' business"* in order to reach a finding in the Complainants' favour.

- 2.9 Of particular note, the Complainants submit, is Case No. D2008-1487, which concerns the present Registrant. Here the WIPO Panelist held that *"Given that the ELITE marks, the Elite group of companies and their activities are well-known worldwide, it is more likely than not that Respondent knew of the previous existence of Complainants, the ELITE model agency, their activities and their ELITE marks at the time of registering the disputed domain names"* in order to reach a finding in the Complainants' favour.
- 2.10 The Complainants own several domain names (and websites accessible thereunder) constituted by the words "elite" and "model(s)" (such as <elitemodel.fr>, <elitemodels.fr>, <elitemodel.it>, <elitemodels.nl>, <elitemodelworld.com> or <elitemodel-world.com>.) These are accessed regularly by thousands of Internet users.
- 2.11 In August 2008, the Complainants discovered that the domain names in question (together with eleven other ".com" domains) had been registered by the Registrant. Such registrations (and use of the ELITE trademarks by the Registrant) had not been authorised in any way by the Complainants. They also discovered that the Registrant is a direct competitor of the Complainants – Mr Farr is a model and celebrity agent/publicist.
- 2.12 On September 5, 2008 the Complainants' representatives sent a warning letter to the Registrant (by e-mail and express mail), requesting transfer of all fourteen infringing domain names (including the three names challenged in the present matter). There was no reaction. Consequently a complaint was lodged at the WIPO Arbitration Centre in respect of the ".com" domains, being the following:-

- elitemanagementsouthafrica.com
- elitemodelcapetown.com
- elitemodelct.com
- elitemodelmanagementcapetown.com
- elitemodelsa.com
- elitemodelscaptetown.com
- elitemodelsct.com
- elitemodelsmanagementcapetown.com
- elitemodelsouthafrica.com
- elitemodelssa.com
- elitemodelssouthafrica.com

2.13 On 24 November 2008, the WIPO arbitration panel ruled in favour of the Complainants.

2.14 On 27 January 2009, the Complainants addressed another warning letter to the Registrant, this time in connection with the domain names in issue in this dispute: <elitemodel.co.za>, <elitemodels.co.za> and <elitemodelmanagement.co.za>. No response was received. The Registrant refused delivery of the confirmation copy of the letter (which had been sent by e-mail).

2.15 The Registrant (either as an individual, business or other organisation) has never been, and is not currently, commonly known by the disputed domain names or any portion thereof.

3 The Complainants' Contentions

- 3.1 The Complainants have established substantial statutory and common law rights in and to the ELITE trade mark as a result of the numerous trade mark registrations and extensive use of the marks over many years.
- 3.2 The main and most distinctive element of the Complainants' marks is the word ELITE. The other elements of the Complainants' marks are of secondary nature (e.g. Elite Model Management) but the descriptive words "model" and "management", if anything, reinforce the confusing similarity between the domain names and the Complainants' trade marks as they relate directly to the services offered by the Complainants.
- 3.3 The domain names in dispute are more similar to the Complainants' trade marks than the ".com" domain names, as they do not contain the additional geographic descriptors.
- 3.4 It is impossible to infer that the registration of the domain names <elitemodel.co.za>, <elitemodels.co.za> and <elitemodelmanagement.co.za> was for any reason other than to impersonate the Complainants. Therefore, the registrations are abusive. In support of this submission, the Complainants refer to British Telecommunications Plc & Others v One In A Million Limited & Others [1998] FSR 265, as well as Nominet DRS 02201 Viking Office Products Inc. v Wenda Sparey, referred to with approval in SAAIPL Decision ZA2007-0007.
- 3.5 Without there being any justification or explanation, the only reasonable conclusion to be drawn is that the reason for the Registrant's choice of domains name was ultimately to sell the domain names to the trade mark owner, or to use the names to

exploit the goodwill associated with the ELITE mark. Therefore, the domain names were registered with abusive intent.

4 Discussion and Findings

- 4.1 The Adjudicator finds that the Complainants have rights as contemplated by Regulation 3(1)(a) read with Regulation 3(2).
- 4.2 The Adjudicator also finds that the Registrant has not acted in good faith. He has registered not one domain name alleged to conflict with another's rights, but a total of fourteen such domain names. This demonstrates that the Registrant has engaged in a pattern of registering domain names, which indicates abuse within the meaning of Regulation 4(1)(c).
- 4.3 The Adjudicator further finds that undisputed facts clearly evidence that the domain names were registered in a manner which took unfair advantage of and which are unfairly detrimental to the Complainants' rights. (A discussion of the various parameters of Regulation 4 is not required.) The Adjudicator agrees with the contentions summarized in (3) above.

5 Decision

For the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain names be transferred, as requested, to the Complainant - Elite Licensing Company SA.

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ADV OWEN SALMON
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za