

ADJUDICATOR DECISION

CASE NUMBER:	ZA2014-0168
DECISION DATE:	27 June 2014
DOMAIN NAME	heliocol.co.za
THE DOMAIN NAME REGISTRANT:	Dominic Symes
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Associated Solar Industries (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	Malcolm Storey
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on 1 April 2014. On 3 April 2014 the SAIIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name at issue, and on 3 April 2014 UniForum SA confirmed that the domain name had indeed been suspended. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIIPL's Supplementary Procedure.
- b. In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on 8 April 2014. In accordance with the Regulations the due date for the Registrant's Response was 12 May 2014. On 8 April 2014, the Registrant sent an email merely stating "I have owned this domain for several years. We used to supply Heliocol panels. We now use our own branding." On 10 April, the Registrant was requested to submit a proper response, using the response template. The Registrant did not submit any response, and accordingly, the SAIIPL notified the Registrant of its default on 13 May 2014. On the same day, the Registrant advised that it had requested an extension. A copy of the extension request was sought on 15 May, but when this had not been received by 19 May, the Registrant was advised that an adjudicator would be appointed. To this, the Registrant merely advised that he was currently overseas.
- c. The SAIIPL appointed Victor Williams as the Adjudicator in this matter on 30 May 2014. 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

- a. The Complainant is Malcolm Storey of Associated Solar Industries (Pty) Ltd.
- b. Associated Solar Industries (Pty) Ltd is the South African importer and distributor of products originating from Magen eco-Energy (ACS) Limited. The Complainant has been involved in the marketing and distribution of HELIOLCOL-branded products for 23 years.
- c. The Registrant registered the domain name heliocol.co.za on 26 March 2006.

d. Parties' Contentions

a. Complainant

- i. The Complainant is relying firstly on the registered HELIOLCOL trade mark of Magen eco-Energy (ACS) Limited. It submits that Magen ego-Energy has been in existence for 36 years. The Complainant was the appointed sole importer of Magen eco-Energy products (including the HELIOLCOL products), and the administrator of its trade marks in South Africa for 23 years.
- ii. The Complainant submits that it has invested significantly in the promotion of the HELIOLCOL brand over the past 23 years. Through this investment, the trade mark HELIOLCOL has become synonymous with high quality solar pool heating systems in South Africa.
- iii. The Registrant registered not only the domain name in question, but also the domain names hometech.co.za, hightemp.co.za and advancedsolar.co.za.
- iv. The website attached to the domain name heliocol.co.za compares the Registrant's products with the Heliocol product.

- v. The Registrant does not own or have any rights in a trade mark identical or similar to HELIOCOL.
- vi. The domain name heliocol.co.za is identical to the HELIOCOL trade mark.
- vii. Registration and use of the heliocol.co.za domain name by the Registrant is abusive in that the domain is identical to a trade mark that does not belong to the Registrant. Use of the domain name amounts to trade mark infringement and passing off, the Registrant has registered or otherwise acquired the domain name primarily to disrupt unfairly the business of the Complainant and the domain name is registered and operated in a manner that leads members of the public to believe that the domain name is registered to, operated, authorised or otherwise connected with the Complainant.
- viii. The Complainant also refers the Arbitrator to the 2010 decision in respect of kwikhotsolar.co.za where the domain name was registered by the same Registrant and was found to be abusive.

b. Registrant

- i. The Registrant informally advised that "I have owned the domain for several years. We used to supply Heliocol panels. We now use our own branding".
- ii. The Registrant was requested to provide a response in accordance with the requirements for domain disputes, but has not done so.
- iii. Although the response was informal, it does appear to indicate that, even had the initial registration of the domain name in dispute been bona fide, the continued registration of the domain name is not warranted.

e. Discussion and Findings

- i. To succeed in a Complaint, the Complainant must prove that it has rights in respect of a name or mark which is identical or similar to the domain name and in the hands of the Registrant, the domain name is an abusive registration.
- ii. The Complainant has relied on the registered rights of Magen eco-Energy (ACS) Limited, as well as common law rights in the trade mark Heliocol in South Africa.
- iii. It is noteworthy that Magen eco-Energy (ACS) Limited, the holder of the rights in the trade mark HELIOCOL is not a party to these proceedings. The question is therefore whether an authorised distributor is entitled to act on behalf of the rights holder; whether it has sufficient rights in this capacity.
- iv. It is accepted that a low threshold of rights must be proven (I refer to the XNet case). By the same token, there are minimum requirements for success in matters of this nature: for example, Regulation 16(2)(h) requires that, where registered rights are relied upon, full details of the trade mark must be provided.
- v. The Adjudicator must decide the matter on the basis of the facts attested to under oath if there is no reason to disbelieve these facts (see ZA2011/0096 in re carmensteffens.co.za). No formal response was received disputing the facts submitted by the Complainant.
- vi. The Complainant has provided confirmation from the trade mark holder that it does indeed hold trade mark rights in South Africa. It has also provided confirmation that it is the sole distributor of Heliocol-branded products in South Africa. These facts have not been disputed.
- vii. In addition to the registered rights, the Complainant claims common law rights exist in the HELIOCOL trade mark. Once again, these would vest in Magen. The existence of the common law rights has not been disputed (although evidence of their existence was minimal).
- viii. The final ground relied upon by the Complainant is the pattern of abusive registration by the Registrant. Regulation 4(3) creates a rebuttable presumption of abusive registrations if the Complainant proves that the

Registrant was found to have made an abusive registration in the prior 12 months. The quickhotsolar case was decided in 2010 and, accordingly, the rebuttable presumption of abusive registration is not effective. However, this case is considered, by the Adjudicator to be an indication that the Registrant has, in the past, been involved in abusive registrations.

- ix. Were any one of the above three grounds cited on its own, the Adjudicator may not have been presented with sufficient grounds to find an abusive registration. However, in light of the accumulative effect of the three, it is found that the domain name is abusive.

a. Complainant's Rights

- i. The question is whether the Complainant has sufficient rights in the HELIOL trade mark to succeed. It is clear that Magen would have sufficient rights, but Magen is not cited in this complaint.
- ii. The required rights, in the view of the Adjudicator, need not be trade mark rights. These rights may be economic rights. The Complainant is the sole distributor of the Heliocol-branded products in South Africa and it generates an income through distribution of these products. It accordingly has, in the Adjudicator's view, rights in the HELIOL trade mark which merit protection.

b. Abusive Registration

- i. The Adjudicator finds that the domain name in dispute has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

f. Decision

- a. For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name be transferred to the Complainant.

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VICTOR WILLIAMS

SAIIPL SENIOR ADJUDICATOR

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