

## ADJUDICATOR DECISION

CASE NUMBER:	<b>ZA2015-0216</b>
DECISION DATE:	<b>30 October 2015</b>
DOMAIN NAME	<b>OGGIESA.CO.ZA</b>
THE DOMAIN NAME REGISTRANT:	<b>HANEL APPLEBY</b>
REGISTRANT'S LEGAL COUNSEL:	<b>None</b>
THE COMPLAINANT:	<b>OGGIES-SA CC</b>
COMPLAINANT'S LEGAL COUNSEL:	<b>Hahn &amp; Hahn (Mrs V Lawrance)</b>
THE 2 <sup>nd</sup> LEVEL DOMAIN NAME ADMINISTRATOR:	<b>ZA Central Registry (CO.ZA Administrators)</b>

## 1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **14 September 2015** and the SAIPL transmitted by email to the ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, which request ZACR complied with. 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.
- b. In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **17 September 2015**. In accordance with the Regulations the due date for the Registrant's Response was **16 October 2015**. The Registrant did not submit any response.
- c. The SAIPL appointed **Deon Boucher** as the Adjudicator in this matter on **21 October 2015**. The Adjudicator has submitted a 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

- a. The Complainant is the proprietor of trade mark registration numbers 2008/23320 – 1 OGGIE in classes 19 and 35, covering, amongst others, "*building materials and retail services*". The trade mark registrations are in force.
- b. The Complainant is also the proprietor of the domain name oggiesa.co.za, which was registered on 9 June 2009 which domain name the Complainant uses to promote its flooring business trading under the name OGGIE HARDWOOD FLOORING.

- c. The Complainant submits that it has used the OGGIE trade mark since, at least, 2008, in relation to hardwood flooring and has established a goodwill and reputation in the OGGIE trade mark.
- d. The Complainant further submits that although the oggiesa.co.za domain name ("Disputed Domain Name") is not presently in use, it was, historically, used to promote wooden floor products, under the name Oiled Wooden Floors, alternatively, Wooden Oiled Floor.
- e. The Complainant objected to such use on 23 March 2015 *inter alia* on the basis that such use amounts to passing-off and the Registrant, subsequently, ceased using the Disputed Domain Name.

### 3) Parties' Contentions

#### a. Complainant

- i. The Complainant submits that the Disputed Domain Name is virtually identical to its oggies-sa.co.za domain name, the only difference being that the Registrant has omitted the hyphen from the Disputed Domain Name.
- ii. The Complainant further submits that the Disputed Domain Name incorporates its registered OGGIE trade mark
- iii. The Complainant also submits that the Registrant has used the Disputed Domain Name in a manner which leads people or businesses to believe that the Disputed Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- iv. Finally, the Complainant also submits that although the Registrant has ceased using the Disputed Domain Name, it is possible that the Registrant may recommence using the Disputed Domain Name in future.
- v. For the above reasons, the Complainant submits that the Disputed Domain Name is an abusive registration, which allows the Registrant to an, unfair, advantage in the market.

#### b. Registrant

- i. The Registrant did not file a response to the Complaint.

#### 4) Discussion and Findings

- a. Although the evidence does not confirm that the Complainant holds common law rights to the OGGIE trade mark, it is clear that the Complainant is the proprietor of the OGGIE trade mark in classes 19 and 35.
- b. 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.
- c. 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).
- d. The Adjudicator, accordingly, finds that the Complainant has rights in the trade mark OGGIE within the meaning of Regulation 3(1)(a).
- e. It therefor remains to be decided if the Disputed Domain Name amounts to an abusive registration in the hands of the Registrant.
- f. Given that the Disputed Domain Name incorporates the exact mark in which the Complainant has rights, the onus is on the Registrant to establish that the Disputed Domain Name is not abusive within the meaning of the Regulations. The Registrant has not filed a response, and therefore fails to discharge the onus.

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- g. The adjudicator will draw such inferences from the Registrant's default as he considers appropriate. This will include the acceptance of plausible evidence of the Complainant, which has not been disputed.
- h. In the matter FIFA v X Y D2005-0866, the Adjudicator stated that a domain name registration will be abusive when the registrant registers a domain name:
- i. which is identical to a name in which the complainant has rights;
  - ii. the disputed domain name is exclusively associated with the complainant;
  - iii. when there is no obvious justification for the registrant having adopted that name for a domain name; and
  - iv. the registrant has not come forward with an explanation for having selected the domain name.
- i. The Registrant made no effort to explain its use of the Disputed Domain Name in relation to products identical or similar to those products sold and services rendered by the Complainant under the OGGIE trade mark, which use *prima facie* suggests that the Registrant registered the Disputed Domain Name with a view to competing with the Complainant.
- j. In the circumstances, the Adjudicator finds that the Disputed Domain Name is an abusive registration.

## 5) Decision

The Complaint is upheld and, in accordance with Regulation 9, the Adjudicator orders that the Disputed Domain Name <oggiesa.co.za> be transferred to the Complainant.

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**DEON BOUWER**  
SAIPL SENIOR ADJUDICATOR  
[www.DomainDisputes.co.za](http://www.DomainDisputes.co.za)