

## Decision

**[ZA2012-0121]**

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

### ADJUDICATOR DECISION

CASE NUMBER:	ZA2012-0121
DECISION DATE:	29 January 2013
DOMAIN NAME	rio2016.co.za and roadtorio2016.co.za
THE DOMAIN NAME REGISTRANT:	Anton Vivier
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	International Olympic Committee (IOC) and South African Sports Confederation and Olympic Committee (SASCOC)
COMPLAINANT'S LEGAL COUNSEL:	Spoor & Fisher (Nolwazi Gcaba)
2 <sup>nd</sup> 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 **15 November 2012**. On **15 November 2012** the SAIPL transmitted by email to UniForum SA a request for the registry to suspend the domain name(s) at issue, and on **15 November 2012** UniForum SA confirmed that the domain name had indeed been suspended. The SAIPL verified that the 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 **19 November 2012**. In accordance with the Regulations the due date for the Registrant’s Response was **18 December 2012**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **19 December 2012**.
- c) The SAIPL appointed Charne Le Roux as the Adjudicator in this matter on **10 January 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.

## 2 Factual Background

- a) The First Complainant is Comite International Olympique (known as International Olympic Committee) (IOC), a Swiss association situated in Lausanne, Switzerland and the Second Complainant is South African Sports Confederation and Olympic Committee (SASCOC), a non profit company registered in South Africa and situated in Johannesburg, Gauteng.

- b) The First Complainant is an international organisation with the primary object of developing and promoting the well known Olympic Games. It is the owner of South African trade mark applications for the **RIO2016** design, covering almost all of the goods and services classes under the Nice Classification.
- c) The Second Complainant is licensed by the First Complainant to use its trade marks in South Africa.
- d) The Complainants have used the trade marks **RIO2016** and **ROADTORIO2016** extensively in South Africa, which has not been disputed by the Registrant and which the adjudicator accepts as fact.
- e) The Disputed Domain Names were both registered on 28 September 2011 in the name of the Registrant.

### 3 Parties' Contentions

#### 3.1 Complainant

- a) The Complainants contend in connection with their rights that:
  - i) the First Complainant is the proprietor of South African trade mark applications for the mark **RIO2016** in various classes.
  - ii) the First Complainant is the proprietor of the domain name rio2016.com, registered on 16 January 2003.
  - iii) the Complainants' own common law rights in the marks **RIO2016** and **ROADTORIO2016** as a consequence of the substantial use that they (the Second Complainant under license of the First Complainant) have made use of them. In support of their use, the Complainants provided printouts from their respective websites showing use of **RIO2016** and **ROADTORIO2016**, and also copies of a magazine published

by the Second Complainant entitled "Road to Rio 2016".

- b) The Complainants explain that the cost to organise and conduct an Olympic Games is very expensive, with the London 2012 Olympic Games 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 submits that it acquires and owns valuable intellectual property, including the trade mark **RIO2016**, which it licenses to sponsors and merchandisers against royalty payments. The Second Complainant's role as licensed user of the First Complainant's intellectual property is to promote the Olympic Movement in South Africa in accordance with the Olympic Charter with strict guidelines. Promotion of every Olympic Games begins almost immediately as soon as the last one ends, with the promotion of the Rio 2016 Olympic Games, which was announced according to the first Complainant's website as long ago as 2 October 2009, already well on its way.
- c) The Complainants claim that the Disputed Domain Names wholly incorporate their **RIO2016** and **ROADTORIO 2016** trade marks. They submit that since the registration by the Registrant of the Disputed Domain Names include names identical to the marks in which the Complainants assert rights, that Regulation 5(c) applies, which shifts the burden of proof to the Registrant to show that the registrations are not abusive. The Complainants submit, in the alternative, that considering the extensive goodwill and reputation that attach to the **RIO2016** and **ROADTORIO 2016** trade marks, that there is no plausible reason for the Registrant's selection of the Disputed Domain Names other than a deliberate attempt to benefit from the Complainants' reputation. The Complainants argue that the Disputed Domain Names cannot but suggest a connection with the Complainants, that they block the Complainants' registration of similar domain names and disrupt the business of the Complainants and prevent them from exercising their rights.

- d) The Complainants also contend that the Registrant is using or has registered the Disputed Domain Names in a way that leads people or businesses to believe that the domain names are registered to, operated or authorised by or otherwise connected to the Complainants. The Complainants argue that the Disputed Domain Names are abusive registrations in the hands of the Registrant in that his use of the trade marks **RIO2016** and **ROADTORIO2016** constitutes infringement in terms of Section 34(1)(a), (b) and (c) as well as 35 of the Trade Marks Act and also passing-off in terms of the South African common law. However, the Complainants did not submit any evidence of the manner in which the Disputed Domain Names are being used
- e) The Complainants request that the Disputed Domain Names be transferred to the Second Complainant.

### 3.2 Registrant

- a) The Registrant did not formally respond to the Complainants' contentions, but the adjudicator noted and takes into account correspondence of the Registrant and the administrative and technical contact for the Disputed Domain Names with the SAIIPL shortly after notification of the Complaint, namely that the Disputed Domain Names will not be renewed and that the Registrant was prepared to transfer them to the Complainant on being made aware of the dispute. It is not clear why the proposed transfers did not materialise.

## 4 Discussion and Findings

- a) Regulation 3(1)(a) requires that the Complainants prove each of the following elements in order for the Disputed Domain Names to be transferred:

- i) That the Complainants have established rights in respect of names or marks which are identical or similar to the Disputed Domain Names; and
  - ii) That in the hands of the Registrant, the Disputed Domain Names are abusive registrations.
- b) The adjudicator will draw such inferences from the Registrant's default as she considers appropriate. This will include the acceptance of plausible evidence of the Complainants which has not been disputed.

#### 4.1 Complainant's Rights

- a) 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. The definition is broad and rights are 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 or the requirements at common law for passing off. Such rights must, however, find recognition in law. See [ZA2007-0008](#) (privatesale.co.za).
- b) The First Complainant does not acquire rights in respect of a name arising from its application for registration of that name or mark, neither does the ownership of the domain name rio2016.com give rise to any rights. See [ZA2007-0001](#) (mrplastic.co.za) where the adjudicator, referring to supporting South African authority, confirmed that the registration of a company name per se conferred to an entity no rights in the sense that name enforceable against third parties, in the sense that third parties can restrict others from using it.
- c) It is clear from the evidence that both the Complainants have made sufficient use of the trade marks **RIO2016** and **ROADTORIO2016** to

give rise to common law rights in these trade marks (even though the Complainants are inconsistent in referring to the marks **ROADTORIO** and **ROADTORIO2016**, where the evidence submitted shows use of the mark **ROADTORIO2016**). These common law rights would vest with the First Complainant as licensor of the marks to the Second Complainant. The question is whether the Second Complainant also owns any rights for purposes of the dispute? The strength of the rights required to be shown by a complainant to have *locus standi* is fairly low and the adjudicator finds that the Second Complainant has *ex facie* its license agreement with the First Complainant established sufficient rights to meet this test. See [ZA2009-0030](#) ([seido.co.za](#)) and the cases referred to therein and also [ZA2008-0016](#) ([mares.co.za](#) and [dacor.co.za](#)) where the adjudicator accepted that the Complainant could claim commercial rights arising from a distribution agreement, albeit that such rights are narrow in scope.

- d) The adjudicator consequently has no difficulty in finding that both the Complainants have discharged the onus in showing that they have established rights in respect of the **ROADTORIO2016** and **RIO2016** trade marks.
- e) The adjudicator also finds that the Disputed Domain Names are identical to the Complainant's **ROADTORIO2016** and **RIO2016** trade marks, as required in terms of Regulation 3(a).

#### 4.2 Abusive Registration

- a) The adjudicator agrees with the Complainant that its finding in paragraph 4.1 (e) above brings into play the provisions of Regulation 5(c), which state that *"the burden of proof shifts to the Respondent to show that 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"*.

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- b) The adjudicator in the dispute under reference ZA2007-0007 (fifa.co.za) dealt with a set of facts similar to the facts in this dispute (although the Complainant in the fifa.co.za matter had both registered and common law rights) and he acknowledged that, where the name forming the subject of the domain name in question is identical to the mark in which the complainant has established rights, and where the registrant has not responded to the complaint, the shifting of the burden of proof disposes of the matter. The adjudicator in that matter nevertheless proceeded to consider the matter on the merits, notwithstanding this incidence of the onus.
- c) The decision to adopt and register two domain names that incorporate trade marks that were at the time already clearly in reference to the Complainants, the Registrant's failure to respond to the allegations made by the Complainants and the Registrant's correspondence with the administrator at the SAIPL to the effect that he has no interest in the Disputed Domain Names, leaves the adjudicator with little doubt that the Disputed Domain Names are abusive registrations in the hands of the Registrant.
- d) The adjudicator is consequently prepared to make a finding that on the basis of Regulation 5(c), the Registrant has not met its burden of proof.

## 5. Decision

- a) For all the foregoing reasons, in accordance with Regulation 9, the adjudicator orders that the Disputed Domain Names roadtorio2016.co.za and rio2016.co.za be transferred to the Second Complainant.



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**CHARNE LE ROUX**

SAIPL SENIOR ADJUDICATOR

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