

ADJUDICATOR DECISION

CASE NUMBER:	ZA2017-0291
DECISION DATE:	9 January 2018
DOMAIN NAME	rolls-roycemotorcars.co.za
THE DOMAIN NAME REGISTRANT:	Ye Li
REGISTRANT’S LEGAL COUNSEL:	None
THE COMPLAINANTS:	Rolls-Royce PLc and Rolls-Royce Motor Cars Limited
COMPLAINANT’S LEGAL COUNSEL:	Adams & Adams
THE 2 nd LEVEL DOMAIN NAME ADMINISTRATOR:	ZA Central Registry (CO.ZA Administrators)

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1) Procedural History

- a. The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **3 November 2017**. On **3 November 2017** the SAIPL transmitted by email to ZA Central Registry (ZACR) a request for the registry to suspend the domain name at issue, and on **6 November 2017** ZACR confirmed that the domain name had indeed been suspended. 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 **7 November 2017**. In accordance with the Regulations the due date for the Registrant's Response was **4 December 2017**. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on **5 December 2017**.
- c. The SAIPL had some difficulty in finding an available adjudicator. It eventually appointed **Vanessa Lawrance** as the Adjudicator in this matter on **14 December 2017**. 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, Rolls-Royce PLC, is a pre-eminent engineering company, the predecessors of which have been in existence for more than a hundred years.
- b. The Second Complainant in this dispute acquired the motor vehicle-related ROLLS-ROYCE trade mark portfolio from the First Complainant. The Second Complainant is a wholly owned subsidiary of BMW AG.

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- c. The Complainants own a number of trade marks in South Africa incorporating the mark ROLLS-ROYCE.
 - d. The ROLLS-ROYCE name and trade mark has been used by the First Complainant and its successors in title for over a hundred years in relation to luxury motor vehicles worldwide, *inter alia*, in South Africa.
 - e. The ROLLS-ROYCE brand is well known worldwide.
 - f. When the Registrant registered the domain name rolls-roycemotorcars.co.za in 2015, the Complainants already owned rights in the name ROLLS-ROYCE.
 - g. The domain name rolls-roycemotorcars.co.za was not registered with the authorisation or consent of the Complainants.
 - h. The domain name rolls-roycemotorcars.co.za is linked to a parking page with pay per click advertising. There is a notice on the website linked to the domain name in question that "the domain may be for sale by its owner!".
 - i. The Complainants caused a letter of demand to be sent to the Registrant, informing it of the Complainants' rights in the ROLLS-ROYCE trade mark and requesting the Registrant to transfer the domain name to BMW AG or the Second Complainant.
 - j. The Registrant responded by offering to transfer the domain name against payment of US\$5 000.
 - k. Following this correspondence, the Second Complainant's domain administrator received e-mail correspondence, from an unknown party, advising that it was possible to acquire the domain name in issue and inviting an offer to buy it. The Complainant is of the view that this approach was linked. The adjudicator finds no evidence of such a link.

3) Parties' Contentions

a. Complainants

- i. The Complainants contend that they have substantial rights in the ROLLS-ROYCE name and trade mark.
- ii. It is further contended that the domain name rolls-roycemotorcars.co.za wholly incorporates the ROLLS-ROYCE name and trade mark, and that the addition of the descriptive word "motor cars" does not serve to distinguish it from the trade mark in which the Complainants hold rights.
- iii. The domain name is identical, barring the .com extension, to the Second Complainant's domain name, which it owns and uses in respect of the official Rolls-Royce Motor Cars' website.
- iv. The Complainants are of the view that the continued existence of the domain name and website is likely to lead members of the public to believe that they are somehow connected to the Complainants and/or that the Registrant and its website are somehow linked or authorised by the Complainants. They are of the view that this will disrupt business of the Complainants, in that traffic is likely to be directed to the Registrant's website, rather than to the website of the Complainants.
- v. It is also alleged that the Registrant acquired the domain name with the specific intention of selling it for an exorbitant amount.
- vi. The Complainants further their argument, alleging that the disputed domain name was registered primarily to intentionally block registration of a name/mark, in which the Complainants have rights.
- vii. The Complainants further argue that registration of the domain name in question takes unfair advantage of the reputation and goodwill in the ROLLS-ROYCE name and trade mark, and is detrimental to the Complainants.

viii. Finally, the Complainants mention at least two other domain names that were found to be abusive and that were previously registered by the Registrant. It is contended that this shows a pattern of abusive registrations.

b. Registrant

i. The Respondent did not reply to the Complainants' contentions.

4) Discussion and Findings

a. Complainants' Rights

- i. The Adjudicator finds that the Complainants hold registered and common law rights in the ROLLS-ROYCE trade mark in South Africa, and that the ROLLS-ROYCE mark is indeed a well known mark in this country.
- ii. The above finding is supported by evidence of registration and use of the trade mark. It has, furthermore, not been denied by the Registrant, and is therefore accepted.

b. Abusive Registration

- i. The Adjudicator agrees that the domain name rolls-roycemotorcars.co.za wholly incorporates the ROLLYS-ROYCE name and trade mark, in which the Complainants have rights. The Complainants' reference to the Case ZA2011/0068 (the Singer Company Ltd vs Singer Sew and Knit Centre) is accepted. This principle was also supported in the decisions ZA2013/00135 electroluxcentralvac.co.za and ZAT2012-0117 sarstax.co.za.
- ii. It is also noted that the domain name is identical, barring the .com extension, to the domain name used by the Second Complainant in respect of the official Rolls-Royce Motorcars website.

- iii. The Registrant offered to transfer ownership of the domain name against payment of US\$5 000. This, *prima facie*, exceeds any out-of-pocket expenses that the Registrant may have incurred in acquiring and maintaining the domain name and seems to point to bad faith on the Registrant's part.
- iv. The Adjudicator further agrees that the Registrant appears to have used or registered the disputed domain name in a way that is likely to lead members of the public to believe that the domain name is registered to, authorised by or otherwise connected with the Complainants. The domain name wholly incorporates the trade mark of the Complainants and is identical to the official website of Rolls-Royce (barring the .com extension). It is found that the domain name rolls-roycemotorcars.co.za will be likely to cause deception and/or confusion.
- v. As the domain name is identical to the domain name attached to the Complainants' official website (barring the .com extension), its registration may indeed block registration of a domain name in which the Complainants have rights, and which they may wish to register to expand their business in South Africa. This seems to be a further indication of the abusive nature of the registration.
- vi. Finally, the Registrant appears to have engaged in a pattern of making abusive registrations, in that it registered at least two other domain names that have been found to have been registered with ill intent.
- vii. In short, it appears that the domain name rolls-roycemotorcars.co.za was registered in a manner which, at the time when registration took place, took unfair advantage of, or was unfairly detrimental to the Complainants' rights.

5) Decision

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

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VANESSA LAWRENCE
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za