

Decision

[ZA2019-0360]

.ZA ALTERNATE DISPUTE RESOLUTION
REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	ZA2019-0360
DECISION DATE:	05 July 2019
DOMAIN NAME:	pari.org.za
THE DOMAIN NAME REGISTRANT:	Ivor Chipkin
REGISTRANT'S LEGAL COUNSEL:	KapdiTwala Inc. t/a Dentons South Africa – Muhammad Patel
THE COMPLAINANT:	Public Affairs Research Institute
COMPLAINANT'S LEGAL COUNSEL:	Cheadle Thompson & Haysom Inc. – Riona Kalua
2 nd LEVEL ADMINISTRATOR:	ZACR

1. Procedural History

- a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIPL") on **14 March 2019**. On the same date the SAIPL transmitted by email to ZACR a request for the registry to suspend the domain name at issue, and on **20 March 2019**, 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 **22 March 2019**. In accordance with the Regulations the due date for the Registrant's Response was **23 April 2019**. On **15 April**, the Registrant requested an extension of the term within which to answer, as the parties were involved in settlement discussions. On **16 April 2019**, the Administrator granted an extension of the term within which to answer until **14 May 2019**. The Registrant submitted its Response on **14 May 2019**, and the SAIPL verified that the Response satisfied the formal requirements of the Regulations and the SAIPL's Supplementary Procedure. The SAIPL forwarded a copy of the Response to the Complainant on **15 May 2019**.
- c) In accordance with the Regulations the due date for the Complainant's Reply was **22 May 2019**. The Complainant submitted its Reply on **22 May 2019**.
- d) The SAIPL appointed Vanessa Lawrance as the Adjudicator in this matter on **13 June 2019**. 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.
- e) Once the papers were closed, the Registrant's representative, on two separate occasions, addressed correspondence, once decrying the revelation, by the Complainant, of information disclosed without prejudice during settlement negotiations, and once complaining about perjury and defamation by the

Complainant. The second of these items of correspondence was received on **2 July**, 2 days before the Adjudicator was called upon to make her decision known.

- f) The Adjudicator is not mandated to make any decision regarding perjury and defamation. The allegations contained in the correspondence are untested by a court of law, and, should the Registrant wish to pursue these claims, it should do so in the correct forum. The allegations, and actions about which are complained, and the information exchanged on without prejudice basis were, in any event of no influence in the findings below.

2. Factual Background

- 2.1 The Registrant founded the Complainant, a non-profit organisation, and was its executive director for 10 years.
- 2.2 The Registrant voluntarily resigned as executive director of the Complainant in 2018.
- 2.3 On or about **5 February 2019**, the Registrant addressed correspondence to the Complainant, advising the Complainant that it would be willing to sell the rights to the domain in dispute (pari.org.za), or to lease them to the Complainant on the basis of a fixed term contract for 3 years at a monthly rate of R 18 250.00. In the same correspondence, the Registrant advised the Complainant that there are other parties interested in the domain name.
- 2.4 The actual expenses in maintaining the domain name is R99 per month.
- 2.5 Since its first registration, the domain name in this dispute has hosted content exclusive to the Complainant.
- 2.6 It is common cause that the domain name pari.org.za is identical to the shortening of the Complainant's name, PARI.

3 Parties' Contentions (summarised, and limited to relevant factors)

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- 3.1 The domain name pari.org.za was registered by the Registrant for use by the Complainant.
- 3.1.1 Since its inception in 2010, the Complainant has used the domain name pari.org.za, and the public associates the domain name with the Complainant.
- 3.1.2 The Complainant has provided Google Analytics, examples of banners, business cards, letterheads, e-mail signatures and the like, demonstrating its use of the domain name pari.org.za in relation to its activities.
- 3.1.3 The domain name in the hands of the Registrant, has become an abusive domain name. This is, *inter alia*, demonstrated thereby that the Registrant has offered to rent the domain name to the Complainant for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses. It has also threatened to sell the domain name to a third party.
- 3.1.4 The Complainant contends that the Registrants intends disrupting unfairly the business of the Complainant, using ownership of the domain name as a tool to do so.
- 3.2 Registrant**
- 3.2.1 The Registrant claims that it coined the name Public Affairs Research Institution, PARI.
- 3.2.2 The abbreviation PARI was coined by the Registrant as it is a colloquial shortening of the French city "Paris", which bears a sentimental value to the Registrant, as he lived and studied in Paris/Parys, a town situated on the banks of the Vaal River in the Free State, for a number of years.
- 3.2.3 The Complainant was established in **May 2010** by the Registrant to conduct research that promotes informed and realistic solutions to the challenges of governance in South Africa. The funding that has resulted in the Complainant being a financially sustainable organisation with multiple sources of income was secured by the Registrant.

- 3.2.4 The Registrant is also the holder of the domain name of pari.co.za, which was registered in the same year as the disputed domain name. The Registrant claims that registration of both domain names were done solely to further the rights and interests of the Complainant. It was never the Registrant's intention to infringe any rights of the Complainant.
- 3.2.5 The Registrant has not caused any material harm to the Complainant since its resignation from the Complainant. The disputed domain name was not sold to a third party nor removed the content from the disputed domain name.
- 3.2.6 The Respondent disputes the Complainant's allegations that it has rights in the mark PARI and claims that it has not provided sufficient evidence thereof.
- 3.2.7 The Complainant is fully aware and approved of the Registrant's ownership of the disputed domain name.

4 Discussion and Findings

- a) The Adjudicator is called upon to weigh up the allegations made by either side and apply the Regulations thereto in order to determine whether or not the domain name pari.org.za is an abusive domain name in the hands of the Registrant.

4.1 Complainant's Rights

- 4.1.1 The Complainant has demonstrated that it is the holder of sufficient rights in respect of a name or mark which is identical or similar to the domain name in dispute.
- 4.1.2 It is common cause that the domain name in dispute has been used in respect of the activities of the Complainant's business since 2010.

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- 4.1.3 The Complainant has submitted evidence, in the form of various examples of its nuse of the use of the name and mark PARI, and also analytics surrounding the website attached to the domain name in dispute.
- 4.1.4 It is a common thread, throughout case law applicable to matters of this nature, that there is a low evidentiary burden to prove the necessary rights. In this regard, the Adjudicator mentions but one case, namely Avaya Inc and Kroftel AB v Phonatics (Pty) Ltd (in re knoftel.co.za) [ZA2012-0115]. In this matter, the matter of www.sido.co.za [ZA2009-0030 (appeal decision)] was cited. That case, in turn, cited WIPO decisions surfcult.com [2002-0381] and dinkybomb.com [D2004-0023], all of which support this position.
- 4.1.5 The Registrant has cited a case in which the Complainant was found not to have sufficient rights. In that case, however, there was a one-sentence bald allegation that the Complainant had been established some years prior to the dispute being entered. This was not followed by any claim to rights or evidence of use whatsoever. That case is therefore not on all fours with the one presently under discussion.

4.2 Abusive Registration

- 4.2.1 An abusive registration is one which either a) was registered or otherwise acquired in a manner which, at the time of registration or acquisition, took unfair advantage or was unfairly detrimental to the Complainant's rights OR b) a domain name which has been used in a manner that takes unfair advantage, or was unfairly detrimental to the Complainant's rights. The first part of this definition is not relevant in this matter. It must be decided whether the domain name has been used in a manner that takes unfair advantage or is unfairly detrimental to the Complainant's rights (in light thereof that it has been found that the Complainant has sufficient rights).
- 4.2.2 The Respondent complains that there is a fatal error in the Regulations in that the list factors that may indicate that a domain name is an abusive registration includes circumstances indicating that the Registrant has "registered or otherwise acquired the domain name primarily to sell, rent or otherwise transfer that domain

name to a Complainant or competitor of the Complainant, or any other party for valuable consideration in excess of the Registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name".

- 4.2.3 The Registrant has argued that the factors that may be used to find that a domain name is an abusive registration, and, particularly, paragraph 4(1)(a) of the Regulations, refer only to situations where the Registrant has registered or otherwise acquired the domain name with the purposes set out.
- 4.2.4 The Adjudicator finds that the factors listed in paragraph 4 are not exhaustive. Indeed, the paragraph commences with the words: "Factors, which may indicate that the domain name is an abusive registration **INCLUDES**" (sic) (my emphasis). Further factors can certainly be considered as an indicator that a specific domain name is abusive. In particular, the Adjudicator finds no reason as to why the factors listed in paragraph 4(a)(1) cannot be applied to an enquiry as to whether a domain name is **used** in a manner that is abusive.
- 4.2.5 The Adjudicator finds that the Registrant has used its ownership of its domain name to attempt to coerce the Complainant to rent the domain name for an amount well in excess of the Registrant's reasonable out-of-pocket expenses directly associated with use of the domain name that has, for almost a decade hosted the website associated with the Complainant.
- 4.2.6 The Registrant is in a position to use the domain name in this manner because it owns the domain name. The Complainant is compelled to consider renting the domain name because it belongs to the Registrant, who is no longer associated with the Complainant, and the Complainant has a vested interest in having access to the domain name to host its website. It would disrupt the business of the Complainant if it did not have access to the domain name pari.org.za, because its business website has been hosted at this address for more than 9 years.

5. Decision

5.1 For all the foregoing reasons, in accordance with Regulation 9, the Adjudicator orders that the domain name, pari.org.za be transferred to the Complainant

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