

Decision

[ZA2024-0495]

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

ADJUDICATOR DECISION

CASE NUMBER:	ZA2024-0495
DECISION DATE:	08 April 2024
DOMAIN NAME	ipintombi.co.za ipintombifoundation.co.za
THE DOMAIN NAME REGISTRANT:	Retail Communication Solutions (Pty) Ltd
REGISTRANT'S LEGAL COUNSEL:	n/a
THE COMPLAINANT:	Songe Music Promotions (Pty) Ltd
COMPLAINANT'S LEGAL COUNSEL:	Witz Inc
2 nd LEVEL ADMINISTRATOR:	ZARC (CO.ZA)

1. Procedural History

- 1.1. This Dispute was filed with the South African Institute of Intellectual Property Law ("SAIPL") on **5 February 2024**. On **6 February 2024** SAIPL emailed a request to ZA Registry Consortium (ZARC) to suspend the domain name in issue, and ZARC confirmed that the domain name had been suspended. SAIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIPL's Supplementary Procedure.
- 1.2. In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on **7 February 2024**. The Registrant submitted a response on **13 March 2024**. The Complainant did not reply to this response.
- 1.3. SAIPL appointed **Adv Owen Salmon SC** as the Adjudicator on **15 March 2024**. He has submitted the respective Statement of Acceptance and Declaration of Impartiality and Independence, as required by SAIPL to ensure compliance with the Regulations and Supplementary Procedure.

2. Procedural Issue

- 2.1. The Registrant's response is not compliant with Regulation 18 which requires it to be under oath. It is in the form of a letter on the letterhead of IPI NTOMBI FOUNDATION emailed to the Case Administrator.
- 2.2. In the interest of natural justice,¹ I take into account the Registrant's response. The Complainant is not prejudiced.

¹ See, for example, ZA2015-0209 at paragraph 2.6; ZA2014-0181 at paragraph 4(A)ii; and the inclusionary approach rationalised in ZA2008-0024 at paragraph 2, and adopted here.

3. The Facts

- 3.1. The following facts are not in dispute.
- 3.2. The Complainant is the proprietor of the intellectual property rights in the stage production known as IPI TOMBI. It is the registered proprietor of the trade mark IPI TOMBI in classes 9, 14 and 41 – the latter being for, in particular, services in connection with or relating to education and/ or entertainment.
- 3.3. The Complainant has been responsible (directly or, as licensor of the relevant grand rights, indirectly) for the production of the IPI TOMBI stage show both in South Africa and internationally since 1974. The name of the show is well-known and several of the musical numbers from the show are popular.
- 3.4. During July 2019, following discussions going back some time, the parties entered into a written agreement – a so-called Grand Rights Agreement – in terms of which (relevantly) the Registrant obtained an option to enter into a licence for the production of the IPI TOMBI stage show. It is not necessary to delve into the technicalities of this agreement. Suffice it to record that the option was dependent upon the Registrant securing finance to ensure a particular run of the stage play. In the end, it failed to do so. The option fell away, with the agreement being cancelled; at least, by formal notification from attorneys in May 2022.
- 3.5. In April 2019, the Registrant had registered the domain <ipintombi.co.za>. In April 2022, it registered the domain <ipintombifoundation.co.za>.
- 3.6. Screenshots annexed to the Complaint demonstrate the Registrant's use of the domains in relation to pages titled "Theatre Incubation Hub", and "Youths For Theatre". In its response, the Registrant asserts that its "...*commitment extends beyond mere performance; we are deeply invested in the development and upliftment of underprivileged communities through our non-profit organisation, IPI NTOMBI Foundation. Geared towards the development of communities*

within the theatrical industry, offering workshops, internships, manufacturing opportunities, and scholars' outreach, to introduce theatre to scholars and focus on media and management within the theatre industry."

- 3.7. This scope of reference clearly accords with the specification of the class 41 trade mark registration referred to above.

4. Complainant's contentions

- 4.1. The following is a summary of the Complainant's contentions.
- 4.2. The names in dispute are similar to the marks in which it has registered and common law rights. As far as trade mark jurisprudence goes, this is a sound contention and I accept it to be established.
- 4.3. Since the termination of the agreement, the representation made by the domain names is misleading, because there is no connection in the course of trade between the parties (*qua* licensor and licensee) and their use takes unfair advantage of and is unfairly detrimental to the Complainant's rights.
- 4.4. Accordingly, the names are abusive within the meaning of the Regulations.

5. Registrant's contentions

- 5.1. The following is a summary of the Registrant's contentions relating to the Complainant's allegations addressing abusiveness as summarized above.
- 5.2. The claim by the Complainant of a goodwill and reputation in the mark IPI TOMBI is disputed. The last user by the Complainant of the name was back in the 1990's and this diminishes any contemporary reputation or goodwill that might be exclusively claimed by the Complainant. In my views, however, this contention runs somewhat antithetically to the notion of paying not insignificant sums of money to secure the license and rights to produce the stage show with

the name IPI TOMBI. Moreover, a letter received by the Registrant (attached to the Complaint, but not dealt with by the Registrant) from the Chief Director: Cultural Development at the Department of Sport, Arts and Culture (dated 19 October 2021) talks of how pleased the Department is "*to acknowledge the revival of the internationally acclaimed stage musical IPI NTOMBI.*"

- 5.3. The Registrant further claims that any reputation or goodwill in the name IPI NTOMBI as applied to its scope of services resides with it, or that at least it should have some form of concurrent rights. As far as trade mark jurisprudence goes, a claim to ownership of rights is inconsistent with a licence for those rights.
- 5.4. The Registrant's user does not infringe on the Complainant's trade mark rights because its distinct operational domain focuses on empowering, developing and educating within the industry. Given the scope of the class 41 registration referenced above, this contention can be rejected. Moreover, it is trite that the likelihoods of confusion and deception do not postulate as a precursor common fields of activity.
- 5.5. It is denied that the domains are abusive as alleged.

6. Discussions and Findings

- 6.1. In terms of Section 1 of the Regulations, an abusive registration means a domain name which either –
 - 6.1.1. Was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's rights; or
 - 6.1.2. Has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

6.2. An indication is given in the Regulations as to what could be considered an abusive registration. In terms of Section 4(1), such factors include:-

“(a) Circumstances indicating that the registrant has registered or otherwise acquired the domain name primarily to –

- (i) Sell, rent or otherwise transfer the domain name to a complainant or to a competitor of the complainant, or any third party, for valuable consideration in excess of the registrant’s reasonable out-of-pocket expenses directly associated with acquiring or using the domain name;
 - (ii) Block intentionally the registration of a name or mark in which the complainant has rights;
 - (iii) Disrupt unfairly the business of the complainant; or
 - (iv) Prevent the complainant from exercising his, her or its rights;
- (b) Circumstances indicating that the registrant is using, or has registered, the domain name in a way that leads people or businesses to believe that the domain name is registered to, operated or authorized by, or otherwise connected with the complainant;
- (c) evidence, in combination with other circumstances indicating that the domain name in dispute is an abusive registration, that the registrant is engaged in a pattern of making abusive registrations;
- (d) false or incomplete contact details provided by the registrant in the Whois database; or
- (e) the circumstances that the domain name was registered as a result of a relationship between the complainant and the registrant, and the complainant has –

- i. been using the domain name registration exclusively; and
- ii. paid for the registration or renewal of the domain name registration.”

6.3. An indication is also given as to what would not be an abusive registration. In terms of Section 5, factors which may indicate this include:-

- “(a) before being aware of the complainant’s cause for complaint, the registrant has –
- (i) used or made demonstrable preparations to use the domain name in connection with a good faith offering of goods or services;
 - (ii) been commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name; or
 - (iii) made legitimate non-commercial or fair use of the domain name;
- (b) the domain name is used generically or in a descriptive manner and the registrant is making fair use of it;
- (c) that the registrant has demonstrated fair use, which use may include websites operated solely in tribute to or fair criticism of a person or business: Provided that the burden of proof shifts to the registrant to show that the domain name is not an abusive registration if 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”

6.4. In terms of Section 9, one of two outcomes is possible in the case of a complaint that the domain is an abusive registration: refusal of the dispute, or transfer of the disputed name.

6.5. To succeed in this complaint the Complainant has to prove,² on a balance of probabilities, the following:-

- It has rights in respect of a name or mark which is identical or similar to the domain name; and
- The domain name, in the hands of the Respondent, is an abusive registration as defined.

6.6. I have recorded that the domain names in issue are similar to the marks in which the Complainant asserts it has rights. The next question is whether the Complainant actually has 'rights' in the mark IPI TOMBI. Clearly it does, if only by virtue of the trade mark registrations.

6.7. The question therefore to be decided is whether the domain names in question:

- were registered or otherwise acquired in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's rights; or
- have been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

6.8. There are two potential abuses:-

- registration with abusive intent; and
- abusive use,

and the nature of "abusiveness" as contemplated by the Regulations does not require a positive intention to abuse the Complainant's rights, but that abuse was the effect of the use or registration. Moreover, as has been established by previous adjudications, the abuse can succeed the registration or acquisition.

6.9. The Registrant claims that it asserts its rights to continue its non-profit and developmental activities under the IPI NTOMBI brands, which it says are "vital" to its mission. This is difficult to understand, in that the name IPI TOMBI resonates deeply with a significant proportion of the South African population

²

Section 3(1)(a) of the Regulations.

(and internationally) as was recognised by the Department of Sport, Arts and Culture. It would be nigh-impossible to cast aside the assumption that a website having the domain name IPI NTOMBI FOUNDATION must have something to do with the well known stage musical. Indeed, this assumption of a connection is underscored by the fact that – as the Registrant states in its response – there had been ongoing negotiations since 2008 with the Complainant regarding the potential to revive the stage musical.

6.10. Within the meaning of the Regulations, as interpreted by countless adjudications, this can only mean that the domain names are abusive. I find accordingly.

7. Decision

7.1. In the circumstances, in accordance with Regulation 9, I order that the disputed domain names be transferred to the Complainant.

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ADV OWEN SALMON SC
SAIIPL SENIOR ADJUDICATOR
www.DomainDisputes.co.za