



BRIEF CASE NOTES

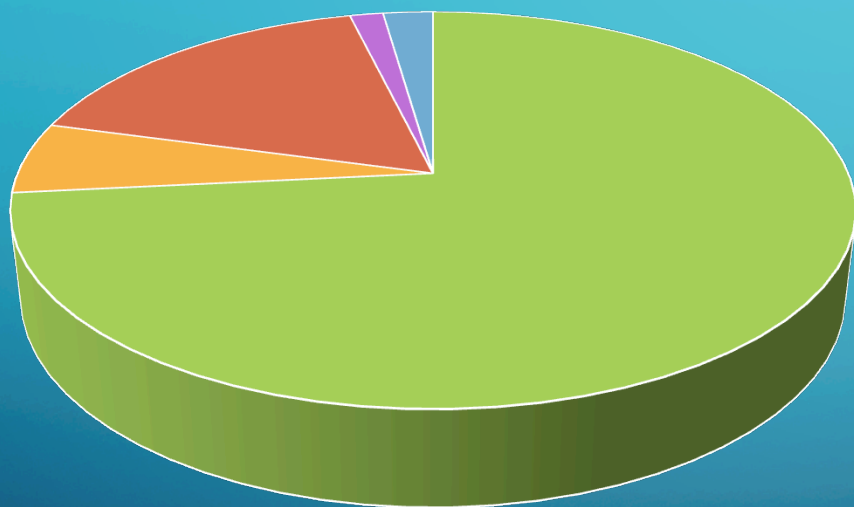
SAIPL ADR – DOMAIN DISPUTE ADJUDICATOR TRAINING: 13 FEBRUARY 2020

CHRISTIAAN STEYN

395 ADR DISPUTES (SINCE 2007)

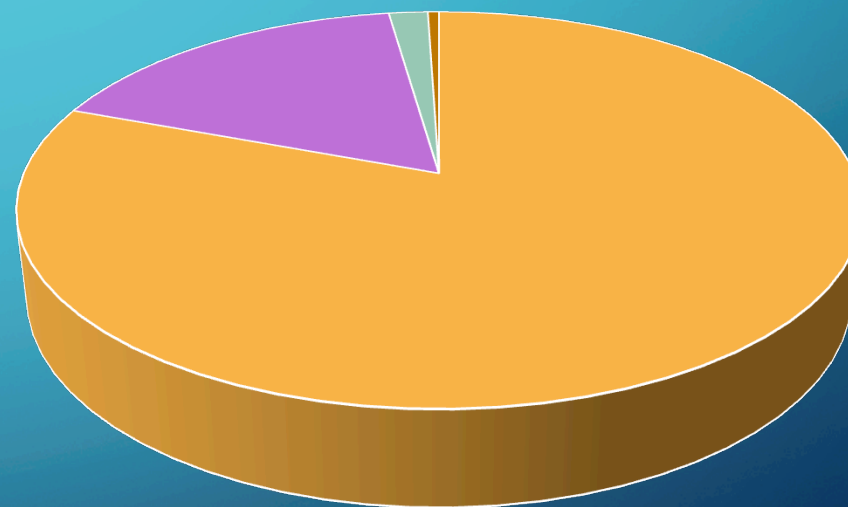
*11 matters in other forums (since 2005)

Outcome



■ Transferred ■ Refused ■ Settled ■ Withdrawn ■ Pending

Proceeding



■ Normal ■ Summary ■ Appeal ■ Mediation

RIGHTS – REGULATIONS 1 AND 3

“...include intellectual property rights, commercial, cultural, linguistic, religious and personal rights protected under South African law... but is NOT LIMITED THERETO...”

- ZA2009-0030 (*seido.co.za*) – Appeal:
 - ✓ Licence Agreement, Foreign Trade Mark & .com domain
- ZA2011-0077 (*xnets.co.za*) – Appeal
 - ✓ .co.za Domain & Reputation
- ZA2012-0115 (*konftel.co.za*)
 - ✓ Registrant’s statement in email to Complainant: “...your brand...”
- ZA2014-0168 (*heliocol.co.za*)
 - ✓ Sole RSA Distributor

RIGHTS (CONTINUED)

“...Lesser threshold than in trade mark jurisprudence...”

- D2002-0358 <*thaigen.net*> (UDRP)
- D2000-0014 *Bennet v Lalwani* (WIPO)
- D2000-0015 *Bennet v Long Distance Telephone Co* (WIPO)

RIGHTS (CONTINUED)

Coolsystem Inc v Game Ready SA (ZA2019-0357 gameready.co.za)

- “Rights” not restricted to those founded on the principles of trade mark law
- Goes beyond “rights” into the Trade Marks Act
- Goes beyond “rights” into the common law requirements for passing-off
- Must however find recognition in law *

* See also ZA2007-0008 (privatesale.co.za)

RIGHTS (CONTINUED)

- Sugarless Company v Green (ZA2019-0375 *sugarless.co.za*) *
 - Disclaimer of “SUGERLESS” in a figurative trade mark (RSA)
 - However, foreign trade mark registrations and common-law rights
- John Planets v Data Protected (ZA2019-0372 *armytek.co.za*) *
 - Rights based on unscrutinised letter granting Complainant rights to ‘protect’
 - Based on EU registration in name of 3rd party
 - Exclusive distributor of goods bearing mark

* “...domain names are, largely speaking, about ecommerce... and the matrix which swirls around the world of ecommerce is what informs the determination of ‘rights’...”

RIGHTS – JUDICIAL NOTICES

ZA2018-0350 *anc.org.za* (ANC v Unwembi Communications) – Appeal

- Evidence to Complaint lacking – no support to ‘rights’ *
- Judicial Notice of rights of Complainant taken by Panel **

* Burden of Evidence???

** Obligation to consider external factors???

ESTABLISHMENT (INCEPTION) OF RIGHTS

- MXIT Lifestyle v Steyn (ZA2008-00020 *mixit.co.za*)

The date on which a complainant's rights must exist is the date of the Complaint,
NOT the registration date of the disputed domain name

* See also ZA2016-0245 (*kfclists.co.za*)

COMPARISON (MARK vs DOMAIN)

CCG Australasia v Cable Gland Company 42807/2014 (cgco.co.za)

CCG vs. CGCO

- On 'side-by-side' comparison – confusion is low
- However imperfect recollection – risk of confusion higher
- Mark/Domain has no meaning – mere “grunts”
- Risk of confusion may vary in contexts – risk is still significant

??? Possible different outcome under ADR ???

RELATIONSHIP BETWEEN PARTIES *

Coolsystem Inc v Game Ready SA (ZA2019-0357 gameready.co.za)

- Goodwill arising from use of a mark by a distributor accrues to the benefit of the proprietor, **NOT** the distributor

* See also Fairhaven Country Estate v Harris 735/2015 (fairhaven<domains>.co.za)

* Concept of “Typo-squatting” – ZA2018-0350 (anc.org.za)

SELL DOMAIN AT AN 'EXORBITANT PRICE'

Regulation 4(1)(a)(i)

"...valuable consideration in excess of the registrant's reasonable out-of-pocket expenses directly associated with acquiring or using the domain name..."

Athena Cosmetics v Bredenhann (ZA2018-0352 *revitalash.co.za*)

- Offered by Registrant at *"...reasonable compensation..."*
- Unreasonable for Adjudicator to make any assumptions insofar as to the monetary value* envisioned by the Registrant

* Not limited to 'monetary value'

BURDEN OF PROOF – REGULATION 5(C)

“...the burden of proof shifts to the Registrant to show that the domain name is not an abusive registration if the domain name is identical to the mark in which the Complainant asserts rights, without any addition.”

- Computer Core Business v PMDVOIP (ZA2019-0378 *istore.co.za*) – Currently on Appeal...
- Rostruct v Rosond 76243/2013 (*rostruct.co.za*)
- Global Vitality v Enzyme Process Africa 20884/2013 (*enzymeprocess.co.za*)



THANK YOU
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