DomainDisputes.co.za
SAIIPL Alternate Dispute Resolution

Decision

[ZA2011-0086]

.ZA ALTERNATE DISPUTE RESOLUTION REGULATIONS (GG29405)

ADJUDICATOR DECISION

CASE NUMBER:	**ZA2011-0086**
DECISION DATE:	**21 October 2011**
DOMAIN NAME	**azisa.co.za**
THE DOMAIN NAME REGISTRANT:	**Azisa**
REGISTRANT'S LEGAL COUNSEL:	**None**
THE COMPLAINANT:	**The Council for Scientific and Industrial Research (CSIR)**
COMPLAINANT'S LEGAL COUNSEL:	**Spoor & Fisher**
2nd LEVEL ADMINISTRATOR:	**UniForum SA (CO.ZA)**

1 Procedural History

a) The Dispute was filed with the South African Institute of Intellectual Property Law (the "SAIIPL") on **4 August 2011**. On the **7th of August 2011** the SAIIPL transmitted by email a request to UniForum SA for the registry to suspend the domain name in issue. The SAIIPL verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the "Regulations"), and the SAIIPL's Supplementary Procedure. There were some delays in the commencement of the Dispute process due to the size of the attachments to the Complaint.

b) In accordance with the Regulations, the SAIIPL formally notified the Registrant of the commencement of the Dispute on **30 August 2011**. In accordance with the Regulations the due date for the Registrant's Response was **26 September 2011**. The Registrant did not file a response and on **27 September 2011** the Administrator declared the Registrant to be in default and proceeded to appoint the Adjudicator.

c) The Case Administrator proceeded with the appointment of an Adjudicator. The SAIIPL appointed Nola Bond as the Adjudicator on **6 October 2011**. The Adjudicator has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the SAIIPL to ensure compliance with the Regulations and Supplementary Procedure.

2 Factual Background

a) The Complainant is The Council for Scientific and Industrial Research (CSIR).

b) The Complainant was constituted in 1945 by an Act of Parliament and is a leading scientific and technological research, development and implementation organisation. The Complainant is clearly an important role player in this field and its services underpin the socio-economic growth and development of South Africa.

c) The Complainant is partly government funded (40%) and enables ongoing technological development, and in the process facilitates the training and development of research expertise.

d) The Complainant's other sources of income stem from research contracts with both the government and private sector, local and foreign research funding agencies. The licensing of technology, royalty payments and dividends paid from IP management and commercial companies created by the Complainant, yield another source of income.

e) The Complainant is the registered proprietor of the trade mark AziSA in class 9, 35, 38, 42 and owns the domain name azisa.org.

f) The Complainant uses its AziSA trade mark in relation to goods and services which were developed as an open source non-proprietary set of standards used as core technology in a project to alleviate rockfalls in mines. Originally known as Smart Mine Azisa, the Complainant elected at an early stage to call its products and services AziSA.

g) In a field where conditions are often hazardous and unhealthy, the Complainant's technology has had a significant impact which has been globally recognised. The Complainant's AziSA systems facilitate data acquisition and underground control through the incorporation of various standards, allowing for real time collation of crucial information which is measured and processed. The Complainant's AziSA system achieves this through standardised wireless sensor networks, a standardized protocol for communicating, an open protocol for connecting to sensors, getting measurements and controlling actuators, a data communication system using existing power cabling, and an open database structure which allows for additional sensors to be added in a cost effective manner.

h) It is clear that the Complainant's products and services are highly sophisticated and offer essential safety features for mine workers, which has apparent worldwide application.

i) The Registrant is AZISA of 260 Surrey Avenue, Randburg, Gauteng, 2194, which entity holds the disputed domain name azisa.co.za, registered on 18 May 2004.

j) The Registrant does not appear to be actively using the domain name, nor is

there any evidence of past usage. Furthermore, the Complainant appears to have made numerous attempts to contact the Registrant by email and letter, all to no avail. The specifics of these communications are contained in paragraphs 11.2.2 – 11.2.3 read with Annexure "J" and "K" of the Complaint.

3 **Parties' Contentions**

3.1 **Complainant**

a) The Complainant's case is hinged on the following contentions:

i) The Complainant holds valid trade mark registrations for the mark AziSA under nos. 2009/03433-6 in classes 9, 35, 38 and 42, of which it has made extensive use.

ii) The Complainant alleges that the domain name in the hands of the Registrant is an abusive registration as defined in Regulation 1(a) insofar as it has been used in a manner that takes unfair advantage of, or is detrimental to the Complainant's rights.

iii) The Complainant further claims that the Registrant's name "AZISA" as listed on WHOIS search report is incomplete making it difficult to identify the complete identity of the Registrant. For this reason, the Complainant argues that the Registrant has abandoned the domain name azisa.co.za and has been passively holding the name without using it. The Complainant states it is tantamount to use in bad faith.

iv) Given these facts, the Complainant alleges that the Registrant has no legitimate claim to the name, and the continued registration of the domain name is disrupting and unfairly interfering with the Complainant's business.

b) The Complainant accordingly seeks a finding that the Registrant's domain name constitutes an abusive registration and requests an order that the domain name be transferred to it.

3.2 **Registrant**

a) Regulation 18(1)(a) provides that a Registrant must respond to the

statements and allegations contained in the Dispute in the form of a Response. In such a Response, the Registrant must detail any grounds to prove the domain name is not an abusive registration.

b) The Registrant failed to submit a Response.

c) Because the Registrant failed to submit a Response, the Adjudicator must decide the matter on the Dispute (see Regulation 18(3)).

d) Regulation 28(2) provides that, in the absence of exceptional circumstances, an Adjudicator shall draw such inferences, as it considers appropriate, from the failure of a party to comply with a provision or requirement of the Regulations.

e) The Adjudicator draws the following two inferences: (i) the Registrant does not deny the facts that the Complainant asserts, and (ii) the Registrant does not deny the conclusions that the Complainant draws from these facts.

f) Notwithstanding these inferences, the Adjudicator has analyzed Complainant's version in order to satisfy herself that the allegations contained in its Complaint are acceptable and probably true (*see Multichoice Subscriber Management v JP Botha ZA2007-0010*).

4 **Discussion and Findings**

a) In terms of Regulation 3, a Complainant must prove, on a balance of probabilities, that the following 3 elements are present, in order to successfully show a domain name to be an abusive registration:

i) That the Complainant has rights in respect of the trade mark (or name);

ii) That the trade mark (or name) is identical or similar to the domain name; and

iii) That, in the hands of the Registrant, the domain name constitutes an abusive registration.

4.2 **Complainant's Rights**

a) The Complainant holds registered trade marks in the AziSA mark. This trade mark is identical to the Registrant's domain name azisa.co.za. Thus, the first two requirements are met.

4.3 **Abusive Registration**

a) The remaining consideration is whether the domain name is tantamount to an abusive registration. An abusive registration is defined as a domain name which either:

i) When the Registrant registered the domain name took unfair advantage of or was unfairly detrimental to the Complainant's rights or;

ii) A domain name that is being used in a manner that takes unfair advantage of, or is detrimental to the Complainant's rights.

b) The Complainant cannot rely on the provision under (a) above, since the domain name was first registered in 2004 by the Registrant, whilst the Complainant's trade mark rights first arose in February 2009. For this reason the Registrant could not have intended to interfere with the Complainant's rights when registering the domain name.

Consequently it is necessary to determine whether the Registrant, by passively holding the domain name, is using it in a manner that takes unfair advantage of, or is detrimental to the Complainant's rights. In various foreign domain name disputes it has been held that the "use" requirement can be met by both positive action and inaction (*D2000-0400 CBS Barneys Inc v BMY Bulletin Board; D2000-0400 CBS Broadcasting Inc v Dennis Toeppen*). This principle has also been accepted into South African Law (*ZA2008/0015 Luxottica U.S. Holding Corp vs Preshal Lyar*).

c) In the decision of *Podek Philippe SA v Thinksecure Labs (WIPO/D2010-0169)* the Registrant had not used the domain name for almost five years and had not responded to any communications. The Panel accepted that this constituted passive use by the Respondent as it had prevented the

Complainant from registering the domain name and as a consequence it had disrupted the Complainant's business.

d) In view of the fact that the Registrant in this matter does not appear to actively use its domain name nor has it responded to communications, and failed to file a Response in this dispute, the Adjudicator finds that this constitutes use as contemplated by the Regulations dealing with abusive registrations. The net effect of this use is to unfairly disrupt the Complainant's business and to prevent the Complainant from exercising its rights.

e) In the course of its submissions, the Complainant stated that the Registrant had failed to provide complete and accurate contact details when registering its domain name which WHOIS search report support. The Adjudicator is satisfied that the Complainant has taken all reasonable steps to contact the Registrant and its failure to respond to the SAIIPL Alternative Dispute Resolution Administrator supports a finding that it has all but abandoned the domain name and has failed to demonstrate any *bona fide* intention to use the domain name.

5 **Decision**

a) The Adjudicator finds that the Complainant has proven, on a balance of probabilities, that the domain name constitutes an abusive registration.

b) Accordingly, in terms of Regulation 9, the Adjudicator orders that the domain name azisa.co.za be transferred to the Complainant.

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NOLA BOND

SAIIPL SENIOR ADJUDICATOR

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