

ADJUDICATOR DECISION

CASE NUMBER:	ZA2010-0047
DECISION DATE:	27 August 2010
DOMAIN NAME	hotelmissoni.co.za
DOMAIN NAME REGISTRANT:	Digital Orange
REGISTRANT'S LEGAL COUNSEL:	N/A
THE COMPLAINANT:	Missoni Spa
COMPLAINANTS' LEGAL COUNSEL:	Adams & Adams
THE 2nd LEVEL DOMAIN NAME ADMINISTRATOR:	UniForum SA (CO.ZA Administrators)

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1. Procedural History

- 1.1** The Dispute was filed with the South African Institute of Intellectual Property Law (the “SAIPL”) on 10 June 2010.
- 1.2** On 15 June 2010, the SAIPL transmitted to UniForum SA, by email, a request for the Registry to suspend the domain name at issue, and thereafter verified that the Dispute satisfied the formal requirements of the .ZA Alternate Dispute Resolution Regulations (the “Regulations”), and the SAIPL’s Supplementary Procedure.
- 1.3** In accordance with the Regulations, the SAIPL formally notified the Registrant of the commencement of the Dispute on 5 July 2010. The due date for the Registrant’s Response was 2 August 2010. The Registrant did not submit any response, and accordingly, the SAIPL notified the Registrant of its default on 10 August 2010.
- 1.4** The SAIPL appointed Adv Owen Salmon as the Adjudicator in this matter on 19 August 2010. 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

- 2.1** The domain was registered on 29th June 2009 in the name of Digital Orange with Joris Kroner as administrative contact. It has been noted in earlier decisions that Digital Orange is the alter ego of Mr Kroner.¹ The facts in the present matter lead to the same conclusion.

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See ZA2009-0037 <ketelone.co.za>, paragraph 2.1; ZA2009-0034 <absapremiership.co.za>, paragraph 2.1.

- 2.2** The following facts are undisputed and, their not being palpably implausible, the Adjudicator accepts them for the purposes of this adjudication.
- 2.3** The Complainant is Missoni SpA, a corporation incorporated in terms of the laws of Italy, with its recorded address at Via Luigi Rossi, 52 - 21040, Sumirago (Varese), Italy (hereinafter referred to as "Missoni").
- 2.4** Missoni is a leading company in the fashion field. Its goods are marketed and promoted in almost every country of the world including South Africa. There are also a number of hotels operated or in development stages known as "Hotel Missoni".
- 2.5** Missoni is the owner of many national, international and community registered trademarks, and the main trademarks on which the Complaint is based are HOTEL MISSONI and MISSONI. The first international filing for MISSONI dates back to 2 September 1969, and to 21 December 2007 for HOTEL MISSONI. In South Africa, the first filing dates back to 11 March 1981 for MISSONI, and to 5 May 2009 for HOTEL MISSONI.
- 2.6** Missoni has published company information via the internet since 2000, and has registered more than 60 country and generic domain names corresponding to its trademarks, including <missoni.com> and <hotelmissoni.com>, and all of which predate (by many years) the domain registration in question.
- 2.7** On 9 June 2009 announcements were published in international media that the Complainant intended to open a HOTEL MISSONI in Cape Town. It is not necessary to decide, for present purposes, whether the registration by Digital Orange of <hotelmissoni.co.za> a few weeks later was coincidental.

2.8 On 21st September 2009 the Milan-based Patent and Trademark Attorneys Modiano and Partners wrote to Digital Orange (attention Mr Joris Kroner) recording the Complainant's interest in the registration of the domain <hotelmisisoni.co.za>, and enquired about the rights of Digital Orange to the name. A few days later a response was received from Mr Kroner stating this "his client" was willing to sell the domain for R100 000,00. Further correspondence ensued, the last of which was an email from Mr Kroner stating:-

"My client is not willing to handover this domain as he has registered it on a first come first serve basis. In all fairness your client has had ample time to do this as well. Client is however willing to lower the price to R80,000. Please note this offer expires Friday 30th of October at 5 PM. After this the price will go up again. As I told you before legal action can be a lengthy and costly affair without a guaranteed positive outcome especially given the fact that there is no unauthorised use of the domain."

2.9 Missoni thereafter lodged the present complaint.

2.10 The domain name points to a single static web page which states that *"This will soon be the new home of the domain: www.hotelmisisoni.co.za".²*

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This was the case in <absapremiership.co.za>, a domain also registered by Mr Kroner – see ZA2009-0034, supra, at paragraph 2.13; and was the case in <ketelone.co.za>, also a domain registered by Mr Kroner – see ZA2009-0037 at paragraph 2.9; and was the case in <peroni.co.za>, a domain also registered by Mr Kroner – See ZA2009-0038 at para 2.9.

3. Complainant's Contentions

3.1 The Complainant submits that the domain name in the hands of the Registrant is an abusive registration, and that the Registrant is taking unfair advantage of its' rights. It is not necessary to elaborate upon the grounds of the objection, given the operation of the three-strike rule (dealt with below).

4. Discussion and Findings

4.1 The Adjudicator finds that the Complaint has rights in respect of the marks MISSONI and HOTEL MISSONI as contemplated by Regulation 3(1) (a). The question is whether the registration in the hands of the Registrant is an abusive registration.

4.2 An abusive registration means a domain name which either:-

- 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
- has been used in a manner that takes unfair advantage of, or is unfairly detrimental to the Complainant's rights.

4.3 Ordinarily, the Complainant is required to prove on a balance of probabilities that the required elements are present.³ However, in the present case, Regulation 4(3) is relevant. It creates the presumption of an abusive registration, in its following provisions:-

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Regulation 3(2).

“There shall be a rebuttable presumption of abusive registration if the Complainant proves that the registrant has been found to have made an abusive registration in three or more disputes in the 12 months before the dispute was filed.”

4.4 In the 12 months preceding the present dispute Digital Orange and/or Mr Kroner has been found to have made an abusive registration in as many as four disputes. These are:-

- Domain Name: <hackett.co.za>, Case No. ZA2009-0033. Decision Date: 10 September 2009
- Domain Name: <absapremiership.co.za>, Case No. ZA2009-0034, Decision Date: 20 September 2009
- Domain Name: <ketelone.co.za>, Case No. ZA2009-0037, Decision Date: 15 December 2009
- Domain Name: <peroni.co.za>, Case No. ZA2009-0038, Decision Date: 19 February 2010

- 4.5** That this is so brings the presumption into operation. It has not been rebutted. It follows therefore, that the Adjudicator is entitled to find that the registration <hotelmissoni.co.za> in the hands of Digital Orange is abusive. The Adjudicator so finds.
- 4.6** In any event, it is clear that Digital Orange (or Mr Kroner) is engaged in a pattern of making abusive registrations and, as contemplated by Regulation 4(1)(c), this is a factor that may be taken into account in determining whether the instant registration is abusive. Moreover, the demand of R80 000 (or R100 000) betrays, palpably, the intention of the Registrant, for the costs attendant upon registering the domain have no relation to these ransom-like sums at all. The inference that can be drawn accommodates the parameters of Regulation 4(1)(a), that the domain was registered primarily to transfer it for a consideration in excess of the reasonable expenses incurred in acquiring the registration.
- 4.7** The Adjudicator finds the domain registration by Digital Orange was abusive.
- 4.8** Accordingly, the Adjudicator upholds the Complainant's Dispute.

5. Decision

- 5.1** For the foregoing reasons the Adjudicator orders that the domain name be transferred to the Complainant.

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ADV OWEN SALMON
SAIPL SENIOR ADJUDICATOR