

INTERNATIONAL DOMAIN DISPUTE SUCCESS: BIGBROTHERAFRICA.COM IS BACK IN ITS OWNER'S HANDS

Category: Commercial Law, Media and OTT
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A brief background

Endemol South Africa ("Endemol SA") produces Big Brother Africa, a successful pan-African reality television program. Endemol SA, represented by PPM Attorneys, has just won an international domain dispute before the World Intellectual Property Organisation's ("WIPO") Arbitration and Mediation Centre.

The history of the dispute went back to 2006 and related to the hijacking of the domain: bigbrotherafrica.com. The dispute reads like a spy novel with claims of online meetings and agreements between people who had never met, the use of technology to find long archived crucial evidence and a secretive "globe-trotting" domain "hijacker" who didn't want to be identified.

How Endemol succeeded

Endemol SA needed to prove three elements in order to succeed with its complaint. It needed to prove that:

- (i) the disputed domain name registered by "the hijacker" is identical or confusingly similar to a trade mark or service mark in which Endemol SA has rights;
- (ii) "the hijacker" has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

Endemol SA was successful in proving that bigbrotherafrica.com was "identical or confusingly similar" to its trade mark. It proved this by showing that it had registered the trademark "Big Brother" in over 30 countries, it had common law rights in the trade mark because it had broadcast the program Big Brother Africa to over 51 countries over a long period and had spent a large amount of resources marketing the program.

Endemol SA proved that "the hijacker" had "no rights or legitimate interests" in the domain. It did this by showing that "the hijacker's" provision of active video links to Endemol SA's Big Brother Africa related videos, without any connection to Endemol SA, was commercial use of the domain, was not a legitimate fan site and was being done in bad faith.

Endemol SA was successful in proving the third element namely that the domain "had been registered...in bad faith". Endemol SA showed that the domain had been registered in bad faith by demonstrating that when the "the hijacker" registered the domain, it knew of Endemol SA's Big Brother Africa productions in Africa and the Big Brother production throughout many parts of the world. It also proved that the domain "had been used...in bad faith". It was shown that "the hijacker" had attempted to create the impression that his fan site was sponsored and endorsed by and affiliated with Endemol SA. In addition, it was shown that in doing so, "the hijacker" obtained

commercial gain.

What to learn from this

The dispute arose from a minor administrative oversight that caused the domain not to be renewed in 2006: renewing a domain costs about ZAR150.00. The legal fees to reclaim the domain were many times more than the renewal fee.

Make sure that you know what the statuses of your domains and other intellectual properties are. Renew them on time and, if you are unable to administer them yourselves, make sure that someone is contractually bound to take care of this for you.