

Nominet UK Dispute Resolution Service

DRS : 5314

The Coca-Cola Company –v- Max Raph

Decision of Independent Expert

1. Parties

Complainant

Complainant: The Coca-Cola Company  
Address: One Queen Caroline Street  
London  
UK  
Postcode: W6 9HQ  
Country: GB

Respondent

Respondent: Max Raph  
Address: Apt B30  
Park Lane  
London  
Postcode: SL1 2TT  
Country: GB

Disputed Domain Name

coca-colacentre.co.uk

3. Procedural Background

On 13 December 2007 the Complaint was lodged with Nominet UK in accordance with the Nominet UK DRS Policy and hard copies of the Complaint were received in full on 17 December 2007.

On 21 December 2007 Nominet UK validated the Complaint.

On 21 December 2007 Nominet UK sent a copy of the Complaint to the Respondent and *inter alia* advised the Respondent that the procedure for the conduct of proceedings under the Dispute Resolution Service had been invoked and allowed the Respondent 15 working days to respond to the Complaint to file a Response to the Complaint.

No Response was received and on 18 January 2008 Nominet UK notified the parties accordingly. The Fees were received from the Complainant on 25 January 2008.

James Bridgeman was selected as Expert and on 28 January 2008 was duly appointed following a conflicts check. The file was transmitted to the Expert pursuant to paragraph 11 of the DRS Procedure on the same date.

On 15 February 2008, at the request of the Expert, Nominet UK sent a request for further information relating to the *status* and identity of the Complainant, details of which are set out below. On 18 February 2008, the Expert and the Respondent were provided with information received from the Complainant in response to the Expert's request.

The Complainant offered to formally amend the Complaint, but in the circumstances the Expert determined that the explanation received was sufficient to clarify the *status* of the Complainant in relation to the rights relied upon and a formal amendment of the Complainant was not required.

The Respondent was allowed five further days in which to consider same and furnish submissions. No further submissions were received within the time and the Expert proceeded to make this decision.

#### 4. The Facts

The Complainant, is the owner of numerous registrations for the trade mark COCA-COLA in the United Kingdom and in most jurisdictions throughout the world.

The domain name in dispute was registered by the Respondent on 26 April 2007. There is no information about the Respondent except that which is noted on the Nominet UK WHOIS database and that appears to be inaccurate.

#### 5. The Parties' Contentions

##### Complainant's Submissions

The Complainant claims to be the owner of a very large number of registered trade marks for the word COCA-COLA and incorporating the term COCA-COLA in every country of the world that accepts trade mark registrations.

The Complainant asserts that COCA-COLA is a famous trade mark for, among other things, beverages. COCA-COLA is also registered for a variety of goods and services,

including but not limited to the goods and services within the following Nice Classification Classes: 05, 06, 08, 09, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27, 29, 30, 32, 33, 34, 38 and 42. 3.

In an annex to the Complaint, the Complainant has provided details of the UK Trade Marks and Community Trade Marks on which the Complainant relies these proceedings.

The Complainant, and its predecessor in title, was founded in the 1880's (initially as The Coca-Cola Corporation) and has been using the COCA-COLA trade mark for the purposes of advertising and selling its products since that time.

The Complainant submits that it has acquired considerable goodwill and reputation throughout the world in its COCA-COLA brand and COCA-COLA is one of the most recognised marks in the world today. As such, in addition to the numerous registered trade mark rights which the Complainant owns in the UK and around the world, the Complainant also has unregistered rights in the COCA-COLA mark under the English law of passing off, Continental laws of unfair competition, and similar laws in other countries, to prevent unauthorised parties from use of its COCA-COLA mark or from using marks or signs which are confusingly similar to the COCA-COLA mark or derivatives thereof.

The use of the COCA-COLA mark in the United Kingdom and throughout the world is therefore exclusively the right of the Complainant and its licensees.

The Complainant objects to the use of its famous COCA-COLA mark and brand as part of the domain name at issue. A print out of the web site to which the domain name at issue resolves has been submitted in an annex to the Complaint.

The Complainant submits that consumers will not see the descriptive word "centre" as adding anything to the famous trade mark COCA-COLA. The domain name coca-colacentre.co.uk is therefore identical to, or at the very least, similar to the Complainant's COCA-COLA trade mark.

Consumers in the United Kingdom who see the domain name at issue listed by a search engine would assume that the domain name in question links to the Complainant's web site. This would have been obvious to the Respondent at the time the domain name was registered.

The Complainant submits that the domain name, in the hands of the Respondent, is an Abusive Registration.

Article 1 of the Dispute Resolution Service Policy states that Abusive Registration means a domain name which either:

- (i) 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

- (ii) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

The Complainant has never consented to the registration or use of the domain name at issue by the Respondent.

The Complainant considers that, in particular, having regard to the considerable reputation of the COCA-COLA mark/brand, the domain name coca-colacentre.co.uk has been registered and used by the Respondent to attract to the web site at that domain name legitimate customers of the Complainant in a manner that takes unfair advantage of, and is detrimental to, the Complainant's rights.

The Respondent is using the domain name at issue to associate the Complainant with advertising a cash lottery prize promotion. The Complainant considers such association to be detrimental to the Complainant's COCA-COLA mark and business generally: the Complainant offers no such lottery. In addition, the Complainant is aware of a current email scam using the Complainant's name for a lottery that does not exist. The Complainant has attached examples of press comments on the lottery scam in the name of the Complainant.

Additionally, the Respondent is infringing the Claimant's copyright by displaying imagery in combination with the Claimant's registered trade marks for THE COKE SIDE OF LIFE on the website to which the domain name in dispute resolves in a manner that takes unfair advantage of, and is detrimental to, the Complainant's rights. The Complainant has submitted a print out of the Respondent's website to illustrate that the content includes both the imagery in which the Claimant claims copyright together with details of the Claimant's registered trade marks for THE COKE SIDE OF LIFE.

The Complainant has been unable to send a cease and desist letter to the Respondent as the Respondent has provided a fictitious correspondence address to Nominet. A copy of the WHOIS record for the domain name coca-colacentre.co.uk registered to the Respondent is attached to the Complaint to illustrate the Complainant's allegation that the Respondent has used a fictitious address. In particular, the UK postcode supplied by the Respondent does not correspond with a Park Lane, London address. The Complainant has provided a listing from the UK Post Office postcode and address finder website, indicating that the postcode SL1 2TT relates to twenty six different addresses in Slough, Berkshire, and not to a Park Lane London address. Nominet's guidance notes indicate that a Respondent providing Nominet with false information about his address is indicative of an abusive registration.

In conclusion, it is evident that:

- (a) to the vast majority of consumers in the United Kingdom, the term COCA-COLA is exclusively associated with the Complainant;
- (b) the Respondent registered the domain name in dispute in full knowledge of the Complainant's rights in the term COCA-COLA and knowing that the vast majority of

consumers in the United Kingdom associate the term COCA-COLA only with the Complainant and its COCA-COLA beverage;

(c) the Respondent did not and does not intend to use the domain name for any other purpose than to mislead consumers by associating its cash lottery prize promotion with the Complainant's COCA-COLA trade mark; and

(d) the domain name at issue in these proceedings is an Abusive Registration under Nominet's Dispute Resolution Service Policy in that at the time when the registration took place, the Respondent took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

In addition, the Complainant submits that the domain name has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Having considered the Complaint, the Expert noted that the trademarks on which the Complaint relies are all registered in the name of the eponymous "The Coca-Cola Company" of One Coca-Cola Plaza, Atlanta, Georgia, United States of America. It would appear from the Complaint that the Complainant is a British registered company with an address in London. The Expert furthermore noted that while the Complainant claims to have substantial goodwill in the sale of COCA-COLA products in the United Kingdom, it has not provided any evidence of sales or other activities by the Complainant in the United Kingdom. In a procedural order, the Expert sought clarification of the basis on which the Complainant claims to have rights in the trade marks owned by the USA corporation. The Respondent clarified that the Complainant is in fact the corporation that is registered in Atlanta, United States of America. The address given for the Complainant in filing this Complaint is the principal place of business of the Complainant within the United Kingdom. The trade mark registrations on which the Complainant relies are recorded to the Complainant's Atlanta address but the owner of the trade mark registrations is one and the same company as the Complainant.

#### Respondent 's Submissions

No Response or other submissions were received from the Respondent.

#### 6. Discussion and Findings:

In order to succeed in these proceedings, paragraph 2(b) of the Nominet UK DRS Policy requires the Complainant to prove on the balance of probabilities that both elements of the test set out in paragraph 2(a) are present *viz.* that

- i. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

## Complainant's Rights

The Complainant relies on a large portfolio of registrations for its COCA COLA trade marks. The Complainant furthermore relies on common law rights in the use of the mark in the United Kingdom and throughout the world.

The trademark registrations relied upon are all owned by The Coca Cola Corporation with an address in the United States of America. The Complaint has been filed by The Coca Cola Corporation with an address in London. The Complainant has clarified that it is one and the same corporation and has merely used the address of its principal place of business for the purpose of filing this Complaint. In the circumstances the Complainant has established its Rights in the COCA-COLA trade mark for the purposes of the Nominet UK DRS and it is not necessary to consider whether the Complainant has any common law rights in the mark in the United Kingdom or elsewhere for the purposes of this Complaint.

The domain name incorporates the Complainant's registered trade mark in its entirety with the addition as a suffix of the word "centre".

The distinctive element of the domain name is the Complainant's distinctive trade mark COCA-COLA. The domain name and the Complainant's trademark are clearly similar and the word "centre" does not serve to reduce the similarity in any way from the distinctive COCA-COLA trademark.

The Complainant has therefore succeeded in establishing the first element of the test in paragraph 2(a) of the Nominet UK DRS Policy.

## Abusive Registration

As defined in paragraph 1 of the DRS Policy, the concept "Abusive Registration" means

*"a Domain Name which either:*

*i. 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*

*ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights;"*

No Response or other communication has been received from the Respondent. It is clear from the evidence that the domain name in issue was registered to take unfair advantage of the Complainant's Rights and the Respondent proceeded to use the domain name in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's Rights.

The domain name at issue is being used by the Respondent purporting to promote a lottery. The Respondent has given false contact information when registering the domain name and the Complainant has shown that the postal address given by the Respondent is incorrect and it appears to be a sham rather than an error.

Furthermore by incorporating the Complainant's registered trade mark as the dominant element of the domain name at issue and by using the Complainant's trade marks and copyright works in the content on the web site to which the domain name resolves, it is clear that the Respondent both registered and is using the domain name in dispute for an abusive purpose namely to divert Internet traffic intended for the Complainant to a web site on which the Respondent is purporting to promote a lottery in very questionable circumstances. The Complainant has made out a *prima facie* case that there is a serious risk that Internet users may be misled into believing that the lottery is in some way connected with a marketing promotion of the Complainant organisation when there is no such connection.

In the circumstances, on the evidence submitted in the Complaint, that has not been challenged, the Complainant has proven that the domain name is an Abusive Registration in the hands of the Respondent.

The Complainant has therefore also satisfied the second element of the test as set out in paragraph 2(a)(ii) of the Nominet UK DRS Policy and is therefore entitled to succeed in its application.

## 7. Decision

Having established both elements of the tests set out in paragraph 2(a) of the Nominet UK DRS Policy, the Complainant is entitled to succeed in its application and this Expert directs that the domain name coca-colacentre.co.uk be transferred to the Complainant.

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James Bridgeman

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Date: 25 February 2008