

Nominet UK Dispute Resolution Service

DRS 15306

McDonald's Corporation

and

Timothy Mayeur

Decision of Independent Expert

1 Parties

Complainant: McDonald's Corporation

Address: One McDonald's Plaza
Oak Brook, IL

Postcode: 60523

Country: United States

Respondent: Timothy Mayeur

Address: 126-2125 Itabashi Way
Burlington
Ontario

Postcode: L7M0A1

Country: Canada

2 Domain name

<mccafe.co.uk>

3 Procedural History

- 3.1 On 9 January 2015 the complaint was received by Nominet, which checked that it complied with the Nominet UK DRS Policy (“the Policy”) and DRS Procedure (“the Procedure”). Nominet notified the respondent the same day. The respondent's response was received on 2 February 2015. The matter was not resolved in mediation. The complainant requested referral of the matter for expert decision under the Procedure, and on 25 February 2015 paid the applicable fee.
- 3.2 I was appointed as expert on 3 March 2015. I have made the necessary declaration of impartiality and independence, confirming that I am independent of each of the parties and that to the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

4 Factual background

- 4.1 The complainant is an internationally known fast-food restaurant business.
- 4.2 The respondent registered the domain name on 11 January 2014.

5 Parties' Contentions

Complainant

- 5.1 The complainant says it owns many trade marks, including UK and Community trade marks, in relation to the mark “McCafe”.
- 5.2 It says it has used the McCafe brand internationally since the 1990s, owns more than 20 domain names based on it, and operates more than 1,600 McCafe-branded stores around the world. It says it has extensively used the McCafe brand to promote its restaurants, and has spent millions advertising it.
- 5.3 It says the domain name is identical to its McCafe mark.
- 5.4 The complainant says the respondent has no legitimate interest in the domain name, and has shown no preparations to use it in connection with a bona fide offering of goods or services. It says he is not making any legitimate non-commercial or fair use of the domain name, or any use of it at all.
- 5.5 It argues that internet users are likely to be confused into believing that the domain name is connected with the complainant even if there is no content associated with the it domain name.

- 5.6 The complainant argues that, although non-use of the domain name is not automatically objectionable, the complainant's trade mark rights are sufficiently well known that the only possible reason for registering the domain name was to take advantage of them.
- 5.7 It argues that the respondent registered the disputed domain name for the purpose of profiting from its reputation.
- 5.8 It says that on November 11, 2014, the respondent offered to sell it the domain name for US \$7,000. It argues that the respondent registered the domain name for the purpose of selling it to the complainant for a price in excess of his costs.
- 5.9 It says the respondent has unfairly disrupted its business by registering the domain name to divert consumers, and prevent it acquiring the domain name.

Respondent

- 5.10 The respondent argues simply that the domain name is his property.
- 5.11 He also says that since he is from Canada, "that is the legal classification of domains that would apply".

6 Discussion and Findings

General

- 6.1 Under paragraph 2(a) of the Policy a complainant must show on the balance of probabilities that:
- it has rights in respect of a name or mark which is identical or similar to the domain name, and that
 - the domain name, in the hands of the respondent, is an abusive registration.

Rights

- 6.2 Rights are defined in the Policy as rights enforceable by the complainant, whether under English law or otherwise.
- 6.3 The complainant has produced documentary evidence from the UK Intellectual Property Office and from the Office for Harmonization in the Internal Market of its UK and Community trade mark registrations for the mark "McCAFE".
- 6.4 At the third level (i.e. disregarding "co.uk"), the domain name consists entirely of the six letter string "mccafe", which corresponds to the complainant's trade mark.
- 6.5 In those circumstances, I am satisfied that the complainant has rights in respect of a mark which is identical to the domain name.

Abusive Registration

- 6.6 Under paragraph 1 of the Policy, 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 which took unfair advantage of or was unfairly detrimental to the complainant's rights.

This definition obviously covers both the time of registration, and later use.

- 6.7 Under paragraph 3(a)(i)(A) of the Policy, circumstances indicating that the respondent has registered the domain name primarily for the purposes of selling it to the complainant or a competitor for more than his costs may be evidence of abusive registration.
- 6.8 The complainant's McCafe brand is quite well known, and the complainant itself very well known internationally, including in Canada where the respondent is based. It is also well known for using other brand names beginning with the prefix "Mc", such as "McMuffin", "McRib", "McFlurry", "Chicken McNuggets" and "McChicken Sandwich".
- 6.9 A possible association is so obvious between the complainant and any name made up of the prefix "Mc" followed by a word representing a food or drink item or a place where food or drink is sold that it is difficult to imagine the respondent was unaware at the time of registration that the complainant might have rights in respect of the domain name.
- 6.10 In addition, the complainant has produced evidence that in November 2014 the complainant contacted it by e-mail offering to sell the domain name for US \$7,000. The respondent has not disputed that.
- 6.11 Neither of these in itself proves what the respondent's intention was at the time of registration, but taken together in my view they establish a prima facie case that the respondent registered the domain name primarily for the purposes of selling it to the complainant for more than it cost him.
- 6.12 The respondent has not claimed to have a legitimate use for the domain name, or to have made preparations for using it in connection with any activity of his own.
- 6.13 It is for the complainant to make good its case. However, for the reasons I have given the evidence before me establishes a prima facie case of abusive registration. The respondent has provided no explanation for his registration of the domain name.
- 6.14 In those circumstances I am satisfied on the balance of probabilities that the domain name, in the hands of the respondent, is an abusive registration.

6.15 To the extent that the respondent may have intended to argue that the domain name is not subject to the DRS, I reject that argument. By registering a domain name ending in “.uk” the respondent entered into a contract of registration with Nominet UK, and agreed to be bound by the Policy and the Procedure.

7 Decision

7.1 I find that the complainant has rights in a mark which is identical to the domain name; and that the domain name, in the hands of the respondent, is an abusive registration.

7.2 The complaint is upheld. I direct that the domain name be transferred to the complainant.

Carl Gardner

23 March 2015