

.nz Dispute Resolution Service

DRS Reference: 1061

The Coca-Cola Company v

**Chefs With an Edge
Australia Pty Ltd**

Key words -

Domain name

mycoke.co.nz

mycoke.net.nz

Identical or similar trade mark or name

Registered mark - similar - mark with generic word

Rights

Commonly known by

Unfair registration

Unfair registration - offer to sell, rent or otherwise transfer - monetary demands, non-monetary demands - respondent having no connection with name or trade mark

Procedure

Transfer

1. Parties

Complainant:

The Coca-Cola Company
Keely Herrick
One Coca-Cola Plaza Atlanta, GA
30313 Atlanta, GA
United States

Represented by: Keely Herrick, Parks Wood LLC

Respondent:

Chefs With an Edge Australia Pty
Ltd
Hamish Rodwell
PO Box 278
Melbourne, VIC 3113,
Australia

2. Domain Names

mycoke.co.nz
mycoke.net.nz

3. Procedural history

- 3.1. The Complaint was lodged on 12 January 2015 and the Domain Name Commission (DNC) notified the Respondent of the validated Complaint on 13 January 2015. The domains were locked on 13 January 2015, preventing any changes to the record until the conclusion of these proceedings.
- 3.2. No response was received.
- 3.3. The Complainant paid Domain Name Commission Limited the appropriate fee on 26 February 2015 for a decision of an Expert, pursuant to Paragraph 9 of the .nz Dispute Resolution Service Policy ("the Policy").
- 3.4. The Hon Robert Fisher QC, the undersigned, ("the Expert") confirmed to the DNC on 4 March 2015 that he knew of no reason why he could not properly accept the invitation to act as Expert in this case and that he knew of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual background

- 4.1. The Complainant was founded in the 1880s under the name The Coca-Cola Corporation. It sells beverages and a range of other products worldwide.
- 4.2. In New Zealand the Complainant registered "COKE" as a trade mark on 22 May 1945. Since that time the Complainant has acquired and owns New Zealand registrations of the "COKE" mark for over 15 goods and services classes.
- 4.3. In the 2000s, the Complainant organised concerts called "My Coke Fest" in South Africa, and launched an online chat game titled MyCoke. The Complainant also registered the domain <mycokerewards.com> in 2005.
- 4.4. The Respondent was described in the domain name registration as "Chefs With an Edge Australia". As that name is not recognisable as a legal entity registration should not have been accepted in that form. I will assume for the purpose of this decision that the real Respondent is Chefs With an Edge Australia Pty Ltd. No other information is available regarding the Respondent or its activities.
- 4.5. On 17 October 2013 the Respondent registered the two disputed domain names <mycoke.co.nz> and <mycoke.net.nz> (the "Domain Names"). The Domain Names are parked with Crazy Domains. There is no suggestion that the Domain Names have ever contained user-uploaded information.
- 4.6. On the same day the Respondent also registered <mycoke.info>, <mycoke.asia>, and <mycoke.pw>. These domain names are also parked with Crazy Domains.

- 4.7. The Complainant registered <mycoke.nz> in October 2014. Later that month it launched a marketing campaign in New Zealand under the name "MyCoke". The campaign is based on a bottle-top sweepstakes program. The Complainant's authorised domain name <coke.co.nz> leads to a page where the term "MyCoke" features prominently.

5. Parties' contentions

(a) Complainant

- 5.1. The Complainant contends that the Respondent's registration of domain names including the "COKE" mark is likely to confuse the public as to source, sponsorship, affiliation or endorsement of the Respondent's domains by the Complainant. The Complainant also argues that there is a pattern of similar registrations by the Respondent and says this suggests an effort to block the Complainant's business until the Complainant purchases these domains.

(b) Respondent

- 5.2. The Respondent has not provided a response.

6. Discussion and findings

- 6.1. The dispute is governed by the Policy issued by Domain Name Commission Ltd on behalf of InternetNZ. Critical portions of the Policy for present purposes are:

3. Definitions ...

Rights includes, but is not limited to, rights enforceable under New Zealand law. However, a Complainant will be unable to rely on rights in a name or term which is wholly descriptive of the Complainant's business;

Unfair 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, or is likely to be, used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights;

...

4. Dispute Resolution Service

- 4.1 This Policy and Procedure applies to Respondents when a Complainant asserts to the DNC according to the Procedure, that:

4.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

4.1.2 The Domain Name, in the hands of the Respondent, is an Unfair Registration.

- 4.2 The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

...

5. Evidence of Unfair Registration

- 5.1. A non-exhaustive list of factors which may be evidence that the Domain Name is an Unfair Registration is set out in paragraphs 5.1.1 – 5.1.5:

- 5.1.1. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

- (a) for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
- (b) as a blocking registration against a name or mark in which the Complainant has Rights; or
- (c) for the purpose of unfairly disrupting the business of the Complainant; or

- 5.1.2. Circumstances demonstrating that the Respondent is using the Domain Name in a way which is likely to confuse, mislead or deceive people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;

- 5.1.3. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .nz or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;

...

- 5.2 Failure on the Respondent's part to use the Domain Name for the purposes of email or a web-site is not in itself evidence that the Domain Name is an Unfair Registration.

...

6. How the Respondent may demonstrate in its Response that the Domain is not an Unfair Registration

- 6.1. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Unfair Registration is set out in paragraphs 6.1.1 – 6.1.4:

...

- 6.4 Trading in Domain Names for profit, and holding a large portfolio of Domain Names, are of themselves lawful activities. The Expert will review each case on its merits.

- 6.2. It will be seen that to support a complaint of the present kind (as distinct from complaints regarding sub-domains) the Complainant must satisfy three elements:
- a) Rights in respect of a name or mark (para 4.1.1);
 - b) Identity or similarity between that name or mark and the Domain Names (para 4.1.1); and
 - c) Unfair registration in the hands of the Respondent (para 4.1.2).

(a) Rights in respect of a name or mark

- 6.3. The Complainant has demonstrated rights in respect of the name "Coke" based on its New Zealand registered trade marks and its business activities in New Zealand using that name.
- 6.4. I accept that the Complainant has rights in respect of the name "Coke". This requirement is satisfied.

(b) Identity or similarity between the name or mark and the Domain Names

- 6.5. The second requirement is to show that the Complainant's name or mark is identical or similar to the Domain Names.
- 6.6. The term "mycoke" in the Domain Names adds nothing to the word "coke" other than to introduce it with the pronoun "my". It therefore does little to deflect attention from the only word of substance in the term, namely "coke". Adding "my" is insufficient to differentiate the term from the Complainant's marks.
- 6.7. I am satisfied that the Domain Names are similar to "COKE". This requirement is satisfied.

(c) Unfair registration in the hands of the Respondent

- 6.8. The third requirement is unfair registration. The Policy includes a non-exhaustive list of factors that may be evidence of unfair registration (paras 5.1.1 to 5.1.5).
- 6.9. Of these, I accept that registration primarily for unfair gain is a reasonable inference from the well-known nature of the mark "COKE", the lack of any active use of the domain names for over a year and the size and resources of the Complainant. It is reasonable to infer that the direct or indirect object of the Respondent was to force the Complainant to purchase or rent the Domain Names at a profit to the Respondent. As such it was and is an unfair registration within the meaning of para 5.1.1.
- 6.10. The third and final element is therefore satisfied.

7. Decision

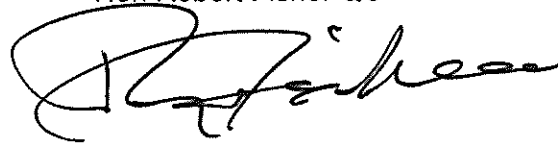
7.1. All three elements identified in para 6.2 above having been satisfied I determine that the disputed Domain Names should be transferred to the Complainant.

Place of decision Auckland

Date 19 March 2015

Expert Name Hon Robert Fisher QC

Signature

A handwritten signature in black ink, appearing to read 'R Fisher', written over the 'Signature' label.