

DISPUTE RESOLUTION SERVICE

DRS 08348

Decision of Independent Expert

The Coca-Cola Company (Non-UK Corporation)

and

Bo Cat (UK Individual)/Mr Paolo Ciuffa

1. The Parties:

Complainant: The Coca-Cola Company
Address: One Coca-Cola Plaza
Atlanta
Georgia

Postcode: GA30313
Country: USA

Respondent: Bo Cat (UK individual)/Mr Paolo Ciuffa

Address: 120 Green Lane
St. Albans
Hertfordshire

Postcode: AL3 6EU
Country: GB

2. The Domain Name:

fivealive.co.uk

3. Procedural History:

The Complaint was received by Nominet on 4 March 2010 and validated on 5 March 2010. The Complaint was sent to the Respondent on 5 March 2010 and a Response was received on 9 March 2010. This was followed by the Complainant's Reply filed on 16 March 2010. The Complaint was not resolved at the mediation stage and the fee to obtain an independent Expert's decision under Nominet's Dispute Resolution Service Policy (the 'Policy') was paid to Nominet on 14 May 2010.

Jon Lang was appointed as the independent Expert on 26 May 2010. The Expert confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances that might call into question his independence in the eyes of the parties.

4. Factual Background

The Complainant is the famous beverages company and the owner of an extensive reputation and goodwill in the mark FIVE ALIVE, the name of the Complainant's well known juice drink. FIVE ALIVE drinks have been available in the UK since 1980 and the FIVE ALIVE mark has become a household brand. The Complainant has only very recently become aware of the Domain Name.

The Complainant is the owner of numerous United Kingdom registrations that consist of or contain the words FIVE ALIVE or 5 ALIVE in relation to beverages, including but not limited to United Kingdom Trade Mark registration no. 1138915 for FIVE ALIVE in Class 32, and United Kingdom Trade Mark registration no. 2302695 for 5 ALIVE in Class 32.

The Respondent is a UK individual. The Domain Name is registered under his business name 'Bo Cat'. Not much is known about the Respondent other than that he appears to have something to do with the music industry.

5. Parties' Contentions

Complainant

The Complainant owns "Rights" in the UK in the name FIVE ALIVE, as defined in the DRS Policy. These Rights include trade mark registrations which are enforceable under English law.

The Domain Name was registered by the Respondent on 26 May 2004, by which time the Complainant had been the owner of registered trade mark rights in FIVE ALIVE and 5 ALIVE in the UK for over 22 years and enjoyed an extensive reputation through its use of FIVE ALIVE.

An internet search against the Domain Name results in an error page message indicating that there has been a failure to connect with the domain name server. A search of the internet archive website www.archive.org shows that the Domain Name previously resolved to a holding page indicating it was registered with the Registrar "1 and 1".

The Respondent is not a licensee of the Complainant and the Complainant has never consented to the registration or use of the Domain Name by the Respondent.

The Respondent does not have any legitimate interest in the Domain Name, particularly given that FIVE ALIVE is a well-known brand in relation to beverages and a distinctive mark registered and used exclusively by the Complainant.

Given the Complainant's extensive pre-existing rights in FIVE ALIVE, the Complainant asserts that the only reasonable conclusion is that the Respondent registered the Domain Name with the Complainant in mind and with the intention of capitalising on the Complainant's goodwill.

Moreover, the Complainant says that it is impossible to conceive of any good faith use of the Domain Name by the Respondent and goes on to state that:

- (A) any goods or services sold by the Respondent from the Domain Name under the name FIVE ALIVE would mistakenly be linked by consumers with the Complainant; and
- (B) the Complainant's customers seeking information on the Complainant's FIVE ALIVE beverages in the UK would be diverted away from the Complainant, such that its legitimate business would be unfairly disrupted.

The Complainant goes on to say that the 'Website is currently unavailable' and therefore the Respondent does not make (and apparently has not made during the five and a half years since registration):

- (A) a genuine offering of goods or services; or

(B) legitimate non-commercial or fair use of the Domain Name; and thus the only reasonable inference (from lack of content and use of the website) is that the Respondent acted without legitimate purpose and with the intention of diverting attention away from the Complainant, unfairly disrupting its legitimate business, and to block registration of a mark in which the Complainant has rights.

Further, given that the Domain Name is not and has not been used to offer any goods or services, or used to provide links through to other websites in the form of a “parked page”, it constitutes a purely passive blocking registration (which can constitute an Abusive Registration), with the sole purpose of disrupting the Complainant’s business and preventing the Complainant from registering the Domain Name in which it has Rights. The Complainant goes on to say that if any other purpose was intended by the Respondent, it has had ample time in which to demonstrate this but has failed to do so.

Finally, the Complainant refers to clause 3(a)(iv) of the Policy stating that independent verification that a respondent has given false contact details to Nominet is evidence of an Abusive Registration. To this end the Complainant states that they have been unable to find an individual or business called Bo Cat and submits that it is unlikely therefore that Nominet has been provided with genuine details for the Respondent and as such, the Domain Name amounts to an Abusive Registration.

Respondent

In his Response, the Respondent contends that the Domain Name was registered with the sole intention of representing a music artist by the name of MC Five Alive to promote his music. The Respondent says that this is an ongoing project which is yet to go live. The Respondent has provided by way of evidence a MySpace url link to the artist plus two recent flyers from events at which MC Five Alive has performed.

The Domain Name has not been used since it was registered in any way to maliciously harm the brand name "FIVE ALIVE" or the Respondent.

Moreover, the Respondent says that the Domain Name was not registered with the intention of capitalising on the goodwill of the Respondent or with the intention of blocking legitimate business or diverting legitimate business away from it.

As to the Complainant's assertions concerning contact details provided to Nominet, the Respondent states that the Domain Name was registered through the online hosting company 'OneAndOne' under his business name "Bo Cat PR" but only since receiving the Complaint was he aware of this and has since changed the details to his birth name.

Complainant's further contentions

In reply to the Response, the Complainant makes the point that if the Respondent's intention was only to promote MC Five Alive, the more obvious choice for a domain name would have been one which clearly indicated its association with an 'MC', such as <mcfivealive.co.uk> (which the Complainant says is available for registration), thereby ensuring no confusion between MC Five Alive and the Complainant's FIVE ALIVE brand.

By deliberately choosing not to register a domain name which distinguishes MC Five Alive from the Complainant's brand, the Respondent was intending to capitalise on the Complainant's goodwill in the FIVE ALIVE mark.

The Complainant goes on to develop a number of points made in its Complaint. It states that the Respondent intended to generate additional web traffic to its Website by diverting consumers away from the Complainant resulting in a greater number of consumers viewing MC Five Alive's website than otherwise would be the case.

The Complainant says that the Respondent has admitted in its Response that it provided incorrect details to Nominet, further supporting a finding of an Abusive Registration.

Finally, the Complainant states that the Respondent has had in excess of 5 years in which to establish a website promoting MC Five Alive but has not done so, thus indicating that this was not the Respondent's sole intention at the time of registration. The only reasonable inference from the Respondent's lack of use, so the Complainant says, is the absence of any legitimate purpose and an intention to divert consumers away from the Complainant, unfairly disrupting its legitimate business and blocking any registration by the Complainant.

6. Discussions and Findings

Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, 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 in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's rights

There can be little doubt that the Complainant has rights in the mark FIVE ALIVE. Ignoring the prefix 'www' and suffix '.co.uk', the Complainant's mark and Domain Name are identical. However, the Complainant still needs to prove an Abusive Registration.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either '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 which has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights;'.

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 3 of the Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily as a blocking registration against a name or mark in which the Complainant has rights, or for the purpose of unfairly disrupting the business of the Complainant.

Other factors suggesting an Abusive Registration include the Respondent using or threatening to use the domain name in a way which has confused or is likely to confuse people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This includes circumstances indicating that before being aware of the Complainant's cause for complaint, the Respondent has:

- a) used or made demonstrable preparations to use the domain name or one that is similar in connection with a genuine offering of goods or services;
- b) been commonly known by the name or legitimately connected with a mark which is identical or similar to the domain name;
- c) made legitimate non-commercial or fair use of the domain

name.

The Expert can understand why the Complainant is unhappy about the registration of <fivealive.co.uk> by the Respondent. It encapsulates an important brand and trade mark in which it clearly has rights. However, a Complainant must also show, on the balance of probabilities, that the registration was abusive.

The fact that a domain name incorporates a trade mark, even if that means that the two are identical, does not automatically mean that there has been an Abusive Registration. There are several examples of trade mark owners failing to secure transfers of domain names incorporating their marks. Thus, whatever analysis might be propounded in terms of intellectual property law, the Complainant must still satisfy the requirements of the Policy.

The Complainant says, in summary, that the Respondent knew of the FIVE ALIVE brand and registered the Domain Name to take unfair advantage of its rights or his actions have been unfairly detrimental to such rights (and has also provided false contact details to Nominet). The Complainant also complains that the Respondent has done nothing with the Domain Name – no goods are sold on any website linked to the Domain Name and it is not used in connection with a ‘parking site’. From this, the Complainant concludes that there is only one inference to draw - that the Domain Name was registered without any legitimate purpose with the intention of diverting Internet users from the Complainant, unfairly disrupting its business and to block registration of a mark in which the Complainant has rights. In terms of the drawing of inferences, this strikes the Expert as a fairly big leap, particularly when a perfectly plausible explanation for registration has been advanced by the Respondent. Moreover, if the Respondent had set out to take advantage of or cause detriment to the Complainant’s rights, disrupt its business etc, the Expert would have expected the Respondent to have made a better job of it. The Respondent however has done nothing with the Domain Name.

This brings the discussion on to the Complainant’s argument that the Respondent’s registration was primarily to block registration by the Complainant. The Complainant suggests, rightly, that a mere passive holding of a domain name can amount to an Abusive Registration. But unlike many cases where this is alleged (where there appears to be no legitimate explanation for registration) the Respondent has advanced what on the face of it appears a perfectly proper motive for registration, namely his involvement with the music artist, MC Five

Alive.

Of this, the Complainant says that if promotion of MC Five Alive was the Respondent's only purpose behind registration, the more obvious choice of domain name would have been something like <mcfivealive.co.uk>. The Complainant goes on to conclude that by not registering what, to its mind, was a more appropriate domain name, the Respondent must have been intending to capitalise on the Complainant's goodwill in the FIVE ALIVE brand and to generate additional traffic to its website (by diverting consumers away from the Complainant).

The Expert considers the conclusions the Complainant draws from the Respondent's choice of Domain Name to be unwarranted.

Finally, the Complainant relies on incorrect registration details having been provided. The Respondent has provided an explanation. People often use trading names in their business that may not be formally registered in phone books and the like. The Panel does not consider that the Respondent's conduct supports a finding of Abusive Registration.

Conclusion

At the heart of the Policy is unfair behaviour in the sense that for a registration to be considered 'abusive' there should be something morally reprehensible in the Respondent's behaviour. Thus it is perfectly possible for a Respondent to make fair use of a domain name that incorporates a Complainant's trade mark and which also, for that matter, causes confusion.

What the Complainant speculates was the intention behind the Respondent's registration may, if proven, amount to unfair behaviour, but it is pure speculation, unsupported by any evidence showing that the Respondent was motivated by the intention so alleged. Instead, there has been advanced what appears to be a perfectly plausible and legitimate explanation for the Respondent's registration, supported by some evidence. The Complainant bears the burden of proof on a balance of probabilities. Does the Expert therefore consider it more probable than not that the Respondent has taken unfair advantage of the Complainant's rights or acted in a way that has been unfairly detrimental to them, such as to constitute an Abusive Registration? In

the Expert's view there is no reason to disbelieve the Respondent (or, given the burden of proof on the Complainant, resolve any doubt against the Respondent) and in these circumstances, the Expert does not find the registration to be abusive.

7. Decision

The Expert finds that the Complainant has rights in a name or mark that is identical to the Domain Name but is not satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that no action be taken in respect of the Complaint

Signed Jon Lang

Dated 08 June 2010