

Starbucks Corporation

- v -

James Leadbitter

Nominet UK Dispute Resolution Service

DRS 02087

Decision of Independent Expert

1. **Parties**

Complainant: Starbucks Corporation
Address: 2401 Utah Avenue South
Seattle
Postcode: 98134
Country: USA

Respondent: Mr. James Leadbitter
Address: 26 Commercial Street
Artsadmin, Toynbee Studio
London
Postcode: E1 6LS
Country: United Kingdom

2. **Domain Name**

<starbuckscoffee.co.uk>
("the disputed Domain Name")

3. **Procedural Background:**

The Complaint was lodged with Nominet UK ("Nominet") on September 28, 2004 and confirmed by hard copy on September 29, 2004. Nominet validated the Complaint and notified the Respondent of the Complaint on October 4, 2004, giving him 15 working days within which to lodge a Response. Nominet agreed to amend the Response date to October 27, 2004 and on the same day a Response was lodged with Nominet by hard copy and it was forwarded to the Complainant. The reply date was also amended by Nominet, to November 8, 2004, and on the same day a Reply to the Response was received from the Complainant by e-mail and by hard copy and a copy was sent to the Respondent

Nominet initiated its Informal Mediation procedure, but it would seem that an acceptable resolution through mediation was not achieved and the parties were informed of this on November 30, 2004. On December 6, 2004 the Complainant paid to Nominet the appropriate fee for a Decision by an Expert pursuant to paragraph 6 of Nominet's Dispute Resolution Service Policy ("the Policy").

On December 6, 2003 the undersigned, Mr. David H Tatham ("the Expert"), confirmed to Nominet that he knew of no reason why he could not properly accept the invitation to act as an expert in this case and further confirmed 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. He was subsequently selected by Nominet as the Expert for this case on December 9, 2004.

4. **Outstanding Formal/Procedural Issues (if any)**

There are no outstanding formal or procedural issues but, for the record, the Expert raises no issues in connection with Nominet's unilateral decision to extend its own time limits for filing the Response and the Reply thereto.

5. **The Facts**

The Complainant

According to a Schedule which was attached to the Complaint, the Complainant is the registered proprietor of a considerable number of trade marks which comprise the word STARBUCKS and/or the words STARBUCKS COFFEE (sometimes with a design) for a variety of goods and services. Also attached were copies of several of the Complainant's registration certificates for its UK and Community Trade Marks all of which pre-date the registration of the disputed Domain Name. In particular the Complainant draws attention to its registered Community trade No. 564427 mark consisting solely of the words STARBUCKS COFFEE.

The Complainant has also registered a very large number of domain names which include the words STARBUCKS or STARBUCKS COFFEE in many different countries both as generic top-level domains and as country domains. A list of these was also attached to the Complaint.

The Complainant began trading in the US in 1971, selling coffee and related food and drinks products through an expanding network of retail outlets. Its STARBUCKS products are also available through a number of other trade channels. For example, from 1995, United Airlines has served STARBUCKS coffee on all its flights and in 1994 hotels now within the Starwood Group began to serve STARBUCKS coffee. The Complainant opened its first overseas

locations in Tokyo and Singapore in 1996. It now sells coffee and related food and drink products in 35 countries and operates in over 8000 retail outlets around the world. It estimates that over 10 million customers visit its stores each week. As a result, the mark STARBUCKS is exceptionally well known internationally. The Complainant also annexed a copy of its 2003 Annual Report from which it can be ascertained that the Complainant's net revenues for the 3 financial years from 2001-2003 rose from \$2.6 billion to \$4.3 billion.

The Complainant advertises STARBUCKS products through media including newspapers, billboards and the internet. STARBUCKS products are distributed through retail outlets, speciality sales, mail order, on-line sales, licensed airport stores and through joint ventures. All of these products and distribution channels across the world have contributed to the establishment of the Complainant's global reputation for coffee and related products and merchandise. The Complainant has been awarded over thirty different awards and accolades relating to its brand, reputation and corporate giving activities, and it listed 13 such awards in the Complaint. Apparently it continues to receive more of such awards each year.

The Respondent

The Respondent chose not to supply any facts or information about himself, and his only response is referred to below.

6. The Parties' Contentions

The Complainant's Contentions

Trade Mark Rights

The Complainant contends that its UK and Community trade mark registrations are enforceable legal rights, falling within the definition of "Rights" under the Policy, which pre-date the date of registration of the disputed Domain Name. Also that it is well established that the first and second level suffixes in a domain name should be ignored for the purposes of assessing whether it is identical or similar to the Complainant's trade mark. Accordingly the disputed Domain Name should be regarded as:

- a) identical to the Complainant's registered trade mark STARBUCKS COFFEE and
- b) identical or at the very least similar to the Complainant's registered trade marks STARBUCKS and its common law rights in this mark.

The Disputed Domain Name

The results of a WHOIS search, a copy of which was annexed to the Complaint, carried out by the Complainant on 2 September 2004 reveal that the disputed Domain Name was registered by the Respondent on 11 May 2004. The Complainant became aware of this registration in about July 2004.

The disputed Domain Name resolves to a website <www.starbuckscoffee.co.uk>, extracts of which were attached to the Complaint. The website reproduces the Complainant's registered trade mark device and shows the Complainant's logo with the words "Starbucks Coffee" changing to read "Fuck Off". These two images then appear alternately on the homepage of the website. The homepage indicates that the website itself is authorised by the Complainant, stating: "On behalf of the starbucks coffee corporation...". The website states that there is a "Product Recall - Starbucks Cup Fault" and claims to identify a "Consumer Warning - Starbucks Cup Recall". Additionally, it refers to the Complainant's "faulty paper cups" in the opening paragraph. The website then proceeds to encourage the Complainant's customers or members of the public to deface the Complainant's registered logo on the Complainant's paper cups, and return these to the Complainant's outlets. Furthermore, the website also provides links to web pages of www.google.com, which direct the reader to additional websites which criticise the Complainant and its business activities. The website to which the disputed Domain Name resolves does not provide any contact details for the Registrant, other than an email address (howard@starbuckscoffee.co.uk).

The Respondent

The Complainant made enquiries of Nominet on 3 September 2004 in order to obtain a postal address for the Respondent, but understands that Nominet is unwilling to provide this information at this stage, on the basis that the Registrant is an individual. Consequently the Complainant has not entered into any correspondence with the Respondent to date.

Abusive Registration

The Complainant contends that the disputed Domain Name is identical to the Complainant's trade mark STARBUCKS COFFEE, and that the Respondent is using it without the Complainant's authorisation. The Complainant further contends that if the Respondent were to allege that his use of the Domain Name was fair, under paragraph 4(b) of the Policy (which the Complainant denies), the burden will shift to him to show that the disputed Domain Name is not an Abusive Registration.

The Complainant submits that in any event the use of the disputed Domain Name is not fair or within paragraph 4(b) of the Policy and that it is an Abusive Registration, for the following reasons:

- a) the website to which the disputed Domain Name resolves infringes the Complainant's copyright in its device logo;
- b) by defacing the Complainant's logo, the Respondent has and continues to make derogatory use of the Complainant's copyright work;
- c) by referring to a "Product Recall - Starbucks Cup Fault" and "Consumer Warning - Starbucks Cup Recall", the Respondent has and continues to deceive

the public into falsely believing that the Complainant's cups are faulty and are being recalled;

d) the Respondent has and continues to tarnish the Complainant's registered device mark, by altering the mark to read "Fuck Off";

e) the Respondent has and continues to tarnish, dilute, damage or be otherwise detrimental to the Complainant's trade marks STARBUCKS, STARBUCK COFFEE and device marks and the Complainant's business, goodwill and reputation;

f) through the website to which the disputed Domain Name resolves, the Respondent has and continues to incite members of the public to deface the property of the Complainant;

g) the Respondent has and continues to impersonate the Complainant by not making it clear in the disputed Domain Name that the site to which it resolves is a criticism site, which is not endorsed by or affiliated to the Complainant. By so doing, the Respondent is illegitimately capitalising on the STARBUCKS name to attract internet traffic to the site;

h) the disclaimer does not clarify that the Respondent is not endorsed by or affiliated to the Complainant;

i) the disputed Domain Name was registered and is used primarily for the purpose of unfairly disrupting the Complainant's business by unfairly diverting users seeking information on the Complainant and its products to a site which is critical of the Complainant to encourage the Complainant's customers to refrain from buying its products;

j) by using the disputed Domain Name in a way which has confused people or businesses in to believing that it is registered to, operated or authorised by, or otherwise connected with the Complainant. The disclaimer used by the Respondent is insufficient to prevent an internet user incorrectly concluding that the site and the disputed Domain Name are somehow endorsed by the Complainant as a forum for criticism or are otherwise connected with the Complainant. (see *Pharmacia AB v Wagstaff* (case no DRS 00048)).

Rights or Legitimate Interest

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the disputed Domain Name because:

a) the Complainant has not authorised, licensed or consented to the Respondent's use of the disputed Domain Name; and

b) the Respondent is not known by the mark STARBUCKS COFFEE or anything similar or derivative thereof.

Conclusion

The Complainant concludes that, for the reasons set out above, the Respondent has registered and used the disputed Domain Name in a manner which takes unfair advantage of and is unfairly detrimental to the Complainant's Rights.

The Response

The Respondent's Response is in the form of a typed and unsigned letter which reads as follows:

Dear Starbucks

We're not so good at writing legal stuff, we tried, but it wasn't happening. So here, we wouldn't want you to feel left out, having paid all that money for a lawyer and all, have some stickers instead. Much more fun!

Best

The Vacuum Cleaner

p.s. the stickers are for personal use only.

Enclosed with this letter were stickers which depict the Complainant's circular green logo but instead of the words STARBUCKS COFFEE there are printed the words FUCK OFF.

The Reply

The Complainant filed a Reply to the Response, of which the following is a summary –

The Complainant notes from the Response, by virtue of it containing a reference to the e-mail address howard@starbuckscoffee.org.uk, that the Respondent has also registered <starbuckscoffee.org.uk> (the "Second Domain Name"). On reviewing this website, the Complainant notes that a further domain name has been registered by the Respondent: <fuckoffstarbucks.co.uk>, (the "Third Domain Name") which is referred to in the disclaimer on the website, a copy of which was annexed to the Complaint. The websites which resolve to the Second and Third Domain Names are identical to the website to which the disputed Domain Name resolves.

In the circumstances, the Complainant submits that the Respondent's registration of the disputed Domain Name is an Abusive Registration on the basis that the Respondent is engaged in a pattern of making Abusive Registrations under paragraph 3(a)(iii) of the Policy.

The Complainant submits that the use of the Second and Third Domain Names is not fair or within paragraph 4(b) of the Policy and that the Second and Third Domain Names are also Abusive Registrations for the reasons set out in the Complaint.

For the reasons set out above, and in addition to the Complainant's submissions in the Complaint, the Complainant submits that the Respondent is engaged in a pattern of making Abusive Registrations.

7. **Discussion and Findings**

General

According to paragraph 2 of the Policy, in order to succeed in a Complaint, the Complainant has to prove to the Expert that –

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

These are the only concerns in a dispute under the Policy, and in connection with whether or not a disputed Domain Name is abusive, it is unnecessary, for example, to prove that a Respondent has no rights or legitimate interest in a domain name, as the Complainant has also attempted to do.

Complainant's Rights

The Complainant has established to the satisfaction of the Expert, that it has substantial rights both by registration and at common law in the trade mark STARBUCKS and, to a lesser degree, to the trade mark STARBUCKS COFFEE, whether with or without a figurative device. The Respondent does not dispute this.

The second of the above marks is identical to the disputed Domain Name because, as the Complainant has pointed out, it is customary in domain name disputes, when making a comparison for similarity, to disregard the suffix '.co.uk' because it has no relevant significance and because it is generic. Bearing this in mind, the Expert is no doubt that the names in which the Complainant has rights are either identical or very similar to the disputed Domain Name, and he is satisfied that the Complainant has established the first leg of paragraph 2 of the Policy.

Abusive Registration

The Complainant considers that the disputed Domain Name is an Abusive Registration.

An 'abusive registration' is defined in paragraph 1 of the Policy as being "*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."

Paragraph 4 of the Policy contains a number of examples of how a Respondent might show that his Domain Name is not an Abusive Registration. For example, according to paragraph 4(b) *"Fair use may include sites operated solely in tribute to or criticism of a person or business, provided that if: (i) the Domain Name (not including the first and second level suffixes) is identical to the name in which the Complainant asserts Rights, without any addition; and (ii) the Respondent is using or intends to use the Domain name for the purpose of a tribute or criticism site without the Complainant's authorisation, then the burden of proof will shift to the Respondent to show that the Domain Name is not an Abusive Registration."*

The Policy has recently been amended and the above wording of paragraph 4(b) of the Policy has been simplified. However the present dispute was filed prior to the coming into force, on October 25, 2004, of Version 2 of the Policy so the former wording still applies, as do any Decisions taken under it.

As a result of paragraph 4(b), before ruling on the question of abusiveness, it is necessary first to consider the question of whether or not the Respondent's website is a legitimate protest site and therefore where the burden of proof lies.

There can be little doubt that the Respondent's website, although written in a jokey manner, is directed against and is hostile to the Complainant. The invitation to the Complainant's customers to deface its cups by changing the words 'STARBUCKS COFFEE' in the Complainant's logo to 'FUCK OFF' is insulting to them, while phrases such as *"the thought of someone getting a fuck off cappuccino is very pleasurable"*, a picture of a "BUSH FUCK OFF" cup outside Buckingham Palace, and indeed the whole concept and tone of the site, are clearly intended to denigrate the Complainant and tarnish its reputation.

The Expert is aware that there is no unanimity among UDRP Panellists over the question of a legitimate right to the freedom of expression on disputed websites. See, for instance, the detailed analysis of this question by a respected and distinguished Panellist (David Bernstein) in the WIPO case D2004-0014 (Howard Jarvis Taxpayers Association v. Paul McCauley). However the Nominet DRS is not the same as the UDRP, which is concerned with top-level domain names, and here in the UK the situation is much clearer. For example, it was said on page 14 of the Decision of the Appeal Panel in Case DRS 00389 (Hanna-Barbera Productions, Inc v. Graeme Hay) in connection with the Domain Name <scoobydoo.co.uk>: *"the Panel is unanimous in the view that the purpose of paragraph 4.b is to dissuade people from taking the name of another without adornment and without permission and with a view to making direct reference to that person whether for tribute or criticism. The clear meaning of the Rule is that such a registration is prima facie abusive, unless the Respondent can show otherwise."*

Likewise, in paragraphs 14-15 of the Decision in Case DRS 00048 (Pharmacia AB v. Steve Wagstaff) in connection with the Domain Name <pharmacia.org.uk> it was said: “14. *The Expert finds that Respondent’s primary purpose in registering the Domain name was to disrupt the Complainant’s business by unfairly diverting users seeking information on the Complainant and its products to his criticism site, thereby taking unfair advantage of the Complainant’s mark.* 15. *The site’s disclaimers and warnings that it is an “independent critique” of Pharmacia and Monsanto are ineffective in undoing the unfair advantage gained by the Respondent in using the Complainant’s mark. In the Expert’s opinion, these disclaimers are also insufficient to prevent an internet user incorrectly concluding, even fleetingly, that the site and the Domain Name are somehow endorsed by these companies as a forum for criticism or otherwise connected with these companies.*”

Decisions by other Experts are not binding, but Appeal Decisions “*will be of persuasive value to Experts in future decisions.*” (paragraph 9(c) of the Policy.

Bearing this in mind, and having studied the website at the disputed Domain name, the Expert has concluded that it is not a protest site as such and the burden of proof therefore falls on the Respondent to prove otherwise. Yet he has done nothing in his defence. He has not prayed in aid Article 4(b), and indeed it can be said that his Response has done nothing to address the issues raised by the Complaint, or the content of the Policy itself. He, or persons acting on his behalf or carrying out his instructions, may find the whole affair amusing, but to plunder the Complainants’ rights in the manner in which he does is clearly unacceptable behaviour.

It is the opinion of the Expert therefore, that the Respondent has not discharged his burden to prove that the website at the disputed Domain Name is not a protest site. Therefore the Complainant’s contentions remain unanswered and, according to the dicta in the Scooby-Doo case referred to above, the disputed Domain Name must therefore be abusive. On this occasion the Expert has decided to follow that Decision.

The Complainant’s contentions that the disputed Domain Name is abusive form a long and impressive list. In the opinion of the Expert not all of them are relevant but they are enough to make the Complainant’s case and, there is nothing to refute any of them.

Paragraph 3 of the Policy sets out further examples of what can be an Abusive registration, and the Complainant has alleged two of them:

3(a) A non-exhaustive list of factors which may be evidence of an Abusive Registration is as follows:

.....

(ii) circumstances indicating that the Respondent is using the Domain Name in a way which has confused people or businesses into believing that the Domain Name is registered to, operated by, or otherwise connected with the Complainant;
(iii) in combination with other circumstances indicating that the Domain Name in dispute is an Abusive Registration, the Complainant can demonstrate that the Respondent is engaged in a pattern of making abusive registrations; or

It is true that the site does include the following ‘disclaimer’:

Starbuckscoffee.co.uk, producthistory.com, re-stock.co.uk, fuckoffstarbucks.co.uk and the vacuumcleaner.co.uk/.org/.tk are all forms of cultural and political criticism and satire. None of these groups, their members, or their associates, intend to harm any person or property with the information contained herein.

By viewing this site, you acknowledge that you are not a law enforcement officer, attorney or prosecutor or other form of, Government and/or Corporate agent intending to use this artistic expression as a means to gather information or evidence for use against any individual, organization of (sic) group associated with starbuckscoffee.co.uk or its affiliated sites.

This site is under constant surveillance, your I.P address is logged with your presence on this site.

This so-called ‘disclaimer’ hardly deserves the name, being qualified and, like some of the images on the site, seems to be intended more as a joke than as a legitimate warning. Furthermore it is not immediately visible to a visitor to the site as it can only be seen if one clicks on the word ‘Disclaimer’. The Expert therefore finds that it is inadequate as a disclaimer and that, because of the misuse of the Complainant’s trade marks on the site, paragraph 3(a)(ii) of the Policy is also proved.

With regard to paragraph 3(a)(iii), the Complainant’s reference in its subsequent Response to the Respondent’s two other domain names which incorporate the Complainant’s trade marks goes some way to proving that the Respondent does make a habit of registering abusive domain names and that he is therefore in breach of this paragraph of the Policy. These two other domain names cannot however form any part of this Decision.

8. Decision

Having weighed all the evidence, the Expert finds that the Complaint as a whole has been proved. Also, that the Complainant does have Rights in the names

STARBUCKS and STARBUCKS COFFEE and that these names are identical or similar to the disputed Domain Name.

The Expert further finds that the disputed Domain Name is an Abusive Registration in the hands of the Respondent.

The Expert therefore directs that the disputed Domain Name <starbuckscoffee.co.uk> be transferred to the Complainant.

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David H Tatham
December 20, 2004