



हरियाणा HARYANA

R 745716

RANJAN NARULA

ARBITRATOR

Appointed by the .In Registry - National Internet Exchange of India

In the matter of:

**McDonald's Corporation**  
2915, Jorie Boulevard  
Oak Brook, Illinois - 60523,  
U.S.A

.....Complainant

**Mr. Timothy**  
126-2125, Itabashi Way,  
Burlington, Ontario,  
L7M0A1,CA  
Email: [timmayeur@gmail.com](mailto:timmayeur@gmail.com)

..... Respondent

Disputed Domain Name: [www.mccafee.in](http://www.mccafee.in)

## AWARD

### **1) The Parties:**

The Complainant in this arbitration proceeding is McDonald's Corporation (incorporated under laws of Delaware) whose address is 2915, Jorie Boulevard, Oak Brook, Illinois, 60523, U.S.A. The Complainant is represented by its authorized representatives S.S, Rana & Co., Advocates of 317, Lawyers Chambers, High Court of Delhi, New Delhi - 110003

The Respondent in this arbitration proceeding is Mr. Timothy of 126-2125, Itabashi Way, Burlington, Ontario, L7M0A1, CA as per the details available in the whois database maintained by National Internet Exchange of India (NIXI).

### **2) The Domain Name, Registrar & Registrant:**

The disputed domain name is www.mccafee.in. The Registrar is Webiq Domains Solutions Pvt. Ltd., Directplex, Next to Andheri subway, Old Nagardar Road, Andheri (E), Mumbai, Maharashtra

The Registrant is Mr. Timothy of 126-2125, Itabashi Way, Burlington, Ontario, L7M0A1, CA

### **3) Procedural History: :**

This arbitration proceeding is in accordance with the .IN Domain Name Dispute Resolution Policy (INDRP), adopted by the National Internet Exchange of India (NIXI). The INDRP Rules of Procedure (the Rules) were approved by NIXI on 28<sup>th</sup> June, 2005 in accordance with the Indian Arbitration and Conciliation Act, 1996. By registering the disputed domain name with the NIXI accredited Registrar, the Respondent agreed to the resolution of the disputes pursuant to the .IN Dispute Resolution Policy and Rules framed thereunder.

As per the information received from NIXI, the history of the proceedings is as follows:

In accordance with the Rules 2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed Ranjan Narula as the Sole Arbitrator for adjudicating upon the dispute in accordance with the Arbitration and Conciliation Act, 1996, and the Rules framed thereunder, .IN Domain Dispute Resolution Policy and the Rules framed thereunder. The Arbitrator submitted the Statement of Acceptance and Declaration of impartiality and independence, as required by NIXI.



- The complaint was produced before the Arbitrator on December 11, 2015, and the notice was issued to the Respondent on December 14, 2015 at his email address with a deadline of 10 days to submit his reply to the arbitration.
- The Arbitrator also directed the Complainant to provide by email copy of complaint and Annexures to the Respondent which was duly complied.
- As the Respondent did not submit any response. Vide email dated December 29, 2015 the Arbitrator granted further opportunity to the Respondent to submit its response on or before January 6, 2016.
- Vide email dated December 31, 2015 NIXI informed that the DTDC courier agency requires the address and contact number of the Respondent to hand over the Complaint along with Annexures to Respondent.
- The Arbitrator vide email dated January 4, 2016 informed the Respondent that as per the attached report by NIXI from the courier agency, it appears the address provided by the Respondent is incomplete. Therefore this report will be treated as deemed service. Furthermore, the Complainant has already provided a soft copy of the Complaint to the Respondent. Also the Respondent vide its email dated 16th December acknowledged the on-going arbitration proceedings and had not requested for any further documents or sought clarification. Thus as per communication dated 29<sup>th</sup> December, 2015 last and final opportunity until **6<sup>th</sup> January, 2016** was granted to Respondent to submit its response.
- No response was filed by the Respondent other than email dated 16<sup>th</sup> December, 2015 that is reproduced below

Hi,

*McDonald's can contact me and work this out civilly if they wish to.*

*The Supreme Court of Canada had ruled that domain names are personal property if holder is from Ontario.*

*From various legal bulletins:*

*"One practical implication of the decision is that it made it possible for domain name owners in Ontario to commence legal proceedings against foreign parties in the Ontario courts without seeking leave of court. Another important take-away is that an Ontario domain name owner can start litigation in Ontario even if administrative proceedings disputing essentially the same issues are pending elsewhere in the world.*



*Both of these findings expand the dispute resolution options available to domain name owners in Ontario. "*

*Best regards,*

*Tim*

The above appears to be a veiled threat to negotiate settlement on terms suitable to the Respondent. I have not been informed of any settlement arrived at between the parties and no formal response has been submitted by the Respondent. In the circumstances the complaint is being decided based on materials submitted by the Complainant and contentions put forth by them.

**Grounds for administrative proceedings:**

- A. The disputed domain name is identical with or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- B. The Respondent has no rights or legitimate interests in respect of the impugned domain name;
- C. The impugned domain name was registered and is being used in bad faith.

**4) Summary of the Complainant's contentions:**

**The Complainant in support of its case has made the following submissions:**

- a) Complainant is a multinational corporation incorporated under laws of Delaware, U.S.A. and has an established business in relation to quick service restaurants, snack shops and cafeterias known as McDonald's, all over the US since 1955 and thereafter in many countries and territories of the world. There are over 35,000 McDonald's restaurants in over 100 countries and territories all over the world including India, serving around 70 million customers daily.
- b) For many years Complainant and its subsidiaries, affiliates, licensees, and franchisees (collectively "McDonald's"), have owned and operated a series of quick service restaurants, snack shops and cafeterias in the United States of America and other countries of the world, which are known as McDonald's.
- c) The Complainant submits that in 1977 Complainant began using family of trade marks that featured the formulation of words by combining the Mc/Mac prefix and suffix with variety of nouns and adjectives, which have become distinctive to Complainant's goods and services. Some of the many Mc/Mac family of trademarks are Mc, McCAFE, McDONALD'S, McSNACK, McTREAT, McHAPPYDAY, McFORTUNE COOKIE, McMUFFIN, McNUGGETS, McCHICKEN, MAC, MAC FRIES, McVEGGIE, McPIZZA, McKIDS, McBURGER, McCRISPY, McBACON, McDONUT, McSALAD, McSHAKE, PIZZA McPUFF, McDELIVERY, McSWIRLS and McFLURRY.



- d) The Complainant further submitted that it is the proprietor of world renowned family of Mc/Mac prefixed/suffixed trademarks. It is pertinent to point out that Mc/Mac is a prominent, significant and distinguishing feature of Complainant's various trademarks, which are registered and being used extensively in many countries of the world including India and are recognized and associated by the public at large with Complainant's services and goods only.
- e) The Complainant is the registered proprietor of various trademarks with prefix/suffix Mc/Mac like Mc, MAC, McCAFE, McDONALD'S, McMASALA, McKIDS, McSALAD SHAKER, McTREAT, McMUFFIN, McNUGGETS, McCRISPY, McCHICKEN, BIG MAC, MAC FRIES, McVEGGIE, McFRIES, MAHARAJAH MAC, McALOO TIKKI BURGER, MCSHAKE, CHICKEN McGRILL, PIZZA McPUFF, McDELIVERY, McSWIRLS, McFLURRY and other family of Mc/Mac trade marks in various classes in India. Most of the families of Mc/Mac trade marks have been used in India since October 13, 1996 and are well known and famous. The Indian Courts have recognized the existence of trans-border reputation and the Trade Marks Act, 1999 provides for protection of well-known and famous trade marks.
- f) McDonald's various trademarks including **McDONALD'S** and family of trade marks with the prefix / suffix **Mc/Mac** are registered and used in more than 100 countries of the world including but not limited to Austria, Canada, Germany, Macedonia, Spain, Switzerland, United Kingdom, China, Hong Kong, Indonesia, Pakistan, Singapore, United Arab Emirates, United States etc. to name a few.
- g) Some of the numerous registrations obtained by McDonald's in various countries are relevant in establishing its right as a proprietor of family of **Me/Mac** trademarks as mentioned in the preceding paragraphs. It also shows the worldwide commercial interest in the family of **Mc/Mac** trademarks. The said trade marks are registered in various classes and used in several countries of the world.
- h) The Complainant created and launched a coffee-house-style food and drink chain under the name **McCAFE** in 1993, in Melbourne, Australia. The chain was started by McDonald's Licensee Ann Brown and reflects a consumer trend towards espresso coffees. The Complainant under its McCAFE brand offers several gourmet coffee choices such as cappuccinos, lattes, and iced and hot mochas. They are brewed with rich, bold espresso and made with real steamed milk, chocolate and whipped cream as well as shakes, smoothies and ice blended beverages. Consequently, the Complainant expanded their McCAFE concept to other parts of the world including India and currently McDonald's offers its McCafe branded products all over the world.
- i) The Complainant's **McCAFE** brand and **McCAFE** branded products marked its entry in the Indian market on October 14, 2013. Currently **McCAFE** branded products are available in various western and southern cities such as Mumbai, Ahmedabad, Nashik, Aurangabad, Pune and Bengaluru.
- j) The Complainant submits that McDonald's registered the domain name [mcdonalds.com](http://mcdonalds.com) on July 12, 1994, and [mcdonaldsindia.com](http://mcdonaldsindia.com) on June 01, 1998. In addition to the [.com](http://.com) domain names the McDonald's also owns many other country specific domain names such as [mcdonalds.in](http://mcdonalds.in) and [mcdonalds.com.au](http://mcdonalds.com.au). Further, McDonald's has a number of domain names registered with the prefix Mc such as [mcd.com](http://mcd.com); [mcdexchange.com](http://mcdexchange.com); [Mcbaby.com](http://Mcbaby.com); [mccalifornia.com](http://mccalifornia.com); [Mccash.com](http://Mccash.com)



- k) McDonald's has an interactive website [www.mcdonalds.com](http://www.mcdonalds.com), in addition to other country specific, websites, which are accessible to persons in any location of the world including in India that offers access to Internet. On the aforesaid website, prominent reference/inclusion has been made to the McCAFE brand and McCAFE branded products. McDonald's websites are viewed by millions of consumers each month. Many active customer accounts and customers from many countries have made purchases through the above mentioned websites.
- l) The Complainant's reputation and goodwill in the trade marks McDONALD'S, McCAFE, Mc, MAC and its family of trademarks with the prefix/suffix Mc / Mac have not come from sales alone. More than a million U.S. dollars are spent each year for promoting Complainant's trade marks in countries around the world by means of national and trans-national advertising. Moreover, the Complainant has spent substantial amount in the advertisement and promotion of its McCAFE branded products all over the world.
- m) In order to promote a global reputation, the Complainant has taken numerous steps through the years. The Complainant has used promotional efforts at sponsoring sports and othdr events in many countries, which are picked up on television and seen by viewers all over the world, such as the Olympic Games, the Soccer World Cup cricket, tennis tournaments and other competitions. The Complainant became an Official Sponsor of the Olympic Games in 1976 and has a long-standing commitment to the Olympic Movement. The London 2012 Olympic Games marked the Complainant's seventh Olympic Games as a Worldwide Partner and eighth as the Official Restaurant of the Olympic Games. The Complainant was also the Worldwide Partner for the Winter Olympics, 2014 held at Sochi, Russia and one of the main sponsors of the recently concluded soccer world cup in Brazil
- n) According to the Landor Image Power Survey, 1990, the Complainant is the world's eighth most powerful and second best known brand in the world. As per the 1990 edition of Interbrand, a leading International branding consultancy company, the Complainant was the third most well known brand name in the world, next only to Coca Cola and Kellogg's. The 1996 results of Interbrand named the Complainant as the world's greatest brand and the same was also reported in a news article 'McDonald's comes a topper in brands' published in the Economic Times dated November 20, 1996. Interbrand, in its Annual Survey for several consecutive years (2001-2012) ranked Complainant in top 10 amongst the Top 100-Brands of the world.
- o) The Complainant further submitted that Millward Brown Optimor ("MBO") is a leading market research and brand valuation and management company. MBO publishes an annual assessment of the 100 most valuable brands in the world entitled "BrandZ - Top 100 Brand Rankings". In 2006, McDonald's was ranked 11<sup>th</sup> in the world.
- p) The Complainant has been conferred with many Awards and recognitions. Details of some of the Awards are mentioned below :

TITLE	AWARD	YEAR
Most Innovative Food Companies	Fast Company	2011
4 <sup>th</sup> Most Valuable Global Brand	BrandZ	2012



7 <sup>th</sup> World's Most Powerful Brand	Forbes	2012
7th Best Global Brand	Interbrand	2012
Most Admired Company in the World	Fortune	2012
Ranked 1 in the Food Services category	Fortune	2012
Greenest Companies in America		2010
Featured in Dow Jones Sustainability Index	Dow Jones Sustainability Index	2005
Food Service Retailer of the year	Star Retailer Awards	2012/2011
Value for Money' brand	Pitch Magazine	2010
The most trusted family restaurant brand in the country	Reader's Digest	2009, 2010 & 2011

- q) The Complainant's **McCAFE** brand and McCAFE branded products have also attracted substantial media attention in **India** and have been widely covered by the print media. The Complainant's **McCAFE** brand has also been advertised in a wide variety of print and electronic media in other parts of the world, including newspapers, magazines, radio and satellite television channels as well as on the Internet.
- r) Because of the extent and the length of time, the family of Mc/Mac trademarks including the trade mark McCAFE have become famous and are associated and related with the Complainant alone. The Complainant's trade mark McCAFE is well known and famous, not only in Australia and the USA but also in many countries of the world including in India. By virtue of such continuous and extensive use, worldwide registrations and the high quality of goods and services provided under the mark McCAFE, the same has become distinctive and associated by the public and the trade with the Complainant's goods and services alone and its family of Mc/MAC trade marks. The Complainant's trade mark McCAFE has acquired substantial reputation and goodwill and is well known and famous in India.
- s) It has been brought to the notice of the Complainant that the Respondent has registered the top level domain name mccaife.in on January 11, 2014. There is no corresponding website and the message displayed on the landing page states that the domain is listed for sale by its owner.
- t) The domain name mccaife.in registered by the Respondent/Registrant is identical with and confusingly similar to the name and trade mark McCAFE, in which the Complainant has statutory and common law rights in India and abroad. The main

objective of registering the domain name mccafe.in by the Respondent/Registrant is to mislead the general public and trade as well as prevent the Complainant from using it or reflecting the mark in a corresponding domain name. The Respondent's domain name incorporates in it entirely the reputed trade mark McCAFE of the Complainant, in which the Complainant has statutory rights.

- u) The Respondent/Registrant has no right or legitimate interest in the impugned domain name. The Respondent has registered the domain mccafe.in without the Complainant's permission or authorization with the sole intention to have web users land on their website. The Respondent is not making a legitimate or fair use of the said domain name for offering goods or services and has rather placed the said domain for sale to extract unfair profits from such sale proceeds. The Respondent (as an individual, business or other organization) has not been commonly known by the name or mark McCAFE.
- v) The Respondent/ Registrant's domain name has been registered and is being used in bad faith. The malicious intention of the Respondent is evident from the blatant misappropriation of the Complainant's trade mark McCAFE.
- w) Infact, the Respondent has made an offer to the DNS Manager of the Complainant Company to sell the domains mccafe.in and mccafe.co.uk for USD 7000. The registration of the domain name mccafe.in incorporating the name and registered trade mark of the Complainant is malafide and for unlawful gains.

#### **5) Respondent**

The Respondent has not filed any formal response to the Complaint other than an email dated 16<sup>th</sup> December, 2015 as mentioned earlier. In the absence of any formal response to the allegations and submissions of the complainant and considering several opportunities granted, the complaint had to be decided based on submissions on record and analyzing whether the Complainant has satisfied the conditions laid down in paragraph 3 of the policy.

#### **6) Discussion and Findings:**

The submissions and documents provided by Complainant in support of use and registration of the mark McCAFE leads to the conclusion that the Complainant has superior and prior rights in the mark containing the word 'McCAFE' particularly when used for quick service restaurants. Thus it can be said a) the web users are likely to associate the word 'McCAFE' with the goods and services of the Complainant b) the web users would reasonably expect to find Complainant's products and services at the [www.mccafe.in](http://www.mccafe.in) and c) they may believe it is an official website of the Complainant and the services being offered/ advertised are associated or licensed by the Complainant.





Based on the elaborate submission and documents, I'm satisfied that the Complainant has established the three conditions as per paragraph 4 of the policy which is listed below. Further the Respondent has not contested the claims therefore deemed to have admitted the contentions of the Complainant.

- (1) the Respondent's domain name is identical or confusingly similar to the trademark in which he has rights;

It has been established by the Complainant that it has statutory rights and common law rights on account of prior and longstanding use of the mark 'McCAFE, McDonald's and several other Mc formative mark. The Complainant has in support submitted substantial documents. The disputed domain name contains the Complainant's 'McCAFE' mark in its entirety.

- (2) the Respondent has no rights or legitimate interests in respect of the domain name;

The Complainant has not authorised the Respondent to register or use the 'McCAFE' domain name. Further, the Respondent has never used the disputed domain name for legitimate business services and their purpose of registration appears to be purely for monetary gain.

The Respondent has not rebutted the contentions of the Complainant and has not produced any documents or submissions to show his interest in protecting his own rights and interest in the domain name. Further, the Respondent has not used the domain name or a name corresponding to the disputed domain name in connection with a bonafide offer of goods or services.

The above leads to the conclusion that Respondent has no rights or legitimate interest in respect of the disputed domain name 'www.mccafe.in'.

- (3) the domain name has been registered in bad faith.

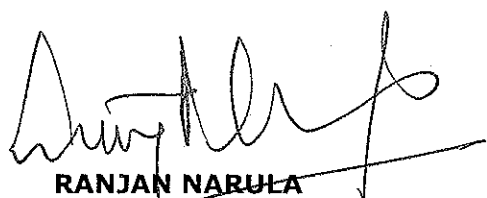
It may be mentioned that since the Respondent did not file any response and rebut the contentions of the Complainant, it is deemed to have admitted the contentions contained in the Complaint. In particular, the Respondent has not rebutted the contentions of the complainant that it had knowledge of the complainant's marks McCAFE and McDonald's.

Based on the documents filed by the Complainant, it can be concluded that adoption by the Respondent of the domain name/mark 'www.mccafe.in' shows 'opportunistic bad faith'.

**7. Decision:**

In view of the foregoing, I am convinced that the Respondent's registration and use of the domain name www.mccafee.in' is in bad faith. The Respondent has no rights or legitimate interests in respect of the domain name. In addition, the Respondent by providing incorrect address at the time of registration, which is evident from non-delivery of courier containing the Complaint as per the report provided by NIXI dated December 31<sup>st</sup>, 2015 from DTDC courier has violated clause 3 (a) of .IN Domain Dispute Resolution policy.

In accordance with the Policy and Rules, the arbitrator directs that the disputed domain name 'www.mccafee.in' be transferred to the Complainant.



**RANJAN NARULA  
SOLE ARBITRATOR  
NIXI  
INDIA**

**January 19, 2016**