

## **ADMINISTRATIVE PANEL DECISION**

Coca-Cola Femsa, S.A.B. DE C.V. v. Super Privacy Service LTD c/o Dynadot / DNS Admin, WEB10 SOLUTIONS INC.

Case No. D2022-2695

### **1. The Parties**

The Complainant is Coca-Cola Femsa, S.A.B. DE C.V., Mexico, represented by Chevez Ruiz Zamarripa, Mexico.

The Respondent is Super Privacy Service LTD c/o Dynadot / DNS Admin, WEB10 SOLUTIONS INC., Seychelles, represented by Zak Muscovitch, Muscovitch Law P.C., Canada.

### **2. The Domain Name and Registrar**

The disputed domain name <kof.com> is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 23, 2022. On July 25, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on July 28, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on August 2, 2022. The Center received email communications from a third party on July 28 and August 4, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on August 12, 2022. In accordance with the Rules, paragraph 5, the due date for Response was September 1, 2022. The Response was filed with the Center August 24,

2022. The Complainant submitted a supplemental filing on August 31, 2022. The Respondent submitted a supplemental filing on September 20, 2022.

The Center appointed Edoardo Fano, Mauricio Jalife Daher, and Adam Taylor as panelists in this matter on October 4, 2022. The Panel finds that it was properly constituted. Each member of the Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

The Panel considers admissible both the Complainant's and the Respondent's supplemental filings.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

#### **4. Factual Background**

The Complainant is Coca-Cola Femsa, S.A.B. DE C.V., a Mexican company operating as the largest franchise bottler of Coca-Cola products and owning several trademark registrations, corresponding to its stock ticker symbol (which it has used since 1993), for KOF and KOF.COM, in Mexico and in other Latin America countries, including:

- Mexican Trademark No. 2289699 for KOF, registered on August 23, 2021;
- Costa Rican Trademark No. 301787 for KOF, registered on December 22, 2021;
- Uruguayan Trademark No. 525659 for KOF, registered on September 13, 2022;
- Mexican Trademark No. 2289706 for KOF.COM, registered on August 23, 2021;
- Costa Rican Trademark No.301750 for KOF.COM, registered on December 20, 2021;
- Uruguayan Trademark No. 525660 for KOF.COM, registered on September 13, 2022.

The Complainant provided evidence in support of the above.

The Respondent, WEB10 SOLUTIONS INC., describes itself as a company in the business of investing in descriptive, generic and acronym domain names.

According to the Whois records, the disputed domain name was registered on July 25, 2003. The Respondent has provided evidence that it (or its related entities) has owned the disputed domain name since April 20, 2013. When the Complaint was filed it resolved to a "coming soon" landing page in which a "kof.com" logo was displayed as an acronym standing for "Kosher Office Foods". The page also stated "Welcome to KOF.COM. Kosher Office Foods website is comming [sic] soon". The disputed domain name is currently inactive.

On May 5, 2021, the Complainant, without identifying itself, contacted the Respondent in order to negotiate the purchase of the disputed domain name: the Respondent replied that it would not consider offers below USD 85,000 and the Complainant considered it too high.

In August 2021 the Complainant, through a broker and again without identifying itself, offered to purchase the disputed domain name for USD 324,350; the Respondent accepted but the Complainant subsequently resiled from it.

## 5. Parties' Contentions

### A. Complainant

The Complainant states that the disputed domain name is identical to its trademarks KOF and KOF.COM, as the disputed domain name wholly incorporates the Complainant's trademarks. The stock ticker "kof" was issued to the Complainant in 1993 and the Complainant states that from that year it has been used as a trademark, providing several Mexican newspapers articles and financial press in Spanish as evidence in support of this statement.

Moreover, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademarks within the disputed domain name, it is not commonly known by the disputed domain name and it is not making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The Complainant submits that the "coming soon" activity displayed at the disputed domain name landing page as "Kosher Office Foods" is a non-existing business and it cannot therefore be considered as a *bona fide* offering of goods or services. If the Respondent wanted to show a *bona fide* offering based on its alleged role as a domain name investor, the landing page should have clearly stated that the disputed domain name was offered for sale.

The Complainant submits that the Respondent has registered and is using the disputed domain name in bad faith, namely with the only purpose of transferring it for a valuable consideration in excess of the registration fees that the Complainant would have had to pay to secure its registration if it were available: in May 2021, in the first approach the Complainant made in order to try and buy the disputed domain name, the Respondent replied that offers lower than USD 85,000 would not be considered, while in the second approach in August 2021 the Respondent requested USD 324,350 for the transfer of the disputed domain name.

Finally, whether or not the Respondent be considered as Super Privacy Service LTD c/o Dynadot, individually or jointly with WEB10 SOLUTIONS INC., the Complainant contends that the Respondent has engaged in a pattern of registering domain names corresponding to famous trademarks in order to resell them to the relevant trademark owners.

### B. Respondent

The Respondent states that it purchased the disputed domain name from the prior owner on April 20, 2013, solely due to its inherent value and attraction as a valuable three-letter ".com" domain name, and that it had never heard of the Complainant or its stock ticker symbol before the registration of the disputed domain name, not being in the habit of reading, or able to read, the Mexican financial press in Spanish.

The Respondent informs the Panel that, around the time it registered the disputed domain name, it registered several other comparable three-letter ".com" domain names, indicating an independent interest in acquiring three-letter domain names rather than targeting the Complainant.

The Respondent acknowledges that the disputed domain name is identical to the Complainant's trademarks, but observes that these were applied for and registered by the Complainant after the Respondent registered the disputed domain name and after the Complainant offered to purchase it. There is no evidence of the Complainant's prior use of KOF as a trademark in relation of goods and/or services, as common law trademark rights, but only as stock ticker symbol to identify the Complainant's corporation.

The Respondent does not dispute the validity of the Complainant's trademarks for the purpose of paragraph 4(a)(i) of the Policy but notes that there is widespread third-party use and common use of the term "kof" that is wholly unrelated to the Complainant, facts which are relevant to the discussions of the Respondent's rights and legitimate interests in the disputed domain name and its lack of bad faith registration and use.

The Respondent contends that it has rights and a legitimate interest in the disputed domain name because the registration of three-letter “.com” and non-infringing domain names, such as the disputed domain name, *ipso facto* establishes the Respondent’s legitimate interest, provided the disputed domain name was not registered with a trademark in mind.

The Respondent has provided sworn testimony that it had no knowledge of the Complainant or its trademarks and did not register the disputed domain name to target the Complainant.

The Respondent purchased the disputed domain name, which is not associated with a single entity, from its prior owner, a circumstance which would indicate that the disputed domain name was free for use and registration.

The fact that the Respondent responded to the Complainant’s inquiry to purchase the disputed domain name is not improper and this does not make its use of the disputed domain name illegitimate. On the contrary, a business based on reselling domain names satisfies the legitimate interest prong of the Policy, provided there is no evidence that a trademark was targeted by the registrant.

The Respondent finally claims that there is no evidence of bad faith registration or use because the primary purpose of the Respondent when it registered the disputed domain name was not to sell it to the Complainant or to a competitor of the Complainant, as the exceptional value of the disputed domain name is wholly independent of the Complainant and its purported trademark rights.

The Respondent states that the Complainant has not been able to demonstrate any trademark rights which pre-exist the disputed domain name registration, or that its trademark rights were so well-known that the Respondent knew or should have known of the Complainant, and therefore there is no evidence of targeting whatsoever.

The Respondent says that the Complainant is wrong to claim that responding to an inquiry to purchase a domain name is evidence of the Respondent’s bad faith, and the Complainant’s unsolicited offer to purchase the disputed domain name is itself an acknowledgement of the Respondent’s legitimate interest in the disputed domain name and good faith use of it. The Respondent informs the Panel that the second anonymous offer in relation to the disputed domain name, consisting of an amount of USD 324,350, was made by the Complainant through a broker, and not by the Respondent as falsely stated in the Complaint, and the Respondent accepted it, although the Complainant then resiled from it in favor of the present UDRP.

As regards the Complainant asserting that the Respondent has engaged in a pattern of registering domain names corresponding to famous trademarks in order to resell them to the relevant trademark owners, the Respondent states that the Complainant appears to confuse the Respondent with the Registrar’s privacy service, namely Dynadot’s Super Privacy Service LTD.

The Respondent requests that the Panel issue a finding of Reverse Domain Name Hijacking since the Complainant brought this Complaint without any genuine evidence of targeting or awareness of the Complainant at the time that the disputed domain name was registered. It also states that the Complainant expressly and falsely claimed that the Respondent requested a much larger amount of money than the first time for the transfer of the disputed domain name to the Complainant, *i.e.*, USD 324,350, and for this reason no agreement was reached between the parties. Lastly, the Complainant’s registration as a trademark not just of KOF but also of KOF.COM, should in the opinion of the Respondent, be considered as an integral part of Complainant’s use of the UDRP as “Plan B”.

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the

Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

#### **A. Identical or Confusingly Similar**

The Panel finds that the Complainant is the owner of the trademarks KOF and KOF.COM and that the disputed domain name is identical to them.

It is also well accepted that a generic Top-Level-Domain (“gTLD”), in this case “.com”, is typically ignored when assessing the confusing similarity between a trademark and a domain name. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.11.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is identical to the Complainant’s trademarks, pursuant to the Policy, paragraph 4(a)(i).

#### **B. Rights or Legitimate Interests**

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

“(i) before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or

(ii) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent’s rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially difficult, since proving a negative circumstance is always more complicated than establishing a positive one. As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not commonly known by the disputed domain name and is not making a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name, but instead in the “coming soon” landing page corresponding to disputed domain name and displayed as “Kosher Office Foods” is a non-existing business that cannot be considered as a *bona fide* offering of goods or services.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain name.

As mentioned above, the Respondent claims to have registered the disputed domain name for its inherent value as a valuable three-letter “.com” domain name and as part of its business of investing in such domain names.

As discussed further under the third element below, the Panel considers that the Respondent selected and acquired the disputed domain name because of its size and inherent value, rather than because it corresponds to the Complainant’s trademarks, and at the same time the Panel considers it unlikely that the Respondent was aware of the Complainant’s trademark at the time it selected and acquired the disputed domain name.

As stated in section 2.1 of the [WIPO Overview 3.0](#), “[...] Over the course of many UDRP cases, panels have acknowledged further grounds which, while not codified in the UDRP as such, would establish respondent rights or legitimate interests in a domain name. For example, generally speaking, panels have accepted that aggregating and holding domain names (usually for resale) consisting of acronyms, dictionary words, or common phrases can be *bona fide* and is not per se illegitimate under the UDRP”.

In addition, section 2.10.2 of the [WIPO Overview 3.0](#) states that: “For a respondent to have rights or legitimate interests in a domain name comprising an acronym, the respondent’s evidence supporting its explanation for its registration (and any use) of the domain name should indicate a credible and legitimate intent which does not capitalize on the reputation and goodwill inherent in the complainant’s mark”.

The Panel does not consider that the right to register such acronyms is unlimited since, by knowing of a complainant’s trademark, and registering a domain name that copies the trademark, or by using it to target the trademark owner, the registrant of that domain name would put at risk its claim to have acquired rights or legitimate interests in the domain name. However, in the present case, the Panel deems that the above factors are absent as there is no evidence suggesting that the Respondent has targeted the Complainant.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has not been satisfied.

### **C. Registered and Used in Bad Faith**

Although the Panel’s finding under the above section 6.B would be sufficient to enable a decision to be reached in relation to this Complaint, the Panel also finds that there is no evidence that the disputed domain name has been registered and used in bad faith.

Paragraph 4(b) of the Policy provides that “for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or
- (ii) that [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or
- (iii) that [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location".

As indicated above, according to the current Whois records, the disputed domain name was registered on July 25, 2003, but the Respondent confirmed that it acquired the disputed domain name from a prior owner on April 20, 2013.

According to section 3.9 of the [WIPO Overview 3.0](#), "the transfer of a domain name registration from a third party to the respondent is not a renewal and the date on which the current registrant acquired the domain name is the date a panel will consider in assessing bad faith".

The Complainant claims that its trademarks are widely known and that the Respondent, who trades on domain names, registered the disputed domain name to take advantage of their reputation. On the other hand, the Respondent states that it was unaware of the Complainant's trademarks, and that it could not have had knowledge of them since there is no evidence of the Complainant's use of KOF as a trademark in relation of goods and/or services, *i.e.*, as common law trademark rights, prior to the disputed domain name registration, but only as stock ticker symbol to identify the Complainant's corporation.

The members of the Panel concur that the Complainant has not provided adequate evidence in order to demonstrate that its stock ticker symbol KOF was used and known as a trademark before the Complainant acquired its registered trademarks, and even the declaration of first use in the Mexican trademark registration is not supported by evidence.

The Panel find that, since – based on the record – the Complainant's stock ticker symbol KOF, before being registered as a trademark, appears to have been used essentially to identify the Complainant's corporation in a very limited, specialist context, the Respondent, which does not operate in the same sector, could hardly have become aware of the Complainant's stock ticker symbol KOF at the time of the acquisition of the disputed domain name, even if use of the ticker were to be treated as generating unregistered trade mark rights (as to which the Panel expresses no view).

As stated in section 3.2.2 of the [WIPO Overview 3.0](#) "[...] On the other hand, where the complainant's mark is not inherently distinctive and it also corresponds to a dictionary term or is otherwise inherently attractive as a domain name (*e.g.*, it is a short combination of letters), if a respondent can credibly show that the complainant's mark has a limited reputation and is not known or accessible in the respondent's location, panels may be reluctant to infer that a respondent knew or should have known that its registration would be identical or confusingly similar to the complainant's mark."

Therefore, the Panel finds that the Respondent did not register the disputed domain name to target the Complainant and its trademarks. In view of the above, also the request for a consideration exceeding the out-of-pocket costs sent in reply to the Complainant's inquiry is not sufficient, in this case, to demonstrate the Respondent's bad faith registration and use of the disputed domain name.

In view of the foregoing, the Panel finds that the Complainant has failed to demonstrate that the Respondent registered and used the disputed domain name in bad faith.

#### **D. Reverse Domain Name Hijacking**

Paragraph 15(e) of the UDRP Rules provides that, if "after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding."

The Rules define Reverse Domain Name Hijacking as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name.”

The Panel also bears in mind that the Complainant in this case is represented by Counsel and, therefore, it should be held to a higher standard (see section 4.16 of the [WIPO Overview 3.0](#)).

As stated in section 4.16 of the [WIPO Overview 3.0](#) “[...] Reasons articulated by panels for finding RDNH include: (i) facts which demonstrate that the complainant knew it could not succeed as to any of the required three elements – such as the complainant’s lack of relevant trademark rights, clear knowledge of respondent rights or legitimate interests, or a clear knowledge of a lack of respondent bad faith (see generally section 3.8) such as registration of the disputed domain name well before the complainant acquired trademark rights, [...] (iv) the provision of false evidence, or otherwise attempting to mislead the panel, (v) the provision of intentionally incomplete material evidence – often clarified by the respondent, [...] (vii) filing the complaint after an unsuccessful attempt to acquire the disputed domain name from the respondent without a plausible legal basis [...]”.

As detailed in the above analysis of the Second and Third Element, the Panel finds that the Complainant and its Counsel have contravened the above RDNH bases: lack of properly-evidenced relevant trademark rights as of the date when the Respondent acquired the disputed domain name; knowledge of a lack of the Respondent’s bad faith directed towards the Complainant, making the assertion that the Respondent must have been targeting the Complainant highly unlikely; attempt to mislead the Panel by stating that “the Respondent requested a much larger amount of money than the first time for the transfer of the Disputed Domain Name to the profit of the Complainant (*i.e.*, \$324,350 USD). Given the aforesaid, no agreement was reached between the parties”, whereas it has become clear (a) that the Respondent did not request this amount, as it was an unsolicited proposal by the Complainant, and (b) that the Respondent did actually agree to sell at that price. Finally, as it has been stated in many previous decisions, a complainant is at risk of a RDNH declaration when its attempt to try and buy a domain name is not successful, and it tries to obtain it by using, or rather “abusing”, the UDRP.

## 7. Decision

For the foregoing reasons, the Complaint is denied and the Panel declares that the Complaint was brought in bad faith in an attempt to Reverse Domain Name Hijacking.

*/Edoardo Fano/*

**Edoardo Fano**  
Presiding Panelist

*/Mauricio Jalife Daher/*

**Mauricio Jalife Daher**  
Panelist

*/Adam Taylor/*

**Adam Taylor**  
Panelist

Date: October 18, 2022