Decision for dispute CAC-UDRP-106256

Case number	CAC-UDRP-106256
Time of filing	2024-02-23 09:11:38
Domain names	mentionmemarketing.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Mention Me Ltd

Complainant representative

Organization	Stobbs IP

Respondent

Name	Abigail Dodd

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the Disputed Domain Name.

IDENTIFICATION OF RIGHTS

The Complainant is the registered proprietor of various MENTION ME trade marks including:

Trade Mark	Device	Territory	Registration No.	Reg. Date.	Class
MENTION ME [figurative]		United States of America	6181999	27 October 2020	35
MENTION ME [figurative]		United Kingdom	UK00917440884	20 February 2018	35
MENTION ME [figurative]		EU	017440884	20 February 2018	35

MENTION ME [figurative]		WIPO	1491703	25 June 2019	35

(the “Registered Marks”)

The terms covered by the Complainant’s Registered Marks include, but are not limited to, coverage for ‘referral marketing; advertising and marketing services provided via communications channels; loyalty, incentive and bonus program services; affiliate marketing; direct marketing; development of promotional campaigns; development of marketing strategies and concepts; developing promotional campaigns for business; marketing; promotional marketing; targeted marketing; marketing consultancy; marketing assistance; marketing analysis; marketing advice.’ (Class 35, UK00917440884).

The Complainant has an active online presence including owning the domain name mention-me.com, which is used for the main operating website at (https://www.mention-me.com/) (the “Official Website”), with the website being live since at least as early as May 2, 2013.

FACTUAL BACKGROUND

The Complainant is an award-winning referral marketing platform empowering brands to harness the exponential power of fans through referral.

Since 2013, the Complainant’s approach has delivered more than 6 million referrals totalling $1.8 billion in revenue for 500 brands around the globe.

The Complainant operates globally, with office locations in the United Kingdom and the United States of America. Since 2018, the Complainant has raised over $32 million in funding, and as of 2021 employs around 100 people.

In 2022, the Complainant earned various awards demonstrating widespread recognition and trust in the MENTION ME brand and service offerings, including:

- Two G2 Trust Badges, which require at least 50 peer-reviewed and published reviews;
- Highly Commended Tech Company of the Year at the British Data Awards;
- Best Use of Data at the DigiDay Awards.

The Complainant is also active on social media and has generated a significant level of endorsement as shown below:

Platform	URL	Followers
Facebook	https://www.facebook.com/MentionMeShare	~3,600
Twitter	https://twitter.com/mentionmeshare	~4,000
LinkedIn	https://www.linkedin.com/company/mention-me/	~12,000
Instagram	https://www.instagram.com/mentionme_share	~250

The Disputed Domain Name was registered in 2023 and points to competing marketing services.

PARTIES CONTENTIONS

COMPLAINANT:

1. The Disputed Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights;

(Policy, Paragraph 4(a)(i); Rules, Paragraphs 3(b)(viii), (b)(ix)(1))

2. The Complainant submits the following substantive grounds:

Rights in 'MENTION ME':

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2.1 The Complainant relies on the general consensus principle held by prior panelists, that, provided a Complainant has a trade mark (in any jurisdiction) at the time of commencing proceedings, they will satisfy the threshold of holding 'rights', for the purpose of the Policy, Paragraph 4(a)(i).

2.2 As illustrated in paragraph 1.7. of this Complaint, the Complainant has registered trade marks for MENTION ME. The Complainant's Registered Marks pre-date the registration of the Disputed Domain Name.

2.3 The dominant textual element of a figurative trade mark should be taken into account under the test for confusing similarity under paragraph 4(a)(i) of Policy. In Commune de Tignes v. Laurence et Sandrine Raymond Case No. D2010-0076 the panel stated:

"According to prior panel decisions, **the dominant textual element of a trademark shall be taken into account to determine whether the domain name is confusingly similar with the trademark** (e.g. Sweeps Vacuum & Repair Center, Inc. v. Nett Corp., WIPO Case No. D2001-0031, and RuggedCom, Inc. v. James Krachenfels, WIPO Case No. D2009-0130).

The dominate textual element of the Complainant's Registered Marks is the words 'Mention Me'. Therefore, the Complainant submits the Disputed Domain Name is confusingly similar to the Registered Marks.

2.4 The above analysis was affirmed in Mention Me Limited v. Brendan Hernou Case No. CAC-UDRP-105599 in relation to the domain name <mention.me>, which was ordered by sole panelist Assen Alexiev to be transferred to the Complainant pursuant the Policy. Panelist Alexiev stated:

"As discussed in section 1.10 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), panel assessment of identity or confusing similarity involves comparing the (alpha-numeric) domain name and the textual components of the relevant mark. To the extent that design (or figurative/stylized) elements would be incapable of representation in domain names, these elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element. On this basis, trademark registrations with design elements would prima facie satisfy the requirement that the complainant show "rights in a mark" for further assessment as to confusing similarity. Therefore, the Panel accepts that the Complainant has shown rights in the MENTION ME trademark for the purposes of the Policy, and will consider the word elements of this trademark (the words "mention me") for the purposes of its comparison with the disputed domain name.". (emphasis added)

The Complainant submits it has established rights in the brand MENTION ME under the Policy.

Comparison with the Disputed Domain Name:

2.5 Turning to the second limb of Policy, Paragraph 4(a)(i), the Complainant submits that the Disputed Domain Name is identical or confusingly similar to that of the MENTION ME trade mark and brand. The Complainant invites the Panel to disregard the top-level domain ".com" as merely a necessary technical component.

2.6 The Disputed Domain Name includes the Complainant's Registered Marks in its entirety, along with the non-distinctive term

“marketing”. Inclusion of the non-distinctive term “marketing” does nothing to alter the overall impression in the eyes of the average internet user. In fact, Complainant’s Registered Marks includes protection for various “marketing” related services therefore, the non-distinctive term is merely descriptive of the Complainant’s goods and services.

2.7 Indeed, prior Panels have consistently held that the addition of other terms do not avoid a finding of confusing similarity, see Harley-Davidson Motor Company Inc. v Duc Tran The Deltavn, Case No. CAC-UDRP-105387 [<harleydavidsonclothes.com>], [<apparel-harleydavidson.com>]:

“The Panel further notes that the addition of the descriptive terms “Clothes”, or "Apparel" which relate directly to one of the Complainant’s field of business (merchandise), does not prevent a finding of confusing similarity.”.

- As noted above, the Complainant submits that the non-distinctive term “marketing” in fact reinforces the connection to the Complainant. In the decision of Harley-Davidson Motor Company Inc. v. Vin Nguyen (Vin Pre) CAC Case No. CAC-UDRP-105614 [**<com>**], the Panel stated:

“The fact that the term “shirt” is added does not eliminate the similarity between Complainant’s trademarks and the disputed domain name, and in fact may even enhance the confusing similarity between the Complainant’s trademarks and the disputed domain name in view of the Complainant having registered trademarks for, and selling shirts under the HARLEY-DAVIDSON trademarks.” (emphasis added).

2.9 The Disputed Domain Name resolves to an active website (the “Infringing Website”) where the Respondent advertises and offers for sale competing marketing services under the brand PARKER SEO. Therefore, the Complainant submits that the Respondent is clearly targeting the Complainant’s brands and any contention otherwise is entirely implausible.

2.10 Based on the above, the Complainant submits that the Disputed Domain Name is identical or at least confusingly similar to the Complainant’s established trade marks.

Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;

(Policy, Paragraph 4(a)(ii); Rules, Paragraph 3(b)(ix)(2))

3. The Complainant submits that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name. Under Policy, Paragraph 4(c), the Complainant acknowledges that a Respondent may demonstrate a right or legitimate interest in the domain name if it can be established that:

“The Respondent’s use of the Disputed Domain Name or a name corresponding to the domain name is in connection with a bona fide offering of goods or services;

The Respondent has been commonly known by the Disputed Domain Name, even if they have acquired no trade mark or service mark rights; or

The Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name, without intent or commercial gain to misleadingly divert consumers.”

3.1 The Complainant proves that each of the above-mentioned defences do not apply. As per the Policy, the burden of proof shifts to the Respondent to put forward evidence that they do have rights or legitimate interests in the Disputed Domain Name.

3.2 The Disputed Domain Name was registered on 16 October 2023, by this point, the Complainant already had rights (both registered and unregistered) in MENTION ME.

No bona fide offering of goods or services

3.3 The Respondent used the Disputed Domain Name to point to the Infringing Website, which offers competing marketing services.

3.4 The Infringing Website features PARKER SEO branding throughout, including the figurative design in the Infringing Website header, within the main title on the homepage, and throughout the Infringing Website’s copy.

3.5 It is clear that the Respondent does not have a legitimate interest in the Disputed Domain Name. The Respondent’s registration and use of the Disputed Domain Name is merely to free-ride off the reputation and goodwill of the Complainant’s Registered Marks in order to divert traffic from internet users seeking the Complainant’s Official Website to the Respondent’s own Infringing Website to offer competing marketing services.

3.5 Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, **impersonating/passing off**, or other types of fraud) can never confer rights or legitimate interests on a respondent. (WIPO Overview 3.0, paragraph 2.13.1) (Emphasis added).

3.6 Consequently, the Respondent cannot claim a defence under the Policy, Paragraph 4(c)(i).

Commonly known by the Disputed Domain Name, even if they have acquired no trade mark or service mark rights

3.7 Upon information and belief, the Complainant submits that the Respondent has never legitimately been known by the name MENTION ME, at any point in time. As stated by panelist, R. Eric Gaum in the case of Vestel Elektronik Sanayi ve Ticaret AS v. Kahveci. WIPO UDRP Case No. D2000-1244[**<vestel.com>**]: 'merely registering the domain name is not sufficient to establish rights or legitimate interests for purposes of paragraph 4(a)(ii) of the Policy'. This factor leads the Complainant to conclude that the only reason why Respondent registered the Disputed Domain Name was to take advantage of the Complainant's goodwill and valuable reputation.

Non-commercial or fair use of the Disputed Domain Name

3.8 Nothing about the Disputed Domain Name suggests that the Respondent is making a legitimate non-commercial or fair use of the Disputed Domain Name. As mentioned above, the Disputed Domain Name is being used to impersonate/pass off as the Complainant with clear commercial activity. Therefore, the Respondent's use cannot come within Policy, Paragraph 4(c)(iii).

3.9 In light of the above submissions, the Respondent does not satisfy any of the above-mentioned grounds under Policy, Paragraph 4(c).

The Disputed Domain Name was registered and is being used in bad faith.

(Policy, paragraphs 4(a)(iii), 4(b); Rules, paragraph 3(b)(ix)(3))

4. The Complainant submits that the Disputed Domain Name has been registered and used in bad faith in accordance with Policy, Paragraph 4(a)(iii).

4.1 The Complainant reiterates the comments made above that the trade mark for MENTION ME pre-dates the registration of the Disputed Domain Name and MENTION ME has a wide reputation. Furthermore, the Respondent is purportedly a Search Engine Optimisation expert, as such it can be presumed the Respondent would have conducted at least a search engine search on any potential domain name prior to purchasing the domain name. A Google search for "Mention Me Marketing" returns search results which relate solely and exclusively to the Complainant. Therefore, Complainant submits that the Respondent had knowledge of MENTION ME at the time of registering the Disputed Domain Name and that the Disputed Domain Name is registered with the sole purpose of targeting the MENTION ME brand.

4.2 The Registered Marks are registered in International Class 35 for, inter alia, advertising and marketing services. The Disputed Domain Name resolves to the Infringing Website offering internet marketing services. Such services are identical to those for which the Registered Marks are afforded protection, and to those which are advertised at the Official Website. The average internet user for both services is likely to be identical – namely a business seeking online marketing support. The Complainant submits that the use of the Registered Marks within the Disputed Domain Name is, therefore, highly likely to cause such internet users to be confused into thinking that the services offered by the Disputed Domain Name come from the same undertaking as the Complainant.

4.3 The Respondent is exploiting and free riding on the coat tails of the Complainant's well-known Registered Marks in a deliberate attempt to trade upon their reputation without incurring their own advertising or brand expenditure. The Respondent's registration and use of the Disputed Domain Name amounts to a misrepresentation which is likely to lead the public to believe that the goods and services offered at the Infringing Website are those of the Complainant, or at the very least that the services offered from the Infringing Website are associated with those of the Complainant. As a result of that misrepresentation, the Complainant is likely to suffer damage in the form of loss of sales, damage to reputation, and loss of exclusivity in the Registered Marks.

Bad Faith: Policy, Paragraph 4(b)(iv)

4.4 The Complainant submits that the Respondent has registered the Disputed Domain Name in bad faith by intentionally attempting to attract, for commercial gain, Internet users to the Infringing Website, by creating a likelihood of confusion with the Complainant's MENTION ME trade mark as to the source, sponsorship, affiliation, or endorsement of the Infringing Website under the Policy, Paragraph 4(b)(iv).

4.5 The Complainant submits that the Respondent registered the Disputed Domain Name in order to drive Internet traffic to the Infringing Website in order to impersonate/pass off as the Complainant. Using a trade mark to divert traffic to a Respondent's own website is consistently held by panelists as amounting to bad faith registration and use under the Policy, Paragraph 4(b)(iv). An example of such findings can be found in the decision between Booking.com BV v. Chen Guo Long. WIPO UDRP Case No. D2017-0311 [**<bookingcom.xyz>**] where panelist, Matthew Kennedy, held that:

'The Respondent uses the disputed domain name, which is confusingly similar to the Complainant's BOOKING.COM trademark, in connection with a video-on-demand website displaying links to many other websites. **The disputed domain name operates by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of the Respondent's website. This use is intentional.** It is more likely than not that the website operates for the commercial gain of the Respondent or the operators of the linked websites, or both. Therefore, the facts satisfy the requirements of paragraph 4(b)(iv) of the Policy.' (Emphasis added)

4.6 The Complainant submits in view of the recognition of the Complainant's trade marks and brand, the Respondent's actual knowledge of the Complainant's brand and business when registering the Disputed Domain Name is unequivocal. Actual knowledge of a complainant's rights in a mark prior to registering a identical or confusingly similar domain name evinces bad faith under the Policy, paragraph 4(a)(iii).Any suggestion otherwise is entirely implausible.

4.7 The Complainant further submits that the Respondent disrupted the Complainant's business by diverting potential customers to the Infringing Website, which purported to offer competing services. Using an identical or confusingly similar domain name in a manner disruptive of a Complainant's business by trading upon the goodwill of a Complainant for the commercial gain evinces bad faith under the Policy, paragraphs 4(b)(iii) and (v).

4.8 Based on the submissions above, the Complainant maintains that the Disputed Domain Name was registered and used in bad faith and all elements of the Policy are satisfied.

RESPONDENT: NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

The Disputed Domain Name registered in 2023 is confusingly similar to the distinctive word element of the Complainant's trade mark MENTION ME (registered as set out above since 2018) containing it in its entirety and adding only the generic word 'marketing' and the gTLD .com which do not prevent said confusing similarity.

The Respondent is not authorised by the Complainant or commonly known by the Disputed Domain Name.

The Domain Name has been used for competing services to the Complainant which is not a bona fide offering of goods or services or a legitimate non commercial or fair use.

The Respondent has not answered this Complaint or rebutted the prima facie case evidenced by the Complainant herein.

The Respondent is an expert in Internet marketing services and so the Panel is persuaded that she is highly likely to have been aware of the Complainant at the time of registration of the Disputed Domain Name. The Panel is entitled to draw adverse inferences from the failure of the Respondent to answer this Complaint.

Accordingly the Respondent has registered and used the Disputed Domain Name in bad faith by intentionally attempting to attract, for commercial gain, Internet users to the Respondent's Website, by creating a likelihood of confusion with the Complainant's MENTION ME trade mark as to the source, sponsorship, affiliation, or endorsement of the Infringing Website under the Policy, Paragraph 4(b)(iv), thereby disrupting the business of a competitor under 4 (b)(iii).

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **mentionmemarketing.com**: Transferred

PANELLISTS

Name	**Dawn Osborne**

DATE OF PANEL DECISION 2024-03-18

Publish the Decision