Decision for dispute CAC-UDRP-106566

Case number	CAC-UDRP-106566
Time of filing	2024-05-27 14:17:09
Domain names	mothercarecode.com

Case administrator

Name	Olga Slanařová (Case admin)

Complainant

Organization	Mothercare UK Limited
Organization	Mothercare Global Brand Limited

Complainant representative

Organization	STOBBS (IP) LTD

Respondent

Organization	Swaqny

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 Complainants own trade mark registrations worldwide for "MOTHERCARE" (the **MOTHERCARE Mark**"), as well as "M" and "m" (the "**M Marks**"), for a range of goods and services. For example:

Region	Reg. No.	Reg. Date	Trade Mark	Class(es)
UK	UK00000855429	1963-10-18	MOTHERCARE	20
UK	UK00000878023	1965-04-08		25

UK	UK00002485942	2008-11-07		3, 5, 8, 9-12, 16, 18, 20, 21, 24, 25, 27, 28, 35
UK	UK00003067655	2014-12-19	MOTHERCARE	3, 5, 8, 9-12, 14, 16, 18, 20, 21, 24-29, 30, 35, 36, 39, 41

FACTUAL BACKGROUND

The Complainants in this administrative proceeding, Mothercare Global Brand Limited ("**MGBL**") and Mothercare UK Limited ("**MUL**"), are companies incorporated in the United Kingdom ("**UK**") on 4 October 2019 under company number 12243944 and on 8 May 1954 under company number 00533087, respectively (collectively "**the Complainants**"). MGBL is the parent company of MUL and the Complainants are the legal owners of the MOTHERCARE brand, which is a global brand for parents and young children. MUL has been trading under the MOTHERCARE brand as a specialist retailer for 70 years, designing, sourcing and supplying products to meet the need of parents and young children.

The first retail store for the MOTHERCARE brand was opened in 1961 in Surrey, UK, initially focussing on pushchairs, nursery furniture and maternity clothing. Subsequently, the range was expanded to include clothing for children up to the age of five and later up to the age of eight. The MOTHERCARE brand now offers a wide range of clothing and essential products through a network of global franchise partners, such as the famous national retailer "Boots" in the UK (https://www.boots.com/mothercare), which operates approximately 700 dedicated MOTHERCARE stores in approximately 36 countries around the world. Key products designed, produced and supplied by the Complainants under the MOTHERCARE brand include, but are not limited to, baby and children's clothing; prams and pushchairs; car seats; and bedding.

The Complainants operate a website for the MOTHERCARE brand, which is available at https://www.mothercareplc.com/ . The Complainants also extensively promote and advertise the MOTHERCARE brand and trade marks on major social media platforms, receiving a significant level of endorsement from Internet users globally:

- Instagram (https://www.instagram.com/mothercaremena/) 540K followers.
- Facebook (https://www.facebook.com/mothercareuk?locale=en_GB) 397K followers.
- X (formerly Twitter) (https://twitter.com/mothercareuk?lang=en) 78.5K followers.
- YouTube (https://www.youtube.com/c/mothercare) 54.7K subscribers.
- Pinterest (https://www.pinterest.co.uk/mothercareuk/) 15.7K followers.

Additionally, the Complainants and their MOTHERCARE brand have featured in articles from online newspapers and journals that are read by Internet users worldwide, such as The Financial Times and the BBC News, as well those popular in the Middle East (which appears to be the target audience of the website at the Disputed Domain Name), such as Gulf Times, Arab News, Saudi Gazette, Tehran Times, and Qatar Tribune.

PARTIES CONTENTIONS

The Complainants contend that the requirements of the Policy have been met and that the Disputed Domain Name should be transferred to them.

No administratively compliant Response has been filed.

The Complainants' contentions in brief.

A.The Disputed Domain Name is confusingly similar to a trademark in which the Complainants have rights;

(ii) Confusing similarity

For the reasons below, the Complainants submit that the Disputed Domain Name is confusingly similar to the MOTHERCARE Mark in which they have rights.

The Disputed Domain Name that is the subject of this administrative proceeding is <mothercarecode.com> (the "Disputed Domain Name"). The Disputed Domain Name incorporates the MOTHERCARE Mark in its entirety, followed by the descriptive and generic term "code" and the gTLD ".com". Incorporation of the MOTHERCARE Mark is in and of itself evidence of confusing similarity (see Nokia Group v. Mr. Giannattasio Mario, WIPO Case No. D2002-0782).

The Complainants and/or their authorised distributors/retailers use discount codes in the course of business and in connection with

goods sold under the MOTHERCARE Mark. The addition of the term “code” (i.e., an abbreviation of “coupon code” or “discount code”) to the Disputed Domain Name would undoubtedly confuse the Complainants' customers, and Internet users generally, as to the identity of the entity/individual behind the Disputed Domain Name and naturally cause them to associate it with the Complainants.

Based on the above, the Complainants maintain that the first element under paragraph 4(a) of the Policy is established.

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

For the reasons below, the Complainants submit that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name.

The Respondent is not affiliated or associated with the Complainants in any way. Further, the Complainants have not authorised or granted license to the Respondent to use the MOTHERCARE Mark or to register a domain name containing that trade mark (or any other trade marks owned by them).

The Disputed Domain Name resolves to a live website purporting to offer discount codes for MOTHERCARE products (the “Infringing Website”).

Previous UDRP panels have found that use of a domain name to host a websites purporting to offer discount codes, especially under trade marks for well-known brands, precludes a respondent from claiming any legitimate interest in the domain name in the Disputed Domain Name (see Hertz System Inc. v. Home, Khuong Mai Ngoc, WIPO Case No. D2012-1946 and The Chase Manhattan Corporation v. John Whitely, WIPO Case No. D2000-0346).

(i) No bona fide offering of goods or services

The Complainants submit that the Respondent appropriated the MOTHERCARE Mark in its entirety and has used the Disputed Domain Name to divert Internet users to the Infringing Website through the creation of Internet user confusion. Internet visitors arriving at the Infringing Website are likely to believe they have arrived at the Complainants’ website, or a website that is affiliated with, sponsored, or endorsed by the Complainants. The Respondent cannot credibly claim to be making a bona fide offering of goods or services when the Disputed Domain Name has been registered and used to falsely suggest affiliation with the Complainants (see Thinx, Inc. v. Weldon Love, WIPO Case No. D2019-0527).

(ii) Respondent is not commonly known by the Disputed Domain Name

The Complainants submit that, upon information and belief, the Respondent has never been commonly known as “MOTHERCARE”, “MOTHERCARECODE” or any similar variation thereof.

(iii) No legitimate non-commercial or fair use

The Complainants refer the Panel to their submissions in this complaint regarding Internet user confusion. The Complainants further submit the below evidence in support of their claim that the Disputed Domain Name falsely suggests affiliation with the Complainants:

- the Disputed Domain Name is confusingly similar to the MOTHERCARE Mark;
- it is not clear to Internet users visiting the Infringing Website that it is not operated/authorised by, or affiliated with, the Complainants;
- there is a notable absence of any disclaimer on the Infringing Website indicating that it is not connected with the Complainants and/or MOTHERCARE brand;
- the Infringing Website prominently displays the MOTHERCARE Mark and labels itself “Mothercare discount code”, “the Mothercare online store”, “Mothercare website” and “Mothercare discount coupons website”; and
- the Infringing Website deceptively offers discount codes purported to valid / authorised by the Complainants, when this is not true.

In consideration of the above, Internet users have and will undoubtedly assume some association/affiliation between the Disputed Domain Name/Infringing Website and the MOTHERCARE Mark/Complainants.

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

Based on the foregoing and following, the Complainants submit that the Disputed Domain Name was registered and is being used in bad faith.

(i) Bad faith registration

The Complainants submit that the Respondent could not have registered the Disputed Domain Name without being aware of the Complainant, the MOTHERCARE Mark and brand. As set out earlier in this complaint, the Complainants have been promoting, producing, and distributing products under the MOTHERCARE Mark since the 1960s. The Disputed Domain Name was not registered until 16 May 2019, by which point in time the Complainant already had a global reputation in the MOTHERCARE Mark. Further, the Infringing Website repeatedly makes direct reference to the Complainants and features both the MOTHERCARE Mark and the M Marks.

Therefore, the Complainants submit that the Respondent has registered the Disputed Domain Name in bad faith.

(ii) Bad faith use

The Complainants submit that the Respondent quickly commenced use of the Disputed Domain Name to operate the Infringing Website (i.e., a misleading website featuring the MOTHERCARE Mark and the M Marks) to deceptively offer discount codes purported to be valid/authorised by the Complainants. Screenshots from a Wayback tool show that since 15 November 2019, and continuously since then, the content at the Infringing Website has contained reference to the Complainants and displayed the MOTHERCARE Mark and/or the M Marks. It is clear that the Infringing Website was deliberately designed to appear as if it is being operated by the Complainants or an entity affiliated with/endorsed by the Complainants. At present, the Infringing Website prominently displays the MOTHERCARE Mark and the M Marks. Additionally, the Infringing Website is repeatedly labelled as "Mothercare discount code", "the Mothercare online store", "Mothercare website" and "Mothercare discount coupons website" in several locations, including on the homepage. This is supplemented with many false statements and misrepresentations, such as "Here you will find Mothercare discount coupons" and "our website […] also displays Mothercare discount codes that are easy to use in purchase vouchers with a 100% effective link through which you get an immediate discount". Given that the codes are not authorised by the Complainants, they would not be effective on the websites of the Complainant's authorised retailers.

The above-mentioned use of the Disputed Domain Name evidences an intention on the part of the Respondent to create a misleading impression of association between Disputed Domain Name and the MOTHERCARE Mark, and the discount codes purportedly offered therein, in a way that has caused, or has the potential to cause, disruption to the Complainants' business (see Great Clips, Inc. v. Kissi Kissi / Kartik Saini, Lootkaro, WIPO Case No. D2023-1886).

Therefore, the Complainants submit that the Respondent has used and continues to use the Disputed Domain Name in bad faith.

RIGHTS

The Complainants have, 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 Complainants have rights (within the meaning of paragraph 4(a)(i) of the Policy).

This is a case of adding a generic term - in this case "code" - to an established trademark and in respect of the well-established practice that the specific top level of a domain name such as ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar, it is found that the disputed domain name is confusingly similar to Complainant´s established trademark MOTHERCARE.

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainants have, 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 Complainants have, 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).

Given the circumstances of the case, including the provided information of the use and reputation of the Complainant's trademark MOTHERCARE and the distinctive nature of this mark, it is inconceivable to the Panel in the current circumstances that the Respondent registered the Disputed Domain Name without prior knowledge of the Complainant and the Complainant's mark.

The Panel therefore finds that the Disputed Domain Name was registered in bad faith.

The Disputed Domain Name currently resolves to a misleading and deceptive website clearly showing the registered trademark MOTHERCARE of the Complainants as well as the M device mark registered by the Complainants both on the website as in the favicon on the tab of the website in the web browser. The Panel finds that apart from the actual trademark infringing use on the website of the disputed domain name by the Respondent that would not be illegitimate, such as being a passing off, an infringement of consumer protection legislation, or an infringement of the Complainant's rights under trademark law. The Panel finds that the fact that the Complainants trademark is registered in the United Kingdom supports the Panels view that the trademark MOTHERCARE is neither descriptive nor non-distinctive, even though it contains the words MOTHER and CARE the trademark MOTHERCARE in itself is a distinctive trademark. Adding the generic term "code" to the trademark does not alter the Panels view. The Panel finds that the registration of a domain name that is identical or confusingly similar to by an unaffiliated entity is sufficient to create a presumption of bad faith, a presumption that is further strengthened in this case by the actual infringing and deceptive use of the Complainants' trademarks on the website to which the Disputed Domain Name resolves.

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 three essential issues under the paragraph 4(a) of the Policy are whether:

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 with respect to the disputed domain name; and

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

1. The Panel reviewed carefully all documents provided by the Complainants. The Respondent did not provide the Panel with any documents or statements. The Panel also visited all available websites and public information concerning the Disputed Domain Name, namely the WHOIS databases.

2. The UDRP Rules clearly say in its Article 3 that any person or entity may initiate an administrative proceeding by submitting a complaint in accordance with the Policy and these Rules.

3. The Panel therefore came to the following conclusions:

a) The Complainants state and prove that the Disputed Domain Name is confusingly similar to its trademarks and its domain names. Indeed, the trademark is partially incorporated in the disputed domain name.

The Disputed Domain Name is therefore deemed confusingly similar.

b) The Respondent is not generally known by the Disputed Domain Name and have not acquired any trademark or service mark rights in the name or mark, nor is there any authorization for the Respondent by the Complainants to use or register the Disputed Domain Name. The Panel therefore finds that the Respondent does not have rights or legitimate interest with respect to the Disputed Domain Name.

c) It is clear that the Complainants' trademarks and website(s) were used by the Complainants long time before the Disputed Domain Name was registered.

The Disputed Domain Name resolves to a website with deceptive content infringing on the Complainants' trademarks. It is concluded that the registration of a domain name that is identical or confusingly similar to an established trademark by an unaffiliated entity, in particular in view of the actual use of the Disputed Domain Name in this case, is sufficient to create a presumption of bad faith.

The Panel therefore finds that the Disputed Domain Name has been registered and is being used in bad faith.

For the reasons stated above, it is the decision of this Panel that the Complainants have satisfied all three elements of paragraph 4(a) of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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

1. **mothercarecode.com**: Transferred

PANELLISTS

Name	**Lars Karnoe**

DATE OF PANEL DECISION 2024-07-04

Publish the Decision