

# ADMINISTRATIVE PANEL DECISION

LEADR Case No: auDRP\_10\_01

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**Domain Name:** mothercare.com.au  
**Name of Complainant:** Mothercare plc, together with its wholly owned subsidiary Mothercare UK Limited  
**Name of Respondent:** Arthur Jason Bobrow  
**Provider:** LEADR  
**Panellist:** John A. McGruther  
**Date:** 18 February 2010

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## 1. THE PARTIES

- 1.1 The Complainant is Mothercare plc, Mothercare UK Limited ("Complainant" – "M").
- 1.2 The Respondent is Arthur Jason Bobrow ("Respondent" – "B").

## 2. THE DOMAIN NAME REGISTRAR AND PROVIDER

- 2.1 The Domain Name at issue is **mothercare.com.au** ('the Disputed Domain Name').
- 2.2 The Trade Marks, names or service marks upon which the Complaint is based are those Trade Marks referred to and listed in detail in Annexure "A" to the Complaint (and as later referred to in this Decision)
- 2.3 The provider in relation to this proceeding is LEADR ('Provider').

## 3. PRELIMINARY MATTERS

- 3.1 Schedule A of the *au Dispute Resolution Policy* ("auDRP") ("Policy") applies to disputes which meet the requirements set out in Paragraph 4a of Schedule A of the auDRP. This subparagraph 4a requires that any party holding a domain name licence "...submit to a mandatory



*administrative proceeding in the event that a third party (a “complainant”) asserts to the applicable Provider, in compliance with the Rules of Procedure that:*

- (i) [their] domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and*
- (ii) [they] have no rights or legitimate interests in respect of the domain name; and*
- (iii) [their] domain name has been registered or subsequently used in bad faith.*

*In an administrative proceeding, the complainant bears the onus of proof.”*

#### **4. PROCEDURAL HISTORY**

4.1 The procedural history in this matter is set out in Annexure ‘A’ to this determination. Additionally:

- (a) On 11 February 2010 LEADR emailed the Respondent noting that any response to the Complaint was due on 8 February 2010, that none had been received by LEADR and that the Complaint and various Respondent emails (including the Respondent emails to LEADR of 3 February 2010) will now be forwarded to the Panellist.
- (b) The Procedural History at paragraphs 8 and 9 of Annexure “A” is clarified by reference to the Respondent 3 February 2010 email (referred to in that paragraph 8) contained certain Respondent brief commentary on the Complaint which, in the circumstance of no other Respondent response, including within Policy procedural timeframes, date due as notified being 8 February 2010, is here regarded as the Respondent’s submission to the Complaint accordingly (“Respondent submission” or “B Submission”). For completeness, the full text of that submission is quoted within this Decision elsewhere. There were other subsequent communications after the due date of 8 February 2010 volunteered from both parties to the Provider. These are mentioned briefly later.

(c) On 11 February 2010 LEADR further emailed the Respondent inquiring:

*"The email you send on the 3<sup>rd</sup> February 2010 will be included in the submissions. Just to clarify, is this your official response?"*

The Respondent replied by email on 15 February 2010:

*"That response should be okay as I am not sure what more to write even after reading the guidelines"*

Thus, the Respondent email of 3 February 2010 referred to above is regarded as and has been taken into consideration effectively as the Complaint response submission of the Respondent.

(d) LEADR sent by email on 12 February 2010 a copy of such Respondent's submissions to the Complainant's representatives who contended for a reserved right to make any Complainant response to it.

(e) The Complainant's representatives (Gadens) sent an email to the Provider on 15 February 2010 which was onsent by the Provider to the Panel and received by the Panel on 17 February 2010. This appears to be pursuant to the right the Complainant reserved referred to at (d) above. It is noted that the Complainant's representatives concurrently sent an email copy of it to the Respondent. The Complainant urged that this communication is made and is for requisite consideration pursuant to the Policy Supplemental Rules including Rules 8 and 10 thereof. The Panel concurs with that submission noting that, although received after the designated notice period for submissions by 8 February 2010, it was to be a Reply to the Respondent's submissions which in turn had been received by the Provider out of time on 12 February 2010 and only then able to be remitted to the Complainant.

4.2 LEADR has appointed this Panellist as the sole Panellist in the matter. The Panellist has had no prior knowledge of or association with either party and has no conflict of interest. The Panel received the Complaint delegation from the Provider on Monday, 15 February 2010.

4.3 All procedural requirements appear to have been satisfied. The Panel has been properly constituted. So far as the Panel is aware all pertinent



written communications by the parties to or with the Provider have been concurrently copied to the other party.

- 4.4 Certain written material has been submitted to the Panel as provided by the parties to the Provider. The observations in this determination arise singularly from the material so submitted and the submissions made. I have read all of the materials subject to the exclusion of "Without Prejudice" material discussed following. There is no need that I traverse all of it in the reasons here given, but all of it has been noted and analysed.

On 18 February 2010 the Panel received from the Provider a copy of a 17 February 2010 email to the Provider from the Respondent which stated:

*"I have been contacted by the complainants lawyers.*

*I would like to further submit the communication by the complainants lawyers (sic).*

*Also a more detailed case to my defense (sic) as is my response to their communication" (sic).*

The bulk of the attachments to this communication comprised, significantly in the view of the Panel, various direct communications between the parties or representatives antecedent to this Complaint and all clearly marked "WITHOUT PREJUDICE" and so specifically designated by both of them.

A copy of the resultant immediate Gadens email to the Provider of 18 February 2010 in part states:

*"Those communications have been clearly marked "Without Prejudice" and we vehemently object to them having been disclosed".*

The Powers of the Panel including procedurally are in part set out at Rule 10 of Schedule B of auDRP Policy which in part recites:

*"10 General Powers of the Panel*

*(a) The Panel shall conduct the administrative proceeding in such manner as it considers appropriate in accordance with the Policy and these Rules....*

*(d) The Panel shall determine the admissibility, relevance , materiality and weight of the evidence..."*

A Panel Decision is an administrative proceeding. Within that proceeding, and consistently with the powers of the Panel (in part as recited above), invested in the Panel is a range of discretions relative to admissible material and other matters. In this regard, the Panel pertinently here notes:

- (a) This further material from the Respondent was volunteered from the Respondent to the Provider without forewarning, and apart from being clearly outside the previously notified final submissions date of 8 February 2010, comprised material substantively marked and designated "WITHOUT PREJUDICE" and as so marked as at each of their dates by both parties.
- (b) This material comprised antecedent direct communications between the parties and representatives intended to be, as specifically designated by both sides, as just that, namely "without prejudice" and thus protected as (broadly) confidential material.
- (c) Whilst the function of the Panel is inherently the progressing of an administrative proceeding, its outcome also devolves into determinative findings. Within the standard principles of administrative, and in particular determinative, proceedings confidentiality embraces communications of the nature or to the effect of those made directly between parties on a specifically designated and qualified basis, namely on a "without prejudice" basis, and the more so where that designation has been clearly signified concurrently at the time when those communications were made. That appears to be the position here.
- (d) The Respondent's submission of this material, apart from its lateness, runs counter to the principles attaching to such designated "without prejudice" communications. The Panel, other than for noting the specific designation on each of them as to being "without prejudice", determines that this material is not properly submittable to it for consideration or deliberation and such material thus has been excluded by the Panel for the reasons stated.



4.5 Paragraph 15(a) of the auDRP Rules states:

*“A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy [the auDRP Policy], these Rules and any rules and principles of law that it deems applicable”.*

4.6 According to auDA, the Disputed Domain Name was created on 23 August 2002. The Policy applies to the Disputed Domain Name.

## **5. FACTUAL BACKGROUND: The Complainant’s case**

5.1 In submissions made with its Complaint, the Complainant (“M”) essentially raised some of the following matters, namely that:

- (a) Mothercare plc and its predecessors in title (collectively “M”) have been and are incorporated in the United Kingdom and listed on the London Stock Exchange in 1972, originally through Mothercare Limited.
- (b) Since 1961, M has retailed actively in Australia and internationally merchandise for expectant mothers and children including trading under or with the Trade Mark “Mothercare”. Some of such active retailing has been through mail ordering, website, direct customer contact and (previously in Australia) franchise retail operations.
- (c) As at the date of this Complaint, the domain name primarily used by M is “mothercare.com” registered in the related subsidiary entity Mothercare UK Ltd, which latter company holds intellectual property including registered Trade Marks in various goods and services in Australia (particularised within annexure “A” of this Complaint).
- (d) That M and/or Mothercare UK Ltd hold many other Trade Mark registrations in numerous other jurisdictions (also exemplified within the same Annexure “A” of this Complaint).



- (e) That the Disputed Domain Name was created on 23 August 2002 including being well after the priority date of most of the Trade Marks of M (including those listed in the Complaint Annexure "A").
- (f) That the Registrar for the Disputed Domain Name is "Smartyhost".
- (g) That search extracts (as at 27 November 2009 and 22 December 2009) of the website using the Disputed Domain Name illustrate that it is not in use (referred to within Annexure "C" of the Complaint).
- (h) A printed extract of the Domain Name System search record of the Disputed Domain Name illustrates that there are no mail servers associated with it (including as referred to in Annexure "D" of the Complaint), such that it can be concluded that the Registrant does not conduct any email communications by reference to it.
- (i) Arising from the above and generally, M submits its Complaint Grounds (briefly recited) include that the Disputed Domain Name:
  - (i) Is identical or confusingly similar to a name, Trade Mark or service mark in which M has rights.
  - (ii) Is not a domain name in which the Registrant / Respondent has any rights or legitimate interests.
  - (iii) That the Respondent has registered or subsequently used it in bad faith.
- (j) Arising from these submissions, M submits for the remedies set out within the Complaint.

## **6. FACTUAL BACKGROUND: The Respondent's (B's) case**

- 6.1 I refer to the Procedural History previously set out within paragraph 4 hereof which describes the background to the submission made by B. For completeness, that B submission (including in an email from B to the Provider of 3 February 2010) is here set out in its fullness, namely:

*"In response to the matter above I have reviewed all documentation and trademarks under which mothercare is assigned.*

*I can confirm that my area of business does not in any way infringe the trademarks for goods or services that are stated in the document.*

*The domain mothercare.com.au is to be used in the scientific area of brain training.*

*I have negotiated a deal with a company where I will be providing brain training services.*

*The domain mothercare.com.au is to assist elderly people with cognitive decline as an example suffering from dementia, loss of memory, Alzheimer's...*

*I have been working on this project for a few years at considerable cost to ensure I have the right scientific technology therefore the domain has not been active as website.*

*I am willing to discuss this matter further and determine positive outcome to both parties.*

*Regards*

*Arthur Bobrow".*

## **7. DISCUSSION AND FINDINGS**

### **Elements of a successful complaint**

7.1 According to Paragraph 4a of the .auDRP Policy, a person is entitled to complain about the registration or use of a domain name where:

- (i) The domain name is identical or confusingly similar to a name, trade mark or service mark in which the complainant has rights; and*
- (ii) The respondent to the complaint has no rights or legitimate interests in respect of the domain name; and*
- (iii) The respondent's domain name has been registered or subsequently used in bad faith.*





7.2 It is to be noted that the three elements of a complaint under Paragraph 4a of the auDRP Policy are cumulative; all of them must be proved if the Complaint is to be upheld.

**Is the Disputed Domain name identical or confusingly similar to a name, Trade Mark or service mark in which the Complainant has rights?**

7.3 The Panel must determine whether the Complainant has rights in a relevant name, Trade Mark or service mark.

7.4 The auDRP Policy states:

*For the purposes of this policy, auDA has determined that a "name...in which the complainant has rights" refers to*

*(a) The complainant's company, business or other legal or trading name, as registered with the relevant Australian government authority;*

*(b) The complainant's personal name."*

7.5 The auDRP Policy does not provide guidance as to the intended meaning of "identical" or "confusingly similar". However, "essential or virtual identity" is sufficient. (*BlueChip Info Tech Pty Limited v Roslyn Jan and another* [LEADR case 06/03]).

7.6 Although it may appear that there is no exactitude as to what is contemplated in the term "confusing", the test of "confusing similarity" could have reliable precedent in the trade mark infringement case application of the expression, where the concept of "deception" contemplates consumers who may be deceived or "caused to wonder" about the source or origin of goods or services. (As, for example, noted in *Camper Trailers WA Pty Ltd v Off Road Equipment Pty Ltd* [LEADR 06/04]).

7.7 The Panel makes the following observations in no priority order.

7.8 Broadly, the submitted chronology on the material before me is accepted substantively as to evidence a very active commercial use and exposure by M of its "MOTHERCARE" trade name, business name and Trade Mark associations, all of which are referred to in earlier

chronology and background recitation. Further, there is no agreement or dispute before me as to the integrity or accuracy of that background.

- 7.9 B has registered the Disputed Domain Name. No argument or dispute is put before me as to there being any relevant doubt about or contention upon the similarity of the Disputed Domain Name to the trade name, operating and business names and Trade Marks and other designations of M. No relevant dispute is put before the Panel here contesting as to that similarity.
- 7.10 Many of various Annexures to the Complainant M's submissions attest to the corporate, trade, commercial, Trade Mark, business name and other representations of its business and conducted as an active and continuing business under and by reference to the primary title or designation "MOTHERCARE". None of that is largely contested here.
- 7.11 Further, no dispute, argument or submission is put by the Respondent B contesting as to the Complainant M having rights in or to all of those "Mothercare" designations other than for the B submission (at 6.1 above) emerging from B in response to this Complaint.
- 7.12 Nor is there any relevant dispute by reference to entitlements of M to its business and ongoing trade usage of "Mothercare" (other than for the Disputed Domain Name issue here) under and by reference to the designations under which, on a continuing and active basis, "Mothercare" (through M) has already operated and has for long been operating, as referred to earlier.
- 7.13 There is no dispute evident on the papers before me, or in any submissions from the Respondent B, that M does not have a relevant reputation residing in its various "Mothercare" designations (previously referred to other than for the text of the Respondent submission quoted earlier).
- 7.14 The onus of establishing the Complaint under this heading rests with M. That onus does not extend to a Complainant needing to establish any consumer association of a word (say, here, "mothercare") singularly with the Complainant's business or reputation. Any name or term used

(and whether 'generic' or otherwise) which 'primarily' has an association with a Complainant's business is enough, prima facie, to give rise to confusing similarity under this heading.

7.15 There is no relevant evidence before the Panel upon which it could safely conclude that the Complainant has not established the relevant onus here.

7.16 The Trade Marks of M (fully particularised within Annexure "A" of the Complaint) have been fully studied. What emerges is:

- (a) Almost all are primarily "MOTHERCARE" registered Trade Marks.
- (b) There are twenty-one (21) of such currently registered Trade Marks in that listing.
- (c) They are registered across fourteen (14) distinct Trade Mark categories (variously) of "Goods and Services" in the registered Trade Mark Class categories there described.
- (d) Those registered Classes appear (broadly) to reconcile with the historical and current active usage by M of the Trade Mark "MOTHERCARE" (and derivatives thereof) in the retail (and other) history recited as part of the background to this Complaint provided by M.
- (e) Additionally, within the same Annexure "A" to the Complaint there is a comprehensive international listing of the countries / territories / regions / jurisdictions in which M, through (various) "MOTHERCARE" designations, and in various Trade Mark Classes or categories, actively trades, or has traded or operated. This list has also additionally been fully noted. This background appears to reconcile with the Complaint Ground under this heading urged by M that the Disputed Domain Name comprises at least one of the Trade Marks as described above and as is comprehensively set out within the Complaint.



7.17 B submits that his “*area of business does not in any way infringe the trade marks for goods or services*” described in the Complaint. Respectfully, the “*area of business*” contention is not one which, even assuming its correctness, defeats the essential Complaint Ground under paragraph 4a of the auDRP Policy (sub-paragraph (i) thereof).

7.18 Broadly, the Panel is satisfied, including on that requisite onus, that there is a position of conviction to the M Complaint, under this heading, and in any event by reference to the undisputed account of matters on the papers before the Panel, that the Disputed Domain Name is identical with or confusingly similar to a name, Trade Mark or service mark in which M as Complainant has rights.

7.19 For these reasons, on the balance of material before the Panel, there is in its determination, the real potential for, and the actuality of, identity confusion in the terms which meet the foundation for the Complaint of M under this heading and where M, in the determination of the Panel, has established the requisite onus.

7.20 Accordingly, the Panel determines that the Complainant has satisfied the requirement of “*identical or confusingly similar*” in Paragraph 4a(i) of the auDRP Policy.

**Does the Respondent have any rights or legitimate interests in respect of the Disputed Domain Name?**

7.21 This is the second element for establishment within a Complaint under the UDRP. It involves deliberation upon the issue as to, whether or not, a Respondent has, in the circumstances of the particular presentation, no rights or legitimate interests in the Disputed Domain Name (as contended by M -here). This is relative to considerations pursuant to Paragraph 4a(ii) of auDRP Policy.

7.22 Firstly, it is imperative to note, including here, that ‘rights or legitimate interests in respect of the Disputed Domain Name’ are not established merely by a Registrar’s determination that the Respondent satisfied any relevant registration criteria for the Disputed Domain Name at the time of its Respondent registration (and refer Note 2 of the Policy).



There is accordingly no basis for any argument singularly put by reference to registration, or necessarily, as to later use since registration, on that basis.

7.23 The relevant burden of proof is to the extent that the Complainant need only make out a prima facie case that the Respondent has no legitimate interest, whereupon that burden then shifts to the Respondent to produce evidence of any relevant interest in the name in issue, as to satisfy the Panel (*Document Technologies, Inc v International Elec Communications Inc* (WIPO Case D2000-0270)).

7.24 The UDRP does not attempt to define forensically what is meant by a right or legitimate interest in a Domain Name. Paragraph 4c of UDRP lists three (3) (and importantly, non-exclusive) examples of what may comprise any contended 'right or legitimate interest', namely:

- (a) Use, or demonstrable preparations to use, the Domain Name in connection with a bona fide offering of goods or services;
- (b) The Respondent being commonly known by that Domain Name; or,
- (c) Making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers.

7.25 It is not necessary for the Panel to traverse in fullness the respective submissions content of the parties under this heading. The following observations are made on the material before the Panel, and in no priority order.

7.26 The Panel notes the following:

- (a) Various search Annexures commissioned by M and as attached to the Complaint (including Annexures "E" and "F") appear to reliably evidence:



- (i) That B does not have an interest currently or historically in any "MOTHERCARE" Trade Mark or business name registration.
- (ii) A Business Name search of the registered ABN (55806533828) of B illustrates:
  - (a) The entity registered is the individual B therein as personally named and as a sole trader.
  - (b) That under that Business Name Registration there are three (3) trading names including (by way of example) "My Deals Australia", but none of which have any attachment or reference to any designation of "Mothercare" or any derivative of that latter name.
  - (c) As relates to any Business Name "My Deals Australia" it was deregistered on 4 July 2009.

7.27 Arising from some of that background, the Panel must concur with those elements of the Complainant M's submissions to the effect that, as at the date of this Complaint:

- (a) B is not an Australian registered company.
- (b) B is not trading under a registered Business Name within Australia, and in particular under no reference, as best as can be reliably discerned, to any "Mothercare" (or derivative) designation.
- (c) The sole trader shown in these searches is apparently B reconciling with the same B being the Registrant (and this Respondent) to the Disputed Domain Name.
- (d) Is not a foreign company licensed to trade in Australia, an owner of any pertinent Australian Registered Trade Mark including, apparently, by reference to the designation "MOTHERCARE" (or any derivative), or an Applicant for any Australian Registered Trade Mark as pertinent here.

(e) Is not an incorporated association within Australia or a commercial Australian statutory body.

7.28 Respectfully, it appears to the Panel that none of the submission content of B (recited fully earlier) addresses the central issue of this element of the Complaint, namely for B to satisfy the requisite auDA Policy criteria that B does have any right or “legitimate interest” in the Disputed Domain Name. Here, respectfully, the urgings, actual or implied, within B’s submissions which could in any way be interpreted to be addressing this heading of Complaint fall short of doing so. In particular, the Panel notes that B appears to be urging (under this heading and generally) that:

(a) His *“area of business does not in any way infringe”* the intellectual property rights of M. This contention does not address this heading.

(b) That his domain registration “mothercare.com.au” is for use *“in the scientific area of brain training. I have negotiated a deal with a company where I will be provided brain training services”*. Thereafter there follows a “domain” reference to assisting *“elderly people with cognitive decline .. working on this project for a few years .. therefore the domain has not been active as website (sic)”*. Respectfully, these urgings are insufficient, in the view and determination of the Panel, to defeat the Complaint Ground urged by M under this heading and by requisite reference to the Policy criteria.

7.29 The Panel observes that the potential for confusion as to the source of the Disputed Domain Name is a relevant and appropriate consideration in analysis of any claim for legitimacy of interest under this heading. The Panel has already discussed this under the “identical or confusingly similar” heading earlier. It is not necessary to traverse that aspect here further accordingly.

7.30 The Panel has already indicated the principles as to the relative evidentiary burdens, but here immediately notes, and determines, that



M as Complainant has made out a prima facie case that B, as registrant of the Disputed Domain Name, has no legitimate interest in it (including as arising from observations which further follow). It is for B then, to satisfy the Panel, the onus resting upon B, that it has a relevant interest in that Name.

- 7.31 As already stated, the mere fact of Disputed Domain Name registration by B as Respondent does not connote a legitimacy of interest or right in it. Equally, by reference to matters recited within Paragraph 4c of UDRP (abbreviated references above), mere assertions of preparations to use, or for working on a commercial project for a few antecedent years without activating the website relative to the Disputed Domain Name, are insufficient to establish that a Respondent has undertaken any relevant demonstrable preparations to use the name in terms of auDRP Paragraph 4c for example.
- 7.32 In particular, and specifically in part pertinent to this presentation in the view of the Panel, an offering of goods or services is not bona fide if use of the Disputed Domain Name is likely to cause consumer confusion including, such as and by one illustration only, that it may infringe a Complainant's trade name rights or acquired reputation (*Universal City Studios Inc v GAB Enterprises* (WIPO Case D2000-0416)).
- 7.33 Here, several matters are noteworthy. Firstly, including in terms of paragraph 4c(a) of UDRP, it is apparent on the material before the Panel that B has not used the Disputed Domain Name in any real connection with a bona fide offering of goods or services. If anything, it would appear reliably that the Disputed Domain Name registration by B, including by Respondent acknowledgment, has thus far, particularly in any trading context, been dormant. In short, respectfully, in the view and determination of the Panel, there is no reliable material persuasively before the Panel from B establishing any "right or legitimate interest" in the terms of UDRP Paragraph 4c including as non-exclusively illustrated within sub-paragraph (a) to (c) thereof.
- 7.34 The Respondent B, further, is not commonly known (nor is that argued here) by any reference, actively or otherwise, to the Disputed Domain Name, including by reference to paragraph 4c(b) of UDRP.



7.35 Further, there is no reliable evidence before this referral that any use by the Respondent B of the Disputed Domain Name is a legitimate non-commercial or fair use of it. Further, specifically, that use thus far by the Respondent B, on the material before the Panel, is illustrative of such usage being retained for purposes of a contended registration ownership only, and not as to use.

7.36 None of the above is illustrative, in the view and determination of the Panel, of the Respondent B maintaining a foundation for rights or legitimate interests in the Disputed Domain Name, or to be acting reasonably or bona fide in adhering to a position of maintaining to itself such registration.

7.37 For these reasons, accordingly, the Panel is not of the view that B has discharged the onus as to establishing, in the circumstances of this presentation, a right or legitimate interest in respect of the Disputed Domain Name in issue here.

7.38 Accordingly, the Panel finds that the Respondent B has no right or legitimate interest in the Disputed Domain Name. Paragraph 4a(ii) of the auDRP Policy has been satisfied by the Complainant.

**8. Has the Disputed Domain Name been registered or subsequently used in bad faith (paragraphs 4a(iii) and 4b of auDRP policy)?**

8.1 The Panel has noted and studied the full context and content of all requisite material under this heading.

8.2 Paragraph 4b of the auDRP Policy sets out circumstances of "*evidence of the registration and use of a domain name in bad faith*". This Paragraph contains four sets of circumstances, any one of which, if established, can constitute evidence of registration in bad faith. It is important to note also that it is a non-exhaustive list of circumstances such that, for example, the Panel is not necessarily constrained from a finding of bad faith should it arise (also by example) from not only any one or other of them, but from a combination of them, or indeed, upon the basis of other reliable material before the Panel inclusive of the illustrated list.

8.3 The essence of each of the subparagraph illustrations in Paragraph 4b of the Policy as non-exclusive examples of evidence of bad faith are:

- (i) Circumstances indicating that the subject registration is primarily for the purpose of selling, renting or otherwise transferring it including for valuable consideration in excess of documented out-of-pocket costs directly related to it;
- (ii) A registration to prevent the owner of a name, trademark or service mark from reflecting those same names or marks in a corresponding domain name;
- (iii) Registration primarily to disrupt business;
- (iv) Use of the domain name as to intentionally attempt to attract, for commercial gain, Internet users to a website by creating a likelihood of confusion.

8.4 As indicated, these are non-exclusive illustrations. Also, as previously stated, the establishment of any one of them can be enough as to a finding of relevant bad faith. Other factors may also demonstrate bad faith.

8.5 It would appear here that, essentially, the Respondent B's position before this referral, expressly or by implication within the submissions of B (quoted fully earlier), is an adherence to an argument of Disputed Domain Name registration 'ownership' upon which all else rests. No discrete Respondent submission or argument is put by reference to this specific heading of 'bad faith', for example. However, some of the history of the matter attracts discussion under this heading. The Panel, in addition to observations already made, and without need to recite all of the observations the Panel might make from its study of the full material before it, discusses further certain matters regarded as pertinent as following, and again in no priority order.

8.6 Relevantly, in the view of the Panel, the Complainant M submits:



(a) That the registrant B would have known of the M Complainant interest in the Disputed Domain Name at the time of B initiating its registration. Here, M points to Annexure "G" to the Complaint, being a "MOTHERCARE" Google search being a search relatively simply undertaken. This search reveals the M ownership in (various) domain names including of:

"mothercare.com"

"mothercarejobs.com"

"mothercare.com.hk"

"mothercareplc.com".

(b) That this Google search directs inquirers to a range of websites where demonstrably offers of Complainant M's products are shown (without particularising the nature or extent of such product or other listings, but all fully noted).

(c) That B has proceeded to register the Disputed Domain Name despite holding no recognised interest in the name, central to which is the designation "mothercare", contrasted against the historical and longstanding background of active usage of such designation by M.

(d) That B has proceeded to so register the Disputed Domain Name in effect to act as a prevention from M as Complainant from reflecting its own active Trade Marks (previously discussed) in a corresponding domain name.

8.7 Respectfully, the B submission text (fully recited earlier) does not satisfactorily to the Panel explain away the Complaint under this heading. In effect, as the Panel interprets it, the B submissions merely recites:

The B contention:

(a) that his "*area of business*" does not infringe the intellectual property rights of M as Complainant. Here, respectfully, it is noted that B does not particularise any currently active "*area of business*" as here referred to, other than references to the future or anticipated commercial sense, namely (if assumed to be correct)

an intention for future commercial use in the phrasing “*is to be used in the scientific area .. (etc)..*”, and (commercially) “*where I will be providing brain training services ..*”, and “*.. is to assist elderly people .. (etc)..*” (emphasis added);

(b) actual acknowledgement by B in terms that “*.. the domain (sic) has not been active as website (sic)*”;

(c) and where otherwise there is silence by B on whether or not there was any prior knowledge of B in the intellectual and other name rights of M in the designation “mothercare” and derivations thereof. Given the nature and content of the Complaint, that silence, or failure to explain, in the view of the Panel, is pertinent. Nowhere, to reiterate the point, does B contest the historic and current intellectual property rights held by M in that very name which coincides with the Disputed Domain Name as chosen to be initiated for registration by B.

8.8 To the extent of these matters, the Panel has given the closest deliberation to the requisite elements of bad faith as exhibited within paragraph 4b of the Policy. It is reiterated that the paragraph 4b circumstances in paragraphs (i) to (iv) thereof are not exclusive, are illustrative only, but that one only of any of them can connote a reliable finding of bad faith. Other circumstances, other than those illustrated at Paragraph 4b, can equally do so. In this regard the Panel concludes and finds that B has effected a registration to prevent the owner of a name, Trade Mark or service mark from reflecting those names or marks in a corresponding domain name as offends Paragraph 4b(ii) of the auDRP Policy.

### **Subsequently used in bad faith**

8.9 For completeness, the Panel deals with this additional Ground Complaint component of M as separate urgings were made with reference to this heading. In a sense, it is not necessary for this Decision to deal with this component in that Paragraph 4b of the Policy is prefaced in the alternative, namely rhetorically “*Has the disputed Domain Name been registered **or** subsequently used in bad faith?*”



(emphasis added). The determinations already made by the Panel effectively resolve the issue in any event under this heading broadly. However, these comments are added for abundant completeness.

8.10 On the material before the Panel, respectfully, the Panel would concur with these areas of submission of the Complainant M under this heading, namely:

(a) That B is not, and certainly not in any substantive way, operating a website from the Disputed Domain Name (Annexure "D" to the Complaint affirms this including that there are no mail servers associated with the Disputed Domain Name illustrated here). Here additionally it is noted that B in fact acknowledges the non-utility of the website in fact to this point.

(b) There had been some prior attempts by M to contact B in respect of matters broadly the subject of this Complaint but without success.

8.11 It is reiterated that the list of circumstances at Paragraph 4b of the auDRP Policy relative to "*bad faith*" are just that, they are illustrative, that is they are non-exhaustive. The Panel may have regard to a range of discretionary considerations, in other words, under this heading, given the nature of each presentation before it.

8.12 It is apparent to the Panel, and the Panel finds (although it is not necessary to so find under this heading, other than for completeness) that the effect of the Disputed Domain Name having been initiated to registration by B, but then remaining dormant and non-utilised, has the ultimate critical effect of preventing the Complainant M from registering the Trade Marks in a corresponding domain name. In the circumstances of this presentation, the Panel is of the view and finds that such non-use by B does constitute a use of the Disputed Domain Name in bad faith.

8.13 Further, there is no material before the Panel indicative of any initiative of B towards any clear website disclaimer as to attempt to diffuse or remove any potential confusion or to identify that B is a qualified

registrant only of the Disputed Domain Name (*AGDEST v Blogger Pty Ltd*, IAMA-3058 (2007)).

8.14 In the Panel's view and determination, each of these considerations, and all such matters taken together, reliably establish that the registration by B of the Disputed Domain Name has been and become evidenced by registration and continuing use in bad faith.

8.15 For the reasons outlined, the Panel determines that M as Complainant has satisfied the requirements of Paragraph 4a(iii) of the auDRP Policy as to Disputed Domain Name registration in bad faith.

## 9. DECISION

9.1 The Panel concludes for the reasons stated:

- (a) That the Disputed Domain Name is confusingly similar to a name, trade mark, or service mark in which the Complainant M has rights;
- (b) That the Respondent B has no rights or legitimate interests in the Disputed Domain Name; and,
- (c) That the Respondent B registered and used the Disputed Domain Name in bad faith.
- (d) Complainant M complies with auDA's Policy, *Domain Name Eligibility and Allocation Policy Rules for the Open 2LDs (2008-05)*, in respect of the Disputed Domain Name.

9.2 For the reasons outlined, the Complainant has satisfied the elements of Paragraph 4a of the auDRP Policy.

## 10. RELIEF

10.1 The Panel orders that the Disputed Domain Name "mothercare.com.au" be transferred to the Complainant M.

10.2 The Panel notes that the Complainant M is eligible to hold the Disputed Domain Name under Schedule A, Paragraph 4a(i) of the auDA Policy as the owner of a 'name, trademark or service mark' in which the Complainant M has rights.

Dated this 18<sup>th</sup> day of February 2010



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**JOHN A. McGRUTHER**  
**SOLE PANELLIST**

## ANNEXURE 'A'

### Procedural History

[mothercare.com.au]  
[auDRP\_10\_01

1. The complaint was submitted for decision in accordance with the (auDRP) Policy and Rules, which was approved by auDA in 2001 and commenced operation on 1 August 2002 and LEADR's Supplementary Rules (LEADR is the Provider).
2. The complete application was received from the Complainant by LEADR on **14/1/2010**.
3. On the 18/1/2010 LEADR sent the Respondent (**Arthur Jason Bobrow**) by **Email** a dispute notification letter and a copy of the complaint submitted.
4. A copy of the complaint submitted and the dispute notification letter sent to the Respondent were also posted to the registrar **SmartyHost** on **18/1/2010**.
5. The Registrar was also sent an email on **1/18/2010** requesting to lock the domain name in dispute.
6. LEADR advised auDA of the complaint on **18/1/2010** via e-mail.
7. On the **18/1/2010** LEADR sent a notification letter to the Complainant (**Mothercare plc, Mothercare UK Limited**) by email along with a copy of the notification letter sent to the Respondent.
8. On **3/2/2010** the Respondent contacted LEADR via **email** and confirmed that the complaint sent had been received and been read through. The due date for the response to the complaint was confirmed to be **8/2/2010**.
9. The Respondent (**Arthur Jason Bobrow**) has yet to submit a formal response to the domain name complaint. The email (response as per Respondent) received on the **3/2/2010** was also sent to LEADR via post; however this is still not received.



10. On **11/2/2010** the provider approached the Panellist. The panellist confirmed their availability, informed LEADR that they had no conflict issues with the parties and accepted the matter on **12/2/2010**
  
11. The Panellist was informed on **12/2/2010** that the package was being sent for Adjudication.