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BEFORE THE INTERNET EXCHANGE OF INDIA

ARBITRATION AWARD

ARBITRATOR: S.SRIDHARAN

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DATED: 27<sup>th</sup> April 2008

Mothercare UK Limited, United Kingdom

: Complainant

Versus

Mr. Rajkumar Jalan, New Delhi

: Respondent

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**Mothercare UK Limited, United Kingdom : Complainant**

**Versus**

**Mr. Rajkumar Jalan, New Delhi : Respondent**

**1. The Parties**

- 1.1 The Complainant is Mothercare UK Limited, a company incorporated under the laws of United Kingdom and having its principal place of business at Cherry Tree Road, Watford, Hertfordshire, WD24 6SH, United Kingdom, represented by its counsel, Ms. Ramni Taneja, A-34, Defence Colony, New Delhi - 110 024, Telephone No.: +91 11 41552051, Fax No.: +91 11 4155 2053, Email: [ramni@ramnitaneia.com](mailto:ramni@ramnitaneia.com)
- 1.2 Respondent is Mr. Rajkumar Jalan, at Pragati Infosoft Private Limited, 286, 1st Floor, Sant Nagar, East of Kailash, New Delhi - 110065.

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2. **The Domain Name and Registrar**

2.1 The disputed domain name <mothercare.in> is registered with Net4India Limited, AB-11, 1st and 2nd Floor, (Community Centre), Safdarjung Enclave, New Delhi - 110 029

3. **Procedural History**

3.1 On 12<sup>th</sup> February 2008, the Arbitrator sent an electronic version of the signed statement of acceptance and Declaration of Impartiality and Independence. On 13<sup>th</sup> February 2008, the Arbitrator received hardcopy of the Complaint along with Annexures.

3.2 On 13<sup>th</sup> February 2008, the Arbitrator issued by mail a Notice to the Respondent setting forth the relief claimed in the Complaint and directing him to file his reply to the Complaint within 15 days. The arbitrator also sent a mail to the Complainant to send an electronic version of the Complaint, preferably as a word document to the Arbitrator at the earliest.

3.3 On 14<sup>th</sup> February 2008, the Complainant sent an electronic version in a word file of the Complaint to the Arbitrator.

3.4 On 18<sup>th</sup> February 2008, on the request of the Respondent, the Arbitrator extended the time for filing reply by another four weeks.

3.5 On 14<sup>th</sup> March 2008, the Respondent filed his reply to the Complaint. The Arbitrator advised the Complainant to file her response to the reply, if any within 10 days.

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- 3.6 On 20th March 2008, on the request of the Complainant, the Arbitrator extended the time for filing response to the reply of the Respondent till 7<sup>th</sup> April 2008.
- 3.7 On 5<sup>th</sup> April 2008, the Complainant filed her rejoinder to the reply filed by the Respondent. On 7<sup>th</sup> April 2008, the Arbitrator received the hard copy of the reply.
- 3.8 On 9<sup>th</sup> April 2008, the Respondent informed his desire to file reply to the rejoinder of the Complainant. He was to attend his mother's funeral rites till 17<sup>th</sup> April in Guwahati, Assam and therefore sought time till 24<sup>th</sup> April 2008 for filing reply.
- 3.9 He was informed that the arbitration needed to be completed on or before 13th April 2008. The material on record was sufficient to pass an award. The Respondent, however, was permitted to file his reply on or before 10<sup>th</sup> April 2008.
- 3.10 The Respondent informed that was not able to attend his works until his mother's sradha ceremony on 17<sup>th</sup> April 2008. Under these circumstances, he needed time till 24<sup>th</sup> April 2008.
- 3.11 The Arbitrator considered the request of the Respondent and the material on record. The Respondent was granted time till 24<sup>th</sup> April 2008 to file his reply. He was advised that he must answer in his reply the following issues:

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- (a) Reason for adopting the disputed domain name.
- (b) Necessity for using the disputed domain name for redirection.
- (c) You offered to transfer the domain name www.indiaparenting.in for Rs.15 lakhs. Can one draw an inference from the decision of the case that you habitually register the domain names without any intention to use the same?

3.12 On 24<sup>th</sup> April 2008, the Arbitrator received the softcopy and the hard copy, of the Respondent's reply to the rejoinder.

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

##### **A Complainant**

4.1 The Complainant was established in the year 1954 in England as M. Kaplan & Co. The Complainant started using the mark "mothercare" since 1961. The Complainant's name was changed to its present name on September 22, 1984. The Complainant has more than 220 shops in the United Kingdom. The Complainant overseas franchise business currently operates through 379 stores in 45 countries. The certificate of incorporation of the Complainant is attached at **Annexure 1**.

4.2 The Complainant's trademark "MOTHERCARE" is registered in various countries. The Complainant's said trademark was first registered in the United Kingdom on October 18, 1963 and in India in 1977. Copies of some of the certificates of registration of the Complainant's trademarks are collectively attached at **Annexure 2**.

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- 4.3 The Complainant owns various domain names containing the mark "MOTHERCARE". The domain names [www.mothercare.co.uk](http://www.mothercare.co.uk) and [www.mothercare.com](http://www.mothercare.com) were registered in August, 1996 and December 5, 1997, respectively. An extract from Whois evidencing the said registrations is collectively attached at **Annexure 3**.
- 4.4 The Complainant is using the mark mothercare in respect of products for babies, children, expectant and feeding mothers such as clothing, toiletries, accessories, nursery furniture, pushchairs, car seats, home safety products, bedding and textiles, feeding equipment, toys, gifts etc. The Complainant sells its products through internet since 1998. The approximate hits in a month on the Complainant's website [www.mothercare.com](http://www.mothercare.com) are 1,500,000. The annual sales through internet are about £47.8 million for the 52 weeks ended March 31, 2007.
- 4.5 The Complainant established its wholly owned subsidiary in India on June 15, 2006, Mothercare Sourcing (India) Private Limited ("**Mothercare India**") after obtaining all the necessary approvals under the applicable laws. The Complainant has licensed its "Mothercare" to Mothercare India. Mothercare India is in the business of sourcing and exporting products to the United Kingdom, Singapore and Dubai". Mothercare India supplies Mothercare branded products to the Complainant's franchisee in India. The franchisee has opened 17 stores all over India including Delhi, Mumbai, Pune, Hyderabad, Bangalore, Chennai, Kolkatta, etc. A copy of certificate of incorporation of Mothercare India is attached at **Annexure 6**.

4.6 The Complainant has acquired a considerable reputation in respect of Kids, expectants' clothing, toys and accessories over four decades. The products bearing the mark "MOTHERCARE" have been promoted in the print and electronic media worldwide. Such extensive publicity has caused the members of the public and trade to associate the mark "MOTHERCARE" solely with the Complainant. The consolidated annual advertisement expenses for the last three years incurred by the Complainant for the products bearing mark "MOTHERCARE" worldwide including India is given below.

Year	Annual Advertisement Expenses (In GBP)
2006	3,934,606
2007	3,928,256
2008 (estimated)	4,051,248

4.7 The Complainant's annual turnover for the year ended on March 31, 2007 using the mark "MOTHERCARE" including India is £498.5 million.

4.8 The present Complaint is instituted since the disputed domain name <mothercare.in> of the Respondent is identical to the Complainant's prior registered trade mark Mothercare and domain name mothercare.com.

#### **B. Respondent**

4.9 The Respondent has been using the disputed domain name <mothercare.in> for very many years and is currently employing it for redirection to its another website www.indiaParenting.Net

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4.10 Respondent has not come out with any reason for adopting the disputed domain name <[mothercare.in](http://mothercare.in)> for redirection.

4.11 The disputed domain name <mothercare.in> is a combination of two generic words "Mother" and "Care".

## 5. Parties Contentions

### A Complainant

5.1 The Complainant is the proprietor of the mark Mothercare and has been using the mark "Mothercare" since 1961.

5.2 The Complainant has got registrations for the mark mothercare in many countries across the globe in relation to wide variety of goods. Mothercare mark was first registered in the United Kingdom in 1963. It was registered in 1977 in India. Mothercare marks are well-known throughout the world.

5.3 The Complainant also owns various domain names containing the mark Mothercare. The domain names [www.mothercare.co.uk](http://www.mothercare.co.uk) and [www.mothercare.com](http://www.mothercare.com) were registered in August, 1996 and December 5, 1997, respectively.

5.4 By continuous and extensive use of the trade mark "Mothercare" by the Complainant has resulted in the mark being identified solely with the Complainant. Such extensive publicity has caused the members of the public and trade to associate the mark "Mothercare" solely with the Complainant. The trademark "Mothercare" is synonymous with the Complainant and has acquired high degree of distinctiveness.



- 5.5 The disputed domain name <mothercare.in> is visually, phonetically and structurally identical to the Complainant's registered trade mark Mothercare and the mothercare domain names except TLD.
- 5.6 The Respondent does not have legitimate right to the disputed domain name <mothercare.in> since it contains the registered trademark of the Complainant. The Respondent's use of the Complainant's trade mark in the disputed domain name <mothercare.in> is only with a malafide intention to mislead the general public. The Respondent's adoption of the disputed domain name <mothercare.in> has the effect of causing loss of distinctiveness of the Complainant's trademark.
- 5.7 The use of the disputed domain name <mothercare.in> leads to confusion in the minds of general public including infrequent internet users.
- 5.8 The disputed domain name <mothercare.in> can be accessed from any part of the world. The Complainant has acquired considerable reputation and goodwill for its trademark "MOTHERCARE". The misuse of the disputed domain name <mothercare.in> has caused irreparable damage, harm, loss and injury to the Complainant's reputation and goodwill both in India and worldwide.
- 5.9 The disputed domain name <mothercare.in> was merely parked until February 13, 2008 and did not have any contents. The redirection of the website to [www.IndiaParenting.net](http://www.IndiaParenting.net) was done only after filing of the Complaint in order to fabricate evidence of use.

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- 5.10 The disputed domain name <mothercare.in> is registered with a malafide intention to impede the Complainant from registering it.
- 5.11 Any registration by any third party does not give any right to the Respondent to register any domain name infringing the right of the Complainant.
- 5.12 The Respondent was restrained from using the mark Indiarenting in any manner whatsoever by an arbitration award dated October 5, 2006 in respect of the domain name www.indiarenting.in .
- 5.13 The Complainant's trademark Mothercare should be considered as whole and should not be split into two words viz; "mother" and "care". The mark Mothercare has acquired distinctiveness by reason of continuous and extensive use made by it over more than four decades now.
- 5.14 The Respondent has failed to establish any case for his legitimate use of the disputed domain name <mothercare.in>.
- 5.15 The Respondent has admitted that the disputed domain name was used merely for redirecting it to its website www.IndiaParenting.net. Though the disputed domain name <mothercare.in> was registered on August 28, 2005, the Respondent had not used the site to offer any product or service till date. The Respondent has miserably failed to establish use of the disputed domain name <mothercare.in> for offering of any products or services through its website even after three years of registration.

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- 5.16 The Respondent's conduct of parking and redirecting the website with disputed domain name <mothercare.in> evidences the Respondent's registration in **bad** faith and with malice intention.
- 5.17 The investments made by the Complainant in connection with its trademark and trade name and the public association worldwide, as well as in India, of the trademark and trade name, "MOTHERCARE" with the Complainant, leave no manner of doubt that the relief claimed by the Complainant is fully justified in fact and in law.
- 5.18 The contentions with regard to the Sunrise Policy and the non-registration by the Complainant of the domain name till 16th February 2005 with the .IN Registry, are not germane to the present Complaint.

**B. Respondent**

- 5.19 The present complaint filed by the complainant is not maintainable as complainant has failed to prove that the respondent has no rights or legitimate interest in the disputed domain name <mothercare.in> and the disputed domain name <mothercare.in> has been registered and being used in bad faith.
- 5.20 The Respondent is using the disputed domain name <mothercare.in> currently for redirection to its website [www.indiaparenting.net](http://www.indiaparenting.net) and does not have any intention of misleading any of the users for any products or services of the complainant.

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- 5.21 The complainant in any case cannot apply for and be granted the above disputed domain name merely for the reason that the said name is similar to a trademark or some domain names owned by the complainant.
- 5.22 Both the words "Mother" and "Care" are purely generic words and no one can claim any right over any combination of such words. Generic words are common words that describe an entire class of goods or services and no trademarks can be granted for such terms. Respondent reserves his right to take appropriate legal action against the Complainant and challenge the trademarks obtained by the complainant for such a generic term which is of entirely different value to the entire human race.
- 5.23 The Complaint as filed by the Complainant is fabricated and has been filed with malafide intentions so as to mislead the Ld. Arbitrator, and the said complaint is liable to be dismissed.
- 5.24 The use of the disputed domain name <mothercare.in> by the Respondent is in connection with a bonafide offering of services through its website.
- 5.25 The Respondent has registered the domain for a rightful and just cause and for its own business and the domain has not been registered and is in no way being used in bad faith.
- 5.26 The Respondent has been making a legitimate use of the disputed domain name <mothercare.in> without any intention of misleading or to divert consumers or to tarnish the mark of the complainant.

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- 5.27 The present Complaint is totally based on frivolous grounds and is an attempt to malafidely usurping the domain name of the Respondent illegally.
- 5.28 Before the launching of the .IN domain names the .IN Registry gave clear opportunity to the legitimate trade mark holders to come forward and to obtain the domain name for which they have Trademarks. The complainant never came forward and registered the domain till the 16th February 2005 after which the domains were made available to general registrants. The domain was registered by the Respondent after more than 6 months of this on 28<sup>th</sup> August 2005.
- 5.29 The Complainant has obtained trade marks for bleaching preparations and other similar chemical/cosmetic preparations under class "3" and articles of clothing for women, children and babies under class "25" of the Trade Marks Act, 1999. The use of domain names no where comes under these classes of services and offerings. The complainant can not have any right whatsoever on a domain name by virtue of such trademarks which has been obtained for a totally different class of services.
- 5.30 The Respondent is using the domain name legitimately for its own business and website since last 3 years and at present also. The Respondent has been running the site IndiaParenting.Net since the year 2003 and it is the Respondent who will suffer in case it is held that the domain name in dispute belongs to the Complainant. The Respondent has also invested huge amount of money and efforts in building this website.

5.31 Mere prior usage of the domain name does not grant any rights. The complainant has no right whatsoever on the disputed domain name <mothercare.in>

5.32 The Respondent in his reply to the rejoinder informed that he filed an appeal in OMP No.98 of 2007 against the award in respect of the domain name www.indiaparenting.in before the Hon'ble High Court at Delhi and the execution of the award was stayed. He attached a copy of the stay order and the email correspondence between the Respondent and the complainant in the said dispute.

8. **Discussion and Findings**

6.1 The Complainant in order to succeed in the Complaint must establish under Para 4 of .IN Domain Name Dispute Resolution Policy (INDRP) the following elements:

- (I) Respondent's domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights;
- (II) Respondent has no rights or legitimate interests in respect of the domain name; and
- III) Respondent's domain name has been registered or is being used in bad faith.

Each of the aforesaid three elements must be proved by a complainant to warrant relief.

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*Disputed domain name is identical or confusingly similar to a trade mark of the Complainant.*

6.3 The Complainant is the proprietor of the mark Mothercare and has been using the mark "Mothercare" since 1961. The Complainant is the registered proprietor of the mark Mothercare in many countries across the world, including India. The Complainant's said trademark was first registered in the United Kingdom on October 18, 1963 and in India in 1977. Mothercare marks are well-known throughout the world. The Complainant also owns various domain names containing the mark Mothercare. The domain names [www.mothercare.co.uk](http://www.mothercare.co.uk) and [www.mothercare.com](http://www.mothercare.com) were registered in August, 1996 and December 5, 1997, respectively. The disputed domain name was registered only in the on 28<sup>th</sup> August 2005. The Complainant is the prior adopter of the mark Mothercare as well as the domain names incorporating the said trade mark. The Respondent did not deny the Complainant's prior adoption and user of the mark Mothercare. The above facts have established that the Complaint has both common law and statutory rights in respect of its trade mark Mothercare.

6.4 The Complainant's Mothercare marks are well known throughout the world including India. It is clearly seen that the disputed domain name <mothercare.in> wholly incorporates (a) the Mothercare mark and (b) mothercare domain names of the Complainant. The suffix <.in> does not

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distinguish the disputed domain name from the Complainant's trade mark Mothercare and other mothercare domain names.

6.5 I, therefore, find that:

(a) The Complaint has both common law and statutory rights in respect of its trade mark Mothercare.

(b) The disputed domain name <mothercare.in> is visually, structurally and phonetically identical to the Complainant's prior registered trade mark Mothercare.

*Respondent has no rights or legitimate interests in respect of the disputed domain name*

6.6 It is already seen that the Complainant is the prior adopter and user of the mark Mothercare. The Complainant has got registrations for the mark Mothercare in various classes in many countries including India. The Complainant's mark Mothercare is well known in many countries across the globe including India.

6.7 Now we will see whether the Respondent has established any rights or legitimate interests in the disputed domain name <mothercare.in>

6.8 The first contention of the Respondent is that the disputed domain name <mothorcare.in> is a combination of two generic words "Mother" and "Care". No one including the Compliant can claim any right over any combination of such words. Generic words are common words that describe an entire class of goods or services and no trademarks can be



granted for such terms. Respondent has reserved his right to take appropriate legal action against the Complainant and challenge the trademarks obtained by the complainant for such a generic term. Determination of generic or otherwise of the mark Mothercare or the dispute domain name <mothercare.in> is beyond the scope of this arbitration. As rightly contented by the Respondent, he may agitate this issue before the appropriate forum. What is relevant for this arbitration is the determination of the prior adopter and user of the trade mark Mothercare. It is undoubtedly clear from the evidence on record that the Complainant is the prior adopter and user of the trade mark Mothercare. Until it is determined by an appropriate authority or court that the Complainant cannot claim any right over any combination of such generic words, the Respondent cannot claim any right or legitimate interest in the disputed domain name <mothorcare,in>.

- 6.9 The second contention of the Respondent is that the Complainant's registrations for the mark Mothercare are only in relation to the goods falling under classes 3 and 25 of the Trade Marks Act and there is no registration for web sites or domain names. Therefore, the Complainant cannot have any right whatsoever on a domain name by virtue of such trademarks which has been obtained for a totally different class of goods. The contention is based on old law. Common field of activity was once considered essential for taking infringement action. The registered proprietor was not able to take infringement action against the infringer for

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using an identical or deceptively similar mark in relation to goods which were different from the goods for which registration was obtained. The courts in various jurisdictions all over the world including the courts in India had gradually dispensed with the application of the principle of common of field of activity. The Trade Marks Act 1999 entitles a registered proprietor to take infringement action in many situations including where the goods/services of the infringer and the proprietor are different. Therefore, Complainant's non-registration of the mark in respect of web sites/domain names does not entitle the Respondent to the disputed domain name <mothercare.in>.

6.10 The third contention of the Respondent in essence is that the Complainant failed to apply for the disputed domain name <mothercare.in> at the first available opportunity. Before launching of the .IN domain names, .IN registry gave clear opportunity to the legitimate trade mark holders to come forward and to obtain the domain name for which they have trademarks. The complainant never came forward and registered the domain till the 16th February 2005 after which the domains were made available to general registrants. The disputed domain name <mothercare.in> was registered by the Respondent after more than 6 months of this on 28<sup>th</sup> August 2005. I noted that the disputed domain name <mothercare.in> was merely parked until February 13, 2008 and did not have any contents. The redirection of the website to www.IndiaParenting.net was done only after filling of the Complaint. It is



clear that the Respondent did not put the disputed domain name <mothorcare.in> into use till date. Mere parking or redirection will not amount to use of any kind. In the absence of any use by the Respondent, it is unwarranted to go further into the issue of delay on the part of the Complainant.

6.11 At no point of time the Respondent came forward with the reason for adopting the disputed domain name <mothercare.in> except as discussed above.

6.12 Therefore, I conclude that the Respondent has failed to establish any rights or legitimate interests in respect of the disputed domain name <mothercare.in>.

*Respondent's domain name has been registered or is being used in bad faith.*

6.13 The Respondent is admittedly using the disputed domain name <mothercare.in> currently for redirection to its website www.indiaparenting.net. The disputed domain name <mothercare.in> was merely parked until February 13, 2008 and did not have any contents. The redirection of the website to www.IndiaParenting.net was done only after filling of the Complaint. Mere parking or redirection will not amount to bonafide use of the disputed domain name <mothercare.in>. Redirection is employed to attract the attention of the internet users of imperfect recollection. Redirection misleads and diverts the consumers/clients of the Complainant to the Respondent's web site www.IndiaParenting.net. It is

nothing but encashing the well known reputation and goodwill earned by the Complainant's trade mark Mothercare. The Respondent has not established any cause or justification whatsoever for adopting the disputed domain name <mothercare.in>. The Respondent did not explain why he needed a redirection in the first instance and the reason for choosing the disputed domain name <mothercare.in> for that purpose.

6.14 By adopting the disputed domain name <mothercare.in>, the Respondent denied the Complainant from bona fide using a domain name reflecting his well known trade mark Mothercare. It is an opportunistic act and disrupting the Complainant's business.

6.15 The Complainant mentioned in his Complaint that the Respondent was restrained from using the mark Indiarenting in any manner whatsoever by an arbitration award dated October 5, 2006 in respect of the domain name www.indiarenting.in . The Complainant has also sent a copy of the award.

6.16 An arbitrator appointed under the .IN Domain Name Dispute Resolution Policy (INDRP) can either cancel the registration or order transfer of the disputed domain name. He has no jurisdiction to grant any other relief, such as injunction. The relief of injunction can only be granted by a court of competent jurisdiction.

6.17 The Respondent in his reply to the rejoinder informed that he filed an appeal in OMP No.98 of 2007 against the award in respect of the domain name www.indiarenting.in before the Hon'ble High Court at Delhi and

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the execution of the award was stayed. He attached a copy of the stay order and the email correspondence between the Respondent and the complainant in the said dispute. The matter is pending before a higher forum and I restrain myself from going into the merits of the appeal.

6.18 I have carefully gone through the email correspondence sent by the Respondent to me in the light of this current arbitration. It is apparent from the emails that the Respondent habitually registers the domain names solely for monetary gain without any intention to use the same.

6.19 The actions of the Respondent should not be encouraged and should not be allowed to continue. The conduct of the Respondent has necessitated me to award costs of the Complaint to and in favour of the Complainant.

## **7 Decision**

7.1 For all the foregoing reasons, the Complaint is allowed as prayed for in the Complaint.

7.2 It is hereby ordered that the disputed domain name <mothercare.in> be transferred to the Complainant.

7.3 A sum of Rs.5,00,000/-(Rupees five lakhs only) is awarded to the Complainant towards the costs of the Complaint.

*Indharam S*  
*Arbitrator*