

ADMINISTRATIVE PANEL DECISION

Marks & Spencer PLC v. Hongxia Li
Case No. D2022-2613

1. The Parties

The Complainant is Marks & Spencer PLC, United Kingdom, represented by Stobbs IP Limited, United Kingdom.

The Respondent is Hongxia Li, China.

2. The Domain Name and Registrar

The disputed domain name <marksspencershop.com> is registered with Name.com, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 18, 2022. On July 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 20, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

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

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on July 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 19, 2022.

The Center appointed Federica Togo as the sole panelist in this matter on August 24, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is the registered owner of trademarks in several jurisdictions for MARKS & SPENCER, e.g., European Union trademark registration No. 000211078 MARKS & SPENCER (word) registered on September 23, 1999, for goods and services in classes 2, 3, 5, 8, 9, 11, 14, 16, 18, 20, 21, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, and 36. This trademark has been duly renewed and is in force.

The disputed domain name was registered on May 18, 2022, and resolves to a website displaying the Complainant's logo, and offering for sale clothing under the Complainant's trademarks and further reproducing the Complainant's copyrighted products images.

5. Parties' Contentions

A. Complainant

It results from the Complainant's undisputed allegations that the Complainant is a major British multinational retailer with headquarters in London, England, specialising in the retail of clothing, beauty, home, and food products. It is listed on the London Stock Exchange as a FTSE 250 Company. The Complainant was founded in 1884 by individuals Michael Marks and Thomas Spencer in Leeds, United Kingdom. As of 2020, the Complainant operates over 900 stores across the United Kingdom. It maintains a strong global presence, with over 400 locations outside of the United Kingdom.

The Complainant contends that its trademark MARKS & SPENCER is distinctive and well known all over the world.

The Complainant uses the domain name <marksandspencer.com> in order to promote its products and services.

The Complainant further contends that the disputed domain name is confusingly similar to the Complainant's earlier trademark, since it wholly incorporates the terms "Marks", "Spencer", which are the dominant and distinctive elements of the Complainant's trademark. The addition of the descriptive term "shop" does nothing to materially alter the impression of the disputed domain name in the eyes of an unsuspecting Internet user and in fact merely reinforces a connection between the disputed domain name and the Complainant.

The Complainant further contends that the Respondent has no rights or legitimate interests in the disputed domain name. According to the Complainant, because of the reputation of the Complainant's mark, there is no believable or realistic reason for registration or use of the disputed domain name other than to take advantage of the Complainant's rights. Since the disputed domain name resolves to a website displaying without authorization the Complainant's logo, utilizing the Complainant's copyrighted images and offering for sale clothing under the Complainant's trademarks, the Respondent has been using the disputed domain name for the purpose of luring consumers to (mistakenly) purchase unauthorized products from the website at the disputed domain name, placing the public at significant risk of phishing and cybercrime. The Complainant further submits that the Respondent's contact address is false as there is no building or business situated at the address stated. According to the Complainant, the Respondent's use of a false address was done intentionally to conceal its identity, and ability to be contacted around its nefarious use. Furthermore, the Respondent is not commonly known under the disputed domain name.

Finally, the Complainant contends that the disputed domain name was registered and is being used in bad faith. In view of the distinctive nature of the MARKS & SPENCER trademark on a global scale, there is no way in which the Respondent could use the disputed domain name without falling foul of paragraph 4(b) of the Policy. Because of the Respondent's subsequent use for the purposes of a website imitating the Complainant makes it simply improbable that the disputed domain name was registered without any knowledge of the Complainant and its MARKS & SPENCER brand.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs this Panel to “decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable”. Paragraph 4(a) of the Policy requires a complainant to prove each of the following three elements in order to obtain an order that the disputed domain name be transferred or cancelled:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the complainant must establish rights in a trademark or service mark, and that the disputed domain name is identical or confusingly similar to a trademark in which the complainant has rights.

It results from the evidence provided, that the Complainant is the registered owner of various MARKS & SPENCER trademarks.

Prior UDRP panels have found that a disputed domain name is confusingly similar to a complainant's trademark where at least a dominant feature of the relevant mark is recognizable in the domain name (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 1.7. This Panel shares this view and notes that the disputed domain name incorporates the dominant feature of the Complainant's trademark, *i.e.* “MARKS” and “SPENCER”, which is clearly recognizable in the disputed domain name. In addition, this is followed by the term “shop”, which is related to the Complainant's business activity. The addition of the term “shop” and the omission of the sign “&” (that is part of the Complainant's trademark, while not a dominant element) do not prevent a finding of confusing similarity between the disputed domain name and the Complainant's trademark since the Complainant's trademark is clearly recognizable in the disputed domain name (see [WIPO Overview 3.0](#) at section 1.8).

Finally, the generic Top-Level Domain (“gTLD”) “.com” of the disputed domain name is typically disregarded under the first element confusing similarity test (see [WIPO Overview 3.0](#) at section 1.11.1).

In the light of the above, the Panel finds that the disputed domain name is confusingly similar to a trademark in which the Complainants have rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests to the disputed domain name.

In the Panel's view, based on the undisputed allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

According to the Complaint, which has remained unchallenged, the Complainant has no relationship in any way with the Respondent and did, in particular, not authorize the Respondent's use of the dominant feature of the Complainant's trademark MARKS & SPENCER, e.g., by registering the disputed domain name comprising the dominant feature of said trademark entirely.

Furthermore, the Panel notes that there is no evidence showing that the Respondent might be commonly known by the disputed domain name in the sense of paragraph 4(c)(ii) of the Policy.

Moreover, the Panel notes that the disputed domain name contains the dominant feature of the Complainant's registered trademark MARKS & SPENCER and that trademark is not a trademark that one would legitimately adopt as a domain name unless to suggest an affiliation with the Complainant. The Panel finds it most likely that the Respondent selected the disputed domain name with the intention to take advantage of the Complainant's reputation by registering a domain name containing the dominant feature of the Complainant's trademark and trade name with the intent to attract Internet users for commercial gain (e.g. *OSRAM GmbH v. Private Registration, OK HOSTING SC*, WIPO Case No. [D2021-0600](#)).

Furthermore, the nature of the disputed domain name carries a risk of implied affiliation, since the disputed domain name contains the dominant feature of Complainant's trademark followed by the term "shop", which is related to the Complainant's business activity, see [WIPO Overview 3.0](#), section 2.5.1. This is also confirmed by the content of the website to which the disputed domain name resolves, displaying without authorization the Complainant's logo, utilizing the Complainant's copyrighted images and offering for sale clothing under the Complainant's trademarks.

It is acknowledged that once the panel finds a *prima facie* case is made by a complainant, the burden of production under the second element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name and the Respondent in the case at hand failed to come forward with any allegations or evidence, this Panel finds, in the circumstances of this case, that the Respondent has no rights or legitimate interests in the disputed domain name.

The Panel finds that the Complainant has therefore satisfied paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

According to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith. One of these circumstances is that the Respondent by using the disputed domain name, has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or location or of a product or service on its website or location (paragraph 4(b)(iv) of the Policy). It is the view of this Panel that these circumstances are met in the case at hand.

It results from the Complainant's documented allegations that the disputed domain name resolves to a website displaying the Complainant's logo, and offering for sale clothing under the Complainant's trademarks and further reproducing the Complainant's copyrighted products images.

For the Panel, it is therefore evident that the Respondent positively knew the Complainant's mark. Consequently, and in the absence of any evidence to the contrary, the Panel is convinced that the

Respondent also knew that the disputed domain name included the dominant feature of the Complainant's trademark when it registered the disputed domain name. This is underlined by the fact that the disputed domain name is clearly constituted by the dominant feature of the Complainant's trademark followed by the term "shop". Registration of a disputed domain name which contains a third party's mark, in awareness of said mark and in the absence of rights or legitimate interests amounts to registration in bad faith (see e.g., *FLRish IP, LLC v. Leonard Rotich*, WIPO Case No. [D2022-1706](#)). In the circumstances of this case, the Panel finds that the registration of the disputed domain name was in bad faith.

Finally, the further circumstances surrounding the disputed domain name's registration and use confirm the findings that the Respondent has registered and is using the disputed domain name in bad faith (see [WIPO Overview 3.0](#) at section 3.2.1):

(i) the nature of the disputed domain name (a domain name incorporating the dominant feature of Complainant's mark plus the addition of the term "shop");

(ii) the content of the website to which the disputed domain name directs, displaying the Complainant's logo, and offering for sale clothing under the Complainant's trademarks and further reproducing the Complainant's copyrighted products images;

(iii) a clear absence of rights or legitimate interests coupled with no credible explanation for the Respondent's choice of the disputed domain name;

(iv) the Respondent seems to have provided false or incomplete information for purposes of registering the disputed domain name.

In light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith pursuant to paragraph 4(a)(iii) of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <marksspencershop.com> be transferred to the Complainant.

/Federica Togo/

Federica Togo

Sole Panelist

Date: September 9, 2022