



**(Hong Kong Office)**

**ADMINISTRATIVE PANEL DECISION**

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<b>Case No.</b>	HK-1600879
<b>Complainant:</b>	Pala Investments Limited
<b>Respondent:</b>	Roger B. Patterson
<b>Disputed Domain Name:</b>	<palainvest.com>

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**1. The Parties and Contested Domain Name**

The Complainant is Pala Investments Limited, of 12 Castle Street, St. Helier, Jersey JE2 3RT, United Kingdom.

The Respondent is Roger B. Patterson, of 4090 Better Street, Kansas City 66215, United States of America.

The domain name at issue is <palainvest.com>, registered by Respondent with ERANET INTERNATIONAL LIMITED, of Unit 2, 7/F, Trans Asia Centre, 18 Kin Hong Street, Kwai Chung, New Territories, Hong Kong.

**2. Procedural History**

The Complaint was received by the Hong Kong office of the Asian Domain Name Dispute Resolution Centre (the “Centre”) on 30 June 2016, and its receipt was acknowledged on 4 July 2016. On 4 July 2016, the Centre sent an email to the Registrar, ERANET INTERNATIONAL LIMITED, requesting verification of the registrant of the disputed domain name. The request was sent for a second time on 14 July 2016. The Registrar replied on 19 July 2016 by email to the Centre confirming that the Respondent is listed as the registrant of the disputed domain name and providing the registrant contact details.

On 19 July 2016, pursuant to the Policy, Article 4 of the Rules and Article 6 of the Supplemental Rules, a Notification of the Commencement of the Proceedings was sent to the Respondent by email and requested the Respondent to submit a Response within 20 calendar days. The Respondent failed to submit a Response within the required period of time. The Centre notified the Respondent’s default on 9 August 2016.

Having received a Declaration of Impartiality and Independence and a Statement of Acceptance from Prof (For your consideration: to be consistent with the confirmation of panelist notice sent to parties on 11 Aug 2016) ZHAO Yun, the Centre notified the parties of the appointment of Prof ZHAO Yun as the sole panelist on 11 August 2016. The Panel

determines that the appointment was made in accordance with Rule 6 and Articles 8 and 9 of the Supplemental Rules. On 11 August 2016, the Panel received the file from the Centre and should render the Decision within 14 days.

### **3. Factual background**

#### **The Complainants**

The Complainant in this case is Pala Investments Limited. The registered address is 12 Castle Street, St. Helier, Jersey JE2 3RT, United Kingdom. The authorized representative for the Complainant is Bird & Bird.

#### **The Respondent**

The Respondent in this case is Roger B. Patterson. The registered address is 4090 Better Street, Kansas City 66215, United States of America. The Respondent registered the disputed domain name <palainvest.com> with the Registrar, ERANET INTERNATIONAL LIMITED, on 7 April 2016.

### **4. Parties' Contentions**

#### **A. Complainant**

The Complainant's contentions may be summarized as follows:

The Complainant is the registered owner of at least 75 "PALA" trade marks globally (including word marks and combined marks)) (collectively referred to as the "PALA Marks"). In addition, the Complainant is also the registrant of the domain name <pala.com>, which was created on 15 October 1997 (the Complainant's Domain Name). The PALA Mark is well recognized in the mining investment industry and has invested in 86 companies in 25 countries across six continents since 2006. The Complainant's Domain Name incorporates the PALA Marks and such marks are also used on the websites associated to the Complainant's Domain Name (the "Complainant's Website").

- i. The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The above shows that the Complainant has rights and interests in the PALA Marks. The Complainant submits that for the purpose of considering whether the Disputed Domain Name is identical or confusingly similar to the PALA Marks, the generic Top-Level Domain (gTLD) suffix ".com" element of the Disputed Domain Name should be disregarded as it is non-descriptive and merely instrumental to the use of the Disputed Domain Name on the internet.

Furthermore, while the Complainant has a number of registrations for "PALA" as a word mark, the Complainant also owns other combination marks which contain both graphic and word elements. When considering whether the Disputed Domain Name is identical or confusingly similar to such combination marks, the graphic elements should not be considered, as they are incapable of being reproduced in a domain name.

The Complainant submits that the second-level portion of the Disputed Domain Name, "PALAINVEST" is the identifying element of the Disputed Domain Name, which consists of

two words, namely “PALA” and “INVEST”. The first part of the identifying element is “PALA”, which is identical to the word elements in the Complainant’s PALA Marks. The Disputed Domain Name incorporates the Complainant’s PALA Marks in its entirety.

The second part of the identifying element “INVEST”, which is the only difference between the Disputed Domain Name and the Complainant’s PALA Mark, refers to the services protected by the Complainant’s PALA Marks registration. The Complainant submits that the word “INVEST” does not sufficiently distinguish the Disputed Domain Name from the Complainant’s PALA Marks or negate the confusing similarity between the two. In fact, the addition of the word “INVEST” increases the risk of confusion, as the word “INVEST” suggests the associated websites of the Disputed Domain Name (the “Respondent’s Websites”) is related to investment related services – which are the same services offered by the Complainant. Therefore, “PALA” is the distinctive and prominent component of the Disputed Domain Name.

It is well-established that in cases where the distinctive and prominent element of a domain name is identical to the complainant’s mark and the only addition is a generic term that adds no distinctive element, such an addition does not negate the confusing similarity between the domain name and the mark.

Further, according to trade mark principles, the likelihood of confusion must be appreciated globally, taking into account all relevant circumstances. A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods or services. Also, the more distinctive an earlier mark, the greater the likelihood of confusion will be. Given the above, the Complainant submits that the combination of the element “PALA” (which is identical to the Complainant’s distinctive PALA Marks) and the element “INVEST” (which is identical to the investment services offered by the Complainant) would render the Disputed Domain Name to be considered highly confusing with the Complainant.

- ii. The Respondent has no rights or legitimate interests in respect of the domain name(s):

The Complainant submits that none of the circumstances set out in Paragraph 4(c) of the Policy can be satisfied by the Respondent and the Respondent has no right or legitimate interests in the Disputed Domain Name.

The Respondent is unable to show that before notice of the dispute, it has used or prepared to use the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services.

The Complainant submits that the contents on the Respondent’s Websites are direct copies of the Complainant’s Websites, except for the contact information on the “Contact” page (<<http://www.pala.com/en/contact.html>>) and the latest news published on the “Pala News” page (<<http://www.pala.com/en/news.html>>). The Complainant submits that all of the copyright in the photos, text and design displayed on the Complainant’s Websites are owned by the Complainant (the current interface of the Complainant’s Websites went online in August 2014), which is prior to the launch of the Respondent’s Websites. Accordingly, the Respondent must have copied the content from the Complainant’s Websites.

The Complainant submits that the Respondent should have been well aware of the Complainant’s rights in the PALA Marks at the time the Disputed Domain Name was registered,

particularly because the PALA Marks had been used extensively prior to the date of registration of the Disputed Domain Name.

Furthermore, the Respondent should have been well aware of the Complainant's rights in the PALA Marks at the time the Disputed Domain Name was registered, particularly because the PALA Marks had been used extensively prior to the date of registration of the Disputed Domain Name.

Furthermore, the Respondent should have been well aware of the Complainant and its rights in the PALA Marks at the time the Disputed Domain Name was registered, particularly because the Complainant has registered all the PALA Marks and had been using them extensively prior to the date of registration of the Disputed Domain Name (7 April 2016).

It is also evident that the Respondent was aware of the Complainant at the time the Disputed Domain Name was registered due to the incorporation of the word "INVEST" in the Disputed Domain Name, as "PALA" is a distinctive and well-known trade mark for the investment services and "INVEST" is descriptive of investment related services.

The Complainant further submits that the Respondent has registered and used the Disputed Domain Name to perpetrate a criminal scam, whereby the Complainant has received complaints from victims in Australia reporting the Respondent has used the Disputed Domain Name to pretend that it is the Complainant. In particular, alleged victims stated that the Respondent has been contacting them by email and phone, purporting to invite potential candidates to apply for a job at the Complainant or even offering them the job. Victims were asked to provide their personal and banking information as part of the recruitment process, presumably in order to defraud them. The website referred in such phishing emails is the Disputed Domain Name, and the victims also received job description documents, job offer letters and employment contracts bearing the Complainant's PALA Marks. As mentioned above, the Respondent's Websites display identical graphics, which are also identical to the look and feel of the Complainant's Websites, but replaced the Complainant's contact information with some other contact details, presumably the Respondent's contact information. The Respondent's Websites are used as a phishing tool in the Respondent's criminal scam, and was clearly created to mislead and deceive internet users. Given the above, such use of the Disputed Domain Name by the Respondent cannot conceivably constitute a bona fide offering of goods or services.

The Respondent (so far as can be ascertained) neither owns nor would the Respondent be expected to own, any registered trade marks which are identical, similar or related to the Disputed Domain Name, and nor does the Respondent appear to be commonly known by the Disputed Domain Name or use the Disputed Domain Name or a name corresponding to the Disputed Domain Name. Therefore, the Respondent does not have any rights or legitimate interest to "PALA" or "PALAINVEST".

The Respondent is not affiliated with or related to the Complainant, and there exists no other relationship between the Complainant and the Respondent that would give rise to any license, permission or authorization by which the Respondent could own or use the Disputed Domain Name which incorporates the Complainant's PALA Marks. Under such circumstances, the Respondent cannot show legitimate rights or interests in the Disputed Domain Name.

It is clear that the Respondent cannot rely on paragraph 4(c)(iii) of the Policy as it is obvious from the content of the Respondent's Websites, it is not making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the PALA Marks. The content of the Respondent's Websites is clearly commercial in nature in furtherance of the Respondent's illegal scams. Such illegal activities cannot be the basis of making a legitimate noncommercial or fair use of the domain name.

- iii. The disputed domain name(s) has/have been registered and is/are being used in bad faith:

The Complainant submits that it cannot be a coincidence that the Respondent's Websites looks virtually identical to the Complainant's Websites. The Respondent's Websites display identical photos and texts displayed on the Complainant's Websites and trade marks owned by the Complainant. As the Respondent registered the Disputed Domain name well after the Complainant registered and began using the Complainant's PALA Mark, Websites and Domain Name, it is more than likely that the Respondent was well aware of the Complainant when it registered the Disputed Domain Name.

The similarity between the Disputed Domain Name and the Complainant's PALA Mark raises the preliminary assumption that the domain name has been registered for some illegitimate purpose. Together with the identical contents on the Respondent's Websites, the Respondent obviously intended to give the impression that the Respondent Websites are held, controlled by, or somehow affiliated or related to the Complainant.

According to the evidence presented above, the Disputed Domain Name has been used by the Respondent to perpetrate a criminal scam. The essence of the scam is the Respondent replicated the Complainant's Websites to the Disputed Domain Name, holding itself out as the Complainant and in particular to create false emails pretending that they are genuine invitations coming from the Complainant. These false emails targeted potential job applicants, to invite them to apply for vacant job posts and provide their banking information to the Respondent as part of the recruitment process.

It is further submitted that the Respondent intentionally attempts to attract, for commercial gain, internet users to the Respondent's Websites, by creating a likelihood of confusion with the Complainant's PALA Marks on the Respondent's Websites, because the Respondent made both the Disputed Domain Name and the Respondent's Websites look very similar to the Complainant's Websites to divert internet users from the Complainant. Therefore, under paragraph 4(b)(iv) of the Policy, the Disputed Domain Name is registered and being used in bad faith.

Moreover, the Respondent purposefully replacing the Complainant's contact information with its own on the Respondent's Websites, while copying all the other contents directly from the Complainant's Websites proves the Respondent is attempting to divert those who are looking to contact the Complainant to the Respondent in bad faith.

The Respondent's conduct shows that it has been using the Disputed Domain Name as the origin of the phishing emails by making it appear as if the phishing emails originated from the Complainant.

It further shows the registration of the Disputed Domain Name was for the purpose of disrupting the business of the Complainant. Such a scam inevitably damages the goodwill of the Complainant and incurs a considerable waste of time and money in unrevealing the scam and its consequences, all of which are disruptive of the business of the Complainant. It is well established that the registration and the use of a domain name in connection with a fraudulent phishing scheme constitutes bad faith under the Policy. The Complainant submits that the whole of the modus operandi of the Respondent was fraudulent, showing that the registration and use of the Disputed Domain Name were in bad faith.

The Complainant requests that the disputed domain name be transferred to the Complainant.

#### B. Respondent

The Respondent failed to submit a Response within the specified time period.

### 5. Findings

The ICANN Uniform Domain Name Dispute Resolution Policy provides, at Paragraph 4(a), that each of three findings must be made in order for a Complainant to prevail:

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

#### A) Identical / Confusingly Similar

The Complainant is an English private equity and a venture capital investment and advisory firm with a particular focus on the mining sector. Evidence shows that the Complainant has registered "PALA" as its trademark in many countries. The earliest trademark was registered in 2007, much earlier than the registration date of the disputed domain name, i.e. 7 April 2016. The trademark is still within the protection period. The Panel has no problem in finding that the Complainant enjoys the prior trademark right over "PALA".

The disputed domain name "palainvest.com" ends with ".com", this suffix only indicates that the domain name is registered under this gTLD and ".com" is not distinctive. Thus, we only need to examine the main part of the disputed domain name.

The main part ("palainvest") of the disputed domain name consists of two sub-parts, "pala" and "invest". Obviously, the first sub-part ("pala") is identical to the Complainant's trademark "PALA". The second sub-part ("invest"), a generic English term, is exactly the investment service registered and provided by the Complainant under the trademark "PALA". This second sub-part is thus not distinctive. The addition of "invest" to the Complainant's trademark "PALA" does not differentiate the main part of the disputed domain name from the Complainant's trademark; with "invest" being the main services provided by the Complainant, such an addition, on the contrary, strengthens the connection between the disputed domain name and the Complainant's trademark. Therefore, the disputed domain name is confusingly similar to the Complainant's trademark "PALA".

Accordingly, the Panel holds that the Complaint fulfills the condition provided in Paragraph 4(a)(i) of the Policy.

### **B) Rights and Legitimate Interests**

The Complainant contends that the Respondent does not have rights to or legitimate interests in the disputed domain name. The Complainant has never authorized the Respondent to use the trademark or the domain name. The Complainant's assertion is sufficient to establish a *prima facie* case under Policy 4(a)(ii), thereby shifting the burden to the Respondent to present evidence of its rights or legitimate interests.

The Respondent has failed to show that the Respondent has any rights or legitimate interests in respect of the disputed domain name. No evidence has shown that the Respondent is using or plans to use the domain name for a *bona fide* offering of goods or services. The Respondent is not commonly known by the domain name. The evidence submitted by the Complainant further shows that the Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. The act of registering the disputed domain name does not automatically endow any legal rights or interests with the Respondent.

The Panel therefore finds that the Complaint fulfills the condition provided in Paragraph 4(a)(ii) of the Policy.

### **C) Bad Faith**

Under Paragraph 4(b) of the Policy, the following are relevant examples a Panel may take as evidence of registration and use in bad faith:

- (i) Circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) You have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or
- (iii) You have registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) By using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.

The Complainant is an English private equity and a venture capital investment and advisory firm established in 2006. The Complainant has registered "PALA" as its trademarks in many countries from 2006 and created an official domain name <pala.com> in 1997 for its business. All these registrations are earlier than the registration date of the dispute domain name, i.e. 7 April 2016. The trademark "PALA", not a generic English word, has been used to promote the Complainant's business in the mining investment industry.

The evidence shows that the website of the disputed domain name is almost identical to the Complainant's website <pala.com>, displaying identical photos and texts from the

Complainant's website. The only differences only lie in the contact information and some news report. The public can be easily misled to believe that this website belongs to, or has affiliation with, the Complainant.

The evidence further shows that the Respondent has been contacting relevant people through email and phone regarding possible positions at the Complainant. The above acts is exactly the type of bad faith use of the disputed domain name as identified in Paragraph 4(b)(iv) of the Policy, i.e. the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website or other on-line location, by creating a likelihood of confusion with the Complainant's trademark as to source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

Accordingly, the Panel finds that the Complaint satisfies the condition provided in Paragraph 4(a)(iii) of the Policy.

## **6. Decision**

Having established all three elements required under the ICANN Policy, the Panel concludes that relief should be granted. Accordingly, it is ordered that the disputed domain name <palainvest.com> be transferred from the Respondent to the Complainant.

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ZHAO Yun  
Panelist

Dated: 23 August 2016