



(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

Case No.	HK-2301803
Complainant:	Jardine Matheson Holdings Limited; Jardine Matheson (Bermuda) Limited
Respondent:	Herald Elbow
Disputed Domain Name(s):	<jardine-matheson.net>

1. The Parties and Contested Domain Name

The Complainants are Jardine Matheson Holdings Limited; Jardine Matheson (Bermuda) Limited of Jardine House, 33-35, Reid Street, Hamilton, Bermuda (together the “Complainants”).

The Respondent Herald Elbow of Alaniya, TR 74839. Main street 42.

The domain name at issue is <jardine-matheson.net> (the “Domain Name”), registered by Respondent with Hosting Ukraine LLC, of PO Box 65, Kiev, 04112, UA (the “Registrar”).

2. Procedural History

The Complaint was filed with the Asian Domain Name Dispute Resolution Centre (the “Centre”) on September 5, 2023. On the same day, the Centre confirmed receipt of the Complaint and transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 11, 2023, the Registrar transmitted by email to the Centre its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Privacy Protection, Hosting Ukraine LLC) and contact information in the Complaint. The Centre sent an email communication to the Complainants on September 19, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on September 22, 2023.

The Centre verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the ADNDRC Supplemental Rules for Uniform Domain Name Dispute Resolution Policy effective from August 21, 2023 (the “Supplemental Rules”).

Under Paragraphs 2 and 4 of the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on September 22, 2023. Under Paragraph 5 of

the Rules, the due date for filing a Response by the Respondent was October 12, 2023. The Respondent submitted no response by this deadline date. The Centre confirmed in an email to the parties that it did not receive a Response Form from the Respondent within the required time on October 13, 2023.

The Centre appointed Olga Zalomyi as the sole panelist in this matter on October 13, 2023. The Panel finds it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Centre to ensure compliance with the Rules, Paragraph 7.

3. Factual background

The 1st Complainant, Jardine Matheson Holdings Limited, is the holding company of the Jardine Matheson Group which a multinational conglomerate. The 2nd Complainant is a subsidiary of the 1st Complainant and the registrant of various intellectual property rights of the Jardine Matheson Group, including its trademarks. The Complainants own numerous registrations for its JARDINE MATHESON trademark, such as:

- the France trademark registration No. 1279586 for the JARDINE MATHESON trademark, registered on July 20, 1984.
- the United Kingdom. trademark registration No. 1348071 for the JARDINE MATHESON trademark, registered on August 23, 1991;
- the Hong Kong trademark registration No. 199505642AA for the JARDINE MATHESON trademark, registered on March 2, 1992.

The Respondent registered the Domain Name on August 14, 2023. The Domain Name used to direct to a website designed to look like it is associated or authorized by the Complainants. The website under the Domain Name displayed a Complainants' corporate logo, a logo of one of the members the Jardine Matheson Group and Complainants' photographs. Layout of the website was similar to that of the official website of the Complainants. The website under the Domain Name was disabled after the Complainants filed the Complaint with the Centre.

4. Parties' Contentions

A. Complainants

The Complainants' contentions may be summarized as follows:

- i. The Complainants assert that the Domain Name is identical to the Complainants' JARDINE MATHESON trademark because the Domain Name incorporates the Complainants' JARDINE MATHESON trademark in its entirety. The Complainants allege that the addition of a hyphen between the words JARDINE and MATHESON in the Domain Name does not detract from the confusing similarity. The Complainants contend that the addition of the generic Top-Level Domain ("gTLD") ".net" is viewed as a standard registration requirement and, as such, is disregarded under the confusing similarity test.
- ii. The Complainants allege that the Respondent has no rights or legitimate interests in the Domain Name because the Complainants did not authorize or permitted the Respondent or anyone outside of the Jardine Matheson Group to use the JARDINE MATHESON trademark to register any domain names. The

Complainants assert that their search of the Global Trademark Database did not reveal any trademarks corresponding to the Domain Name owned by the Respondent. The Complainants contend that the Respondent is not commonly known by the Domain Name because his name differs from the Domain Name. The Complainants contend that the Respondent has no other rights in the Domain Name because it has been using the Domain Name to mislead customers into believing that the Respondent's website is associated with the Complainants' websites.

- iii. The Complainants allege that the Respondent registered the Domain Name in bad faith because it registered the Domain Name with the knowledge of the Complainants' trademark and the Complainant's business. The Complainants contend that the Respondent is using the Domain Name in bad faith because the Domain Name directs to a website that reproduces the Complainants' names, trademarks, information and photographs. The Respondent used the Domain Name to collect personal information and payment information of Internet users who attempted to register accounts at the website under the Domain Name. The Complainants allege that the Respondent disabled the website under the Domain Name shortly after they filed the Complaint in the present case and claim that the Respondent moved content of the website under the Domain Name to a website under a recently registered domain name that also infringes on the Complainants' rights.

B. Respondent

The Respondent did not reply to the Complainants' contentions.

5. Findings

It is a consensus view among UDRP panelists that “[a] respondent's default does not automatically result in a decision in favor of the complainant... [T]he complainant must establish each of the three elements required by paragraph 4(a) of the UDRP.”¹ A panel may draw inferences from a respondent's default.²

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

To satisfy the first UDRP element, a domain name must be “identical or confusingly similar” to a trademark, in which a complainant has rights.

The Complainants have established their rights in the JARDINE MATHESON trademark by submitting copies of JARDINE MATHESON trademark registrations. Pursuant to

¹ Paragraph 4.2., WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”)

² Paragraph 4.3., WIPO Overview 3.0.

section 1.2.1 of the WIPO Overview 3.0, “[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case”. Therefore, the Complainants satisfied the UDRP standing requirement.

“Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.”³ It is well-established, that the applicable gTLD should be disregarded under the confusingly similarity test as a standard registration requirement.⁴

Here, the Domain Name consists of the Complainants’ JARDINE MATHESON trademark, a hyphen between the words comprising the Complainants’ mark and the gTLD “.net”. Because the Complainants’ JARDINE MATHESON trademark is recognizable within the Domain Name, the inclusion of the hyphen does not detract from confusing similarity. The gTLD “.net” is disregarded from the assessment of confusing similarity as a standard registration requirement. Therefore, the Domain Name is confusingly similar to the Complainants’ JARDINE MATHESON trademark.

Thus, the first element of the UDRP has been satisfied.

B) Rights and Legitimate Interests

Under the second UDRP element, a complainant must make a *prima facie* case in respect of the lack of rights or legitimate interests of the respondent⁵.

Pursuant to paragraph 4(c) of the UDRP, the following may demonstrate rights or legitimate interests in the Domain Name:

- (i) before any notice of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Based on the evidence submitted, the Panel finds the following:

First, the Complainants have not authorized or licensed the Respondent to use the Complainants’ JARDINE MATHESON trademarks in any manner.

Second, the Respondent is not commonly known by the Domain Name, which supports finding of a lack of rights or legitimate interests.

³ Section 1.8., WIPO Overview 3.0.

⁴ Section 1.11.1, WIPO Overview 3.0.

⁵ Section 2.1, WIPO Overview 3.0.

Third, the Respondent's unauthorized use of the Complainants' JARDINE MATHESON trademark, its use of the Complainants' contact information and photographs do not result in rights or legitimate interest of the Respondent, because the Respondent is trying to pass off its website as the Complainants' website or as a website affiliated with the Complainants. Passing off activities have been consistently held to demonstrate a lack of rights or legitimate interests under the UDRP⁶.

Fourth, the Respondent is currently passively holding the Domain Name, which does not constitute use of the Domain Name in connection with bona fide offering of goods or services.

Based on the above, the Panel therefore, finds that the Complainant has made out *the prima facie* case and the burden of producing evidence demonstrating it has rights or legitimate interests in the Domain Name has shifted to the Respondent⁷. Since the Respondent failed to present any rebutting evidence, the Complainant is deemed to have satisfied the second element of the UDRP.⁸

C) Bad Faith

Under the third UDRP element, the Complainants are required to prove that the Domain Name was registered and is being used in bad faith.

It is likely that that the Respondent registered the Domain Name in full knowledge of the Complainants' rights because the Domain Name used to direct to the website displaying the Complainants' trademarks, photographs and contact information. Prior UDRP panels have held that actual knowledge of a complainant's rights at the time of registration of a domain name constitutes strong evidence of bad faith. See *Playboy Enterprises International, Inc. v. John Hanley*, WIPO Case No. D2014-0618 (<mrplayboy.com>): "Prior panels have found that knowledge, actual or inferred, of a strong mark is evidence of registration in bad faith."

The Respondent's registration and use of the Domain Name constitute bad faith under paragraph 4(b)(iv) of the Policy, because the Respondent has used the Domain Name to intentionally attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainants' JARDINE MATHESON mark as to the source, sponsorship, affiliation, and/or endorsement of the Domain Name, the Respondent's website. Prior Panels have consistently held that seeking to cause confusion for respondent's commercial benefit constitute evidence for respondent's intentional attempt to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's mark.⁹ Here, the Respondent's prior use of the Domain Name presents such evidence. The Respondent used the Domain Name to direct to a website that was designed to look like the Complainants' website and was used for phishing by trying to collect personal and financial information of Internet users. A screenshot of the Respondent's website associated with the Domain Name shows that to register for a website account, a user was supposed to submit a monetary deposit at the time of the registration.

⁶ Section 2.13, WIPO Overview 3.0.

⁷ Section 2.1, WIPO Overview 3.0.

⁸ *Id.*

⁹ Section 3.1.4, WIPO Overview 3.0

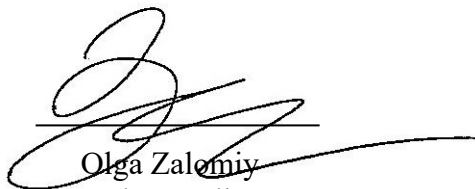
Currently, the Domain Name is passively held. Section 3.3 of the WIPO Overview 3.0 describes the circumstances under which the passive holding of a domain name will be considered to be in bad faith: “While panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put.”

Such circumstances are present in this case. There is no evidence in the record of a legitimate use of the Domain Name. The Complainant’s trademark is distinctive and widely used in commerce. The Respondent used false contact details to register the Domain Name. The Respondent failed to submit a response providing evidence of any good actual or contemplated good faith use. Finally, The Respondent’s prior use of the Domain Name makes improbable any good faith use of the Domain Name. Based on the aforementioned, passive holding of the Domain Name does not prevent a finding of bad faith

Therefore, the Panel finds that the Domain Name was registered and is being used in bad faith. The third element of the UDRP has been satisfied.

6. Decision

Under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the Domain Name <jardine-matheson.net> be transferred to the 2nd Complainant- Jardine Matheson (Bermuda) Limited.



Olga Zalomiy
Sole Panelist

Dated: 24 October 2023