

## Decision for dispute CAC-UDRP-105031

Case number CAC-UDRP-105031

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Domain names manulifegroup.com

### Case administrator

Organization Iveta Špiclová (Czech Arbitration Court) (Case admin)

### Complainant

Organization The Manufacturers Life Insurance Company

### Complainant representative

Organization Microsoft Corporation

### Respondent

Name Tyler Kacsor

#### OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

#### IDENTIFICATION OF RIGHTS

Complainant is the owner of a family of MANULIFE trademark registrations worldwide (both with and without design or stylized elements), including:

- Canadian Reg. No. TMA385240, registered on May 31, 1991;
- United States Reg. No. 74094413, registered on August 31, 1993;
- European Reg. No. 000540989, registered on July 9, 1999;
- European Reg. No. 014106256, registered on October 30, 2015.

The disputed domain name <manulifegroup.com> was registered on April 24, 2023.

#### FACTUAL BACKGROUND

##### FACTS ASSERTED BY THE COMPLAINANT AND NOT CONTESTED BY THE RESPONDENT:

Complainant is a wholly-owned subsidiary of Manulife Financial Corporation ("Manulife") and a leading Canadian-based

financial services company that offers a diverse range of financial protection products and wealth management services. Manulife is a leading international financial services group with principal operations in Asia, Canada, and the United States, where it has served customers for more than 155 years.

Serving tens of millions of customers with over a trillion U.S. dollars in assets under management and administration, Complainant's MANULIFE brand has received widespread media and industry recognition, including by Interbrand as one of the Best Canadian Brands. Manulife has been repeatedly ranked at the top spot among Canadian insurers on the Forbes list of the World's Best Employers.

Respondent created the disputed domain name at 2023-04-24T18:10:23Z according to the registrar's Whois verification response and the disputed domain name redirects Internet traffic to Complainant's official website. Therefore, the Respondent lacks rights or legitimate interests in the disputed domain name under Policy paragraph 4(a)(ii). See *Altavista Co. v. Brunosousa*, WIPO Case D2002-0109 (holding that the respondent was attempting to build up "mistaken confidence" in the disputed domain name by having it resolve to the complainant's official website and that "an unconnected party has no right or legitimate interest to use an otherwise deceptive trademark, name or indicia to redirect Internet traffic, even if it is directed to the legitimate owner of the trademark").

### **First UDRP Element - Confusing Similarity**

The disputed domain name incorporates the registered mark MANULIFE and appends the generic identifier "Group." The applicable Top Level domain is a standard registration requirement and, as such, is generally disregarded. [§ 1.11.1 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (WIPO Jurisprudential Overview 3.0)].

The MANULIFE mark is recognizable with the disputed domain name, and the generic identifier word appended even relates explicitly to the Complainant's leading international financial services group covered by the MANULIFE registered mark. Therefore, Complainant satisfies the requirements of paragraph 4(a)(i) of the Policy in establishing its rights in MANULIFE and demonstrating that the disputed domain name is confusingly similar per the Policy element. [§ 1.7. of WIPO Jurisprudential Overview 3.0].

### **Second UDRP Element - No Legitimate Interest**

The Complainant has not authorized the Respondent to use its name or marks, and the Respondent cannot show it is legitimately known by the disputed domain name. Based on the evidence, the Respondent is likely using the disputed domain name for illegal activity consisting of sending fraudulent emails impersonating the Complainant, which Panels have categorically held can never confer rights or legitimate interests on a respondent. [§ 2.13 of WIPO Jurisprudential Overview 3.0].

Specifically, the Complainant received a report that someone is masquerading as a Director of Global Procurement Strategy for Complainant using the e-mail "bowen.liu@manulifegroup.com" on the Disputed domain name).

Furthermore, the Respondent set up mail records with Google on the disputed domain name:

- manulifegroup.com. 3600 IN MX 10 alt3.aspmx.l.google.com.
- manulifegroup.com. 3600 IN MX 10 alt4.aspmx.l.google.com.
- manulifegroup.com. 3600 IN MX 5 alt1.aspmx.l.google.com.
- manulifegroup.com. 3600 IN MX 5 alt2.aspmx.l.google.com.
- manulifegroup.com. 3600 IN MX 1 aspmx.l.google.com.

Any e-mails spoofing Complainant sent from the disputed domain name or replies to Respondent sent to the disputed domain name would likely be intended for Complainant. There is no legitimate interest in confusing people into mistakenly thinking they are communicating with Complainant through a mailbox under Respondent's control or management.

Accordingly, the Respondent does not have rights or legitimate interest in the disputed domain name under the second element of the Policy.

### Third UDRP Element - Registered and Used in Bad Faith

It is well established that the mere registration of a domain name that is confusingly similar to a trademark by an unaffiliated entity can lead to the presumption of bad faith.

Manulife is a leading international financial services group with principal operations in Asia, Canada, and the United States, where it has served customers for more than 155 years. The Respondent likely registered the disputed domain name to commit fraud. Someone claimed to have received an email from the disputed domain name with a signature purporting to come from Complainant's Director of Global Procurement Strategy.

Respondent is presumed to have knowledge of Complainant's registered marks and reputation because the disputed domain name incorporates Complainant's registered MANULIFE mark in its entirety.

Setting up mail records on the disputed domain name to spoof Complainant in emails and re-enforce the deception by redirecting the website on the disputed domain name to Complainant's site is bad faith registration and use per the Policy.

Some Panels have held that merely registering the disputed domain name "in spite of actual or constructive knowledge amounts to bad faith registration and use pursuant to [UDRP] Policy paragraph 4(a)(iii)."

For all the preceding reasons, the disputed domain name was likely registered and is being used in bad faith under the third element of the Policy.

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#### PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

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#### RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

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#### NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

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#### BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

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#### PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

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#### PRINCIPAL REASONS FOR THE DECISION

For the Complainant to succeed it must prove, within the meaning of paragraph 4(a) of the Policy, that:

- I. The 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 domain name; and
- III. The domain name has been registered and is being used in bad faith.

### **I. Identical or Confusingly Similar**

The Complainant has established the fact that it has valid rights for the MANULIFE trademark registrations

- Canadian Reg. No. TMA385240, registered on May 31, 1991;
- United States Reg. No. 74094413, registered on August 31, 1993;
- European Reg. No. 000540989, registered on July 9, 1999;
- European Reg. No. 014106256, registered on October 30, 2015.

The disputed domain name <manulifegroup.com> was registered on April 24, 2023, i.e. more than 30 years after the first of the above mentioned MANULIFE trademark registrations, and fully incorporates the Complainant's trademark MANULIFE in its first part. It is therefore confusingly similar to the trademark for purposes of UDRP (WIPO Jurisprudential Overview 3.0, Section 1.7).

The generic term "GROUP" is non-distinctive and its addition does not prevent the disputed domain name from being confusingly similar to the Complainant's trademarks. The addition of the generic top-level domain ".COM" does not change the overall impression of the designation as being connected to Complainant's trademark.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name <manulifegroup.com> within the meaning of paragraph 4(a)(ii) of the Policy.

### **II. Rights or Legitimate Interests**

As stated in the WIPO Jurisprudential Overview 3.0 at Section 2.1, while the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the often impossible task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element.

The Complainant has established a prima facie case (not challenged by the Respondent who did not file any response to the complaint) that the Respondent has no rights or legitimate interests in the disputed domain name.

The disputed domain name resolves to the Complainant's website <manulife.ca>, but as stated in *Altavista Co. v. Bruno Sousa*, WIPO Case D2002-0109, an "unconnected party has no right or legitimate interest to use an otherwise deceptive trademark, name or indicia to redirect Internet traffic, even if it is directed to the legitimate owner of the trademark ... such an owner of rights should be able to control how such trademarks, names and indicia are used in the course of trade and when so used to control who is directed to its website and by whom".

There is no available evidence that the Respondent is engaged in, or have engaged in any activity or work, i.e. legitimate or fair use of the disputed domain name, that demonstrates a legitimate interest in the disputed domain name.

There is further no evidence, that the Respondent is known by the disputed domain name or that it has a legitimate interest over the disputed domain name. It has not been proved by the Respondent that he has rights or legitimate interests in the disputed domain name or the Respondent is related with the Complainant. Neither license nor authorization has been proven to be granted to the Respondent to make any use of the Complainant's trademark or apply for registration of the disputed domain name.

The Panel therefore considers that the Respondent has no rights or legitimate interests in respect of the disputed domain name <manulifegroup.com> within the meaning of paragraph 4(a)(ii) of the Policy.

### III. Registered and Used in Bad Faith

The Respondent has registered the disputed domain name which consists of the full content of the Complainant's trademark "MANULIFE" and generic term "GROUP" that refers to the holding of the companies and could refer to the whole group (holding) of the companies that is including the Complainant. There are no doubts that the Respondent had the Complainant and its trademark in mind when registering the disputed domain name as he redirected the disputed domain name to the Complainant's official website.

The Complainant has established the fact, that the disputed domain name creates direct association to the Complainant and is therefore capable of creating a likelihood of confusion of the internet users. The registration and usage of the disputed domain name could therefore potentially harm Complainant's business. The e-mail presented by the Complainant proves that someone sent an e-mail from the e-mail address from the disputed domain name with a signature purporting to come from Complainant's Director of Global Procurement Strategy. Such use of the disputed domain name could be deemed to be a fraud activity violating the Complainant and its customers as well as demonstrate a lack of good faith in the registration and use of the disputed domain names.

Considering the confusing similarity between the Complainant's trademark and the disputed domain name, long time between the registration of the Complainant's trademark and the disputed domain name, unsolicited redirection of the internet users to Complainant's website from the disputed domain name, distinctiveness of the Complainant's trademark, attempt to use the disputed domain name in the fraudulent activities and failure to submit a response in the UDRP proceedings and to provide any evidence of good faith use, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

The Panel therefore considers that the disputed domain name <manulifegroup.com> has been registered and is being used in bad faith within the meaning of paragraph 4(a)(iii) of the Policy.

The Panel finally considers that the Complainant has shown that the disputed domain name <manulifegroup.com> is confusingly similar to a trademark in which the Complainant has rights, the Respondent has no rights or legitimate interests in respect of the disputed domain name and the disputed domain name has been registered and is being used in bad faith. The Complainant has thus established all three elements of paragraph 4(a) of the Policy.

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FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

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AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **manulifegroup.com**: Transferred

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### PANELLISTS

Name	Petr Hostaš
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DATE OF PANEL DECISION 2023-06-28

Publish the Decision

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