

ADMINISTRATIVE PANEL DECISION

The Manufacturers Life Insurance Company v. Whois Agent, Domain Protection Services, Inc. / Registration Private, Dataczar, Inc
Case No. D2022-0772

1. The Parties

Complainant is The Manufacturers Life Insurance Company, Canada, represented by CSC Digital Brand Services Group AB, Sweden.

Respondent is Whois Agent, Domain Protection Services, Inc., United States of America (“United States”) / Registration Private, Dataczar, Inc, United States.

2. The Domain Name and Registrar

The disputed domain name <manulife-invest.com> (the “Domain Name”) is registered with Name.com, Inc. (Name.com LLC) (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 4, 2022. On March 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On March 6, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from named Respondent and contact information in the Complaint. The Center sent an email communication to Complainant on March 11, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on March 13, 2022.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on March 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 11, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent's default on April 12, 2022.

The Center appointed Clive L. Elliott Q.C., as the sole panelist in this matter on April 26, 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

Complainant is a leading Canadian-based financial services company which was founded in 1887 and which has principal operations in Canada, Asia, and the United States. Complainant operates in Canada and Asia as Manulife and in the United States as John Hancock. Since its founding Complainant has grown into a global, financial services leader providing financial advice, insurance and wealth and asset management solutions for individuals, groups, and institutions.

Complainant is the owner of numerous trade mark registrations across various jurisdictions ("Complainant's Marks"), including:

| Mark | Jurisdiction | Registration No. | Registration Date |
|----------------------|----------------|------------------|-------------------|
| MANULIFE | United States | 3301663 | October 2, 2007 |
| MANULIFE | United States | 1790892 | August 31, 1993 |
| MANULIFE | Canada | TMA385240 | May 31, 1991 |
| MANULIFE | European Union | 000540989 | July 9, 1999 |
| MANULIFE INVESTMENTS | Canada | TMA610229 | May 13, 2004 |

Complainant also operates numerous websites, with its primary website at <www.manulife.com>.

According to the publicly available Whois the Domain Name was registered on November 1, 2021. At the time of filing this complaint the Domain Name was resolving to a page displaying Complainant's Marks and logo, thereby giving the impression it was owned and operated by Complainant. The Domain Name currently redirects Internet users to a parked DAN.com website listing the Domain Name for sale.

5. Parties' Contentions

A. Complainant

Complainant contends that it has established considerable fame and goodwill in Complainant's Marks and consequently it has enjoyed a substantial degree of public recognition and Complainant's Marks have become uniquely associated with Complainant.

Complainant asserts that the Domain Name is confusingly similar to Complainant's Marks as it incorporates the MANULIFE Mark in its entirety with the addition of the descriptive term "invest" and the fact that such term is closely linked and associated with Complainant's Marks only serves to underscore and increase the confusing similarity. Complainant further asserts that the addition of a hyphen does nothing to distinguish the Domain Name from Complainant's Marks.

Complainant states that Respondent's Domain Name initially resolved to a page displaying Complainant's Marks and logo. Complainant advised it sent the Domain Name's Hosting provider and registrar a take-down notice advising that the Domain Name was being used in a phishing scheme and the Domain Name was consequently disabled.

Complainant goes on to state that Respondent is not sponsored by or affiliated with Complainant, nor has Complainant given Respondent permission to use Complainant's Marks in any manner, including in domain names. Complainant also notes that Respondent is not commonly known by the Domain Name, and at the time of filing of the complaint, Respondent was using a privacy Whois service.

Complainant asserts that Respondent's attempt to capitalize on Complainant's well-known marks by luring unsuspecting Internet users to its website in order to obtain personal information for commercial gain, does not constitute a use in connection with a *bona fide* offering of goods and services or any other legitimate use or interest in the Domain Name.

Complainant claims that the Domain Name has been registered and used in bad faith by Respondent with the intention to cause confusion, mistake and deception.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

A. Identical or Confusingly Similar

Complainant has provided evidence of various trade mark registrations for Complainant's Marks. Further, Complainant asserts it is a leading Canadian-based financial services company, founded as far back as 1887 and has operated in Canada, Asia, and the United States.

The Domain Name reproduces the MANULIFE mark which comprises the dominant part of Complainant's Marks. The MANULIFE mark is reproduced in its entirety, along with the word "invest", accompanied by a hyphen. The MANULIFE mark is clearly recognizable in the Domain Name. The addition of the word "invest" does not prevent a finding of confusing similarity. See section 1.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"). Further, a dominant feature of the Complainant's MANULIFE INVESTMENTS mark is recognizable in the Domain Name. See section 1.7 of [WIPO Overview 3.0](#).

The Domain Name is therefore confusingly similar to Complainant's Marks.

The first ground under the Policy is made out.

B. Rights or Legitimate Interests

Complainant submits that Respondent is not sponsored by or affiliated with Complainant, nor has Complainant given Respondent permission to use Complainant's Marks in any manner, including in domain names. On that basis, the Panel is satisfied that Complainant has put forward a *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name. That shifts the burden to Respondent to come forward with relevant evidence demonstrating or submissions directed to rights or legitimate interests in the Domain Name.

Complainant contends that the Domain Name initially resolved to a page displaying Complainant's Marks and its logo. Complainant points out that it sent the Domain Name's Hosting provider and registrar a take-down notice advising that the Domain Name was being used in a phishing scheme and the Domain Name was consequently disabled.

In the absence any attempt by Respondent to challenge these allegations, or to reinstate the Domain Name with its hosting provider, the Panel accepts that Respondent is either unable or unwilling to do so. The Panel also sees merit in Complainant's argument that Respondent is attempting to capitalize on Complainant's

well-known marks by luring unsuspecting Internet users to Respondent's website for improper purposes and that this cannot be construed as a *bona fide* offering of goods and services or any other legitimate use or interest in the Domain Name.

Respondent has therefore failed to rebut Complainant's *prima facie* case that Respondent lacks rights or legitimate interests in the Domain Name.

Accordingly, the second ground under the Policy is made out.

C. Registered and Used in Bad Faith

Finally, Complainant claims that the Domain Name has been registered and used in bad faith by Respondent with the intention to cause confusion, mistake, and deception. Again, Respondent's silence in the face of Complainant's allegations counts against it. In the absence of any attempt to challenge the allegations, the fact that Complainant has traded in Complainant's Marks for many years and that the Domain Name and Complainant's Marks are very similar, the Panel is satisfied that the Domain Name was registered and used in bad faith.

Complainant has therefore established the third ground under 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 Domain Name, <manulife-invest.com> be transferred to the Complainant.

/Clive L. Elliott Q.C./

Clive L. Elliott Q.C.

Sole Panelist

Date: May 10, 2022