

ADMINISTRATIVE PANEL DECISION

Principal Financial Services, Inc. v. lion media
Case No. D2022-3697

1. The Parties

The Complainant is Principal Financial Services, Inc., United States of America (“United States”), represented by Neal & McDevitt, United States.

The Respondent is lion media, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <principal-capital.net> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 4, 2022. On October 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 5, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 1, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 8, 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 the Respondent of the Complaint, and the proceedings commenced on November 10, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 30, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 1, 2022.

The Center appointed Wolter Wefers Bettink as the sole panelist in this matter on December 8, 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 a publicly-traded multi-national financial services institution headquartered in Des Moines, Iowa, United States. The Complainant offers, through its licensees, member companies and affiliates, a broad range of services in, among others, the financial, insurance, investment, banking, retirement, global asset management, real estate, and healthcare sectors.

The Complainant owns a number of trade marks consisting of or containing the element PRINCIPAL, including the following (the "Trade Marks"):

- United States trade mark PRINCIPAL registered on October 24, 1989, under No. 1,562,541.
- United States trade mark PRINCIPAL registered on October 30, 2007, under No. 3,324,583.
- United States trade mark PRINCIPAL registered on November 15, 2016, under No. 5,083,535.
- United States trade mark PRINCIPAL FREEDOM registered on June 20, 2006, under No. 3,107,136.
- United States trade mark PRINCIPAL ADVANTAGE registered on November 21, 2006, under No. 3,174,382.
- United States trade mark PRINCIPAL FUNDS registered on January 15, 2008, under No. 3,368,181
- United States device mark  (stylized "P") registered on 15 November 2016 under No. 5,083,538.
- United States device marks consisting of a stylized "P" and PRINCIPAL registered on 1 November 2016, under Nos. 5,074,931 and 5,074,932.

The Domain Name was registered on August 26, 2022 and resolves to a website which reproduces the PRINCIPAL word mark and the stylized "P and P PRINCIPAL marks. The website displays information on the Complainant and purports to offer various insurance and financial services, overlapping and otherwise similar to the services that the Complainant provides and states that it "was established in 2021 by Principal Financial Group". A person claiming to have served as "Principal Asia Marketing Director", but unknown to the Complainant, is named as the CEO of the business.

5. Parties' Contentions

A. Complainant

The Complainant states that it owns the Trade Marks which have been used by it in connection with a variety of finance-related products and services since 1985. According to the Complainant, the Trade Marks are known throughout the world as denoting the source of the products and services offered and sold by the Complainant through its licensees, affiliates, and member companies. The Complainant points out that the Domain Name incorporates the PRINCIPAL mark in its entirety, while the addition of the word "capital" does not eliminate the confusing similarity with the Trade Marks.

The Complainant submits that the following circumstances establish that the Respondent does not have rights or legitimate interests in the Domain Name:

The Complainant has not licensed or otherwise authorized or permitted the Respondent to use or register the Domain Name, or to use the PRINCIPAL word mark in a domain name.

The Respondent will not be able to provide any evidence of legitimate noncommercial or fair use of the Domain Name.

The Respondent will not be able to provide any evidence of demonstrable preparation to use the Domain Name in connection with a *bona fide* offering of goods or services, as the Domain Name

resolves to a website impersonating the Complainant and purporting to offer services under the Trade Marks which are similar to those of the Complainant.

The Respondent is not commonly known by the Domain Name.

According to the Complainant, the Respondent registered the Domain Name in bad faith as it was certainly aware of the Trade Marks and registered the Domain Name with the clear intention to target the Trade Marks. In this context, the Complainant points to the reputation of the Trade Marks and the fact that the Domain Name resolves to a website displaying the Trade Marks and providing information about the Complainant.

With respect to use in bad faith, the Complainant contends that use of the Domain Name for a website publishing the Trade Marks and information on the Complainant and purporting to offer services bearing the PRINCIPAL word mark and stylized P mark, generates the false impression that it resolves to an official website operated by the Complainant or one of its affiliated entities or authorized resellers. Such conduct in the view of the Complainant demonstrates bad faith use as it shows that the only purpose of the Respondent was to use the Domain Name to intentionally attempt to attract, for commercial gain, Internet users to its website, creating a likelihood of confusion and taking unfair advantage from the well-known character of the Trade Marks for its personal profit. In this connection, the Complainant also points out that the Respondent used a privacy protection service to conceal its identity and contact details in the Whois records.

B. Respondent

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

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has shown that it has registered rights in the Trade Marks. The Domain Name is confusingly similar to the Trade Marks as it incorporates PRINCIPAL, of which the Trade Marks consist or which they contain, in its entirety. The addition of the term "capital" and a hyphen "-" does not prevent a finding of confusing similarity between the Domain Name and the Trade Marks (see WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8; see also, *inter alia*, *TPI Holdings, Inc. v. Carmen Armengol*, WIPO Case No. [D2009-0361](#), and *F. Hoffmann-La Roche AG v. John Mercier*, WIPO Case No. [D2018-0980](#)). The generic Top-Level Domain ".net" is typically disregarded under the confusing similarity test, since it is a technical registration requirement (see [WIPO Overview 3.0](#), section 1.11).

Therefore, the Panel finds that the Domain Name is confusingly similar to the Trade Marks in which the Complainant has rights.

B. Rights or Legitimate Interests

Under paragraph 4(c) of the Policy, the second element a complainant has to prove is that a respondent lacks rights or legitimate interests in a domain name. This 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. In order to satisfy the second element, the Complainant has to make out a *prima facie* case that the Respondent does not have rights or legitimate interests in the Domain Name. If the Complainant succeeds in doing so, 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 (see [WIPO Overview 3.0](#), section 2.1).

Based on the evidence and the undisputed submissions of the Complainant, the Panel concludes that the Respondent has no connection or affiliation with the Complainant, the Respondent has not received the Complainant's consent or authorization to use the Trade Marks as part of the Domain Name. In assessing

whether the Respondent has rights or legitimate interests in the Domain Name, it should also be taken into account that (i) since the Domain Name incorporates the Trade Marks in their entirety with an additional term, it carries a risk of implied affiliation ([WIPO Overview 3.0](#), section 2.5.1); and (ii) the Respondent has not provided any evidence, nor is there any indication in the record of this case, that the Respondent is commonly known by the Domain Name. Furthermore, the Domain Name resolves to a website which falsely suggests to be from or authorized by the Complainant, by displaying the Trade Marks and information on the Complainant and offering services similar to some of the services provided by the Complainant. Therefore, the Respondent is not making a legitimate noncommercial or fair use of the Domain Name, nor does such use constitute a *bona fide* offering of goods or services.

In view of all of the above, the Panel concludes that the Complainant has established that the Respondent has no rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

Based on the undisputed information and the evidence provided by the Complainant, the Panel finds that at the time of registration of the Domain Name, the Respondent was or should have been aware of the Complainant and the Trade Marks, since:

- The Respondent's registration of the Domain Name occurred some 34 years after the registration of the earliest of the Trade Marks;
- A simple trade mark register search, or even an Internet search, prior to registration of the Domain Name would have informed the Respondent of the existence of the Trade Marks; and
- The subsequent use of the Domain Name to resolve to a website displaying the Trade Marks and containing information on the Complainant.

With regard to bad faith use, the Panel finds that the following circumstances taken together warrant a finding of bad faith use of the Domain Name:

- The probability that the Respondent was aware or should have been aware of the Complainant's rights in the Trade Marks;
- The use of the website to which the Domain Name resolves for offering the same or similar services as the Complainant, while purporting to be from, authorized by or linked to the Complainant, by using the Trade Marks and displaying information on the Complainant; The lack of a response from the Respondent; and
- The use of a privacy service to hide the identity of the Respondent.

Therefore, the Panel concludes on the basis of all of the above circumstances, taken together, that the Domain Name has been registered and is being used in bad faith.

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 <principal-capital.net> be transferred to the Complainant.

/Wolter Wefers Bettink/

Wolter Wefers Bettink

Sole Panelist

Date: December 19, 2022