

## **ADMINISTRATIVE PANEL DECISION**

Singapore Exchange Limited v. GCMG, GCMG  
Case No. D2022-0837

### **1. The Parties**

The Complainant is Singapore Exchange Limited, Singapore, represented by Ravindran Associates LLP, Singapore.

The Respondent is GCMG, GCMG, United States of America.

### **2. The Domain Name and Registrar**

The disputed domain name <sgxgroup.com> (the “Disputed Domain Name”) is registered with Network Solutions, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 10, 2022. On March 10, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On March 15, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that the 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 March 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on April 19, 2022.

The Center appointed Nick J. Gardner as the sole panelist in this matter on April 25, 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 was incorporated in Singapore in 1999 following the demutualization and merger of the 'Stock Exchange of Singapore' and the 'Singapore International Monetary Exchange'. It is the Singapore Stock Exchange and is widely known by the acronym SGX. Its network of subsidiaries and joint venture companies are widely known as the SGX Group.

The Complainant owns a range of registered trademarks for the term SGX including for example Singapore trademark T00/013371 registered on January 29, 2000. These trademarks are collectively referred to as the "SGX trademark" in this decision.

The Complainant's predecessor registered the domain name <sgx.com> in 1995. It has since 1999 been linked to the Complainant's principal website promoting its business.

The Disputed Domain Name was registered on April 21, 2010. Apart from a period in 2021 when the Disputed Domain Name resolved to an automatically generated parking page there is no evidence it has ever been used for anything.

There is no evidence before the Panel that the term SGX Group has any other meaning apart from in relation to the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant's contentions can be summarized as follows.

The Disputed Domain Name is similar to the SGX Trademark.

The Respondent has no rights or legitimate interests in the term "SGX" or "SGX Group".

In consequence the Complainant alleges that the Disputed Domain Name was registered and is being used in bad faith. The Complainant relies upon the line of previous UDRP decisions relating to domain names that are similar to well-known trademarks and have been passively held (see discussion below).

##### **B. Respondent**

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

#### **6. Discussion and Findings**

##### **Preliminary Matters**

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to "employ reasonably available means calculated to achieve actual notice". Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent's failure to file any Response. While the Respondent's failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent's default (see, e.g., *Verner Panton Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

## Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

### A. Identical or Confusingly Similar

The Complainant has rights in the SGX trademark. The Panel finds the Disputed Domain Name is confusingly similar to this trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). It is established that, where a mark is recognizable within a disputed domain name, the disputed domain name is considered to be confusingly similar to that mark (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”) at section 1.7).

It is also established that the addition of a descriptive term (such as here “group”) to a disputed domain name does not prevent a finding of confusing similarity between the domain name and the mark ([WIPO Overview 3.0](#) at section 1.8).

It is also well established that the generic Top-Level Domain (“gTLD”), in this case “.com”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See, for example, *Rollerblade, Inc. v. Chris McCrady*, WIPO Case No. [D2000-0429](#).

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

### B. Rights or Legitimate Interests

The Panel finds the SGX trademark is, on the evidence before the Panel, a term in which the Complainant has developed a significant reputation.

Paragraph 4(c) of the Policy provides a non- exhaustive list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, 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 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.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use the SGX trademark. The Complainant has prior rights in the SGX trademark which precede the Respondent’s acquisition of the Disputed Domain Name. The Complainant has therefore established a *prima facie* case that the

Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the Disputed Domain Name. Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

### **C. Registered and Used in Bad Faith**

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (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.

On the evidence that the Respondent has made no use of the Disputed Domain Name in the time it has owned it (apart from period in 2021 when it was linked to a parking page – see below) and it is not entirely clear whether any of the above categories apply. In the circumstances of this case the Panel therefore adopts the approach set out in the [WIPO Overview 3.0](#) at section 3.3 as follows:

“Can the ‘passive holding’ or non-use of a domain name support a finding of bad faith?”

From the inception of the UDRP, panelists have found that the non-use of a domain name (including a blank or ‘coming soon’ page) would not prevent a finding of bad faith under the doctrine of passive holding.

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”.

Overall it does not generally matter that the Respondent has not as yet used the Disputed Domain Name. “Passive holding” can itself amount to bad faith registration and use where the holding involves a domain name deliberately chosen because of its association with the Complainant. See *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), *Jupiters Limited v. Aaron Hall*, WIPO Case No. [D2000-0574](#), *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#), *Westdev*

*Limited v. Private Data*, WIPO Case No. [D2007-1903](#); *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#), *Intel Corporation v. The Pentium Group*, WIPO Case No. [D2009-0273](#) *Advance Magazine Publishers Inc. and Les Publications Conde Nast S.A. v. ChinaVogue.com* WIPO Case No. [D2005-0615](#).

In the present case the Panel adopts the approach described above and notes in particular the Respondent's failure to provide any evidence of actual or contemplated good-faith use. It also notes that the Complainant's SGX mark is reproduced in its entirety within the Disputed Domain Name (along with the term "group"), and there is no evidence that the term SGX Group refers to the Respondent. The Panel also notes the Respondent has not advanced any case of good faith use that it might have.

Further even if the Disputed Domain Name has for a period resolved to a parking page with pay-per-click ("PPC") links to other third-party websites does not alter the analysis. The Panel infers that some visitors, once at this website will follow the provided links and "click through" to other sites which offer services some of which may compete with those of the Complainant. Some revenue is presumably generated in respect of such "click through" activity. The Panel infers the website is automatically generated. This does not however matter. It is well established that where a domain name is used to generate revenue in respect of "click through" traffic, and that traffic has been attracted because of the name's association with the Complainant, such use amounts to use in bad faith, see for example *Shangri-La International Hotel Management Limited v. NetIncome Ventures Inc.*, WIPO Case No. [D2006-1315](#); *Owens Corning v. NA*, WIPO Case No. [D2007-1143](#); *McDonald's Corporation v. ZusCom*, WIPO Case No. [D2007-1353](#); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#); *Rolex Watch U.S.A., Inc. v. Vadim Krivitsky*, WIPO Case No. [D2008-0396](#).

See also [WIPO Overview 3.0](#) section 3.5: "Can third-party generated material "automatically" appearing on the website associated with a domain name form a basis for finding bad faith?"

Particularly with respect to 'automatically' generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links *ipso facto* vest the respondent with rights or legitimate interests).

Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith".

Accordingly, and applying the principles in the above noted extracts from [WIPO Overview 3.0](#) and the above noted UDRP decisions the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith. It follows that the third condition of paragraph 4(a) of the Policy has been fulfilled.

## 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 <sgxgroup.com> be transferred to the Complainant.

/Nick J. Gardner/

**Nick J. Gardner**

Sole Panelist

Date: May 9, 2022