HONG KONG INTERNATIONAL ARBITRATION CENTRE

.hk Domain Name Dispute Resolution
ARBITRATION PANEL DECISION

Complainant: The Prudential Insurance Company of America
Respondent: Nan Lee
Case Number: DHK-2100181
Contested Domain Name: <pgim.hk>
Panel Member: Douglas Clark

1. Parties and Contested Domain Name

The Complainant is The Prudential Insurance Company of America, whose address is 751 Broad Street, Newark, New Jersey 07102, USA. Its authorised representative in this matter is Zhiling Zhao whose address is 2305 Tower B Center Plaza, No. 161 Linhexi Rd., Tianhe District, Guangzhou, 510620, PR China 510620.

The Respondent is Nan Lee whose email address is leenan@tyedye group.hk.

The domain name at issue is <pgim.hk> (the “Disputed Domain Name”) registered with Eranet International Limited (the “Registrar”) whose email address is info@todaynic.com.

2. Procedural History

On 18 March 2021, the Hong Kong International Arbitration Centre (“HKIAC”) received a complaint (the “Complaint”) filed by the Complainant pursuant to the Domain Name Dispute Resolution Policy for .hk and .香港 domain names (the “Policy”), adopted by the Hong Kong Domain Name Internet Registration Corporation Limited (“HKIRC”) on 22 February 2011, the HKIRC Domain Name Dispute Resolution Policy Rules of Procedure (the “Rules”), approved by HKIRC effective from 15 July 2020, and the HKIAC Supplemental Rules for HKIRC Domain Name Dispute Resolution Policy (the “Supplemental Rules”), effective from 15 July 2020.

On 19 March 2021, the HKIAC transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. By email of the
same date the Registrar its response, confirming that the Respondent is listed as the registrant or holder of the Disputed Domain Name, that the Policy is applicable to the current dispute and provided HKIAC with the WHOIS information regarding the Disputed Domain Name, including contact details of the Respondent.

On 19 March 2021, the HKIAC served on the Respondent by email a Notification of Commencement of Proceedings ("NCP") and that the Respondent had 15 days, on or before 14 April 2021, to submit a Response to the Complaint in accordance to the Policy, the Rules and the Supplemental Rules. The Complaint and its annexures were sent alongside the NCP issued by the HKIAC.

The Respondent did not respond to the Complaint by the due date and on 15 April 2021 the HKIAC issued a notification of the Respondent in Default.

On 16 April 2021, the HKIAC appointed Mr. Douglas Clark as the sole Panelist of the Arbitration Panel in this matter. The sole Panelist has, prior to the appointment, submitted his Statement of Acceptance and Declaration of Impartiality and Independence in compliance with the Rules; and the case file was transferred by HKIAC to the said sole Panelist on the same date.

3. **Factual Background**

**For the Complainant**

The Complainant is a leading financial services company, offering a wide range of products and services, including life insurance, annuities, retirement planning, mutual funds and investment management. The Complainant has operations in the United States, Asia, Europe and Latin America.

The Complainant owns a global investment management business called PGIM. PGIM is one of the largest investment managers in the world in terms of global assets under management. The Complainant has used the PGIM trade mark for many years in relation to its investment and financial services. Furthermore, the Complainant uses the PGIM trademark with an image of the Rock of Gibraltar (the "Rock Logo"), to which the Complainant has used for over a century in relation to its insurance, investment and financial services.

The Complainant has obtained registrations for the PGIM trade mark in Hong Kong, which include the following:

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<th>Mark</th>
<th>Jurisdiction</th>
<th>Reg. No.</th>
<th>Registration Date</th>
<th>Services</th>
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<tbody>
<tr>
<td>PGIM</td>
<td>Hong Kong</td>
<td>AN: 304148109</td>
<td>June 26, 2018</td>
<td>Class 36: Global distribution of investment products and services;</td>
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<td></td>
<td>Hong Kong</td>
<td>AN: 303306294</td>
<td>September 8, 2015</td>
<td>Class 36: Global distribution of investment products and services; private and public equity and debt investment services; mutual fund services, namely, establishing mutual funds for others, mutual fund distribution and mutual fund investment; private placement financing services; mortgage financing services; mezzanine debt financing services; investment portfolio management and analysis services; real estate investment services; administration, underwriting and marketing of commingled, open-end equity real estate funds and single client accounts; consulting and advisory services related to all the foregoing services.</td>
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- portfolio management and analysis services; real estate investment services; administration, underwriting and marketing of commingled, open-end equity real estate funds and single client accounts; consulting and advisory services related to all the foregoing services.

For the Respondent

The Respondent is based in China and registered the Disputed Domain Name on 16 February 2021. At the date of this Decision, the Disputed Domain Name redirects to the domain name <pgim.group>, which resolves to a website featuring the Complainant’s PGIM trade mark and Rock Logo, along with content copied from the Complainant’s websites at “pgim.com” and “prudential.com”.

4. **Parties’ Contentions**

The Complainant

The Complainant’s contentions are summarized as follows:

- a. The Disputed Domain Name is confusingly similar to its trade mark. The Disputed Domain Name incorporates the Complainant’s PGIM trade mark in its entirety and the addition of the term “.hk” in the Disputed Domain Name does not eliminate the overall notion that the designation is connected to the trade mark and the likelihood of confusion that the Disputed Domain Name and the trade mark are associated;

- b. The Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent is not affiliated with the Complainant in any way and the Complainant has never granted any authorisation or license to use the Complainant’s trade mark. The Respondent is not commonly known by the Disputed Domain Name and their use of the Disputed Domain Name does not constitute as a bona fide offering of goods and services.
c. The Disputed Domain Name was registered and is being used in bad faith. The Respondent was aware of the Complainant’s trade mark at the time of registration and the Respondent registered the Disputed Domain Name in order to unfairly associate itself with the Complainant.

The Respondent

The Respondent did not respond to the Complaint.

5. Findings

According to Paragraph 4a of the Policy which is applicable hereto, the Complainant has the burden of proving that:

(i) the Disputed Domain Name is identical or confusingly similar to a trade mark or service mark in Hong Kong in which the Complainant has rights; and

(ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain; and

(iii) the Disputed Domain Name has been registered and is being used in bad faith; and

(iv) if the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of Domain Name.

(1). Identical/confusing similarity

The Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trade mark. The Disputed Domain Name incorporates the Complainant’s PGIM trade mark in full with the Country Code Top-Level Domain (“ccTLD”) “.hk”, which is the country code for Hong Kong. The Complainant has established its rights to the PGIM trade marks by submitting evidence of their registration in Hong Kong. In addition, a web search of “pgim.hk” directs to the Complainant’s website at “pgim.com” on the first page of results. Based on previous HKDRP decisions, the ccTLD is generally disregarded when considering this element.

The Complainant has therefore satisfied the first element under Paragraph 4a of this Policy.

(2). Rights or Legitimate Interests of Respondent

The Respondent has not asserted any rights or legitimate interests in relation to the Disputed Domain Name.
The Complainant has asserted that the Respondent has no business with and is in no way affiliated with the Complainant. The Respondent is not authorized nor licensed to use the Complainant’s PGIM trade mark or to apply for registration of the Disputed Domain Name. The Respondent’s use of the PGIM trade mark and the Disputed Domain Name does not constitute as a bona fide offering of goods or services. The Respondent is not commonly known by the Disputed Domain Name, and to the best of the Complainant’s knowledge, the Respondent does not own any registration or application of the PGIM trade mark in Hong Kong.

In addition, the Respondent has not responded to any of the Complainant’s contentions. The Panel finds that the Complainant has made a prima facie case that the Respondent lacks rights or legitimate interests, which has not been rebutted by the Respondent. Accordingly, the Respondent has no rights or legitimate interests in regard to the Disputed Domain Name.

The Complainant has therefore satisfied the second element under Paragraph 4a of the Policy.

(3) **Bad faith**

Based on the given evidence, the Disputed Domain Name was registered and is being used in bad faith.

Paragraph 4b of the Policy states that any of the following circumstances may be evidence of the registration and use of a domain name in bad faith:

a) circumstances indicating that the domain name holder has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name to the Complainant who is the owner of the trademark, or to a competitor of that Complainant, for valuable consideration; or

b) the domain name holder has registered the domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that the domain name holder has engaged in a pattern of such conduct; or

c) the domain name holder has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

d) by using the domain name, the domain name holder has intentionally attempted to attract Internet users to the website for commercial gain by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the domain name holder’s website.
The Disputed Domain Name was registered long after the Complainant has registered the PGIM trade mark. The PGIM trade mark has been used by the Complainant for 33 years to conduct its business, far before the registration of the Disputed Domain Name. The Panel is satisfied that the Respondent was aware of the Complainant and its PGIM trade mark when he or she registered the Disputed Domain Name.

The Respondent has also set up and has been operating a website through the Disputed Domain Name. On the website, the Respondent has made unauthorised use of materials created by and belonging to the Complainant. In particular, the Respondent is making direct use of the Complainant’s PGIM trade mark, Rock Logo and content found in the Complainant’s websites at “pgim.com” and “prudential.com”. Based on the Respondent’s conduct, the Panel is satisfied that the Disputed Domain Name was registered to attract Internet users to the website for commercial gain by creating a likelihood of confusion with the Complainant’s trade mark.

For the above reasons, the Panel finds that the Disputed Domain Name was both registered and is being used in bad faith.

The Complainant has therefore satisfied the third element under Paragraph 4a of the Policy.

(4). If the Disputed Domain Name is registered by an individual person, the Registrant does not meet the registration requirements for that individual category of domain name

Paragraph 4c of the Policy sets out the circumstances that can be used as evidence of registration in violation of the eligibility requirements for .idv.hk/.個人.hk/.個人.香港 domain names (“Individual Domain Name Categories”).

As the Disputed Domain Name does not fall within the Individual Domain Name Categories, the fourth element under Paragraph 4a of the Policy is therefore not applicable.

6. Conclusion

For the foregoing reasons, in accordance with Paragraph 4a of the Policy and Paragraph 15a of the Rules, the Panel orders that the disputed domain name <pgim.hk> be transferred to the Complainant.

[Signature]
Douglas Clark

Dated 23/4/21