

ADMINISTRATIVE PANEL DECISION

Prudential Corporation Asia v. Kieu Pham Van, Ruby Ads
Case No. D2023-0972

1. The Parties

The Complainant is Prudential Corporation Asia, Singapore, represented by ZeroFox, United States of America.

The Respondent is Kieu Pham Van, Ruby Ads, Viet Nam.

2. The Domain Name and Registrar

The disputed domain name <dailyprudential.com> is registered with Dynadot, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 3, 2023. On March 6, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 14, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 17, 2023 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 amendment to the Complaint on March 24, 2023.

The Center verified that the Complaint together with the amendment to 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 30, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 19, 2023. The Respondent did not submit any formal response but for sending two informal emails to the Center on April 3, 2023. Accordingly, the Center notified the Parties that it would proceed with the panel appointment on April 20, 2023.

The Center appointed William A. Van Caenegem as the sole panelist in this matter on April 27, 2023. 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.

The Center issued Administrative Panel Procedural Order No. 1 on May 15, 2023 requesting that the Complainant provide by May 22, 2023, information sufficient to demonstrate its relationship with Prudential IP Services Limited and/or The Prudential Insurance Company of America, and/or a copy of registration certificates for trademarks owned by the Complainant itself. On May 19, 2023, the Center received a response from the Complainant, indicating that it is a subsidiary of Prudential PLC. The present proceeding was said by the Complainant to fall under the corporate jurisdiction of Prudential Corporation Asia as the Respondent was impersonating the Complainant's primary website for Viet Nam. The Complainant also indicated that "Prudential IP Services Limited" is an entity that secures and supports the intellectual property rights of the larger Prudential company, and that the Complainant has the required trademark rights and privileges afforded to it by the rest of the Prudential body. The Respondent did not make any submissions in reply nor communicated with the Center within the time limit.

4. Factual Background

The Complainant is a subsidiary of the United Kingdom based Prudential PLC, which provides life and health insurance and asset management products, with revenue of more than USD26 billion in 2021.

The Complainant's trademark in Viet Nam (referred to as Registration #40238563000 in the Complaint) is registered in the name of "Prudential IP Services Limited". The Complainant does not attach a trademark certificate for the Vietnamese trademark but the referenced trademark No. 4-0238563-000 for PRUDENTIAL FINANCE, owned by Prudential IP Services Limited and registered on January 9, 2015 is accessible via the WIPO Global Brands Database.

The Complainant registered the domain name <prudentialplc.com> in 1999 and its domain name for the Asian subsidiary <prudentialcorporation-asia.com> was registered in 2004. The Complainant also registered the Vietnamese domain name <prudential.com.vn> in 1999.

The disputed domain name was registered on October 23, 2019. On March 30, 2023, it resolved to a website that mimicked the Complainant's official website in Vietnamese.

5. Parties' Contentions

A. Complainant

The Complainant points out that the Respondent registered the disputed domain name on October 23, 2019, well after the Complainant established its rights to trade under their mark PRUDENTIAL in many jurisdictions. The Complainant also points to its rights in the Vietnamese registered trademark PRUDENTIAL FINANCE. The Complainant says that Prudential IP Services Limited, the actual registrant of the Vietnamese trademark referenced by the Complainant, the Prudential Corporation Asia, and Prudential PLC of the United Kingdom, are all the same entity "Prudential" and that according to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.4.1, standing is given to subsidiaries for trademarks registered under the larger entity.

The Complainant indicates that the website to which the disputed domain name resolves uses the Complainant's brand, colors, logos, and company image deliberately to mislead visitors and obtain personal information or username/password combinations by using pre-phishing techniques, such as an MX record. Further, the Complainant points out that the disputed domain name is virtually identical to the Complainant's registered PRUDENTIAL marks. It fully incorporates the Complainant's universally recognized brand name with the simple addition of a descriptive word "daily" which even disregarding the content on the website, does nothing to distinguish the disputed domain from the Complainant's trademark.

The Complainant also asserts that the Respondent has no rights or legitimate interests in the disputed domain name. While the Complainant concedes that the Respondent has a right to establish a website for the purpose of legitimate criticism, comparison and commentary, the disputed domain name contains no indication whatsoever that it refers to a criticism or commentary website, nor does the content of the website to which it resolves indicate anything similar. Rather, the Complainant says, the Respondent chose a domain name that is [nearly] identical to the Complainant's established trademarks, and simply added "daily" before the trademark PRUDENTIAL. The Respondent even went a step farther in designing the website to look as if it is the official Prudential site which services Viet Nam. The Complainant contends that the use of trademarked names, logos and designs strongly implies a relationship or sponsorship with the Complainant, which does not in fact exist. There is no *bona fide* offering of goods or services, and according to the Complainant, such activities clearly do not constitute either fair or noncommercial use. Because of the distinctive nature of the Complainant's PRUDENTIAL trademark, and the Respondent's use of the disputed domain name to divert unsuspecting viewers to a website that impersonates the Complainant's site, it is clear that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant maintains that the registration and use of the disputed domain name by the Respondent is clearly for the purpose of disrupting the business of the Complainant and to attract Internet users to the Respondent's web site by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation or endorsement of the Respondent's site. The Complainant points out that the Respondent could have chosen any number of domain names which indicate to the viewer the true nature of its website. Instead, it chose to directly copy the Complainant's trademark in order to dress itself up in the Complainant's image to lure internet users to its site. The Complainant points to previous WIPO Panel decisions that have consistently held that this is clearly bad faith registration and use of the domain name.

Finally, the Complainant says that the Respondent is using the disputed domain name to impersonate the Complainant. The design, logos, and layout of the website to which the disputed domain name resolves are copied directly from the Complainant's official website so as to mislead consumers into believing they are using the services and products of the Complainant. This impersonation along with the active MX record for sending emails indicates an intent not only to mislead consumers, but also to benefit from this confusion by malicious means, the Complainant asserts. There is thus clear bad faith on numerous levels in the Respondent's registration and use of the disputed domain name.

B. Respondent

The Respondent did not reply to the Complainant's contentions but sent two informal emails to the Center on April 3, 2023 stating "I canceled that domain name and don't use it anymore".

6. Discussion and Findings

A. Identical or Confusingly Similar

The Complainant has established its relationship with Prudential IP Services Ltd, the actual registered owner of the Vietnamese trademark for PRUDENTIAL FINANCE, and with Prudential PLC, the principal company of which the Complainant is a subsidiary. The Complainant asserts that Prudential IP Services Limited is the company that holds registered trademark rights on behalf of the Prudential group of companies. The word PRUDENTIAL is clearly, by registration and by operation of the common law, a mark wholly owned by the Prudential group of companies in relation to financial services. The Complainant is a member of that group of companies. Therefore, the Complainant has standing to bring this proceeding in accordance with [WIPO Overview 3.0](#), section 1.4.1.

The PRUDENTIAL mark is included in its entirety in the disputed domain name and is recognizable as such. The addition of the term "daily" does not prevent a finding of confusing similarity. It is now well established that if the Complainant's trademark is visible within the disputed domain name, the first element is satisfied.

Therefore, the Panel holds that the disputed domain name is confusingly similar to the PRUDENTIAL trademark of the Complainant.

B. Rights or Legitimate Interests

The Respondent has not replied to any of the contentions of the Complainant. The disputed domain name resolves to an imposter website that is dressed up to resemble the Complainant's official site. The Respondent has no permission from the Complainant to establish such a site or to incorporate the PRUDENTIAL trademark in a domain name nor to make any other use of it. There is nothing before the Panel to indicate that the Respondent has antecedent rights in the relevant trademark derived from legitimate use or registration. The establishment of a website for the purpose of deceiving Internet users into supplying private information that the Respondent can turn to its illegitimate advantage in various ways, is not the kind of activity that calls for the recognition of rights or legitimate interests.

The Respondent indicated, in emails to the Center dated April 3, 2023, that he cancelled the disputed domain name and does not use it anymore. However, on May 11, 2023, when the Panel accessed it, the disputed domain name resolved to a website concerning a "Free Real Time Voice Changer" and containing material and information. There is in any case no evidence before the Panel that the disputed domain name was indeed cancelled or what the term 'cancelled' in this context was intended to convey. In any case, in the absence of consent from the Complainant purported cancellation at that time after commencement of proceeding has no effect in terms of how the matter continues.

Therefore, the Panel holds that the Respondent has no rights or legitimate interests in the disputed domain name.

C. Registered and Used in Bad Faith

The PRUDENTIAL trademark of the Complainant has been used in relation to life insurance and like financial services for many decades, and has acquired a strong reputation also in Asia in more recent times. It is highly unlikely that the Respondent acquired the disputed domain name in ignorance of the trademark rights or related business activity of the Complainant. In any case a cursory google search would have made the existence and beneficiary of those rights evident. The disputed domain name was also carefully chosen by inclusion of the additional term "daily", and the Respondent made plain that he was intent from the start upon an illegitimate use of the disputed domain name by linking it to an imposter website that he caused to be established. There is no possible honest purpose or intent to anything that the Respondent has done in this regard; rather, the clear intent was to defraud unsuspecting Internet users by creating the illusion of a legitimate site belonging to the Complainant. The Panel finds that the Respondent has registered the disputed domain name to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark. This practice was abusive and dishonest, and entirely in bad faith. As for the purported cancellation of the disputed domain name, the remarks made above apply in an analogous manner to the consideration of bad faith.

Therefore the Panel holds that the disputed domain name was registered and 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 <dailyprudential.com> be transferred to the Complainant.

/William A. Van Caenegem/

William A. Van Caenegem

Sole Panelist

Date: May 30, 2023