

DISPUTE RESOLUTION SERVICE

DRS 08253

Decision of Independent Expert

Jupiter Investment Management Group Limited

and

Karl Stompolski

1. The Parties:

Complainant: Jupiter Investment Management Group Limited
Address: 1 Grosvenor Place
London
Postcode: SW1X 7JJ
Unit Country: United Kingdom

Respondent: Karl Stompolski
Address: C/ Libra SN
Mijas-Costa
Riviera del Sol
Malaga
Postcode: 29649
Country: Spain

2. The Domain Name(s):

<jupitermg.co.uk>, <jwmg.co.uk>, <jwmggroup.co.uk>, and <jfmgroup.co.uk>

3. Procedural History:

This dispute was entered into the Nominet system on 8 February 2010 and Nominet validated the Complaint and took appropriate steps to notify the Respondent of the Complaint on 9 February 2010. On 16 February 2010 a Response was received from the Respondent. On 24 February 2010 a mediator

was appointed. Informal mediation having failed to resolve the dispute, on 18 March 2010 the Complainant paid the fee to obtain an expert decision pursuant to paragraphs 8(b) and 21(a) and (d) of the Nominet Dispute Resolution Service Procedure (“the Procedure”).

On 26 March 2010, Christopher Gibson, the undersigned, was selected as the Expert. The Expert has confirmed to Nominet that he knows of no reason why he cannot properly accept the invitation to act as Expert in this case and further confirmed that he knows of no matters which ought to be drawn to the attention of the parties, which might appear to call into question his independence and/or impartiality.

4. Factual Background

The Complainant, Jupiter Investment Management Group Limited, was incorporated in 1964 and is the parent company of the United Kingdom-based fund management group, Jupiter. The Complainant operates a number of websites including www.jupiteronline.co.uk and www.jupiterassetmanagement.co.uk.

The Domain Names were registered by the Respondent on the following dates:

- (a) <jupiterng.co.uk> - registered on 30 June 2009;
- (b) <jwmg.co.uk> - registered on 7 September 2009;
- (c) <jwmggroup.co.uk> - registered on 24 September 2009; and
- (d) <jfmgroup.co.uk> - registered on 7 October 2009.

5. Parties’ Contentions

Complainant

The Complainant and its predecessor companies have carried on business under names that include the word JUPITER since 1985. The Complainant states that, as a result of carrying on its business under the JUPITER name for over 25 years, it has established substantial goodwill and reputation in the name JUPITER, both in the United Kingdom (“UK”) and internationally. As at 31 December 2009, Jupiter had more than £21 billion worth of assets under its management, spread across a range of UK and offshore funds and investment trusts. The Complainant’s latest audited accounts show that at that date the Complainant had net assets of £103 million. Currently, the Complainant provides financial services to approximately 290,000 customers.

The Complainant is the owner of the registered Community trade marks for JUPITER (No. 641712) and the JUPITER and Planet Device (No. 755447), both of which are registered in classes 35 and 36 in respect of the following services:

- 35: Company administration and secretarial services
- 36: Asset management; unit trust management; fund management; pension fund management; off-shore fund management; private client fund management; investment trust management and corporate finance; and advice on all of the aforesaid.

The Complainant's trade marks were registered on 16 March 1999 and 14 June 2000. The Complainant has submitted evidence to show that the marks are part of an international portfolio of registered marks comprising or containing the word JUPITER.

The Complainant contends that each of the Domain Names includes a variety of related abbreviations which, according to the websites to which the Domain Names resolve, have the following meanings: "j" means "jupiter", "w" means "wealth", "m" means "management", "f" means "financial" or "fund" and "g" means "group". The Complainant has submitted evidence to show, for example, that the website at www.jfmgroup.co.uk, to which the Domain Name <jfmgroup.co.uk> resolved, bore the branding of "Jupiter Financial Management" and "Jupiter Fund Management". Moreover, the website at www.jwmggroup.co.uk, to which the Domain Name <jwmggroup.co.uk> resolved, bore the branding of "Jupiter Wealth Management Group". According to the Complainant, when a web user accessed a website to which these Domain Names resolved, the user would understand that the abbreviations used in the Domain Names have the following meanings:

- (a) jupitermg - to mean Jupiter Management Group;
- (b) jwmg - to mean Jupiter Wealth Management Group;
- (c) jwmggroup - to mean Jupiter Wealth Management Group; and
- (d) jfmgroup - to mean Jupiter Financial Management Group or Jupiter Fund Management Group.

Therefore, according to Complainant, the users would understand that the Domain Names comprise the Complainant's trade marks with the addition of generic, descriptive words that are relevant to Complainant's activities. Taken as a whole, the Domain Names and the websites to which they resolve (or have previously resolved before being taken down as described below) create a direct connection with the Complainant's business, which is compounded by the use on the websites of the Complainant's marks and of claims to be part of the Jupiter group. For the reasons described below, the Respondent has deliberately set out to create this direct connection. Accordingly, the Complainant has Rights in marks that are similar to the Domain Names.

The Complainant also contends that the Domain Names in the hands of the Respondent are abusive registrations. The Complainant states that the websites to which the Domain Names resolve are tools that have been used as part of a boiler room scam by individuals perpetrating fraud in the UK. In particular, individuals cold-call (i.e., make unsolicited telephone calls to) people in the UK offering investment opportunities. When questioned as to their credentials, they identify themselves as "Jupiter Wealth Management" or "Jupiter Financial Management", depending on the website to which the caller intends to refer the recipient of the call. In addition, the cold-callers claim on the call, on the website, and in

subsequent communications to members of the public, that the entity they represent is connected with the Complainant. In fact, however, there is no connection and the Complainant does not telephone members of the public direct to offer its financial products and services.

In its capacity as the financial services regulator, the FSA issued public warnings in respect of these websites in September and November 2009. In general, the FSA issues alerts about firms and individuals based both overseas and in the UK when there are grounds to suspect that they are offering UK consumers and investors financial services or products without the necessary authorisation from the FSA or overseas EEA regulators. The FSA has included Jupiter Wealth Management and Jupiter Financial Management on its list of Unauthorised Overseas Firms Operating in the UK. These public warnings advise members of the public that:

- (a) Jupiter Wealth Management and Jupiter Financial Management are not authorised under the Financial Services and Markets Act 2000 to carry on regulated activities in the UK,
- (b) these organisations may be targeting UK customers, and
- (c) the Complainant's Jupiter group is not connected to these organisations.

The Complainant explains that it became aware of the Respondent's activity because members of the UK public who have been so contacted have subsequently contacted the Complainant to seek further information in the belief that the Complainant is connected with the Respondent. The Complainant has provided evidence (emails and phone call transcript) to show confusion on the part of several members of the public. Shortly after it became aware of the www.jupitermg.co.uk website in August 2009, Complainant instructed its legal representatives to contact the ISP that hosts that website to request that it be taken down. The Complainant's representatives wrote to The Planet.com Internet Services, Inc. (which operated the IP address hosting the website) on 8 September 2009 to draw to its attention that the website was being used as part of an apparently fraudulent operation. They requested that the website be immediately taken down, which it occurred the same day. The ISP subsequently confirmed to Jupiter's representatives that the "customer has represented to us that the content referenced in your attached complaint has been removed and/or disabled".

Complainant states, however, that on the preceding day, 7 September 2009, the Respondent had registered another Domain Name, <jwmg.co.uk>. Shortly after the Domain Name was registered, Jupiter began to receive queries from members of the UK public regarding a new website, www.jwmg.co.uk. Once again, Complainant instructed its legal representatives to contact the ISP hosting the website with a view to have the website taken down. Complainant's representatives wrote to the relevant ISP, Godaddy.com, Inc., drawing attention to the fraudulent content on the website. The website was taken down on 18 September 2009.

The Complainant further asserts that the Respondent has subsequently registered two additional Domain Names subject of this dispute, <jwmggroup.co.uk> and <jfmgroup.co.uk>, and set up corresponding websites. These latest websites are in all material respects identical to the previous sites (www.jupitermg.co.uk and

www.jwmg.co.uk), except for the substitution of "Financial" for "Wealth" in the case of www.jfmggroup.co.uk. In particular, according to the Complainant the sites to which the Domain Names have resolved each have had the following features:

- (a) They are or were purportedly operated by Jupiter Wealth Management (or in the case of www.jfmggroup.co.uk by Jupiter Financial Management) and by Jupiter Fund Management Limited. The Complainant has provided an extract from Companies House to show that Jupiter Fund Management Limited is not a registered company in the UK. The name, however, is very similar to Jupiter's group company, Jupiter Fund Management Group Limited. On examination the contact information provided on the Respondent's websites corresponds to Jupiter's real address.
- (b) They provide what the Complainant strongly suspects to be unauthorised newsfeeds to legitimate third party websites (such as BBC) for financial news and updates in an attempt to establish credibility. The websites also display the logos of The Queen's Awards For Enterprise 2007 and the Gold Standards Awards Winner 2007. Again, the Complainant believes that the use of these logos is unauthorised.
- (c) They claim that the services offered under the sites are regulated by the FSA. This is plainly false. The opposite is in fact true: the FSA have issued public warnings in respect of these sites and has included Jupiter Wealth Management and Jupiter Financial Management on its list of Unauthorised Overseas Firms Operating in the UK.

Moreover, communications sent to members of the public by or on behalf of the Respondent contain the following sign-off:

"Jupiter Wealth Management (JWM), Jupiter Management Group (JMG) and Jupiter Management Services UK Limited (JMS) Jupiter Investment Management Group (JIMG) Jupiter Asset Management (JAM) and Jupiter Unit Trust Managers (JUTM) are all registered in England and Wales (nos 792020, 2036243 and 2009040). The registered address of JWM, JMG JMS JIMG [sic], JAM and JUTM is 1 Grosvenor Place, London, SW1X 7JJ. JUTM and JAM are authorised and regulated by the Financial Services Authority under references 122488 (JUTM) and 141274 (JAM). See fsa.gov.uk/register for more details. Full legal information can be viewed by clicking the link above."

The Complainant is aware that individuals have continued to contact members of the public and offer investment opportunities. For example, a recent notification contains an email to Jupiter in January 2010 from a member of the public who had invested with Jupiter Financial Management. This person had been directed to www.jfmggroup.co.uk and offered an investment in their Bullion Funds, which this person subsequently made. This member of the public had already reported the matter to the FSA by the time of the email sent to Jupiter.

The Complainant believes that the websites are spurious attempts to demonstrate fair use of the Domain Names and are designed to provide a credible reference

point for the Respondent and/or the Respondent's affiliates and telephone sales persons to direct the public to and induce those members of the public into purchasing investments offered by the Respondent. Complainant contends that it is clear from the content of the websites to which the Domain Names resolve that the use does not constitute use of, or preparations to use, the Domain Names in connection with a genuine and legal offering of goods or services. Instead, the Respondent is causing significant and ongoing damage to the Complainant's goodwill and reputation. In addition, the Domain Names and websites to which they resolve (or previously resolved) present a danger to members of the public who the Respondent and/or its affiliates are illegally attempting to induce into unregulated investments.

In sum, the Complainant submits that the above facts demonstrate that:

- a) the Domain Names are unfairly disrupting the business of the Complainant (paragraph 3(a)(i)(C) of the Policy);
- b) the Respondent is using or threatening to use the Domain Names in a way that has confused or is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant (paragraph 3(a)(ii) of the Policy); and
- c) the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names that correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Names are part of that pattern (paragraph 3(a)(iii) of the Policy),

The Domain Names therefore should be considered to be Abusive Registrations.

Respondent

A communication was received from the Respondent. In it he admits that he registered the Domain Names and hosted the content. However, he claims that he was unaware of any fraudulent activity as alleged by the Complainant. Respondent's submission states as follows:

"I received an email from yourselves blaming me for what seems to be some sort of scam of some kind. I have looked at the evidence sent, and I dont really know what its all about. The only thing I recognize is the website, [...] which is the site that I uploaded, not created. There is a phone conversation and several emails which I have never seen, and I have no idea what they are about. Same with the company information [...], I dont know the companies at all. I sent yourselves an email saying that I have nothing to do with these companies, but I was asked to explain why my name is on the domains.

A friend of mine met someone who said they need help registering a domain, some server space and uploading some files. I met with a man called Arthur, not sure of his surname.... He told me he wanted to buy a domain and server

space and upload a website that he already had made. He told me the domain he wanted, so I then bought the domain and the server space, and uploaded the website which he provided. I then gave him all the details to the server to be able to do changes and set up email accounts. About a month later he called me on my mobile, he always used to call from withheld numbers, and asked me to register another domain for him, and a couple weeks after that another domain, and a fourth. All the domains were pretty similar, all along the lines of Jupiter Management Group. After I registered the fourth domain, I didn't hear anything from him.

I have nothing to do with what this company is doing, nor the content of the websites. I am an independent web developer, but this content was given to me. In the evidence it says that it was copied off another site called Templeton. How am I supposed to know this? I am given content from someone to upload, how I do I know he's copied another site? I was simply given instructions which I followed and was then paid for doing the work. That's it.

Since I received your email the other day, I have deleted all these domains off my account, and cancelled the server.

Please let me know what else I have to do to clear my name of this”.

Complainant's Reply

The Complainant has submitted a Reply arguing that it is clear from the Respondent's Response that the Domain Names are abusive registrations and should be transferred to the Complainant. The Complainant also suggests a factual inconsistency in the Respondent's position. While the Respondent maintains that he is not in any way associated with the individuals and entity that are behind the websites associated fraudulent activities, the Complainant explains as follows: the Complainant's legal representatives contacted the ISP that hosts the website to which <jupiterng.co.uk> previously resolved. That communication included written assertions of fraudulent use of the Domain Names and associated websites. The ISP contacted the named registrant, the Respondent, and received confirmation that the material on that website had been removed. As the named registrant and recipient of that communication, the Respondent must have become aware of the fraudulent activities for which the Domain Names were being used. Nevertheless, despite having received that communication and warning from the ISP on 11 September 2009, the Respondent proceeded to register two more allegedly abusive Domain Names following this date on behalf of those perpetrating the fraud.

6. Discussions and Findings

General

Under paragraph 2 of the Dispute Resolution Service Policy (“the Policy”), the Complainant is required to show, on the balance of probabilities, that;

- (1) it has rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (2) the Domain Name in the hands of the Respondent is an Abusive Registration.

Complainant’s Rights

“Rights” are defined in the Policy as “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”. In this case, the Complainant has submitted ample evidence to establish that, as a result of its registered trade marks and carrying on business under the JUPITER name for over 25 years, it has established substantial goodwill, reputation and distinctive Rights in its JUPITER name and related trade marks, which pre-date by a lengthy period the Respondent’s registration of the Domain Names.

As to the issue of similarity between the Domain Names (<jupitermg.co.uk>, <jwmg.co.uk>, <jwmggroup.co.uk>, and <jfmggroup.co.uk>) and the Complainant’s marks, the Expert finds that Domain Names each comprise an acronym that was specifically designed to create an association between, on the one hand, the Domain Name and the website to which it resolved and, on the other hand, the Complainant and its marks. In particular, each of the Domain Names includes an abbreviation which, according to the websites to which the Domain Names resolved, had the following obvious meanings: “j” means “jupiter”, “w” means “wealth”, “m” means “management”, “f” means “financial” or “fund” and “g” means “group”. The Complainant submitted evidence to show that the website at www.jfmggroup.co.uk, to which the Domain Name <jfmggroup.co.uk> resolved, bore the branding of “Jupiter Financial Management” and “Jupiter Fund Management”. The website at www.jwmggroup.co.uk, to which the Domain Name <jwmggroup.co.uk> resolved, bore the branding of “Jupiter Wealth Management Group”. As the Complainant has carefully explained in its Complaint, taken as a whole, the Domain Names and the websites to which they resolved created a direct connection with the Complainant’s business, which was compounded by the use on the websites of the Complainant’s marks and of claims to be part of the Complainant’s Jupiter group. Thus, the addition of generic or descriptive words, or of letters as abbreviations corresponding to the Complainant’s activities, made little difference to the overall impression or impact of the Domain Names (see Nominet Appeal Panel DRS 00248 <seiko-shop.co.uk>; <spoonwatchshop.co.uk>).

In this context, therefore, the Expert finds that the Domain Names are similar to a name or mark in which the Complainant has Rights. The Complainant has established the first element of the test in paragraph 2(a) of the Policy.

Abusive Registration

As to whether the Domain Name registration is abusive in the hands of the Respondent, paragraph 1 of the DRS Policy defines “Abusive Registration” as:

“a Domain Name which either:

- i. was registered or otherwise acquired in a manner, which at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant’s Rights; or
- ii. has been used in a manner, which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

The Expert should take into account all relevant facts and circumstances in determining whether the Domain Name is an Abusive Registration.

The Expert is strongly persuaded by the Complainant’s submissions that the registration and use of the Domain Names has been abusive. The Complainant has submitted evidence to show that each of the Domain Names was selected and registered as a means of (i) specifically targeting the Complainant and its trade marks and (ii) perpetrating fraudulent schemes on UK consumers who might be interested in the Complainant’s financial services. This type of behaviour by the Respondent, or by the person or entity who purportedly instructed the Respondent, creates serious and significant harm not only to the Complainant but also to innocent Internet users who may, as a result of the fraudulent activities and confusion created by the Domain Names, be misdirected to the illegal websites associated with the Domain Names. Whether or not the Respondent was aware of the illegal use of the Domain Names in connection with a “boiler room scam by individuals perpetrating fraud”, the Respondent is nonetheless responsible for the Domain Names registered in his name.

Accordingly, the Panel finds on the balance of probabilities that the Domain Names, in the hands of the Respondent, are Abusive Registrations.

7. Decision

The Expert finds that the Complainant has Rights in respect of a name or mark which is similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are Abusive Registrations. The Expert therefore directs that the Domain Names – <jupitermg.co.uk>, <jwmg.co.uk>, <jwmggroup.co.uk>, and <jfmgroup.co.uk> – be transferred to the Complainant.

Christopher Gibson
13 May 2010