

Nominet UK Dispute Resolution Service

DRS 4284

**JP Morgan Chase
-v- Antonino Sausa**

Decision of Independent Expert

1. Parties:

Complainant: JP Morgan Chase & Co
Address: 270 Park Avenue
New York
Post Code: 10017-2070
Country: USA

Respondent: Antonino Sausa
Address: Via Fantacchiotto 28
Latina
NA
Postcode: 04100
Country: IT

2. Domain Name:

jpmorgancorp.co.uk ("the Domain Name")

3. Procedural Background:

Nominet received the Complaint in electronic form on 7 December 2006 and in hard copy form on 8 December 2006. Nominet validated it on 8 December 2006. The same day the complaint was sent by Nominet to the Respondent by airmail and email to the postal and email addresses provided to Nominet by the Respondent for Nominet's Whois database. The Respondent acknowledged receipt of the Complaint.

No Response was received (in time or at all), so mediation was not possible.

On 8 January 2007, the appropriate fee having been paid to Nominet by the Complainant, and Tony Willoughby, the undersigned Expert, having indicated to Nominet that there was no reason why he should not handle the case, the case was referred to the Expert for a decision.

4. Outstanding Formal/Procedural Issues (if any):

None.

5. Factual Background

The Complainant claims and the Respondent does not challenge that the Complainant is a global financial services firm with assets in excess of US\$1.3 trillion making it the second largest banking institution in the US. It is headquartered in New York, USA. The Complainant operates in more than 50 countries (including the UK and Italy) with over 160,000 employees providing financial services to 90 million customers worldwide.

The Complainant uses the trade marks JPMorgan and JPMorgan Chase to market and sell its financial services. JP Morgan is the investment banking arm of the Complainant. The name JPMorgan has been in use by the Complainant and its predecessors since the founding of JP Morgan & Co in 1861.

The Complainant is the registered proprietor of a large number of trade mark registrations featuring the name JP Morgan. For present purposes it is only necessary to cite one of them, namely:

UK registration no. 1325133 dated 27 October 1987 JP MORGAN (words) in class 36 for various banking and investment services.

On 17 May 2006 a company was incorporated in the UK under the name JP Morgan Corporation plc of which the Respondent was a founding director and a 50% shareholder. He had previously been a director of a now defunct company, which was incorporated in the UK in 2003 under the name of Morgan Corporation Limited. Neither company has filed any accounts.

On 23 May, 2006 the Respondent registered the Domain Name in his own name 'trading as JP Morgan Corporation plc'.

On a date unknown a customer of the Complainant received a letter from the Respondent's company, JP Morgan Corporation plc, in connection with a property transaction. The letter concluded: 'We declare to support the sale with our guarantee. In the next days will be contacted by Mr Sausa in relation to the negotiation'. The email address appearing in the sign off to the letter features the Domain Name.

On 18 September, 2006 the Complainant's representatives wrote cease and desist letters to the Respondent and others drawing attention to the Complainant's rights and seeking *inter alia* transfer of the Domain Name. The letter to the Respondent was returned undelivered. A further letter was sent on 6 October, 2006, but no reply was received.

6. The Parties' Contentions:

Complainant's Contentions

The Complainant contends that it is the owner of rights in the name, JP Morgan, by virtue of its registered rights in the name and its common law rights acquired by virtue of its and its predecessors' extensive use of the name over many years.

The Complainant contends that its name is identical or similar to the Domain Name.

The Complainant contends that in the hands of the Respondent the Domain Name is an Abusive Registration. The Complainant points to the fame of its name, JP Morgan, and contends that the circumstances are such that when registering both the company name JP Morgan Corporation plc and the Domain Name the Respondent must have been well aware of the Complainant and its rights in the name JP Morgan.

The Complainant points out that the Respondent has no obvious right to the name. The Respondent is not named JP Morgan and the Complainant has not licensed the Respondent to use its name and trade mark.

The Complainant contends that the Respondent registered the Domain Name with the primary purpose of using it and the company name, which is stated to be the Respondent's trading name, to lead people to believe that the Respondent and his company is in some way associated with the Complainant.

The Complainant points to the letter to one of its customers from the Respondent's company, mentioning the Respondent and containing what purports to be a guarantee from JP Morgan Corporation plc.

The Complainant contends that the Domain Name registration should be transferred to the Complainant.

Respondent's Contentions

The Respondent has not responded to the Complaint.

7. Discussion and Findings:

General

To succeed in this Complaint the Complainant has to prove to the Expert pursuant to paragraph 2 of the Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the Policy) in respect of a name or mark identical or similar to the Domain Name and, secondly, that the Domain Name, in the hands of the Respondent, is an Abusive Registration (as defined in paragraph 1 of the Policy).

Complainant's Rights

Manifestly the Complainant has registered and unregistered rights in the name and mark JP Morgan, a name or mark, which is similar to the Domain Name.

The Expert finds that the Complainant has rights in respect of a name or mark identical or similar to the Domain Name.

Abusive Registration

This leaves the second limb. Is the Domain Name, in the hands of the Respondent, an Abusive Registration? Paragraph 1 of the 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."*

Paragraph 3 of the Policy contains a non-exhaustive list of what may constitute an Abusive Registration for these purposes. Paragraph 4 of the Policy contains a non-exhaustive list of what a Respondent may show to demonstrate rights or legitimate interests in respect of the Domain Name.

The circumstances of this case are such that the Expert sees no need to examine those paragraphs of the Policy in any great detail. The fact is that the name JP Morgan is a household name in the field of financial services. It is highly distinctive. There is nothing before the Expert to indicate why the Respondent should be said to have any right or legitimate interest in respect of the name. The mere incorporation of a company under a similar name a few days earlier cannot of itself give rise to any such rights or interests.

The Expert agrees with the Complainant that the inescapable inference is that the Respondent used the Complainant's famous name, JP Morgan, as part of both his company name and the Domain Name in order to cause deception i.e. to lead people falsely to believe that the Respondent and his company are in some way associated with the Complainant, there being no such association.

The Complaint set out the Complainant's contentions clearly. The Respondent acknowledged receipt of the Complaint, but failed to file a Response. The Expert infers from this (in the particular circumstances of this case) that the Respondent has no answer to the Complainant's allegations.

Can there be any serious doubt that use of the Domain Name by the Respondent in the course of his business in the field of financial services will not have led or be likely to lead to deception?

The Complainant points to the letter received by one of its customers from the Respondent's company, JP Morgan Corporation plc, and purporting to contain a guarantee from that company. An extract is quoted in section 5 above. While the style of that letter and the execrable English would deceive nobody, the Respondent's fraudulent intent is clear and the Expert has no doubt that there is a high risk that at some stage (if it has not occurred already) someone will be deceived if the Respondent is permitted to continue to use the Domain Name.

The Expert finds that (i) the Domain Name was registered by the Respondent with full knowledge of the Complainant's rights in respect of the name, JP Morgan, and with the intention of deceiving people into believing there to be a connection between the Respondent and the Complainant, (ii) it is inevitable that at some stage deception will occur if it has not already occurred and (iii) this constitutes an Abusive Registration under the Policy in that the Respondent has intentionally taken unfair advantage of the Complainant's rights and threatens to cause unfair detriment to those rights.

8. Decision:

Having concluded that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration, the Expert directs that the Domain Name, <jpmorgancorp.co.uk>, be transferred to the Complainant.

Tony Willoughby

3 February, 2007