

## **DISCOVERYINISTRATIVE PANEL DECISION**

Discovery Limited, and Discovery Finance Company Europe Limited v.  
Privacy service provided by Withheld for Privacy ehf / Richard Farber  
Case No. D2022-0383

### **1. The Parties**

Complainants are Discovery Limited, South Africa, and Discovery Finance Company Europe Limited, United Kingdom (“U.K.”), represented by Spoor & Fisher Attorneys, South Africa.

Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland, / Richard Farber, United Kingdom.

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

The disputed domain names <discoveryfinancecompanyeurope.com>, and <discoveryfinanceeurope.com> are registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 3, 2022. On February 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 4, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to Complainants on February 7, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting Complainants to submit an amendment to the Complaint. Complainants filed an amended Complaint on February 11, 2022.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on February 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was March 9, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 10, 2022.

The Center appointed Scott R. Austin as the sole panelist in this matter on March 15, 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 following facts appear from the Complaint and its Annexes.

Complainant Discovery Limited based in South Africa (“Discovery”) is the ultimate and controlling parent company of the companies in the Discovery Group, including Complainant Discovery Finance Company Europe Limited, which is wholly-owned by Complainant Discovery Limited and based in the U.K. (“Discovery Finance”, and with Discovery collectively referred to for purposes of this decision as “Complainants”). As part of the Discovery Group, Complainants comprise a global, integrated financial services organization offering a range of services in the fields of health, life, short term and commercial insurance, as well as various saving, investment, credit card, and banking services provided under the trademark DISCOVERY (the “DISCOVERY Mark”) that is now considered widely known. Discovery is also the largest health insurance provider in South Africa with over five million customers and GBP 11.6 billion in assets. Since Discovery’s incorporation in 1992 its expanding international presence have made Complainants the fourth largest private medical insurance company in the U.K. Complainant Discovery Finance acts as a finance vehicle for the benefit of the Discovery Group and for use in Discovery’s U.K. life insurance business.

Complainant Discovery has secured ownership in, and also licenses to its subsidiaries including Complainant Discovery Finance, a large number of trademark registrations for the DISCOVERY Mark in South Africa, the U.K. and across many jurisdictions worldwide for its financial services, including but not limited to the following:

South Africa Trademark Registration No. 1995/09362, DISCOVERY FUND, registered on February 18, 1999, for financial, insurance and related services, in international class 36.

South Africa Trademark Registration No. 2003/04271, DISCOVERY, registered on September 17, 2009, for a range of insurance and related financial services in international class 36.

South Africa Trademark Registration No. 2011/19625, DISCOVERY FINANCIAL SERVICES, registered on March 25, 2014, for a range of insurance and financial services, including banking services and investment services in international class 36.

South Africa Trademark Registration No. 2017/33042, DISCOVERY BANK, registered on June 20, 2019, for a range of financial services, including banking, electronic banking, investment services and asset management services, and related financial services in international class 36.

European Union Trademark Registration No. 007140312, DISCOVERY (stylized), registered on November 26, 2013, for a range of insurance, health care financing and health insurance services and products in international class 36.

Since 1996, when it registered its official domain name <discovery.co.za> Complainant Discovery has maintained its global presence online via its official website accessed through that official domain name (the “DISCOVERY Mark Official Website”). The DISCOVERY Mark Official Website has been used extensively by Complainants to promote their services under the DISCOVERY Mark and to provide a wide range of information about the Discovery Group companies and their offerings. Legitimate email communications from Complainants officers to clients and potential clients are sent from an email address that ends with “[...]@discovery.co.za”.

The disputed domain names were both registered on December 31, 2020, and as of the filing of the Complaint the disputed domain names provide direct access to, or redirect to, the homepage of

Respondent's copycat website which displays content designed to impersonate Complainant Discovery Finance, including the heading "WELCOME TO DISCOVERY FINANCE", above "Discovery Finance Company Europe Limited is a consulting and financial services firm" and provides a copyright notice at the bottom attributing ownership of the content copyright to "Discovery Finance Company Europe Limited".

The record submitted also provides probative evidence that Respondent's disputed domain names through their associated emails are used to facilitate an elaborate cybercrime scheme to defraud unsuspecting consumers of Complainant Discovery Finance. The fraudulent email activities included impersonating an authorized representative of Complainant Discovery Finance to negotiate the attempted sale of fraudulent financial instruments using forged documents. Complainants alerted appropriate U.K. fraud and cybercrime authorities of these events when notified by customers questioning the authenticity of the proposed documents.

## **5. Parties' Contentions**

### **A. Complainants**

Complainants contend that the disputed domain names are identical or confusingly similar to Complainants' trademark; that Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain names were registered and are being used in bad faith.

### **B. Respondent**

Respondent did not reply to Complainants' contentions.

## **6. Discussion and Findings**

There are no exceptional circumstances within paragraph 5(e) of the Rules to prevent this Panel from determining the present dispute based upon the Complaint (as amended), notwithstanding the failure of the Respondent to lodge a substantive formal Response in compliance with the Rules. Under paragraph 14 of the Rules, where a party does not comply with any provision of the Rules, the Panel shall "draw such inferences therefrom as it considers appropriate".

Where no substantive Response is filed, however, Complainant must still make out its case in all respects under paragraph 4(a) of the Policy. To determine which party prevails, the Panel must decide whether Complainant has demonstrated that all the elements listed in paragraph 4(a) of the Policy have been satisfied:

(i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

(ii) Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will address each of these requirements in turn.

The standard of proof under the Policy is often expressed as the "balance of the probabilities" or "preponderance of the evidence" standard. Under this standard, an asserting party needs to establish that it is more likely than not that the claimed fact is true. See, WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

## A. Identical or Confusingly Similar

As an initial matter in its analysis of trademark rights under this element of the Policy, the Panel is compelled to discuss that it is apparent that Complainants consider that since they form part of the Discovery Group, this entitles them to act collectively in respect of any violation of the trademark or domain name rights which one or both of them may hold. The Panel must, therefore, consider whether there are circumstances which show that Complainants are affiliated companies who trade under the same banner collectively and that reliance may be established depending upon the intra-enterprise relationships or even licensing arrangements *inter se*, they may all be involved in what can be considered to be a common venture and thus establish that an individual member company has standing as a co-complainant. See *Pro Dive Pty Ltd and Pro Dive International Pty Ltd v. Tony Lennartsson*, WIPO Case No. [D2004-0097](#). Given the evidence submitted shows that Complainant Discovery Finance is both a wholly-owned subsidiary under the control of Complainant Discovery and a licensee of the DISCOVERY Mark, the Panel finds Complainants each have trademark rights sufficient for standing and their affiliation permits them to collectively bring their claims under the Policy. See *Old Mutual Life Assurance Company (South Africa) Limited; Old Mutual PLC, Old Mutual Investment Advisers, Inc.; Old Mutual Life Assurance Company Zimbabwe Limited; South African Mutual Life Assurance Society; Old Mutual Life Assurance Company Kenya; Old Mutual Swaziland (Proprietary) Limited v. OLDMUTUAL FINANCE / Registration Private, Domains By Proxy, LLC*, WIPO Case No. [D2016-2607](#); see also [WIPO Overview 3.0](#), sections 1.4 and 4.11.

Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2.1. Complainants have demonstrated their rights because they have shown that they are respectively the holder and licensee of multiple valid and subsisting trademark registrations for the DISCOVERY Mark. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#).

Prior UDRP panels have held “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.” See [WIPO Overview 3.0](#), section 1.7.

The Panel finds here that each of the disputed domain names wholly incorporates Complainants’ registered DISCOVERY Mark, followed respectively by the terms “finance”, “company” and “europe”, thereby encompassing the corporate name of Complainant Discovery Finance; and, by the terms “finance” and “europe”. These respective additions of dictionary words that relate to the business and geography of Complainant Discovery Finance following the DISCOVERY Mark does not change the fact that the DISCOVERY Mark is still wholly recognizable within each disputed domain name.

As will be considered in more detail under the second and third elements of the Policy below, Complainants contends that Respondent chose these terms so that the disputed domain names could be used to mislead its customers and prospective customers both through Respondent’s copycat website and emails to be falsely associated with Complainants and their authorized representatives impersonated to further Respondent’s cybercrime scheme. Prior UDRP panels have found similar appended terms to a banking complainant’s mark did not prevent a finding of confusing similarity. See *Norton Financial Services Limited, Norton Finance and Mortgages v. Norton Finance Group Limited*, WIPO Case No. [D2013-1889](#); and, *Old Mutual Life Assurance Company (South Africa) Limited, et al., supra*.

Finally, prior UDRP panels have found that the applicable generic Top-Level Domain (“gTLD”) in a domain name (e.g., “.com”, “.club”, “.co”) is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test. Accordingly, the gTLD “.com” does not avoid a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.11; see also *Research in Motion Limited v. thamer Ahmed Alfarshooti*, WIPO Case No. [D2012-1146](#).

Complainants DISCOVERY Mark is readily recognizable as incorporated in its entirety into each disputed domain name and for these reasons the Panel finds each of the disputed domain names confusingly similar to the DISCOVERY Mark in which Complainants have rights, thus satisfying the first element of the Policy.

## **B. Rights or Legitimate Interests**

Under the second element of the Policy, a complainant is first required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. If a complainant makes that showing, the burden of production on this element shifts to the respondent to come forward with relevant evidence of such rights or legitimate interests in the domain name. If the respondent fails to come forward with such evidence, a complainant is generally deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also, *Malayan Banking Berhad v. Beauty, Success & Truth International*, WIPO Case No. [D2008-1393](#). Respondent is in default and thus has not attempted to come forward to show any rights or legitimate interests in the disputed domain names under the Policy at paragraph 4(c).

Complainants have established, *prima facie*, that Respondent lacks rights or legitimate interests in the disputed domain names. First, Complainants assert that neither of them have authorized, licensed, or permitted Respondent to use its DISCOVERY Mark or any confusingly similar mark in a domain name or otherwise.

Second, according to the record submitted in this case, Respondent is not commonly known by the disputed domain names. Both disputed domain names were registered on December 31, 2020, and Respondent in these proceedings is an individual apparently located in the United Kingdom, where Discovery Finance is based, whose name bears no resemblance to either disputed domain name. Based on these facts, combined with the lack of evidence in the record to suggest otherwise, this Panel finds that Respondent is not commonly known by either disputed domain name or any variation thereof pursuant to Policy paragraph 4(c)(ii).

It is generally regarded as *prima facie* evidence of no rights or legitimate interests if a complainant shows that the disputed domain name is identical or confusingly similar to a complainant's trademark, that the respondent is not commonly known by the disputed domain name, and that a complainant has not authorized the respondent to use its mark (or an expression which is confusingly similar to its mark), whether in the disputed domain name or otherwise. See, *Roust Trading Limited v. AMG LLC*, WIPO Case No. [D2007-1857](#).

Finally, Complainants have provided detailed explicit email evidence in the annexes attached to the Complaint that Respondent's disputed domain names were registered and its copycat website and emails configured to be used as tools to facilitate an elaborate cybercrime scheme. The annex evidence shows that Respondent has created a platform where fraudulent activities are conducted to impersonate Complainant Discovery Finance, and specifically an authorized corporate representative, where unsuspecting consumers are to be deceived and financially prejudiced. Complainants' evidence submitted supports that by using the fraudulent website accessed through the disputed domain names to impersonate Complainants, prospective buyers of banking financial instruments are misled by Respondent to believe that the website and services offered are those of Complainants. In furtherance of this false association, the prospective buyers are sent emails, with fraudulent documents attached which purport to be sent from a specific bank officer of Complainant Discovery Finance.

Prior UDRP panels have held that the use of a domain name for illegal activity (e.g., phishing, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) as has been done here can never confer rights or legitimate interests on a respondent. See, [WIPO Overview 3.0](#), section 2.13. See also, *Springer Nature Limited v. Registration Private, Domains By Proxy, LLC / Collections Springer Nature*, WIPO Case No. [D2020-0955](#).

In view of the above, the Panel finds that Complainants have made out a *prima facie* case that Respondent has no rights or legitimate interests in the disputed domain names used for its fraudulent scheme.

Respondent has not submitted any argument or evidence to rebut Complainants' *prima facie* case. The Panel concludes, therefore, that Complainants have established, by a preponderance of the evidence that Respondent lacks rights or legitimate interests in the disputed domain names and Complainants have successfully met its burden under paragraph 4(a)(ii) of the Policy.

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

Complainants contend that because Respondent has registered the disputed domain names that are confusingly similar to Complainants DISCOVERY Mark, incorporate in one case the entirety of the corporate name of Complainant Discovery Finance, and both of which sustain email addresses used in furtherance of impersonation of Discovery Finance and its representative to perpetrate an elaborate fraudulent scheme, it is implausible to believe that Respondent was not aware of Complainants' DISCOVERY Mark when it registered its confusingly similar disputed domain names. This is especially true where Complainants well-known DISCOVERY Mark has been used for almost thirty years and is recognized worldwide, having maintained a global presence online for providing a vast array of insurance and financial services including its banking services in the U.K., where Respondent is apparently located.

Prior UDRP panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly typos or domain names incorporating the mark plus a descriptive term) to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith which is certainly borne out here given the highly orchestrated fraudulent conduct present. See, [WIPO Overview 3.0](#), section 3.1.4.; see also, *Allianz SE v. Well Domains are either owned by us or Client Managed*, WIPO Case No. [D2008-0535](#).

Finally, as noted in more detail in Section 6 B above, Complainants evidence submitted showing emails sent from Respondent's disputed domain names, impersonating Complainant Discovery Finance and its trusted representative to confuse and mislead its customers in furtherance of generating commercial benefit from Respondent's fraudulent email cybercrime scheme, is sufficient to establish bad faith registration and use under the Policy. See *Old Mutual Life Assurance Company (South Africa) Limited, Old Mutual PLC, Old Mutual Investment Advisers, Inc., Old Mutual Life Assurance Company Zimbabwe Limited, South African Mutual Life Assurance Society, Old Mutual Life Assurance Company Kenya Comer, Old Mutual Swaziland (Proprietary) Limited v. Private Whois, Knock Knock WHOIS Not There, LLC / Daria Werbowy*, WIPO Case No. [D2017-1426](#); and *TVS Motor Company Ltd. v. VistaPrint Technologies Ltd.*, WIPO Case No. [DCO2014-0007](#).

For the foregoing reasons, the Panel finds that Respondent registered and used each of the disputed domain names in bad faith and Complainants have met their burden under the third element of the Policy.

### **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 names, <discoveryfinancecompanyeurope.com>, and <discoveryfinanceeurope.com> be transferred to Complainant Discovery Limited.

*/Scott R. Austin/*

**Scott R. Austin**

Sole Panelist

Date: March 29, 2022