

ADMINISTRATIVE PANEL DECISION

Liberty Group Limited v. Lei Shi (石磊)

Case No. D2022-3389

1. The Parties

The Complainant is Liberty Group Limited, South Africa, represented by Adams & Adams, South Africa.

The Respondent is Lei Shi (石磊), China.

2. The Domain Names and Registrar

The disputed domain names <libertygroupbenefit.com>, <libertygroupbenefits.com>, and <libertygroupbenefits.com> are registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on September 12, 2022. On September 12, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 13, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

On September 15, 2022, the Center transmitted an email communication to the Parties in English and Chinese regarding the language of the proceeding. On September 16, 2022, the Complainant confirmed its request that English be the language of the proceeding. The Respondent did not comment on the language of the proceeding.

The Center verified that 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 in Chinese and English of the Complaint, and the proceedings commenced on September 23, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 13, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 17, 2022.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on October 27, 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 Complainant is a financial services group focusing on the African markets, and is headquartered in South Africa. The Complainant was founded in 1957 by Sir Donald Gordon and, at present, the Complainant has a presence in over 24 African countries, offering its financial services to over three million people across Africa. Currently, the Complainant operates as an African wealth management group, offering a diverse range of products and services, including asset management, health and life insurance related products and services, investment management services, property investment, and retirement income facilitation.

The Complainant owns an international portfolio of trademark registrations for a series of LIBERTY related trademarks, of which its LIBERTY GROUP trademarks are the most relevant to this Decision. These trademarks include, but are not limited to, South African trademark number 2000/15088 for the mark LIBERTY GROUP, registered on October 29, 2004, and Kenyan trademark registration number 1066728 for the mark LIBERTY GROUP, registered on July 5, 2010. The Complainant also maintains an Internet presence through its social media channels and its official websites, including the one located at its domain name <liberty.co.za>, which hosts a website that displays information about the Complainant and its activities in South Africa.

The disputed domain names <libertygroupbenefit.com>, <libertygroupbenefits.com>, and <libertygroupbenifits.com> were all registered on February 3, 2022 and all such disputed domain names are therefore of a later date than the abovementioned registered trademarks of the Complainant. The disputed domain names are currently linked to active websites, each displaying what are presumed to be pay-per-click hyperlinks relating to, *inter alia*, insurance claims, employee benefits, employers, and employee feedback management platform.

The Complainant attempted to settle this matter amicably through the online form provided by the Registrar and subsequently received a reply by email from the Respondent on April 5, 2022 offering to sell the disputed domain name <libertygroupbenefits.com> for USD 2,199. The Complainant sent a letter of demand on June 23, 2022 to the Respondent and received no answer.

5. Parties' Contentions

A. Complainant

The Complainant essentially contends that the disputed domain names are confusingly similar to its prior trademarks for LIBERTY GROUP, that the Respondent has no rights or legitimate interests in respect of the disputed domain names, and that the disputed domain names were registered, and are being used in bad faith.

The Complainant claims that its trademarks are distinctive and internationally well known, and provides evidence of its official website contents, marketing materials and awards, including winning the Life and Risk and Employee categories in the Financial Association of South African awards. The Complainant essentially contends that the Respondent chose to register the disputed domain names that include the Complainant's LIBERTY GROUP marks to create consumer confusion and to obtain unlawful financial gains through placing pay-per-click hyperlinks at the websites connected to the disputed domain names. The Complainant contends that such use does not grant the Respondent any rights or legitimate interests in the disputed domain names. The Complainant also contends that the Respondent has attempted to sell the disputed domain names to the Complainant for the sum of USD 6,597, being USD 2,199 per disputed domain name,

which it argues is an amount far in excess of the Respondent's out of pocket expenses. The Complainant essentially contends that the registration and use of the disputed domain names in such circumstances constitutes registration and use in bad faith.

The Complainant requests the transfer of the disputed domain names.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

6.1. Preliminary Issue: Language of the Proceeding

Pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

According to the Registrar's verification response, the language of the Registration Agreements for the disputed domain names is Chinese. Nevertheless, the Complainant filed its Complaint in English, and requests that English be the language of the proceeding. The Panel notes that the Respondent did not comment on the language of the proceeding and did not submit any arguments on the merits of this proceeding.

The Panel has carefully considered all elements of this case, and considers the following elements particularly relevant: the Complainant's request that the language of the proceeding be English; the lack of comments on the language of the proceeding and the lack of response on the merits of this proceeding by the Respondent (the Panel notes that the Respondent was invited in a timely manner by the Center to present its comments and response in either English or Chinese, but chose not to do so); the fact that the websites hosted at the disputed domain names contain links only in English and that the disputed domain names comprise English words and are written in Latin letters and not in Chinese characters; and, finally, the fact that making Chinese as the language of this proceeding could lead to unwarranted delays and additional costs for the Complainant. In view of all these elements, the Panel grants the Complainant's request, and decides that the language of this proceeding shall be English.

6.2. Discussion and Findings on the Merits

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain names are identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

Based on the evidence and arguments submitted, the Panel's findings are as follows:

A. Identical or Confusingly Similar

The Panel finds that the Complainant has shown sufficient evidence that it has valid rights in the mark LIBERTY GROUP, based on its intensive use and registration of the same as a trademark in several jurisdictions.

Moreover, as to confusing similarity, the Panel considers that the disputed domain names each incorporates the entirety of the Complainant's LIBERTY GROUP trademark. In this regard, the Panel refers to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.7, which states: "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". The Panel finds that the aforementioned disputed domain names all incorporate the entirety of the Complainant's trademark for LIBERTY GROUP, combined with the elements "benefit", "benefits", or "benifits", which do not prevent a finding of confusing similarity (see [WIPO Overview 3.0](#), section 1.8). The Panel therefore considers all of the aforementioned disputed domain names confusingly similar to the Complainant's trademark for LIBERTY GROUP. Furthermore, the Panel notes that the applicable generic Top-Level Domain ("gTLD") (".com" in this case) is viewed as a standard registration requirement for the disputed domain names, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1.

Accordingly, the Panel concludes that the disputed domain names are all confusingly similar to the Complainant's trademark and finds that the Complainant has satisfied the requirements of the first element under the Policy.

B. Rights or Legitimate Interests

On the basis of the evidence and arguments submitted, the Panel finds that the Complainant makes out a *prima facie* case that the Respondent is not, and has never been, an authorized reseller, service provider, licensee or distributor of the Complainant, is not a *bona fide* provider of goods or services under the disputed domain names and is not making a legitimate noncommercial use or fair use of the disputed domain names. The Panel also notes that the Respondent is not commonly known by the disputed domain names. As such, the Panel finds that the burden of production regarding this element shifts to the Respondent (see [WIPO Overview 3.0](#), section 2.1). However, the Respondent did not provide any Response or evidence in this proceeding.

Furthermore, upon review of the facts, the Panel notes that the disputed domain names direct to active webpages containing what are presumed to be pay-per-click hyperlinks relating to, *inter alia*, insurance claims, employee benefits, employers, and employee feedback management platform. The Panel concludes that this shows the Respondent's intention to compete with, or capitalize on the reputation and goodwill of the Complainant's trademark for LIBERTY GROUP (see also [WIPO Overview 3.0](#), section 2.9, and previous UDRP decisions in this sense such as *Maker Studios, Inc. v. ORM LTD / Contact Privacy Inc. Customer 0137258808*, WIPO Case No. [D2014-0918](#) and *Comerica Incorporated v. Balticsea LLC / Contact Privacy Inc. Customer 0131519121*, WIPO Case No. [D2013-0932](#)).

On the basis of the foregoing, the Panel finds that none of the circumstances of rights or legitimate interests envisaged by paragraph 4(c) of the Policy apply, and that the Complainant has satisfied the requirements of the second element under the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the registration of the disputed domain names, containing the entirety of the Complainant's intensively used and widely-known mark LIBERTY GROUP by the Respondent, who is unaffiliated with the Complainant, is, by itself, sufficient to create a presumption of bad faith of the Respondent (see in this regard *Alain Afflelou Franchiseur v. Lihongbo, Lihongbo*, WIPO Case No. [D2020-2075](#) and *Randstad Holding nv v. Pinaki Kar*, WIPO Case No. [D2013-1796](#)). Furthermore, the Panel also considers that the Respondent clearly and consciously targeted the Complainant's prior registered trademarks for LIBERTY GROUP by registering the disputed domain names, which are all confusingly similar to such trademarks and contain the English word "benefit" or the typographical variations thereof, which could refer to services offered by the Complainant. The Panel deduces from these efforts that the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks at the time of registering the disputed domain names. In the Panel's view, the preceding elements indicate the bad

faith of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain names in bad faith.

As to use of the disputed domain names in bad faith, the websites linked to the disputed domain names currently display pay-per-click hyperlinks relating to, *inter alia*, insurance claims, employee benefits, employers, and employee feedback management platform. This shows that the Respondent is misleading and diverting consumers for commercial gain to such websites. Moreover, the Panel also notes that the Complainant sufficiently proves that the Respondent has attempted, by his email of April 5, 2022, to sell the disputed domain name <libertygroupbenefits.com> to the Complainant for the sum of USD 2,199, which the Panel considers to be an amount far in excess of the Respondent's out-of-pocket expense. The preceding elements lead the Panel to conclude that the Respondent is using the disputed domain names in bad faith.

Finally, the Respondent has failed to provide any response or evidence to establish its good faith or absence of bad faith. The Panel therefore finds that the Complainant has satisfied the requirements of the third element under 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, <libertygroupbenefit.com>, <libertygroupbenefits.com>, and <libertygroupbenefits.com>, be transferred to the Complainant.

/Deanna Wong Wai Man/

Deanna Wong Wai Man

Sole Panelist

Date: November 10, 2022