

## **ADMINISTRATIVE PANEL DECISION**

**Benefitfocus.com, Inc. v. Carolina Rodrigues, Fundacion Comercio Electronico; Zhichao; 杨智超 (Zhichao Yang); LAKSH INTERNET SOLUTIONS PRIVATE LIMITED**  
Case No. D2022-4032

### **1. The Parties**

The Complainant is Benefitfocus.com, Inc., United States of America (“USA” or “United States”), represented by Nelson Mullins Riley & Scarborough, L.L.P., USA.

The Respondents are Carolina Rodrigues, Fundacion Comercio Electronico, Panama (the “Respondent 1”); Zhichao, China (the “Respondent 2”); 杨智超 (Zhichao Yang), China (the “Respondent 3”); and LAKSH INTERNET SOLUTIONS PRIVATE LIMITED, India, self-represented (the “Respondent 4”).

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

The disputed domain name <bebenefitfocus.com> is registered with Alibaba Cloud Computing (Beijing) Co., Ltd. (the “Registrar 1”); the disputed domain name <benefitfocis.com> is registered with NameCheap, Inc. (the “Registrar 2”); the disputed domain name <benefitfocs.com> is registered with Alibaba Cloud Computing Ltd. d/b/a HiChina (www.net.cn) (the “Registrar 3”); the disputed domain names <benefitfocus.com> and <mybenefitfocus.com> is registered with Dynadot, LLC (the “Registrar 4”); the disputed domain name <benefitsbenefitfocus.com> is registered with Chengdu West Dimension Digital Technology Co., Ltd. (the “Registrar 5”); the disputed domain name <benifitfocus.com> is registered with Tirupati Domains and Hosting Pvt Ltd. (the “Registrar 6”); and the disputed domain name <brookdalebenefitsbenefitfocus.com> is registered with GoDaddy.com, LLC (the “Registrar 7”) (together, the “Registrars”).

### **3. Procedural History**

The Complaint was filed in English with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 27, 2022, the Center transmitted by email to each of the Registrars a request for registrar verification in connection with the disputed domain names.

On October 27, 2022 and October 28, 2022, the Registrar 2 and the Registrar 7 respectively transmitted by email to the Center their verification responses disclosing that the registrant for the disputed domain names <benefitfocis.com> and <brookdalebenefitsbenefitfocus.com> is the Respondent 1, Carolina Rodrigues, Fundacion Comercio Electronico, together with contact information which differed from the named

Respondent (Domains By Proxy, LLC and Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint.

On October 27, 2022, the Registrar 4 transmitted by email to the Center its verification response disclosing that the registrant for the disputed domain names <benefitocus.com> and <mybenefitfocus.com> is the Respondent 2, Zhichao, together with contact information, which differed from the named Respondent and contact information in the Complaint.

On October 28, 2022, the Registrar 1, the Registrar 3, and the Registrar 5, each transmitted by email to the Center its verification response disclosing that the registrant for the disputed domain names <bebefitfocus.com>, <benefitfocs.com>, and <benefitsbenefitfocus.com> is the Respondent 3, 杨智超 (Zhichao Yang), together with contact information, which differed from the named Respondent and contact information in the Complaint. They also disclosed that the Registration Agreement for each of the disputed domain names <benefitsbenefitfocus.com>, <benefitfocs.com>, and <bebefitfocus.com> is in Chinese.

On October 29, 2022, the Registrar 6 transmitted by email to the Center its verification response disclosing that the registrant for the disputed domain name <benifitfocus.com> is the Respondent 4, LAKSH INTERNET SOLUTIONS PRIVATE LIMITED, together with the contact information which differed from the named Respondent (Domain Whois Protect Service) and contact information in the Complaint.

On October 31, 2022, the Center sent an email communication to the Complainant providing the registrant and contact information disclosed by the Registrars, and inviting the Complainant to submit an amendment to the Complaint. On the same day, the Center transmitted another email communication to the Parties in English and Chinese regarding the language of the proceeding. The Complainant filed an amended Complaint in English (the "First Amended Complaint") on November 2, 2022, including a request for English to be the language of the proceeding. The Respondents did not comment on the language of the proceeding.

On November 3, 2022, the Respondent 4, LAKSH INTERNET SOLUTIONS PRIVATE LIMITED, sent an email indicating their willingness to transfer the disputed domain name <benifitfocus.com> to the Complainant at a price of USD 800. On November 4, 2022, the Complainant submitted to the Center a request to suspend the proceeding in order to explore settlement options with the Respondent 4. The proceeding was therefore suspended as of November 8, 2022 for a period of 30 days. On December 5, 2022, the Complainant submitted to the Center a request to reinstitute the proceeding. The proceeding was therefore reinstated as of December 8, 2022. On December 7, 2022, the Complainant filed a second amended Complaint in English (the "Second Amended Complaint").

The Center verified that the Complaint together with the two amended Complaints 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 Respondents in English and Chinese of the Complaint, and the proceedings commenced on December 8, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 28, 2022. The Respondent 4 filed a Response in English on December 28, 2022.

The Center appointed Deanna Wong Wai Man as the sole panelist in this matter on January 17, 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.

#### **4. Factual Background**

The Complainant in this proceeding is a cloud-based benefits administration technology company mainly serving employers and health plans. The Complainant particularly provides services to organizations simplifying the complexity of benefits administration while enrolling people in the right healthcare and benefit programs for them and their families. The Complainant's customers include employers of all sizes across a variety of industries, including some of the USA's largest insurance carriers and aggregators. The Complainant claims that it provides its services to 25 million individuals, or one of every 12 employees in the USA.

The Complainant owns a portfolio of trademark registrations (word marks) for BENEFITFOCUS, including, but not limited to, United States trademark registration number 2,496,059, registered on October 9, 2001 and United States trademark registration number 4,565,511, registered on July 8, 2014. The Complainant also states that it owns additional trademark registrations in jurisdictions such as Australia, Canada, China, Ireland, Israel, India, New Zealand, South Africa, and United Kingdom.

The disputed domain names were registered on various dates between December 12, 2006, and August 30, 2022, with seven out of the eight disputed domain names being registered between March 15, 2020, and August 30, 2022. However, for the reasons stated in section 6.1 below, this Decision will deal with the disputed domain name <benefitfocus.com> only. This disputed domain name was registered at a later date than the earliest of the abovementioned registered trademarks of the Complainant, *i.e.*, on December 12, 2006, which appears to be acquired by the Respondent 4 in 2013 (see further discussion below). The disputed domain name <benefitfocus.com> directs to a website displaying pay-per-click hyperlinks to service providers of employee benefits and health insurance.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant essentially contends that the disputed domain names are confusingly similar to its trademarks for BENEFITFOCUS, that the Respondents have 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 intensively used in the employee benefits sector, and provides evidence of its marketing materials. Moreover, the Complainant provides evidence that the disputed domain names are linked to various active websites, which it claims are taking unfair advantage of its trademarks through either hosting pay-per-click hyperlinks or through redirecting visitors to websites that appear to attempt to download malicious software. The Complainant essentially contends that the registration and use of the disputed domain names in such manner does not confer any rights or legitimate interests in respect of the disputed domain names and constitutes registration and use of such disputed domain names in bad faith.

The Complainant requests the transfer of the disputed domain names.

##### **B. Respondent**

In its email communication of November 3, 2022, the Respondent 4 asserted that: a) it had purchased the disputed domain name <benefitfocus.com> for a website on "Focused benefits"; b) as the Complainant claimed to have rights in this disputed domain name, it was willing to transfer it to the Complainant on the payment of its out-of-pocket expenses of USD 800.

In its Response regarding the disputed domain name <benefitfocus.com>, the Respondent 4 essentially contends that the Complainant does not own sufficient trademark rights as its trademarks do not cover the

entire world or all classes of goods and services. With reference to rights or legitimate interests, the Respondent 4 denies the Complainant's allegations and argues that it has paid compensation of USD 800 for the acquisition of the disputed domain name and that it is therefore entitled to own this disputed domain name. The Respondent 4 also denies that it is using the disputed domain name in bad faith. The Panel notes that the Respondent 4 submits an alleged domain name transfer invoice in 2013 concerning the disputed domain name <benifitfocus.com> listing the transfer amount of USD 800. The Respondent 4 argues that, by requesting the sum of USD 800 from the Complainant for the transfer of the disputed domain name, it is only requesting the proven out-of-pocket costs relating to this disputed domain name. The Respondent 4 finally also argues that the Complaint was filed in bad faith and constitutes reverse domain name hijacking.

## 6. Discussion and Findings

### 6.1 First Preliminary Issue: Consolidation of the Respondents

The Complainant requested consolidation of the Respondents in this proceeding.

In this regard, paragraphs 3(c) and 10(e) of the Rules, respectively, provide that: "The complaint may relate to more than one domain name, provided that the domain names are registered by the same domain-name holder" and "A panel shall decide a request by a Party to consolidate multiple domain name disputes in accordance with the Policy and these Rules". It follows from the foregoing paragraphs of the Rules and from the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), paragraph 4.11.2, that the consolidation of multiple respondents in a single administrative proceeding may, in certain circumstances, be appropriate, provided that the Complainant can demonstrate that the disputed domain names or the websites to which they resolve are subject to common control, and the Panel, having regard to all of the relevant circumstances, determines that such consolidation is procedurally efficient, fair and equitable to all parties.

In the present case, the Complainant essentially contends that the disputed domain names are all under common control based on the following elements: the similar naming pattern of the disputed domain names, the similar nameservers used, the similarity between some of the contents of the websites linked to some of the disputed domain names and the fact that the Respondent 1, the Respondent 2, and the Respondent 3 are allegedly habitual cybersquatters and have been named as co-respondents in a number of earlier UDRP proceedings, such as *Oboleo Ltd v. 杨智超 (Zhi Chao Yang)*, *Zhichao Yang*, *Zhichao*, *Privacy Administrator*, *Anonymize, Inc.*, *Carolina Rodrigues*, *Fundacion Comercio Electronico*, and *Milen Radumilo*, WIPO Case No. [D2020-1952](#).

The Panel finds that the Respondent 2, Zhichao and the Respondent 3, 杨智超 (Zhichao Yang) are in fact the same person because they share the same email address and Zhichao is pinyin for his Chinese name 智超. The Respondent 2 and the Respondent 3 are therefore collectively referred to as the "Respondents 2 and 3". However, the Panel finds that the above-mentioned factors, considered alone or in combination, do not sufficiently support the Complainant's claim that there is common control being exercised by the Respondents over the disputed domain names. The Panel particularly notes the following facts: the Respondent 4, LAKSH INTERNET SOLUTIONS PRIVATE LIMITED, has provided a Response, and this Response only concerns the disputed domain name <benifitfocus.com> and none of the other disputed domain names; there are no similarities between the Respondents' identities and contact information to render a clear link; the disputed domain names were registered on different dates and with different Registrars; the nameservers and IP addresses associated with the disputed domain names owned by the Respondent 1, and the Respondents 2 and 3 are different; and prior UDRP panels have already declined to grant the request for consolidation concerning the Respondent 1, and the Respondents 2 and 3 (see notably *Oboleo Ltd v. 杨智超 (Zhi Chao Yang)*, *Zhichao Yang*, *Zhichao*, *Privacy Administrator*, *Anonymize, Inc.*, *Carolina Rodrigues*, *Fundacion Comercio Electronico*, and *Milen Radumilo*, *supra*; and *Lennar Pacific Properties Management, Inc.*, *Lennar Mortgage, LLC v. Registration Private, Domains By Proxy, LLC / Carolina Rodrigues*, *Fundacion Comercio Electronico*, 杨智超 (Zhichao Yang), WIPO Case No.

[D2021-4262](#)). Based on the above elements, the Panel finds that the Complainant has not demonstrated that the disputed domain names are under common control, or that there is a clear affiliation between the Respondents.

Accordingly, having regard to the above circumstances, the Panel hereby rejects the Complainant's request for consolidation. The Panel, however, accepts the Complaint filed in relation to the disputed domain name, <benefitfocus.com>, for which a Response was filed, and will confine this Decision accordingly in reference to that disputed domain name only.

The Panel notes that the Complainant remains at liberty to file new complaints in respect of the other disputed domain names. Further references below to the Respondent and the disputed domain name in this Decision are therefore intended to refer solely to the Respondent 4, namely LAKSH INTERNET SOLUTIONS PRIVATE LIMITED, and the disputed domain name, namely <benefitfocus.com>. This Decision is made without prejudice to the refiling of complaints regarding the other disputed domain names in this administrative proceeding. The Panel will not be commenting on the other disputed domain names and the related submissions.

## **6.2 Second Preliminary Issue: Language of the Proceeding**

In relation to <benefitfocus.com>, pursuant to paragraph 11(a) of the Rules, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding.

Given the fact that the present proceeding is now limited to the disputed domain name <benefitfocus.com>, for which the language of the Registration Agreement is in English, and that the Complaint was filed in English, and that the Complainant requests English as the language of the proceeding, and that the Respondent filed its Response in English, the Panel decides that the language of the proceeding shall be English.

## **6.3. Discussion and Findings on the Merits**

The Policy requires the Complainant to prove three elements:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name has been registered and is 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 BENEFITFOCUS, based on its intensive use and registration of the same as a trademark. The Panel disagrees with the Respondent's arguments that such marks would not be sufficient as the Complainant does not own its trademarks for the entire world and for all classes of goods and services. In this regard, the Panel refers to the [WIPO Overview 3.0](#), section 1.1.2, which states "[n]oting in particular the global nature of the Internet and Domain Name System, the jurisdiction(s) where the trademark is valid is not considered relevant to panel assessment under the first element".

Moreover, as to confusing similarity, the Panel refers to the [WIPO Overview 3.0](#), section 1.9, which states: "[a] domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element". In this

case, the disputed domain name is clearly an intentional misspelling of the Complainant's trademark for BENEFITFOCUS, incorporating such trademark in its entirety, except that in a single letter of such mark is misspelled (notably, the letter "e" is replaced by the letter "i"). The Panel also considers that in spite of this intentional misspelling, the Complainant's BENEFITFOCUS trademark still remains clearly recognizable in these disputed domain name. Accordingly, the Panel considers that this is a clear case of intentional misspelling of the Complainant's trademark, also known as "typosquatting", and the Panel therefore considers the disputed domain name confusingly similar to the Complainant's trademarks for BENEFITFOCUS.

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 name, and may as such be disregarded by the Panel, see in this regard the [WIPO Overview 3.0](#), section 1.11.1.

For the reasons above, the Panel concludes that the disputed domain name is 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 good faith provider of goods or services under the disputed domain name and is not making legitimate noncommercial use or fair use of the Complainant's disputed domain name. The Panel also notes that the Respondent is not commonly known by the disputed domain name. 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).

In its Response, the Respondent essentially denies the Complainant's contentions and argues that it has paid compensation of USD 800 for the transfer of the disputed domain name and that it is therefore entitled to own this disputed domain name. The Respondent also claims that it has purchased the disputed domain name to be used for a website on "Focused benefits".

The Panel does not agree with the Respondent's arguments. Firstly, it is the settled view of panels applying the Policy that the mere registration or acquisition of a domain name does not establish rights or legitimate interests *per se* in such domain name (see in this regard for instance *Alain Afflelou Franchiseur v. lihongbo*, WIPO Case No. [D2020-2074](#) and *National Football League Properties, Inc. and Chargers Football Company v. One Sex Entertainment Co., a/k/a chargergirls.net*, WIPO Case No. [D2000-0118](#)). Furthermore, the Respondent has not provided any evidence regarding its intended use of the disputed domain name for a website on "Focused benefits". Rather, the Panel notes that, according to the evidence submitted, the disputed domain name directs to an active webpage containing what are presumed to be pay-per-click hyperlinks to service providers of employee benefits and health insurance. The Panel concludes that this shows that it is most likely that the Respondent's intention is to compete with, or capitalize on the reputation and goodwill of the Complainant's trademark for BENEFITFOCUS (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](#)). Moreover, if the Respondent indeed had an intention to set up a website on "Focused benefits", the Respondent could have registered a domain name incorporating that term or a similar one. Why did the Respondent purchase the disputed domain name which misspells the word "benefit" together with "focus"?

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 name, constituting typosquatting of the Complainant's prior and intensively used mark by the Respondent, who is entirely unaffiliated with the Complainant, is, by itself, sufficient to create a presumption of bad faith of the Respondent (see in this regard also *Alain Afflelou Franchiseur v. Lihongbo, Lihongbo* WIPO Case No. [D2020-2075](#)). Furthermore, the Panel also considers that the Respondent clearly and consciously targeted the Complainant's prior registered trademark for BENEFITFOCUS by registering the disputed domain name, which is confusingly similar to this trademark, differing only a single letter from such mark. The Panel deducts from the Respondent's efforts to consciously target the Complainant's intensively used trademark that the Respondent knew, or at least should have known, of the existence of the Complainant's trademark at the time of registering the disputed domain name. In the Panel's view, the preceding elements clearly indicate the bad faith of the Respondent, and the Panel therefore finds that it has been demonstrated that the Respondent registered the disputed domain name in bad faith.

As to use of the disputed domain name in bad faith, the Respondent denies that it is using the disputed domain name in bad faith, but provides no evidence or substantiated arguments to support its contentions. On the other hand, the Complainant provides evidence that the website linked to the disputed domain name resolves to an active webpage containing what are presumed to be pay-per-click hyperlinks to service providers of employee benefits and health insurance. The Panel finds that this shows that the Respondent is misleading and diverting consumers for financial gain to such website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the registrant's website. The Panel concludes that this constitutes direct evidence of the bad faith of the Respondent under paragraph 4(b)(iv) of the Policy.

The Panel therefore finds that the Complainant has satisfied the requirements of the third element under the Policy.

### **D. Reverse Domain Name Hijacking**

Noting that the Complainant has satisfied the three elements under paragraph 4(a) of the Policy, the Panel finds that the Complaint was not brought in bad faith and does not constitute an abuse of the administrative proceeding.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that: (a) the disputed domain name, <benefitfocus.com>, be transferred to the Complainant; and (b) the claim regarding the disputed domain names <bebenefitfocus.com>, <benefitfocis.com>, <benefitfocs.com>, <benefitocus.com>, <benefitsbenefitfocus.com>, <brookdalebenefitsbenefitfocus.com>, and <mybenefitfocus.com> is dismissed without prejudice.

*/Deanna Wong Wai Man/*

**Deanna Wong Wai Man**

Sole Panelist

Date: February 8, 2023