



DECISION

Securian Financial Group, Inc. v. Hou Chang Li

Claim Number: FA2005001896814

PARTIES

Complainant is **Securian Financial Group, Inc.** (“Complainant”), represented by **William Schultz of Merchant & Gould, P.C.**, Minnesota. Respondent is **Hou Chang Li** (“Respondent”), China.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is **<mnlifeinsurance.com>**, registered with **West263 International Limited**.

PANEL

The undersigned certifies that he has acted independently and impartially and to the best of his knowledge has no known conflict in serving as Panelist in this proceeding.

David L. Kreider as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the FORUM electronically on May 18, 2020; the FORUM received payment on May 18, 2020.

On May 19, 2020, West263 International Limited confirmed by e-mail to the FORUM that the **<mnlifeinsurance.com>** domain name is registered with West263 International Limited and that Respondent is the current registrant of the name.

West263 International Limited has verified that Respondent is bound by the West263 International Limited registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On May 20, 2020, the FORUM served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of June 9, 2020 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@mnlifeinsurance.com. Also on May 20, 2020, the Written Notice of the Complaint, notifying Respondent of the e-mail addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on May 30, 2020.

On June 3, 2020, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the FORUM appointed David L. Kreider as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the FORUM has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent" through submission of Electronic and Written Notices, as defined in Rule 1 and Rule 2.

Preliminary Issue – Language of the Proceeding

Pursuant to UDRP Rule 11(a), the Panel finds that persuasive evidence has been adduced by Complainant to suggest the likely possibility that the Respondent is conversant and proficient in the English language. After considering the circumstances of the present case, the Panel decides that these proceedings should be conducted in English.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

a. The Domain Name is Confusingly Similar to the MINNESOTA LIFE Mark.

The Domain Name <mnlifeinsurance.com> gives the impression of relating to Complainant's MINNESOTA LIFE trademark. The term Minnesota Life, albeit with Minnesota abbreviated to "MN," is combined with the services Complainant provides, namely "insurance," to form the Domain Name. Thus, the Domain Name is confusingly similar to the MINNESOTA LIFE mark pursuant to Policy ¶ 4(a)(i). The abbreviation "MN" is insufficient to differentiate the Domain Name from the trademark. Further, it is natural for consumers to assume that the website located at <mnlifeinsurance.com>, which contains information similar to Complainant's offerings under the MINNESOTA LIFE brand, is sponsored by, affiliated, or associated with the Complainant. *See Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999) (holding the content of a website may increase the likelihood of consumer confusion). Further, the addition of the top-level domain is immaterial under the Policy. *See, e.g., Trip Network Inc. v. Alviera*, FA 914943 (Nat. Arb. Forum Mar. 27, 2007)

(concluding that the affixation of a gTLD to a domain name is irrelevant to a Policy ¶ 4(a)(i) analysis).

The requirement of confusing similarity is met.

b. The Respondent Does Not Have Any Right or Legitimate Interest in the Domain Name.

Respondent does not have any right or legitimate interest in the Domain Name. The registration of a domain name for the purpose of redirecting Internet users interested in another's services is not a *bona fide* offering pursuant to Policy ¶ 4(c)(i). Moreover, Respondent has no legitimate right to the name in that it has not received permission to use the mark pursuant to Policy ¶ 4(c)(ii). Furthermore, before any notice to Respondent of the dispute, Respondent did not use the mark for a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii) because Respondent directed the Domain Name to a website that offers information confusingly similar to the Complainant's offerings, including commercial links to competing products.

A respondent's use of a domain name to trick consumers into visiting its website instead of the trademark owner's site is not a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i). *See Bank of Am. Corp. v. Nw. Free Cmty. Access*, FA 180704 (Nat. Arb. Forum Sept. 30, 2003) ("Respondent's demonstrated intent to divert Internet users seeking Complainant's website to a website of Respondent and for Respondent's benefit is not a *bona fide* offering of goods or services under Policy ¶4(c)(i)"). Indeed, the use of a domain name to forward Internet users to a third-party product page does not constitute a *bona fide* use of a domain name. *Seiko Epson Corporation and Epson America, Inc. v. H.M., LLC*, FA1008001341798 (Nat. Arb. Forum, Oct. 5, 2010) (holding use of amazon.com links to third parties who sold complainant's goods was not a *bona fide* offering of goods or services under Policy ¶ 4(c)(i)); *Ashley Furniture*

Industries, Inc. v. Domain, FA1439400 (Nat. Arb. Forum May 13, 2012) (holding that forwarding a domain name to a website hosting pay-per-click links was not a *bona fide* offering of goods or services under Policy ¶ 4(c)(i) or a legitimate noncommercial or fair use under Policy ¶ 4(c)(iii)).

Respondent does not have a *bona fide* interest in the Domain Name pursuant to Policy ¶ 4(c)(i) in that its intent in registering the Domain Name was to divert traffic away from the Complainant and to commercially benefit from the confusion by having consumers visit its website. Not only did the increased traffic increase the value of the Domain Name, Respondent placed pay-per-click advertising on the website associated with the Domain Name that competed against the Complainant's services.

c. The Domain Name Has Been Registered and Used In Bad Faith.

Respondent's registration of a domain name with knowledge of the Complainant's trademark rights in that name shows bad faith pursuant to Policy ¶ 4(b)(ii). Because Respondent's website associated with the Domain Name is aimed at taking customers away from the Complainant, thereby disrupting the Complainant's business. Respondent has also acted in bad faith pursuant to Policy ¶ 4(b)(iii). Respondent's intentional attempt to attract Internet users to its website by using a name that is confusingly similar to the Complainant's MINNESOTA LIFE mark is also in violation of Policy ¶ 4(b)(iv).

Respondent's registration of the Domain Name was in bad faith pursuant to Policy ¶ 4(b)(ii) because at the time the name was registered, Respondent knew of the MINNESOTA LIFE mark and prevented the Complainant from registering the Domain Name. "[T]here is a legal presumption of bad faith when [a] Respondent reasonably should have been aware of Complainant's trademarks, actually or constructively." *Digi Int'l v. DDI Sys.*, FA124506 (Nat. Arb. Forum Oct. 24, 2002); *see also Pavillion Agency, Inc. v. Greenhouse Agency, Ltd.*, D2000-

1221 (WIPO Dec. 4, 2000) (finding that the domain names are so obviously connected with Complainant that the use or registration by anyone other than Complainant suggests opportunistic bad faith); *see also Samsonite Corp. v. Colony Holding*, FA 94313 (Nat. Arb. Forum Apr. 17, 2000) (finding that evidence of bad faith includes actual or constructive knowledge of a commonly known mark at the time of registration).

Respondent had actual knowledge of the Complainant's trademark rights in its MINNESOTA LIFE Mark prior to the registration of the Domain Name, as is demonstrated by the fact that Respondent registered a domain name that includes "MNLIFE" (the abbreviation for Minnesota Life) and then linked the Domain Name to a website that has confusingly similar content to Complainant's own services, including links to "Insurance Policies," "Life Insurance Policies," and "Policies Life Insurance." Additionally, Respondent associated the Domain Name with multiple websites, showing a pattern of conduct that infringes on Complainant's rights. These circumstances lead to the conclusion Respondent knew of the Complainant and its MINNESOTA LIFE brand at the time the Domain Name was registered and continued to perpetuate a pattern of bad faith conduct when it registered the name and associated the Domain Name with multiple websites.

Bad faith is shown because Respondent registered the domain name in order to trade on the Complainant's goodwill associated with its MINNESOTA LIFE mark by creating a likelihood of confusion as to the source of the website. Respondent used the Domain Name to attract consumers who are searching for MINNESOTA LIFE services or attempting to arrive at Complainant's site. By registering and using a domain name that uses an abbreviation of the mark, Respondent tricks consumers to click on the Domain Name. Doing so directed and diverted traffic to another of Respondent's websites that was set up to commercially provide links to third party sites and advertisements. *See, The Neiman Marcus Group*,

Inc. and NM Nevada Trust v. Horoshiy, Inc., FA338381 (Nat. Arb. Forum, Oct. 5, 2004) (finding bad faith based on use of commercial links on website). Further, the displayed services competed with Complainant's services. By offering competing services to those the Complainant offers, Respondent's use of the Domain Name disrupts the Complainant's business. This demonstrates Respondent's bad faith.

B. Respondent

- a. **Respondent did not see among the Complaint and Annexures any trademark documents showing Complainant's trademark registration in China corresponding to the disputed Domain Name.**

The Respondent avers that the terms MN, Life, and Insurance, are common letters or words not subject to use as trademarks. Thus, MNLIFEINSURANCE does not constitute an infringement, unless Complainant had registered the trademarks MNLIFE or MNLIFEINSURANCE.

- b. **The respondent has a right or legal interest in the disputed domain name.**

Additionally, MN could be the abbreviated form for any two words with an M and N. It is also the abbreviated form of the Chinese word for next year "ming-nian". Respondent registered the Domain Name for the purpose of launching a domestic website for "明年人身保险".¹ As there was no reason to disclose Respondent's future plans (as anyone would understand this constituted a commercial secret), it was quite normal, the Respondent asserts, that such plans would not be articulated beforehand on the domain.

Respondent registered the domain due to his personal business needs, as a preliminary proposal, and not to use it to obtain any unlawful commercial gain or to tarnish Complainant's trademark.

c. The disputed domain name was not registered and used in bad faith.

Respondent lawfully registered the Domain Name with a Chinese registrar, providing truthful registration particulars and personal data in accordance with the registration regulations, with no obstacles or difficulties whatsoever, that is, the Respondent obtained registration of the disputed Domain Name via a lawful path.

The use of the Domain Name in areas that are not trademark protected or well-recognized by Complainant's consumers should not concern the Complainant and will not result in confusion or reputational damage. The registration of the Domain Name was reasonable and was not done for the purpose of selling it to the [Complainant]ⁱⁱ or its so-called competitors, of whom Respondent has no knowledge whatsoever. This does not reflect that the [Respondent]ⁱⁱⁱ registered the disputed domain name with any malicious intent.

The Respondent registered the Domain Name primarily for use in meeting its personal business needs and not with any intent to prevent the Complainant from reflecting its trademark in a corresponding domain name. Respondent could not have prevented this in any event and was testing the Domain Name to decide which provincial servers to buy in China. Such preparation is particularly important before the website goes online.

d. Reverse Domain Name Hijacking

In summary, we solemnly request that the Panel reject the Complainant's application and conclude that the Complainant is engaged in reverse domain name hijacking. In this case, the Complainant initially abandoned the Domain Name and the Respondent thereafter registered the name in the ordinary course. Now, the Complainant seeks to maliciously claw back the name through reverse domain name hijacking.

FINDINGS

1. Complainant and its predecessors in interest have extensively used and advertised the MINNESOTA LIFE brand in association with a wide range of products and services dating back to at least as early as 1880.
2. Complainant has established its trademark rights in the MINNESOTA LIFE mark through its registration of the mark with the United States Patent and Trademark Office ("USPTO") (e.g., Reg. No. 2462139 registered on June 19, 2001).
3. Respondent registered the disputed domain name on December 30, 2019.
4. Respondent registered and is using the Domain Name in connection with pay-per-click advertising which competes against the Complainant for traffic and then serves advertisements for profit related to the Complainant's competitors.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The Panel accepts Complainant's contention that the disputed Domain Name gives the impression of relating to the MINNESOTA LIFE trademark. The term Minnesota Life, albeit with Minnesota abbreviated to "MN," is combined with the services Complainant provides, namely "insurance," to form the Domain Name. *See, Minnesota State Lottery v. Bryan Mendes*, Forum Claim Number FA0102000096701 and *Microsoft Corp. v. Montrose Corp.*, D2000-1568 (WIPO Jan. 25, 2001).

The Respondent's objection that the Complainant has not adduced proof of registered rights in the mark in the People's Republic of China is misplaced and without merit under the Policy. Rather, proof by a complainant of trademark rights in any country is sufficient for purposes of Policy ¶ 4(a)(i). *See, Koninklijke KPN N.V. v. Telepathy Inc.*, Case No. D2001-0217 (WIPO May 7, 2001) (The Policy does not require that the mark be registered in the country in which the Respondent operates. It is sufficient that a complainant can demonstrate a mark in some jurisdiction.)

The Panel finds that the Domain Name is confusingly similar to Complainant's MINNESOTA LIFE mark pursuant to Policy ¶ 4(a)(i).

Rights or Legitimate Interests

Complainant must first make out a *prima facie* case that the Respondent lacks rights and legitimate interests in the disputed Domain Name under Policy ¶ 4(a)(ii), then the burden shifts to the Respondent to show it does have rights or legitimate interests. *See Advanced International Marketing Corporation v. AA-1 Corp*, FA 780200 (Forum Nov. 2, 2011) (finding that a complainant must offer some evidence to make its *prima facie* case and satisfy Policy ¶ 4(a)(ii)).

The Panel accepts the Complainant's evidence that Respondent has no rights or legitimate interests in the <mnlifeinsurance.com> Domain Name, as Respondent is not commonly known by the Domain Name and Complainant has not licensed or authorized Respondent to use the MINNESOTA LIFE mark. The burden shifts to the Respondent to adduce evidence that the Respondent has rights or legitimate interests in the Domain Name.

The Respondent alleges in the Response that he registered the Domain Name <mnlifeinsurance.com> because "MN" is "the abbreviated form of the [Romanized] Chinese word for next year – 'ming + nian'". Respondent asserts that registered the Domain Name because he planned to launch a website in China for a business to be called "明年人身保险", which translated into English means "Next Year Life Insurance". The Panel observes, however, that the Romanized form of Respondent's contemplated Chinese business name, "明年人身保险", would be "Ming Nian Ren Shen Bao Xian", and not "MNLIFE INSURANCE" as Respondent alleges.

Moreover, the Respondent has adduced no evidence beyond mere bare assertions, whereas ¶ 4(c)(iii) of the Policy requires that Respondent adduce independent evidence of “*demonstrable preparations*” to launch a website associated with an intent to make a *bona fide* offering of goods or services. *See, e.g., Activeworlds, Inc. v. Carnatic Trade Links Pvt. Ltd*, Case No. D2001-0249 (WIPO April 14, 2001).

The Panel finds that Respondent lacks rights and legitimate interests in the disputed Domain Name under Policy ¶ 4(a)(ii)

Registration and Use in Bad Faith

Complainant has adduced evidence to prove Respondent registered the domain name in order to trade on Complainant’s goodwill associated with its MINNESOTA LIFE mark by creating a likelihood of confusion as to the source of the website. Respondent used the Domain Name to attract consumers who are searching for MINNESOTA LIFE services or attempting to arrive at Complainant’s site. By registering and using a domain name that uses an abbreviation of the mark, Respondent tricks consumers to click on the Domain Name. Doing so directed and diverted traffic to another of Respondent’s websites that were set up to commercially provide links to third party sites and advertisements. *See, The Neiman Marcus Group, Inc. and NM Nevada Trust v. Horoshiy, Inc.*, FA338381 (Nat. Arb. Forum, Oct. 5, 2004) (finding bad faith based on use of commercial links on website). Further, the displayed services competed with Complainant’s services. By offering such competing services, Respondent’s use of the Domain Name disrupts Complainant’s business. This demonstrates Respondent’s bad faith.

Moreover, the Panel finds by a preponderance of the evidence that Respondent’s registration of the Domain Name was in bad faith pursuant to Policy ¶ 4(b)(ii),

because at the time the name was registered, Respondent knew of the MINNESOTA LIFE mark and prevented Complainant from registering the Domain Name. *See, Digi Int'l v. DDI Sys.*, FA124506 (Nat. Arb. Forum Oct. 24, 2002).

No Reverse Domain Name Hijacking by Complainant

Respondent has adduced no evidence whatsoever to show Reverse Domain Name Hijacking by the Complainant.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <mnlifeinsurance.com> domain name be **TRANSFERRED** from Respondent to Complainant.



David L. Kreider, Panelist

Dated: June 7, 2020

ⁱ The Panel finds that the Chinese character name “明年人身保險” is correctly translated as “Next Year Life Insurance”.

ⁱⁱ The original Chinese text of the Response reads “被投诉人” meaning “Respondent”. It is apparent from the context, however, that the reference should be to the “Complainant”, or in Chinese the “投诉人” .

ⁱⁱⁱ Again, the original text of the Response, refers to the “Complainant”, although the context clearly shows that the reference should be to the “Respondent”. The Panel has made the necessary edits within brackets [].