

ADMINISTRATIVE PANEL DECISION

Zacks Investment Research, Inc. v. Domains By Proxy, LLC / James Ross
Case No. D2022-2117

1. The Parties

The Complainant is Zacks Investment Research, Inc., United States of America (“United States”), represented by Latimer LeVay Fyock LLC, United States.

The Respondent is Domains By Proxy, LLC, United States / James Ross, United States.

2. The Domain Name and Registrar

The disputed domain name <thezacks.com> (the “Domain Name”) is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 10, 2022. On June 13, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On June 13, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 2022, the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on June 16, 2022.

The Center verified that the Complaint together with the amendment to 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 of the Complaint, and the proceedings commenced on June 17, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on July 12, 2022.

The Center appointed Ellen B Shankman as the sole panelist in this matter on July 25, 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 company that provides investment research and analysis.

The date of the Domain Name registration is April 9, 2022.

The trademark ZACKS serves as key brand of the Complainant and is protected as a registered trademark. The Complainant provided evidence of trademark registration for the mark ZACKS, United States Trademark Registration No. 5652428 (registered on January 15, 2019, in International Class 36), that predates the date of the Domain Name registration for a variety of financial services. The Complainant claims that it has spent a considerable amount of time and money protecting its intellectual property rights, and has used the mark in commerce since as early as 1978.

The Complainant provided some evidence that the Domain Name at one point resolved to a website mirroring the website belonging to the Complainant with erroneous contact information. The Panel conducted an independent inquiry to confirm that the Domain Name currently resolves to an error page.

5. Parties' Contentions

A. Complainant

The Complaint alleges that since 1978 the Complainant has been offering independent research and investment related content and provides professional investors with financial data and analysis which allows customers to make better investment decisions for proprietary accounts and the investment accounts of clients. The Complainant's research services are used by thousands of analysts at hundreds of brokerages in order to provide their clients with reliable investment information. The Complainant's primary website is <zacks.com>. The Complainant also manages client assets worth billions of dollars through its Zacks Investment Management subsidiary.

The Complainant provided evidence that the Domain Name resolved to a page that virtually mirrors the <zacks.com> website, and which featured an email address and a phone number which are not associated with the Complainant, as well as a page in which users would enter their contact information.

The Complainant argues that the Domain Name adds only the non-distinctive term "the" to the Complainant's trademark. The most dominant feature of the Domain Name is "zacks" which is the primary component of the Complainant's name and the ZACKS trademarks. The addition of a nondistinctive, descriptive or generic term like "the" does not change the overall impression of the Domain Name or avoid confusion.

Further, the Respondent is not affiliated or related to the Complainant in any way and is not licensed or otherwise authorized to use the Complainant's trademark. The Respondent registered and is using the Domain Name to apparently create a mirror site to the legitimate <zacks.com> website which contains incorrect contact information. It is the Complainant's belief that the Domain Name is used by the Registrant to phish unsuspecting Internet user into giving up their sensitive financial information thinking that the website is operated by the Complainant. The use by the Respondent could cause Internet users to mistakenly believe that the services offered on this website are offered by the Complainant, or by an entity affiliated to the Complainant. The Respondent's improper activities and motives exacerbates the seriousness of the Respondent's bad faith registration as it could potentially induce users to provide personal financial information to the Respondent thinking they were providing it to the Complainant. In addition,

demonstrate the Respondent's apparent attempt to misleadingly divert consumers from the Complainant, and for commercial gain, and to capitalize on the reputation and goodwill associated with the Complainant's mark. The Respondent's conduct demonstrates bad faith registration and use of the Domain Name.

To summarize the Complaint, the Complainant is the owner of registration for the trademark ZACKS, in respect of financial analysis and investment services. The Domain Name is confusingly similar to the trademark owned by the Complainant. By registering the Domain Name that comprises the Complainant's trademark in its entirety, with the mere addition of the term "the" the Respondent has created a domain name that is confusingly similar to the Complainant's trademark. As such, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. The addition of the generic term does not prevent a finding of confusing similarity. Therefore, the Domain Name could be considered virtually identical and/or confusingly similar to the Complainant's trademark. The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Domain Name. The Domain Name was registered and is being used in bad faith. Thus, the Respondent's registration and use of the Domain Name constitutes bad faith registration and use under the Policy, and the Complainant requests transfer of the Domain Name.

B. Respondent

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

6. Discussion and Findings

The burden for the Complainant under paragraph 4(a) of the Policy is to prove:

- (i) the Domain Name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforementioned three elements is present in order to obtain the transfer of the Domain Name.

In accordance with paragraph 14(a) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint. Since the Respondent did not respond to this Complaint, the supported facts regarding the use and reputation of the Complainant's mark taken from the Complaint are generally accepted as true in the circumstances of this case.

A. Identical or Confusingly Similar

The Panel finds that the Complainant has satisfactorily proven that it has registered trademark rights for ZACKS.

Further, the Panel finds that the Domain Name integrates the Complainant's mark ZACKS in its entirety with the addition of the term "the", and that the Domain Name is confusingly similar to the Complainant's trademark. Further, the Panel finds that the mere addition of the term "the" to the Domain Name does not prevent a finding of confusing similarity between the Domain Name and the Complainant's trademark. See *Pfizer Inc. v. Asia Ventures, Inc.*, WIPO Case No. [D2005-0256](#). See also *Ansell Healthcare Products Inc. v. Australian Therapeutics Supplies Pty, Ltd.*, WIPO Case No. [D2001-0110](#).

Accordingly, the Panel finds that the Complainant has satisfied the first requirement that the Domain Name is confusingly similar to the Complainant's trademark, under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy in turn identifies three non-exclusive means through which a respondent may establish rights or legitimate interests in a domain name. Although the complainant bears the ultimate burden of establishing all three elements of paragraph 4(a) of the Policy, panels have recognized that this could result in the often-impossible task of proving a negative, requiring information that is primarily, if not exclusively, within the knowledge of the respondent. Thus, the consensus view is that paragraph 4(c) shifts the burden of production to the respondent to come forward with evidence of rights or legitimate interests in the disputed domain name, once the complainant has made a *prima facie* showing. See, e.g., *Document Technologies, Inc. v. International Electronic Communications Inc.*, WIPO Case No. [D2000-0270](#).

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the Domain Name and that it is not related to or affiliated in any way with the Complainant, nor has the Complainant authorized the Respondent to use its trademarks, and is not using the Domain Name for a *bona fide* offering of goods or services nor making a legitimate noncommercial or fair use of the Domain Name. The fact that the Domain Name currently resolves to an inactive page does not change this.

Based on the available record, the Panel finds that the Complainant has established a *prima facie* case, which was not refuted by the Respondent, and that the Respondent lacks rights or legitimate interests in the Domain Name.

Therefore, the Complainant has satisfied the second requirement that the Respondent has no rights or legitimate interests in the Domain Name, under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel agrees with the Complainant that when considering the balance of probabilities, it is more likely than not that the Respondent had actual or constructive knowledge of the ZACKS trademark. Based on the evidence provided, the Panel finds that it is implausible that there could be any legitimate use of the Domain Name, confusingly similar to the Complainant's trademark. In light of and on balance of the facts set forth within this Complaint, the Panel finds that it is more likely than not that the Respondent knew of and targeted the Complainant's trademark. The Panel agrees with the Complainant's contention that indeed, the Respondent's purpose in registering the Domain Name was probably to capitalize on the reputation of the Complainant's trademarks.

By registering the Domain Name that comprises the Complainant's trademark in its entirety, with the mere addition of the term "the", and with evidence of the "mirrored" version of the Complainant's website, the Respondent has demonstrated a knowledge of and familiarity with the Complainant's brand and business. In light of the facts set forth within this Complaint, the Panel finds that it is "not possible to conceive of a plausible situation in which the Respondent would have been unaware of" the Complainant's brand at the time the Domain Name was registered. See *Telstra Corporation Limited. v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#). Further, "it defies common sense to believe that the Respondent coincidentally selected the precise domain without any knowledge of the Complainant and its trademarks." See *Asian World of Martial Arts Inc. v. Texas International Property Associates*, WIPO Case No. [D2007-1415](#).

Furthermore, the lack of current active use of the Domain Name does not prevent a finding of bad faith in the circumstances of this case. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 3.3. In that regard, the reputation of the Complainant's trademark, the choice of additional term in the Domain Name, the evidence of the earlier website, the failure of the Respondent to provide any evidence of actual or contemplated good faith use, and the implausibility of any good faith use to which the Domain Name could be put, support a finding of bad faith.

In addition, the Panel notes that, at the time of initial filing of the Complaint, a privacy service masked the registrant identity, which past panels have held serves as further evidence of bad faith registration and use. See *Dr. Ing. H.C. F. Porsche AG v. Domains by Proxy, Inc.*, WIPO Case No. [D2003-0230](#). See also [WIPO Overview 3.0](#), section 3.6 (“Panels have also viewed a respondent’s use of a privacy or proxy service which is known to block or intentionally delay disclosure of the identity of the actual underlying registrant as an indication of bad faith.”).

In light of the above, the Panel finds that the Complainant has satisfied the third requirement that the Respondent has registered and is using the Domain Name in bad faith, under paragraph 4(a)(iii) 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 Domain Name <thezacks.com> be transferred to the Complainant.

/Ellen B Shankman/

Ellen B Shankman

Sole Panelist

Date: August 2, 2022