

## ADMINISTRATIVE PANEL DECISION

Zacks Investment Research, Inc. v. carl max  
Case No. D2023-2086

### 1. The Parties

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

Respondent is carl max, United States.

### 2. The Domain Name and Registrar

The disputed domain name <zacksinvestonline.com> is registered with NameSilo, LLC (the “Registrar”).

### 3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 10, 2023. On May 11, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 11, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy, PrivacyGuardian.ord LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on May 12, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on May 12, 2023.

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 Respondent of the Complaint, and the proceedings commenced on May 16, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 5, 2023. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on June 6, 2023.

The Center appointed Scott R. Austin as the sole panelist in this matter on June 12, 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**

Without contest by Respondent, Complainant asserts in its Complaint as amended, and its Annexes attached provide evidence sufficient to support that:

Since 1978, Complainant together with its related and affiliated entities (collectively "Complainant"), has provided independent investment research and analysis services to professional investors, as well as investment management services under the service mark ZACKS (the "ZACKS Mark"). Complainant's research services are used by thousands of analysts at hundreds of brokerages to provide their clients with reliable investment information. Complainant also manages over USD 5 billion of client assets through its investment management subsidiary under the ZACKS Mark.

Complainant holds numerous trademark registrations for the ZACKS Mark and variations thereof in the U.S., including:

1. U.S. Registration No. 5,500,740, ZACKS. OUR RESEARCH. YOUR SUCCESS., filed on June 6, 2017, registered on June 26, 2018, for "financial research and information services," in International Class 36 and claiming a first use date of January 1, 2012.
2. U.S. Registration No. 5,652,428, ZACKS, filed on June 8, 2017, registered on January 15, 2019, for "financial research and information services," in International Class 36 and claiming a first use date of January 1, 2000.
3. U.S. Registration No. 5,664,114, ZACKS RANK, filed on June 8, 2017, registered on January 29, 2019, for "Compiling and analyzing statistics, data and other sources of info for investment research purpose to assign a rating value to stocks," in International Class 36 and claiming a first use date of January 1, 2000.
4. U.S. Registration No. 5,683,593, ZACKS PREMIUM filed on February 4, 2018, and registered on February 26, 2019, for "financial information provided by electronic means in the field of investments," in International Class 36 and claiming a first use date of April 1, 2006.

Complainant has also registered numerous domain names that incorporate the ZACKS Mark, including <zacks.com> its primary domain name used to access the Official ZACKS Website where it promotes its investment research and analysis services in connection with the ZACKS Mark, as well as owning <zacksim.com> used to access Complainant's website providing Complainant's investment management services. An affiliate of Complainant operates through the domain name <zackstrade.com> a website which allows individual investors both U.S. and international to actively trade.

The disputed domain name was registered on April 19, 2023, and as of April 28, 2023 resolved to a copycat website configured to impersonate Complainant by prominently featuring the ZACKS Mark with a similar triangular design feature displayed near the Mark and content headings similar to those found on Complainant's investment management website, also offering stock strategy services, to lead consumers to reasonably believe Respondent's website originated with or was affiliated with Complainant perhaps to encourage them to share their personal financial information with Respondent.

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

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

Complainant contends that the disputed domain name is identical or confusingly similar to Complainant's

trademark, that Respondent has no rights or legitimate interests in respect of the disputed domain name, and that the disputed domain name was registered and is being used in bad faith.

## **B. Respondent**

Respondent did not reply to Complainant's contentions.

## **6. Discussion and Findings**

In view of Respondent's failure to submit any Response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(f), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable, and supported, allegations and inferences set forth in the Complaint as true, unless the evidence is clearly contradictory.

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 succeed, Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied.

The Panel will address its findings on each of these requirements in more detail below.

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**

Ownership of a nationally registered trademark constitutes *prima facie* evidence that 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.

Complainant claims registered trademark rights in the ZACKS Mark for its investment research and analysis, and investment management services dating back to 2000. Sufficient evidence has been submitted in the form of electronic copies of valid and subsisting national and international trademark registration documents in the name of Complainant referenced in Section 4. Complainant has demonstrated, therefore, that it has rights in the ZACKS Mark required under the Policy. See *Horten Advokatpartnerselskab v. Domain ID Shield Service CO., Limited / Krutikov Valeriy Nikolaevich et al.*, WIPO Case No. [D2016-0205](#); see also *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). Complainant's extensive and detailed evidence submitted in the Complaint and its Annexes relating to the disputed domain name shows it clearly and prominently encompass Complainant's ZACKS Mark in full. Complainant contends, therefore, that the ZACKS Mark remains fully recognizable in the disputed domain name and is confusingly similar to Complainant's ZACKS Mark. Complainant also contends that Respondent's selection of the specific terms appended to its ZACKS Mark, which relate its investment and trading services aspects of Complainant's business is also enhances a determination of confusing similarity, but the Panel considers these facts more appropriate for consideration under the second and third elements of the Policy.

Prior UDRP panels have held that a domain name which wholly incorporates a complainant's registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy despite the addition of other terms to such marks. [WIPO Overview 3.0](#), section 1.8 ("Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms [whether descriptive, geographical, pejorative, meaningless, or otherwise] would not prevent a finding of confusing similarity under the first element") see also *Meta Platforms, Inc. et al. v. Abuz Hamal et al.*, WIPO Case No. [D2022-0212](#). Further, the addition of a

generic Top-Level Domain “is viewed as a standard registration requirement and as such is disregarded under the first element confusing similarity test”. [WIPO Overview 3.0](#), Section 1.11.1.

Complainant has satisfied paragraph 4(a)(i) of the Policy.

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

Under the second element of the Policy, Complainant has to make out a *prima facie* case that the respondent does not have rights to or legitimate interests in the disputed domain name, and if successful the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights to or legitimate interests in the disputed domain name. If the respondent fails to come forward with such evidence, a complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1. See also *The American Automobile Association, Inc. v. Privacy--Protect.org et al.*, WIPO Case No. [D2011-2069](#).

Paragraph 4(a)(ii) of the Policy also directs an examination of the facts to determine whether a respondent has rights or legitimate interests in a domain name. Paragraph 4(c) lists a number of ways in which a respondent may demonstrate that it does have such rights or legitimate interests.

The first example, under paragraph 4(c)(i), is where “before any notice to you of the dispute, your use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services”.

Here, the annexes to the Complaint show that as recently as April 28, 2023, the disputed domain name resolved to a copycat website configured by Respondent to pass its business off as Complainant’s Investment Management website or sponsored or endorsed by Complainant through prominently displaying Complainant’s ZACKS Mark, its small triangular design ornamentation near the ZACKS Mark consistent with the content displayed by Complainant on its investment management website accessed through its <zacksim.com> official domain name. Respondent’s website also used content headings substantially similar to those used by Complainant on its investment management website with no evidence of disclaimers. Complainant contends such configuration and copycat content was created by Respondent to lead consumers to reasonably believe Respondent’s copycat website originates with or is affiliated with Complainant and to engage in phishing for personal and financial data from prospective customers for Respondent’s commercial benefit.

Prior UDRP panels have held that the use of disputed domain names to confuse and attract Internet users through misuse of a well-known trademark, and the provision of content which promotes goods and services impersonating and competitive to Complainant cannot be considered use in connection with a *bona fide* offering of goods or services under Paragraph 4(c)(i). See *The Clorox Company v. WhoisGuard Protected, WhoisGuard, Inc. / Enos Villanueva, Melissa Rosenberg, Yang Ming*, WIPO Case No. [D2021-0603](#).

Prior UDRP panels have also held that the use of a domain name for illegal activity involving impersonation and fraud (e.g., phishing, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) 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](#).

Applying the foregoing decision to these facts this Panel finds the disputed domain name is not being used in connection with a *bona fide* offering of goods or services sufficient to demonstrate Respondent has any rights or legitimate interests in the disputed domain name under the factors specified by paragraph 4(c)(i) of the Policy.

The second example, under paragraph 4(c)(ii), is a scenario in which a respondent is commonly known by the domain name. Complainant states that Respondent is not related in any way to Complainant, does not carry out any activity for, nor has any business with Respondent. Neither has Complainant granted any

license or authorization to Respondent to make any use of Complainant's ZACKS Mark or apply for registration of the disputed domain name. Complainant has never authorized Respondent to use the ZACKS Mark, or any marks confusingly similar thereto for any purpose, including as a domain name. Prior UDRP panels have found a lack of rights or legitimate interests under the second element of the Policy based on such circumstances. See, e.g., *Charles Schwab & Co., Inc. v. Josh Decker d/b/a I GOT YOUR TIX*, WIPO Case No. [D2005-0179](#); *Guerlain S.A. v. H I Investments*, WIPO Case No. [D2000-0494](#).

Complainant also shows that Respondent is not commonly known by the disputed domain name because the original Respondent listed in the Whois record submitted with the initial Complaint displayed "Redacted for Privacy, PrivacyGuardian.ord LLC" of the United States. The Registrar identified the underlying registrant in its verification process, "carl max" of the United States, who has been substituted in the amended Complaint as Respondent. Neither bears any resemblance to the disputed domain name whatsoever. Thus, there is no evidence in this case to suggest that Respondent is commonly known by the disputed domain name, that it is licensed or otherwise authorized to use Complainant's trademark, or that it has acquired any trademark rights relevant thereto. As such, the Panel finds this sub-section of the Policy is of no help to Respondent and the facts presented here support a lack of rights or legitimate interests in the disputed domain name. See *Expedia, Inc. v. Dot Liban, Hanna El Hinn*, WIPO Case No. [D2002-0433](#).

In light of the above, and with no Response or other submission in this case to rebut Complainant's assertions and evidence, the Panel finds that the facts of this case demonstrate that Respondent has no rights or legitimate interests in the disputed domain name. Complainant has successfully met its burden under paragraph 4(a)(ii) of the Policy.

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

Finally, Complainant must prove, by a preponderance of the evidence, that the disputed domain name has been registered and used in bad faith under paragraph 4(a)(iii) of the Policy. See, e.g., *Hallmark Licensing, LLC v. EWebMall, Inc.*, WIPO Case No. [D2015-2202](#).

Paragraph 4(b) of the Policy sets out a non-exhaustive list of circumstances that point to bad faith conduct on the part of a respondent. The panel may, however, consider the totality of the circumstances when analyzing bad faith under Policy, paragraph 4(a)(iii) and may make a finding of bad faith that is not limited to the enumerated factors in Policy, paragraph 4(b). See *Do the Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#).

First, Complainant contends that given its ZACKS Mark is well-known, and the disputed domain name incorporates the ZACKS Mark in its entirety, shows both Respondent's actual knowledge of the ZACKS Mark and widespread recognition, especially in the United States where Respondent is located. The ZACKS Mark has been in use for decades and registered in the U.S. for almost five years before Respondent registered the disputed domain name. Prior UDRP panels have found that where, as here, it would be implausible to believe that Respondent selected and was using the disputed domain name for any other purpose than to trade on Complainant's trademark rights and reputation, establishes a fact pattern that repeatedly has been held to constitute bad faith registration and use. See *Houghton Mifflin Co. v. Weathermen, Inc.*, WIPO Case No. [D2001-0211](#); see also *Philip Morris Inc. v. Tsytkin*, WIPO Case No. [D2002-0946](#).

Prior UDRP panels have also held that a respondent's selection of a disputed domain name that comprises Complainant's mark in its entirety demonstrates a respondent's actual knowledge to support a finding of bad faith in registering and using the domain name. See, e.g., *Lloyds Bank Plc v. Marc Wiese*, WIPO Case No. [D2015-0914](#); see also, *Heineken Brouwerijen B.V. v Mark Lott*, WIPO Case No. [D2000-1487](#). Moreover, panels have consistently found that the mere registration of a domain name that is identical or confusingly similar to a well-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. See [WIPO Overview 3.0](#), section 3.1.4.

Finally, as noted in 6B. above, Respondent has intentionally configured the disputed domain name to enhance confusing similarity to Complainant's ZACKS Mark by adding a descriptive term common to

Complainant's financial services industry, "investonline", and using the disputed domain name to direct or redirect consumers to Respondent's copycat website providing asset management and stock investment services in competition with Complainant's services. Prior UDRP Panels have found these facts demonstrate a clear indication that Respondent abused Complainant's ZACKS Mark by incorporating it into the disputed domain name to create a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of Respondent's website to intentionally attract Internet users to its website for Respondent's own commercial gain and, therefore, registered and used the disputed domain name in bad faith in violation of paragraph 4(b)(iv) of the Policy. See, e.g., *Microsoft Corporation v. Zerbo*, WIPO Case No. [D2005-0644](#); *Royal Bank of Canada v. China Capital Investment Limited*, WIPO Case No. [D2017-1025](#); *Travelscape, LLC v. WhoisGuard Protected, WhoisGuard, Inc. / Irwin Periola*, WIPO Case No. [D2020-2741](#).

The Panel finds Complainant's arguments and evidence persuasive and has received no arguments or evidence from Respondent to the contrary. Considering all the circumstances, the Panel concludes that Respondent has registered and used the disputed domain name in bad faith and Complainant has satisfied 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 disputed domain name <zacksinvestonline.com> be transferred to Complainant.

*/Scott R. Austin/*

**Scott R. Austin**

Sole Panelist

Date: July 3, 2023