

ADMINISTRATIVE PANEL DECISION

Guggenheim Capital, LLC v. Martin Oravec

Case No. D2023-4543

1. The Parties

The Complainant is Guggenheim Capital, LLC, United States of America (“United States”), represented by Snell & Wilmer, LLP, United States.

The Respondent is Martin Oravec, Ukraine¹.

2. The Domain Name and Registrar

The disputed domain name <guggenheim-advisors.com> is registered with Lexsynergy Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 1, 2023. On November 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 3, 2023, 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.

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 of the Complaint, and the proceedings commenced on November 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 4, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 5, 2023.

¹ While the Panel notes that the Respondent provided Ukraine as the registrant’s country for the disputed domain name, the Panel notes that the Respondent identified London as the city.

The Center appointed Adam Taylor as the sole panelist in this matter on December 8, 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

For over 20 years, the Complainant's group has provided investment and financial advisory services under the marks GUGGENHEIM, GUGGENHEIM PARTNERS and GUGGENHEIM INVESTMENT ADVISORS. The group operates at least 16 offices in six different countries and employs more than 2,200 employees worldwide, managing over USD 295 billion in assets.

The Complainant owns the following trade marks amongst others:

- United Kingdom trade mark No. 902920387 for GUGGENHEIM, registered on November 4, 2004, in classes 9, 16, 35 and 36; and
- United States trade mark No. 3,712,544 for GUGGENHEIM INVESTMENT ADVISORS, registered on November 17, 2009, in class 36.

The Complainant operates a website at "www.guggenheimpartners.com".

The disputed domain name was registered on February 24, 2023.

As of October 27, 2023, the disputed domain name resolved to a website that was branded "INNOVATIVE SOLUTIONS ENDURING VALUES" and "GUGGENHEIM ADVISORS", and which impersonated the Complainant including use of a logo and purple colour scheme, similar to those used by the Complainant. The site contained the prominent statement that "Guggenheim Advisors is a global investment and advisory firm with more than USD 285 billion in assets under management and a track record of delivering results through innovation solutions", which had been substantially copied from the Complainant's site, substituting "Guggenheim Advisors" for "Guggenheim Partners".

5. Parties' Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for transfer of the disputed domain name.

B. Respondent

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

6. Discussion and Findings

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- the disputed domain name is identical or confusingly similar to a trade mark in which the Complainant has rights;
- the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trade mark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the mark is recognisable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "advisers" in respect of the GUGGENHEIM mark) may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. For similar reasons, it is irrelevant that the disputed domain name omits the word "investment" from the GUGGENHEIM INVESTMENT ADVISORS mark.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognised that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Furthermore, panels have held that the use of a domain name for illegal activity (here, impersonation/passing off or other kinds of fraud) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel considers that the Respondent has intentionally attempted to attract Internet users to its website for commercial gain by creating a likelihood of confusion with the Complainant's trade mark in accordance with paragraph 4(b)(iv) of the Policy.

Not only does the disputed domain name reflect the Complainant's distinctive mark, but the Respondent has used the disputed domain name for a website that deliberately sets out to impersonate the Complainant, no doubt for some fraudulent purpose.

Panels have held that the use of a domain name for such fraudulent/illegal activity constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

Based on the available record, the Panel finds the Complainant has established the third element 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 <guggenheim-advisors.com> be transferred to the Complainant.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: December 22, 2023