

## **ADMINISTRATIVE PANEL DECISION**

Guggenheim Capital, LLC v. Martin Oravec, Guggenheim Advisors Limited  
Case No. D2024-0036

### **1. The Parties**

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

The Respondent is Martin Oravec, Guggenheim Advisors Limited, United Kingdom.

### **2. The Domain Name and Registrar**

The disputed domain name <guggenheim-advisor.com> is registered with Hosting Concepts B.V. d/b/a Registrar.eu. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on January 5, 2024. On January 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On January 9, 2024, 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) and contact information in the Complaint. The Center sent an email communication to the Complainant on January 15, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on January 17, 2024.

The Center verified that the Complaint together with the amended 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 January 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was February 7, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on February 12, 2024.

The Center appointed Anna Carabelli as the sole panelist in this matter on February 16, 2024. 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 global provider of investment and financial advisory services. It 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 multiple trademark registrations all over the world (including the United Kingdom, where the Respondent is purportedly based), consisting of, or containing the word element GUGGENHEIM, including, but not limited to the following registrations:

- United Kingdom trademark No. UK902920387 for GUGGENHEIM, registered on November 4, 2004, in classes 9, 16, 35 and 36;
- United Kingdom trademark No. UK00906176267 for GUGGENHEIM PARTNERS EUROPE LIMITED, registered on July 29, 2008, in classes 16, 35, 36 and 38;
- United States of America trademark No. 3,712,544 for GUGGENHEIM INVESTMENT ADVISORS, registered on November 17, 2009, in class 36;

(hereinafter also collectively referred to as the GUGGENHEIM Marks).

The Complainant conducts business under the GUGGENHEIM Marks and since at least as early as 2003 promotes and advertises its finance-related services through its official website at "www.guggenheimpartners.com". The Complainant's group also owns numerous other GUGGENHEIM-formative domain names, including <guggemheim-advisor.net>, <guggemheim-advisor.biz>, <guggemheim-advisor.org>, <guggemheim-advisor.uk>, <guggemheim-advisors.co>, <guggemheimadvisors.net>, <guggemheimadvisors.biz>, <guggemheimadvisors.org>, <guggemheimadvisors.uk>, <guggemheimadvisors.co>.

The disputed domain name was registered on November 4, 2023. According to the uncontested evidence submitted by the Complainant, the disputed domain name resolves to a WordPress sample page that states "Hello world! Welcome to WordPress. This is your first post. Edit or delete it, then start writing!"

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

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

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

Notably, the Complainant contends that:

- Due to extensive use and advertising associated with the GUGGENHEIM Marks worldwide, the Complainant enjoys substantial goodwill and name recognition in many regions around the world;
- The disputed domain name is identical or confusingly similar to the Complainant's GUGGENHEIM Marks;

- The Respondent has no rights or legitimate interests in the disputed domain name since: (i) the Complainant has not authorized or somehow given consent to the Respondent to register and use the disputed domain name, (ii) the Respondent is not commonly known by the disputed domain name, and (iii) the Respondent's use of the disputed domain name is neither a bona fide offering of goods or services nor a legitimate noncommercial or fair use;
- The disputed domain name was registered and is being used in bad faith. The Respondent registered the disputed domain name having in mind the Complainants' GUGGENHEIM Marks to disrupt the Complainant's business. The use of the disputed domain name to display a WordPress blog sample page does not prevent a finding of bad faith under the doctrine of passive holding;
- In addition to the disputed domain name, the Respondent had registered the <guggenheim-advisors.com> domain name which was found confusingly similar to the Complainant's GUGGENHEIM Marks (see *Guggenheim Capital, LLC v. Martin Oravec*, WIPO Case No. [D2023-4543](#)). A circumstance which shows that the Respondent has engaged in a pattern of bad faith conduct, which has continued in the present case.

Based on the above the Complainant requests the disputed domain name be transferred to the Complainant.

## **B. Respondent**

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

## **6. Discussion and Findings**

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

Under paragraph 4(a) of the Policy, the complainant must prove each of the following:

- (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.

Paragraph 4(b) of the Policy sets out four illustrative circumstances, which for the purposes of paragraph 4(a)(iii) of the Policy, shall be evidence of registration and use of a domain name in bad faith.

Paragraph 4(c) of the Policy sets out three illustrative circumstances any one of which, if proved by the respondent, shall be evidence of the respondent's rights to or legitimate interests in a disputed domain name for the purpose of paragraph 4(a)(ii) of the Policy above.

### **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 trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The disputed domain name consists of the Complainant's GUGGENHEIM mark followed by a hyphen, the term "advisor" and the generic Top-Level Domain ".com".

The entirety of the mark is reproduced and recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the Complainant's GUGGENHEIM mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

The addition of a hyphen and the term "advisors" do not prevent a finding of confusing similarity. The addition of the generic Top-Level Domain such as ".com" is viewed as a standard registration requirement and as such is typically disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11.1.

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 recognized 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. The Respondent does not appear to make any legitimate noncommercial or fair use of the disputed domain name, nor any use in connection with bona fide offering of goods and services. The evidence in the Complaint is that the disputed domain name resolves to a WordPress sample page which solely contains the following message: "Hello world! Welcome to WordPress. This is your first post. Edit or delete it, then start writing!"

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 notes that the Complainant's GUGGENHEIM Marks have been continuously and extensively used for many years and have as a result acquired considerable reputation and goodwill worldwide. In view of the well-known character of the GUGGENHEIM Marks, it is difficult to believe that the Respondent did not have in mind the Complainant's trademarks when registering the disputed domain name.

Prior panels have consistently found that the mere registration of a domain name that is identical or confusingly similar (particularly domain names comprising typos or incorporating the mark plus a descriptive term) to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. [WIPO Overview 3.0](#), section 3.1.4.

As to bad faith use, the evidence submitted with the Complaint shows that the disputed domain name does not point to an active website and merely resolves to a WordPress sample page.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain name does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes the reputation of the Complainant’s GUGGENHEIM Marks, the composition of the disputed domain name which reflects the Complainant’s GUGGENHEIM Marks, the failure of the Respondent to submit a response, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Respondent being involved in the *Guggenheim Capital, LLC v. Martin Oravec*, WIPO Case No. [D2023-4543](#) in relation to the registration of a different domain name (<guggenheim-advisors.com>) which also incorporates the Complainant’s GUGGENHEIM Marks, is further evidence of bad faith.

The Panel finds that 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-advisor.com> be transferred to the Complainant.

*/Anna Carabelli/*

**Anna Carabelli**

Sole Panelist

Date: March 1, 2024