

ADMINISTRATIVE PANEL DECISION

Fisher Asset Management, LLC v. Salvatore Carpanzano, Fisher Investments Private Cli

Case No. D2024-0561

1. The Parties

Complainant is Fisher Asset Management, LLC, United States of America (“US”), represented by CSC Digital Brand Services Group AB, Sweden.

Respondent is Salvatore Carpanzano, Fisher Investments Private Cli, US.

2. The Domain Names and Registrar

The disputed domain names <fisherinvestm.com> and <fisherinvestm.online> are registered with Domain.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 7, 2024. On February 8, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On February 8, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Domain Privacy Service FBO) and contact information in the Complaint. The Center sent an email communication to Complainant on February 9, 2024 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on February 15, 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 Respondent of the Complaint, and the proceedings commenced on February 16, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 7, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on March 12, 2024.

The Center appointed Phillip V. Marano as the sole panelist in this matter on March 25, 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

Complainant is a privately held investment advisory firm that manages over USD 3 billion in retirement-plan assets for a diverse global base of over 135,000 clients. Complainant offers its services through its official <fisherinvestments.com> domain name and website. Complainant owns valid and subsisting registrations for the FISHER INVESTMENTS trademark in numerous countries, including the trademark for FISHER INVESTMENTS (Reg. No. 3,103,881) in the US, registered on June 13, 2006 with the earliest priority dating back to December 1977. The term “investments” is disclaimed from a number of Complainant’s trademark registrations.

Respondent registered both of the disputed domain names <fisherinvestm.com> and <fisherinvestm.online> on July 31, 2023. At the time this Complaint was filed, both of the disputed domain names resolved to a 403-error message stating, “Forbidden. You don’t have permission to access / on this server.” Each of the disputed domain names is configured with mail server (“MX”) records, enabling Respondent to send email communications using the disputed domain names.

5. Parties’ Contentions

A. Complainant

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

Complainant asserts ownership of the FISHER INVESTMENTS trademark and has adduced evidence of trademark registrations described above, with earliest priority dating back to December 1977. The disputed domain names are confusingly similar to Complainant’s FISHER INVESTMENTS trademark, according to Complainant, because each is a purposeful misspelling, and prototypical example of typosquatting, which vary from Complainant’s trademark by only four letters—Respondent has omitted the letters “ents” from the end of Complainant’s FISHER INVESTMENTS trademark.

Complainant further asserts that Respondent lacks any rights or legitimate interests in the disputed domain name based on: the lack of any permission, sponsorship, or affiliation between Complainant and Respondent; the lack of any evidence that Respondent, identified by the Registrar as “Salvatore Carpanzano, Fisher Investments Private Cli”, is known by the disputed domain names; Complainant’s longstanding rights in its FISHER INVESTMENTS trademark, well-predating registration of the disputed domain names; Respondent’s passive holding of the disputed domain names in connection with inactive websites; and Respondent’s configuration of the disputed domain names with MX records, which may be involved in a future phishing or fraud.

Complainant argues that Respondent has registered and used the disputed domain name in bad faith for numerous reasons, including: the well-known nature of Complainant’s services offered under the FISHER INVESTMENTS trademark; Respondent’s use of false registration data, including use of a generic “@aol.com” email address and false “Fisher Investments Private Cli” organization name; Respondent’s purposeful misspelling of Complainant’s FISHER INVESTMENTS trademark; Respondent’s passive holding of the disputed domain names in connection with inactive websites; Respondent’s configuration of the disputed domain names with MX records, which may be involved in a future phishing or fraud; Respondent’s use of a privacy service to hide its identity; and Respondent’s failure to respond to cease-and-desist correspondence from Complainant.

B. Respondent

Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed in its Complaint, Complainant must establish in accordance with paragraph 4(a) of the Policy:

- i. The disputed domain names are identical or confusingly similar to a trademark in which Complainant has rights;
- ii. Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- iii. The disputed domain names have been registered and are being used in bad faith.

Although Respondent did not reply to Complainant's contentions, the burden remains with Complainant to establish by a balance of probabilities, or a preponderance of the evidence, all three elements of paragraph 4(a) of the Policy. A respondent's default would not by itself mean that the complainant is deemed to have prevailed; a respondent's default is not necessarily an admission that the complainant's claims are true. UDRP panels have been prepared to draw certain inferences in light of the particular facts and circumstances of the case, e.g., where a particular conclusion is prima facie obvious, where an explanation by the respondent is called for but is not forthcoming, or where no other plausible conclusion is apparent. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 4.2 and 4.3; see also *The Vanguard Group, Inc. v. Lorna Kang*, WIPO Case No. [D2002-1064](#) ("The Respondent's default does not automatically result in a decision in favor of the Complainant. The Complainant must still prove each of the three elements required by Policy paragraph 4(a)").

A. Identical or Confusingly Similar

Ownership of a nationally or regionally registered trademark serves as prima facie evidence that Complainant has trademark rights for the purposes of standing to file this Complaint. [WIPO Overview 3.0](#), section 1.2.1. Where a complainant establishes UDRP standing on the basis of a mark subject to a disclaimer, the existence of the disclaimer may be relevant to the panel's assessment of the second and third elements, e.g., in considering possible legitimate trademark co-existence or scenarios where the disclaimed elements correspond to a dictionary term. [WIPO Overview 3.0](#), Section 1.10. Complainant submitted evidence that the FISHER INVESTMENTS trademark has been registered in numerous regions and countries including in Canada, the European Union, and the United States, with priority dating back to December 1977. Thus, the Panel finds that Complainant's rights in the FISHER INVESTMENTS trademark have been established pursuant to the first element of the Policy.

The only remaining question under the first element of the Policy is whether the disputed domain names are identical or confusingly similar to Complainant's FISHER INVESTMENTS trademark. In this Complaint, the disputed domain names are confusingly similar to Complainant's FISHER INVESTMENTS trademark because, disregarding the ".com" and ".online" generic Top-Level Domain ("gTLD"), the dominant portion of the trademark is contained within the disputed domain names. [WIPO Overview 3.0](#), section 1.7. ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the domain name ... [I]n cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar..."). In this Complaint, the Panel concurs with Complainant that Respondent has purposefully omitted the letters "ents" from the end of Complainant's FISHER INVESTMENTS trademark within the disputed domain names. In regards to gTLDs, such as ".com" or ".online" in the disputed domain names, they are generally viewed as a standard registration requirement and are disregarded under the first element. [WIPO Overview 3.0](#), section 1.11.1.

In view of the foregoing, the Panel concludes that Complainant has established the first element of the Policy.

B. Rights or Legitimate Interests

Complainant must make out a prima facie case that Respondent lacks rights or legitimate interests in the disputed domain names, shifting the burden of production on this element to Respondent to come forward with evidence demonstrating such rights or legitimate interests. Where, as in this Complaint, Respondent fails to come forward with any relevant evidence, Complainant is deemed to have satisfied the second element of the Policy. [WIPO Overview 3.0](#), section 2.1. As a threshold matter, it is evident from the record that Respondent, identified by Whois data for the disputed domain names as “Salvatore Carpanzano”, is not commonly known by the disputed domain name or Complainant’s FISHER INVESTMENTS trademark.

Passively holding a domain name in and of itself does not constitute a bona fide offering of goods or services. *Philip Morris USA Inc. v. Gabriel Hall*, WIPO Case No. [D2015-1779](#); *Teachers Insurance and Annuity Association of America v. Wreaks Communications Group*, WIPO Case No. [D2006-0483](#) (“Absent some contrary evidence from Respondent, passive holding of a Domain Name does not constitute legitimate noncommercial or fair use”). In this Complaint, Respondent’s use of the disputed domain names in connection with a 403-error does not constitute rights or legitimate interests in the disputed domain names.

In addition, UDRP panels have categorically held that use of a domain name for illegal activity—including the impersonation of the complainant and other types of fraud—can never confer rights or legitimate interests on a respondent. Circumstantial evidence can support a credible claim made by Complainant asserting Respondent might be engaged in such illegal activity, including that Respondent has masked its identity to avoid being contactable. [WIPO Overview 3.0](#), section 2.13. In its Complaint, Complainant has argued that Respondent lacks any legitimate reason to configure with MX records, or send emails using, either of the two disputed domain names.

In view of the foregoing, the Panel concludes that Complainant has established the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy proscribes the following non-exhaustive circumstances as evidence of bad faith registration and use of the disputed domain name:

- i. Circumstances indicating that Respondent has registered or Respondent has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to Complainant who is the owner of the trademark to a competitor of that Complainant, for valuable consideration in excess of Respondent’s documented out of pocket costs directly related to the disputed domain name; or
- ii. Respondent has registered the disputed domain name in order to prevent the owner of the trademark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or
- iii. Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- iv. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent’s website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of Respondent’s website or location or of a product or service on Respondent’s website or location.

Passively holding a domain name does not prevent a finding of bad faith. [WIPO Overview 3.0](#), section 3.3. This includes domain names that do not resolve to any website content as well as domain names that are parked with a “coming soon” message or other similar content like a 403-error landing page. Where a domain name is being passively held, as alleged in this case, bad faith registration and use exists based upon: (i) the degree of distinctiveness or reputation of the complainant’s mark; (ii) the failure of the respondent to submit any response or offer any credible evidence of rights or legitimate interests; (iii) the respondent’s concealing its identity or use of false contact details; and (iv) the implausibility of any good faith use which the domain name may be put. *See also Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#) (“A remedy can be obtained under the Policy only if those circumstances show that the Respondent’s passive holding amounts to acting in bad faith.”)

In the Panel’s view, good faith use of the disputed domain names is relatively implausible based on Complainant’s portfolio of longstanding and international trademark registrations for Complainant’s FISHER INVESTMENTS trademark (and coupled with, as discussed below, Respondent’s purposeful misspelling of Complainant’s trademark, failure to respond to Complainant’s cease-and-desist correspondence or Complaint, use of MX records presumptively in furtherance of fraud, and use of a proxy registration service to obfuscate its identity).

Indeed, it is evident that Respondent registered and used the disputed domain names to intentionally target Complainant’s FISHER INVESTMENTS trademark in a manner intended to confuse and mislead Internet users.

Under the facts of this case, the Panel considers configuration of an email server on the disputed domain names as additional evidence that the disputed domain name has been registered and use in bad faith. The disputed domain name contains an intentional misspelling of Complainant’s FISHER INVESTMENTS trademark, and the record is devoid of any evidence to suggest that Respondent has any legitimate interest in sending emails from the disputed domain names. Conversely, Complainant has made a plausible argument that Respondent’s proactive configuration of an email server, creates a risk that Respondent is engaged in a phishing scheme, thereby using an email address associated with Complainant to try to steal valuable sensitive, financial or other confidential information from Complainant’s clients or employees. Prior WIPO panel determinations have recognized the same risk, and considered it as additional evidence of bad faith. *See e.g., Accor SA v. Domain Admin, C/O ID#10760, Privacy Protection Service INC d/b/a PrivacyProtect.org / Yogesh Bhardwaj*, WIPO Case No. [D2017-1225](#); *Carrefour S.A. v. WhoisGuard, Inc / Gaudet Jose*, WIPO Case No. [DCO2018-0041](#) (“The Panel concurs with the Complainant that the connection of the disputed domain name with an email server configuration enhances a likelihood of confusion and presents a risk that the Respondent is engaged in a phishing scheme.”)

Furthermore, where it appears that a respondent employs a proxy service, or selects a registrar that applies default proxy services, merely to avoid being contacted by a complainant, or notified of a UDRP proceeding filed against it, UDRP panels tend to find that this supports an inference of bad faith. [WIPO Overview 3.0](#) section 3.6. Use of a privacy or proxy registration service to shield a respondent’s identity and elude or frustrate enforcement efforts by a legitimate complainant demonstrates bad faith use and registration of a disputed domain name. *See Fifth Third Bancorp v. Secure Whois Information Service*, WIPO Case No. [D2006-0696](#) (the use of a proxy registration service to avoid disclosing the identity of the real party in interest is also consistent with an inference of bad faith when combined with other evidence of evasive, illegal, or irresponsible conduct). Here, it is evident that Respondent has either intentionally employed a proxy registration service, or intentionally selected a registrar that offers default proxy registration services, in order to conceal its identity in conjunction with use of the disputed domain names in connection with MX records to send emails in a manner designed to create confusion with Complainant and Complainant’s FISHER INVESTMENTS trademark.

And finally, the Panel further concludes that failure by Respondent to answer Complainant’s cease and desist letter “suggests that Respondent was aware that it has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith.”

See *America Online, Inc. v. Antonio R. Diaz*, WIPO Case No. [D2000-1460](#). See also *Spyros Michopoulos S.A. v. John Talias, ToJo Enterprises*, WIPO Case No. [D2008-1003](#). Furthermore, the failure of Respondent to answer this Complaint or take any part in the present proceedings, in the view of the Panel, is another indication of bad faith on the part of Respondent. See *Bayerische Motoren Werke AG v. (This Domain is For Sale) Joshuathan Investments, Inc.*, WIPO Case No. [D2002-0787](#).

In view of the foregoing, the Panel concludes that 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 names <fisherinvestm.com> and <fisherinvestm.online> be transferred to Complainant.

/Phillip V. Marano/

Phillip V. Marano
Sole Panelist

Date: April 8, 2024