

ADMINISTRATIVE PANEL DECISION

Zacks Investment Research, Inc. v. Crystal Felix, Xerosoft
Case No. D2024-0859

1. The Parties

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

Respondent is Crystal Felix, Xerosoft, U.S.

2. The Domain Name and Registrar

The Disputed Domain Name <zackstrade.org> is registered with Hostinger Operations, UAB (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 27, 2024. On February 28, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On February 29, 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, Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on March 6, 2024, 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 March 8, 2024.

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 March 12, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 1, 2024. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on April 7, 2024.

The Center appointed Richard W. Page as the sole panelist in this matter on April 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

Since 1978, Complainant has been offering independent research and investment related content. Complainant 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. Complainant's research services are used by thousands of analysts at hundreds of brokerages in order to provide their clients with reliable investment information. Complainant's primary website is "zacks.com". Complainant also manages over USD 5 billion of client assets through its Zacks Investment Management subsidiary - located at the "zacksim.com" homepage. The owner of Zacks also operates, through a separate company, at the website "zackstrade.com" which allows individual investors both U.S. and international to actively trade.

Complainant is the owner of the ZACKS Mark which includes several trademarks with "Zacks" as the primary component. The following are valid registrations, without limitation:

ZACKS U.S. Registration No. 5,652,428 class "financial research", registered on January 15, 2019.

Complainant registered the <zacks.com> domain name on November 9, 1994, the <zacksim.com> domain name on September 3, 2003, and the <zackstrade.com> domain name on May 15, 2008. Complainant has used and operated under the ZACKS Mark in connection with "financial research" since 1978.

The Disputed Domain Name was registered February 14, 2024, and resolved to a website that claimed to be for a company called Zacks Trade offering trading capabilities for cryptocurrency and other assets. Complainant contacted the Registrar to complain about the website and, at the time of filing of the Complaint, it has been disabled.

5. Parties' Contentions

A. Complainant

Complainant contends that it has satisfied each of the three elements required under the Policy for a transfer of the Disputed Domain Name.

Complainant further contends that the Disputed Domain Name adds only the non-distinctive term "trade" to the ZACKS Mark. The most dominant feature of the Disputed Domain Name is "zacks" which is the primary component of Complainant's name and of the ZACKS Mark.

Complainant further contends that the Disputed Domain Name is clearly similar to the <zackstrade.com> domain name in that it merely substitutes ".org" for ".com".

Complainant submits that Respondent is not affiliated or related to Complainant in any way and is not licensed by Complainant or otherwise authorized to use the ZACKS Mark.

Complainant further submits that Respondent is not commonly known by the Disputed Domain Name and has not acquired any trademark or service marks rights in the "Zacks" name.

Complainant further submits that Respondent registered and used the Disputed Domain Name to unlawfully advertise for a false company called Zacks Trade.

Complainant alleges that Respondent has registered and used Disputed Domain Name that incorporates the ZACKS Mark, with the addition of the term “trade.” As recently as February 23, 2024, the Disputed Domain Name resolved to a webpage claiming to offer identical services as those of Complainant in addition to featuring the ZACKS Mark.

B. Respondent

Respondent did not reply to Complainant’s contentions.

6. Discussion and Findings

Paragraph 15(a) of the Rules instructs the Panel as to the principles the Panel is to use in determining the dispute: “A Panel shall decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules, and any rules and principles of law that it deems applicable.”

Even though Respondent has failed to file a Response or to contest Complainant’s assertions, the Panel will review the evidence proffered by Complainant to verify that the essential elements of the claims are met. See section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Paragraph 4(a) of the Policy directs that Complainant must prove each of the following three elements:

- i) that the Disputed Domain Name registered by Respondent is identical or confusingly similar to the ZACKS Mark in which Complainant has rights; and,
- ii) that Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and,
- iii) that 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 Complainant’s trademark and the Disputed Domain Name. [WIPO Overview 3.0](#), section 1.7.

[WIPO Overview 3.0](#), section 1.2.1 states that registration of the ZACKS Mark is prima facie evidence of Complainant having enforceable rights.

Complainant has shown rights in respect of the ZACKS Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the Disputed Domain Name. Accordingly, the Disputed Domain Name is confusingly similar to the ZACKS Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of the term “trade” 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 ZACKS Mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8. The generic Top-Level Domain “.org” 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.

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 Respondent may demonstrate rights or legitimate interests in the Disputed Domain Name.

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

Paragraph 4(c) of the Policy allows three nonexclusive methods for the Panel to conclude that Respondent has rights or a legitimate interest in the Disputed Domain Name:

(i) before any notice to you [Respondent] of the dispute, your use of, or demonstrable preparations to use, the Disputed Domain Name or a name corresponding to the Disputed Domain Name in connection with a bona fide offering of goods or services; or

(ii) you [Respondent] (as an individual, business, or other organization) have been commonly known by the Disputed Domain Name, even if you have acquired no trademark or service mark rights; or

(iii) you [Respondent] are making a legitimate noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the ZACKS Mark.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Disputed Domain Name. Respondent has not rebutted 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 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.

Paragraph 4(b) of the Policy sets forth four nonexclusive criteria for Complainant to show bad faith registration and use of the Disputed Domain Name:

(i) circumstances indicating that you [Respondent] have registered or you have 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 ZACKS Mark or to a competitor of Complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the Disputed Domain Name; or

(ii) you [Respondent] have registered the Disputed Domain Name in order to prevent the owner of the ZACKS Mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you [Respondent] have registered the Disputed Domain Name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the Disputed Domain Name, you [Respondent] have intentionally attempted to attract, for commercial gain, Internet users to your website or other online location, by creating a likelihood of confusion with the ZACKS Mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product on your website or location.

In the present case, the Panel finds that Respondent has violated paragraph 4(b)(iv) of the Policy.

The Panel finds 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 Name <zackstrade.org> be transferred to Complainant.

/Richard W. Page/

Richard W. Page

Sole Panelist

Date: April 30, 2024