

ADMINISTRATIVE PANEL DECISION

Zacks Investment Research, Inc. v. Zack Ryan
Case No. D2024-2709

1. The Parties

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

The Respondent is Zack Ryan, United States.

2. The Domain Name and Registrar

The disputed domain name <zacksmining.com> (the “Disputed Domain Name”) is registered with PDR Ltd. d/b/a PublicDomainRegistry.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 2, 2024. On July 3, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 4, 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 (Domain Admin, Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 8, 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 amendment to the Complaint on July 9, 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 the Respondent of the Complaint, and the proceedings commenced on July 11, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 31, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 2, 2024.

The Center appointed Lynda M. Braun as the sole panelist in this matter on August 15, 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 has been offering independent research and investment-related content since 1978, providing professional investors with financial data and analysis to its clients. The Complainant's research services are used by thousands of analysts at hundreds of brokerages in order to provide its clients with reliable investment information so that they can make better investment decisions for proprietary accounts and the investment accounts of clients. The Complainant manages over USD 11.7 billion of client assets through its subsidiary "Zacks Investment Management". The Complainant has provided services under its ZACKS trademarks to customers throughout the United States as well as globally.

The Complainant owns the following trademarks in the United States, registered with the United States Patent and Trademark Office ("USPTO"), including, but not limited to: ZACKS, United States Trademark Registration No. 5,652,428, registered on January 15, 2019, in international class 36; ZACKS ULTIMATE, United States Trademark Registration No. 5,683,596, registered on February 26, 2019, in international class 36; and ZACKS INVESTOR COLLECTION, United States Trademark Registration No. 5,683,595, registered on February 26, 2019, in international class 36 (hereinafter collectively referred to as the "ZACKS Mark"). The Complainant has invested significant time and resources in the ZACKS Mark and actively protects all of its trademarks.

The Complainant owns several domain names. Among them, the domain name <zacks.com> was registered on November 11, 1994 and resolves to the Complainant's official website at "www.zacks.com," the domain name <zacksim.com> was registered on September 3, 2003 and resolves to the website "www.zacksim.com," the domain name <zackstrade.com> is owned by a wholly owned subsidiary of "Zacks Investment Management," was registered on May 15, 2008, and resolves to the "www.zackstrade.com" website.

The Disputed Domain Name was registered on May 21, 2024, long after the Complainant's registered its ZACKS Mark. The Disputed Domain Name initially resolved to a website featuring a company purportedly called "Zacks Mining," which offered trading, financial and investment advisory services for securities, stocks, and gold, including trading information related to cryptocurrency products¹. The website included a login page requiring users to enter a username and password. The Complainant alleges that the Respondent connected the Disputed Domain Name to mail exchanger ("MX") servers, purportedly to use the Disputed Domain Name as part of a phishing scheme to send fraudulent emails to the Complainant's clients, although the Complainant has not submitted any evidence of phishing by the Respondent.

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:

- the Disputed Domain Name is confusingly similar to the Complainant's trademark because the Disputed Domain Name contains the ZACKS' Mark in its entirety, followed by the additional term "mining," and then followed by the generic Top-Level Domain ("gTLD") ".com," and thus does not prevent a finding of confusing similarity;
- the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because, among other things, the Complainant has not authorized the Respondent to register a domain name containing the ZACKS Mark, the Respondent was not making a bona fide offering of goods or services through the Disputed Domain Name, and the Respondent was not commonly known by the ZACKS Mark or any similar name;

¹ The Complainant provided screenshots of the webpages as an Annex to the Complaint. As of the writing of this Decision, however, the Disputed Domain Name resolves to a Dangerous Scam Page.

- the Disputed Domain Name was registered and is being used in bad faith because, among other things, the Respondent had actual knowledge of the ZACKS Mark when it registered the Disputed Domain Name and created MX records purportedly to send fraudulent emails to the Complainant's customers; and
- the Disputed Domain Name's resolving website features a sophisticated fraudulent scheme targeting the Complainant's customers or potential customers as part of a phishing scheme.

The Complainant seeks the transfer of the Disputed Domain Name from the Respondent to the Complainant in accordance with paragraph 4(i) of the Policy.

B. Respondent

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

6. Discussion and Findings

In order for the Complainant to prevail and have the Disputed Domain Name transferred to the Complainant, the Complainant must prove the following (Policy, paragraph 4(a)):

- (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 was registered and is being used in bad faith.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy requires a two-fold inquiry: a threshold investigation into whether a complainant has rights in a trademark, followed by an assessment of whether the disputed domain name is identical or confusingly similar to that trademark. The Panel concludes that in the present case, the Disputed Domain Name is confusingly similar to the ZACKS Mark as explained below.

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. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

It is uncontroverted that the Complainant has established rights in the ZACKS Mark based on its years of use as well as its registered trademarks for the ZACKS Mark before the USPTO. Thus, the Complainant has shown rights in respect of a trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The consensus view of panels is that "registration of a mark is prima facie evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive". See *CWI, Inc. v. Domain Administrator c/o Dynadot*, WIPO Case No. [D2015-1734](#). The Respondent has not rebutted this presumption, and therefore the Panel finds that the Complainant has rights in the ZACKS Mark.

The Disputed Domain Name consists of the ZACKS Mark in its entirety followed by the term "mining," presumably related to the mining of cryptocurrency, and then followed by the gTLD ".com". It is well established that a domain name that wholly incorporates a trademark may be deemed confusingly similar to that trademark for purposes of the Policy despite the addition of other terms. As stated in section 1.8 of [WIPO Overview 3.0](#), "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." Thus, the mere addition of the term "mining" to the Complainant's ZACKS Mark in the Disputed Domain Name does not prevent a finding of confusing similarity. See e.g., *Allianz Global Investors of America, L.P. and Pacific Investment Management Company (PIMCO) v. Bingo-Bongo*, WIPO Case No. [D2011-0795](#); and *Hoffmann-La Roche Inc. v. Wei-Chun Hsia*, WIPO Case No. [D2008-0923](#).

Finally, the addition of a gTLD such as “.com” in a domain name is a technical requirement. As such, it is well established that a gTLD may typically be disregarded when assessing whether a disputed domain name is identical or confusingly similar to a trademark. See *Proactiva Medio Ambiente, S.A. v. Proactiva*, WIPO Case No. [D2012-0182](#) and [WIPO Overview 3.0](#), section 1.11.1. Thus, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s ZACKS Mark.

Based on the available record, the Panel finds that 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 a 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 that 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 Complainant’s prima facie case includes the fact that the Complainant has not authorized, licensed or otherwise permitted the Respondent to use its ZACKS Mark, that the Complainant does not have any type of business relationship with the Respondent, that there is no evidence that the Respondent is commonly known by the Disputed Domain Name or by any similar name, and that there is no evidence that the Respondent was using or making demonstrable preparations to use the Disputed Domain Name in connection with a bona fide offering of goods or services. See Policy, paragraph 4(c). Moreover, based on the circumstances of the case and the use made of the Disputed Domain Name to initially resolve to a website that purported to offer financial and trading information services similar to the Complainant’s website, the Panel finds that the Respondent was not making a bona fide offering of goods or services nor making a legitimate noncommercial or fair use of the Disputed Domain Name. In addition, panels have held that the use of a domain name for illegal activity, here claimed as phishing, impersonation, or passing off, can never confer rights or legitimate interests on a respondent. See [WIPO Overview 3.0](#), section 2.13.1.

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

C. Registered and Used in Bad Faith

The Panel finds that based on the record, the Complainant has demonstrated the existence of the Respondent’s bad faith registration and use of the Disputed Domain Name pursuant to paragraph 4(a)(iii) of the Policy.

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 out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

The use of a domain name to intentionally attempt to attract Internet users to a respondent's website or online location by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation or endorsement of the registrant's website or online location for commercial gain demonstrates registration and use in bad faith. Here, the Panel finds that the Respondent's registration and use of the Disputed Domain Name had been done for the specific purpose of trading upon and targeting the name and reputation of the Complainant, since the Disputed Domain Name was used to resolve to a website that purported to offer financial and trading services similar to the Complainant's website. See *Madonna Ciccone, p/k/a Madonna v. Dan Parisi and "Madonna.com,"* WIPO Case No. [D2000-0847](#) (“[t]he only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain”).

Moreover, the Panel concludes that the Respondent's registration of the Disputed Domain Name was an attempt to disrupt the Complainant's business. See *Banco Bradesco S.A. v. Fernando Camacho Bohm,* WIPO Case No. [D2010-1552](#). The Respondent's use of the Disputed Domain Name was also likely to confuse Internet users into incorrectly believing that the Respondent was authorized by or affiliated with the Complainant.

Additionally, the Complainant alleged that the Respondent activated MX records, which could be used to send fraudulent emails to the Complainant's clients and purportedly in an attempt to perpetuate a fraudulent phishing scheme to acquire personal and confidential information from users searching for the Complainant's website (although the Complainant did not submit any evidence that a phishing scheme had already taken place). The creation of MX records associated with the Disputed Domain Name evidences a likelihood of bad faith use of the Disputed Domain Name to engage in fraudulent email communications as part of a phishing scheme. See, e.g., *Tetra Laval Holdings & Finance S.A. v. Himali Hewage,* WIPO Case No. [D2020-0472](#) (evidence of active MX records indicates that the disputed domain name could be used for fraudulent email communications in bad faith).

Finally, the Panel finds that the Respondent knew that the Complainant had rights in the ZACKS Mark when registering the Disputed Domain Name, emblematic of bad faith registration and use. It strains credulity to believe that the Respondent did not know of the Complainant or the ZACKS Mark when registering the Disputed Domain Name since it used the trademark and set up a website with similar content to that of the Complainant. See *Myer Stores Limited v. Mr. David John Singh,* WIPO Case No. [D2001-0763](#) (“a finding of bad faith may be made where the respondent ‘knew or should have known’ of the registration and/or use of the trademark prior to registering the domain name”). The Panel finds that in the present case, the Respondent had the Complainant's ZACKS Mark in mind when registering and using the Disputed Domain Name. This is especially true since the Disputed Domain Name and the MX records incorporated the ZACKS Mark in its entirety.

In sum, the Panel concludes that the circumstances of this case, including, but not limited to, the Complainant's claim that the Disputed Domain Name had been used to create MX records containing fraudulent emails, and the failure of the Respondent to submit a response or to provide any evidence of actual or contemplated good faith use, support an inference of bad faith.

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

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 <zacksmining.com> be transferred to the Complainant.

/Lynda M. Braun/

Lynda M. Braun

Sole Panelist

Date: August 28, 2024