

ADMINISTRATIVE PANEL DECISION

Zacks Investment Research, Inc. v. Venkateshwara Distributor Private Limited., Venkateshwara Distributor Private Limited.

Case No. D2024-2713

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 Venkateshwara Distributor Private Limited., Venkateshwara Distributor Private Limited., India.

2. The Domain Name and Registrar

The disputed domain name <wwwzacks.com> (the “Disputed Domain Name”) is registered with Tirupati Domains and Hosting Pvt Ltd. (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 √ which differed from the named Respondent (WHOIS PROTECT SERVICE) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 9, 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 7, 2024.

The Center appointed Nick J. Gardner as the sole panelist in this matter on August 12, 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 an investment research firm in the United States which has offered independent research and investment related content since 1974. The Complainant's research services are used by analysts at brokerage firms in providing their clients with investment information. The Complainant also manages over USD 11.7 billion of client assets through its Zacks Investment Management subsidiary. An affiliate company to the Complainant operates a website linked to the domain name <zackstrade.com> which allows individual investors to actively trade.

The Complainant owns a United States Trademark Registration Number 5652428 for the term "ZACKS", registered on January 15, 2019. It also owns a number of other trademarks which include the term ZACKS. These were registered on various dates from 2018 onwards.

The Complainant owns and operates its primary website at <zacks.com>. It has used this domain name since 1994.

The Respondent appears to be an individual with an address in the United States.

The Disputed Domain Name was registered on December 9, 2003, and resolves to a website which contains click through links to third party websites offering services which compete with those the Complainant provides.

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 says that "the Disputed Domain Name <wwwzacks.com> was registered on December 9, 2003, long after Complainant's adoption and registration of its ZACKS Trademarks and long after Complainant's registration and use of its ZACKS domain names". The Complainant contends that the linking of the Disputed Domain Name to a website with pay-per-click ("PPC") links is evidence of bad faith registration and use. Additionally, it says the Disputed Domain Name has active MX records configured which can be used to send emails and this evidences a likelihood of an additional bad-faith use of the Disputed Domain Name to engage in fraudulent email or phishing communications.

B. Respondent

The Respondent did not reply to the Complainant's contentions

6. Discussion and Findings

Preliminary Matters

The Panel notes that no communication has been received from the Respondent. However, given the Complaint and Written Notice were sent to the relevant addresses disclosed by the Registrar, then the Panel

considers that this satisfies the requirement in paragraph 2(a) of the UDRP Rules to “employ reasonably available means calculated to achieve actual notice”. Accordingly, the Panel considers it is able to proceed to determine this Complaint and to draw inferences from the Respondent’s failure to file any Response. While the Respondent’s failure to file a Response does not automatically result in a decision in favor of the Complainant, the Panel may draw appropriate inferences from the Respondent’s default (see, e.g., *Verner Pantan Design v. Fontana di Luce Corp*, WIPO Case No. [D2012-1909](#)).

Substantive Matters

To succeed, in accordance with paragraph 4(a) of the Policy, the Complainant must satisfy the Panel that:

- (i) the Disputed Domain Name is identical with or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name;
- (iii) 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 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 rights in the ZACKS trademark. This trademark was registered in 2019 whilst the Disputed Domain name was registered in 2003. So far as the Complainant’s other registered trademarks containing the word Zack are concerned the earliest of these was filed in 2018. The Panel does not understand the Complainant’s argument that the Disputed Domain Name was registered long after the Complainant’s registered trademarks – that is simply not the case. In any event, while the UDRP makes no specific reference to the date on which the holder of the trademark or service mark acquired its rights, such rights must be in existence at the time the complaint is filed. In this case, the fact that the Disputed Domain Name was registered before the Complainant acquired (registered) trademark rights, does not by itself preclude the Complainant’s standing to file a UDRP case, nor the Panel’s finding of identity or confusing similarity under the first element. [WIPO Overview 3.0](#), section 1.1.3.

Moreover, in the present case the Panel does not consider the term “ZACKS” to be descriptive. It is not a dictionary word and so far as the Panel is aware has no meaning save in relation to the Complainant and its services. The Complainant has traded under the name ZACKS since at least 1974. Whilst the evidence is not particularly comprehensive as to the extent of the Complainant’s business prior to 2003 the Panel is persuaded that the Complainant had established unregistered trade mark rights in its name by 2003. Were there any doubt about this the Panel considers it relevant that the Respondent clearly thought it worthwhile to adopt a typographic variation of the Complainant’s “www.zacks.com” domain name to attract users to its own website. See *PEMF Supply, LLC v. Domain Administrator, See PrivacyGuardian.org / Gregory Lewis, American Healthcare Foundation*, WIPO Case No. [D2019-0235](#) (“in light of the use of the PEMF SUPPLY mark that was submitted in this proceeding, the targeting of Complainant by Respondent is sufficient to establish Complainant has limited unregistered trademark rights in the PEMF SUPPLY mark for the purposes of the Policy”). See also *Greenspring Associates, Inc. v. Lisa Knowles, Victoria capital pty* WIPO Case No. [D2019-0265](#): “To that extent, Complainant has in fact used the domain name <gspring.com> as a source identifier for its services. One person who cannot dispute that fact is Respondent, who (as is discussed below) deliberately targeted that source identifier (<gspring.com>) to attempt to perpetrate a fraud via confusion. The Domain Name differs from the GSPRING mark only to the extent that the Domain Name replaces the “i” with an “l”. The visual similarity between the “i” and the “l” – especially when the font is small – is obvious”. The Panel accordingly concludes that the Complainant had also established unregistered trademark rights in ZACKS by the time the Complaint was filed and also by the time the Disputed Domain Name was registered.

The Panel finds the Disputed Domain Name is confusingly similar to the ZACKS trademark. Previous UDRP panels have consistently held that domain names are identical or confusingly similar to a trademark for purposes of the Policy “when the domain name includes the trademark, or a confusingly similar approximation, regardless of the other terms in the domain name” (*Wal-Mart Stores, Inc. v. Richard MacLeod d/b/a For Sale*, WIPO Case No. [D2000-0662](#)). See also [WIPO Overview 3.0](#), section 1.8.

It is well established that the Top-Level Domain (“TLD”), in this case “.com”, does not affect the Disputed Domain Name for the purpose of determining whether it is identical or confusingly similar. See [WIPO Overview 3.0](#), section 1.11.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant’s trademark and hence the first condition of paragraph 4(a) of the Policy has been fulfilled.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances any of which is sufficient to demonstrate that a respondent has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a bona fide offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if the respondent has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

None of these apply in the present circumstances. The Complainant has not authorised, licensed, or permitted the Respondent to register or use the Disputed Domain Name or to use ZACKS trademark. The Complainant has prior rights in the ZACKS trademark which precede the Respondent’s acquisition of the Disputed Domain Name. The Complainant has therefore established a prima facie case that the Respondent does not have any rights or legitimate interests in the Disputed Domain Name and thereby the burden of production shifts to the Respondent to produce evidence demonstrating rights or legitimate interests in respect of the Disputed Domain Name (see, for example, *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#); *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#)).

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the Disputed Domain Name. Accordingly, the Panel finds the Respondent has no rights or any legitimate interests in the Disputed Domain Name and the second condition of paragraph 4(a) of the Policy has been fulfilled.

C. Registered and Used in Bad Faith

Under paragraph 4(b) of the Policy a non-exhaustive list of factors evidencing registration and use in bad faith comprises:

- (i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or
- (ii) you have registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that you have engaged in a pattern of such conduct; or

(iii) you have registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.

The Panel concludes that (iv) applies as the Disputed Domain Name is likely to attract traffic because of confusion with the Complainant's mark (and domain name <zacks.com>), and the Respondent derives commercial gain as a result. The website linked to the Disputed Domain Name comprises a series of PPC links to other third-party websites. The Panel infers that some consumers, once at this website will follow the provided links and "click through" to other sites which offer products some of which may compete with those of the Complainant. The Respondent presumably earns "click through" linking revenue as a result. The Panel infers the website is automatically generated. This does not however matter. It is well established that where a domain name is used to generate revenue in respect of "click through" traffic, and that traffic has been attracted because of the name's association with the Complainant, such use amounts to use in bad faith, see for example *Shangri-La International Hotel Management Limited v. NetIncome Ventures Inc.*, WIPO Case No. [D2006-1315](#); *Owens Corning v. NA*, WIPO Case No. [D2007-1143](#); *McDonald's Corporation v. ZusCom*, WIPO Case No. [D2007-1353](#); *Villeroy & Boch AG v. Mario Pingerna*, WIPO Case No. [D2007-1912](#); *Rolex Watch U.S.A., Inc. v. Vadim Krivitsky*, WIPO Case No. [D2008-0396](#).

See also [WIPO Overview 3.0](#) section 3.5: "Can third-party generated material 'automatically' appearing on the website associated with a domain name form a basis for finding bad faith?"

Particularly with respect to "automatically" generated pay-per-click links, panels have held that a respondent cannot disclaim responsibility for content appearing on the website associated with its domain name (nor would such links ipso facto vest the respondent with rights or legitimate interests).

Neither the fact that such links are generated by a third party such as a registrar or auction platform (or their affiliate), nor the fact that the respondent itself may not have directly profited, would by itself prevent a finding of bad faith".

In view of the above finding the Panel does not need to reach a conclusion on the further argument the Complainant has submitted in relation to active MX records.

Accordingly, the Panel finds that the Disputed Domain Name has been registered and is being used in bad faith and the third condition of paragraph 4(a) of the Policy has been fulfilled.

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 <wwwzacks.com> be transferred to the Complainant.

/Nick J. Gardner/

Nick J. Gardner

Sole Panelist

Date: August 26, 2024