

ADMINISTRATIVE PANEL DECISION

Fisher Asset Management, LLC v. Domain Admin
Case No. D2023-3801

1. The Parties

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

The Respondent is Domain Admin, Bahamas.

2. The Domain Names and Registrar

The disputed domain names, <fisherinvestments.com>, and <fsheinvestments.com>, are registered with Internet Domain Service BS Corp (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on September 12, 2023. On September 12, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On September 13, 2023, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 September 20, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on October 17, 2023.

The Center appointed Wilson Pinheiro Jabur as the sole panelist in this matter on October 20, 2023. 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 was founded in 1979 in the United States and is a privately held investment advisory firm launched by its founder Ken Fisher, who is also a writer and was a columnist for Forbes magazine from 1984 through 2016 on "Portfolio Strategy". Presently, the Complainant counts with 5,000 employees and serves over 135,000 clients globally, managing over USD 211 billion.

The Complainant operates the <fisherinvestments.com> website which had an average of 2.2 million visits during the period of May to July 2023 (Annex 7 to the Complaint), as well as is the owner of the following, amongst other, trademark registrations (Annex 1 to the Complaint):

- United States trademark registration No. 3,103,881 for the word mark FISHER INVESTMENTS, filed on June 27, 2005, registered on June 13, 2006, successively renewed, in class 36;
- European Union trademark registration No. 013338595 for the word mark FISHER INVESTMENTS, filed on October 7, 2014, registered on February 5, 2015, in classes 16, 36, and 41; and
- United Kingdom trademark registration No. UK00913338595 for the word mark FISHER INVESTMENTS, filed on October 7, 2014, registered on February 5, 2015, in classes 16, 36, and 41.

The disputed domain names were registered on December 12, 2017, and presently resolve, and when the Complaint was filed resolved, to parked webpages displaying pay-per-click ("PPC") advertisements.

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 names.

Notably, the Complainant contends that its FISHER INVESTMENTS trademark has become a well-recognized brand by consumers, industry peers, and the broader global community, having the Complainant made significant investments over the years to advertise, promote, and protect its trademark through various forms of media, including the Internet.

According to the Complainant, the disputed domain names are purposeful misspellings of the Complainant's FISHER INVESTMENTS trademark and must be considered confusingly similar to the Complainant's trademark, given that in the disputed domain name <fisherinvestments.com>, the letter "t" in the Complainant's trademark was omitted and in the disputed domain name <fsherinvestments.com>, the first letter "i" was suppressed.

As to the absence of rights or legitimate interests, the Complainant argues that:

- (i) the Respondent is not commonly known by the disputed domain names what indicates a lack of rights or legitimate interests, not having the Complainant licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademark;
- (ii) the Respondent chose to use a privacy WHOIS service, which past panels have also found to equate to a lack of legitimate interest;
- (iii) the Respondent is not using the disputed domain names in connection with a *bona fide* offering of goods or services given that the Respondent is using them to redirect Internet users to websites featuring links to third-party websites, some of which directly compete with the Complainant's business;

(iv) the disputed domain name <fsheinvestments.com> is being offered for sale for an amount that far exceeds the Respondent's out-of-pocket expenses in registering it what further evidences the Respondent's lack of rights and legitimate interest in it; and

(v) the disputed domain name <fisherinvestments.com> has active mail servers configured; being the Respondent likely to use or intend to use email addresses hosted by the disputed domain name what could confuse Internet users into believing they are dealing with the Complainant, what is not true.

Lastly, the Complainant points out that given the renown of the FISHER INVESTMENT trademark, the Respondent chose the disputed domain names to attract visitors to websites to generate traffic and income, or even worse, pass off as the Complainant. Also, the offer for sale of one of the disputed domain names and the choice to retain privacy protection services further corroborate the Respondent's bad faith.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy sets forth the following three requirements which have to be met for this Panel to order the transfer of the disputed domain names to the Complainant:

- (i) the disputed domain names are 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 names; and
- (iii) the disputed domain names have been registered and are being used in bad faith.

The Complainant must prove in this administrative proceeding that each of the aforesaid three elements is present so as to have the disputed domain names transferred to it, according to paragraph 4(a) of the Policy.

In accordance with paragraph 14(b) of the Rules, if the Respondent does not submit a Response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the Complaint.

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.

Based on the available record, the Panel finds 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 Panel finds the suppression of the letter "t" in the disputed domain name <fisherinvestments.com> and the suppression of the first letter "i" in the disputed domain name <fsheinvestments.com> still makes the Complainant's mark recognizable within the disputed domain names. Accordingly, the disputed domain names are identical or confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Based on the available record, 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 non-exclusive list of circumstances that indicate the Respondent's rights to or legitimate interests in the disputed domain names. These circumstances are:

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

While 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 often impossible 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. 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 record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain names. 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 names such as those enumerated in the Policy or otherwise.

The Respondent, in not responding to the Complaint, has failed to invoke any of the circumstances, which could demonstrate, pursuant to paragraph 4(c) of the Policy, any rights or legitimate interests in the disputed domain names. This entitles the Panel to draw any such inferences as it considers appropriate pursuant to paragraph 14(b) of the Rules.

As seen above, the disputed domain names are being used to generate revenues from PPC advertisements. Indeed such use cannot be considered here a *bona fide* offering of goods or services nor legitimate noncommercial or fair use under the Policy given the misspelling of the Complainant's well-known trademark what shows the Respondent's attempt to attract Internet users taking an unfair advantage thereof.

In addition to that, the Complainant states that it has not licensed, authorized, or permitted the Respondent to register domain names incorporating the Complainant's trademark.

Additionally, the typo in the Complainant's trademark represented in the disputed domain names is demonstrative of the Respondent's lack of rights or legitimate interests. Such typo illustrates the Respondent's intent to mislead unsuspecting Internet users, unaware of the typo in the disputed domain names and expecting to find the Complainant.

Furthermore, the absence of any trademarks registered by the Respondent corresponding to the disputed domain names corroborates with the indication of the absence of a right or legitimate interest.

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

C. Registered and Used in Bad Faith

The Policy indicates in paragraph 4(b) that bad faith registration and use can be found in view of:

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

The registration and use of the disputed domain names in bad faith can be found in the present case in view of the following circumstances:

- (i) the Respondent has provided no evidence whatsoever of any actual or contemplated good faith use of the disputed domain names;
- (ii) the well-known status of the Complainant's trademark and the nature of the disputed domain names;
- (iii) the PPC links available at the webpages relating to the Complainant's business area;
- (iv) the offer for sale of one of the disputed domain names for an amount that far exceeds the Respondent's out-of-pocket expenses in registering it; and
- (v) the potential use of the other disputed domain name in connection with email addresses which could confuse Internet users into believing they are dealing with the Complainant.

Based on the available record, the Panel finds the third element of the Policy has not 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 names, <fisherinvestments.com>, and <fsherinvestments.com>, be transferred to the Complainant.

/Wilson Pinheiro Jabur/

Wilson Pinheiro Jabur

Sole Panelist

Date: November 1, 2023