

## **ADMINISTRATIVE PANEL DECISION**

Zacks Investment Research, Inc. v. Carolina Rodrigues, Fundacion Comercio Electronico

Case No. DCO2023-0045

### **1. The Parties**

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

The Respondent is Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

### **2. The Domain Name and Registrar**

The disputed domain name <zackstrade.co> is registered with GoDaddy.com, LLC (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on May 5, 2023. On May 23, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On May 23, 2023, 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 (Registration Private, Domains By Proxy LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on May 24, 2023, 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 May 25, 2023.

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 May 26, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on June 29, 2023.

The Center appointed Peter Burgstaller as the sole panelist in this matter on July 17, 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 has been offering independent research and investment related content since years and provides also information over its (and its subsidiary companies) websites available under the domain names <zacks.com>, <zacksim.com> and <zackstrade.com> (Annex 4 – 6 to the Complaint).

The Complainant is the owner of several United States trademark registrations containing the mark ZACKS, *inter alia*, the U.S. trademark ZACKS (word), Registration No. 5,652,429, registered on January 15, 2019 in the class 36, and Zacks Rank (word), Registration No. 5,664,114, registered on January 29, 2019 in the class 36 (Annex 7 to the Complaint).

The disputed domain name was registered on July 21, 2022 and was offered for sale for USD 1,299 (Annex 1 to the Complaint).

Further, the disputed domain name resolved to a page which said, “Google Chrome Security Check” and then a page which said “Your Norton Anti-Virus subscription has expired”. Additionally, the disputed domain name had active MX records (Annex 8 and 9 to the Complaint); currently, the disputed domain name is not used (Panel’s own visit to the disputed domain name on July 25, 2023).

#### **5. Parties’ Contentions**

##### **A. Complainant**

The Complainant has been offering independent research and investment related content since 1978. It 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. The Complainant’s primary website is addressed under the domain name <zacks.com>.

The Complainant also manages client assets worth billions of USD through its Zacks Investment Management subsidiary; the Zacks Investment Management’s website is available under the domain name <zacksim.com>; moreover, the Complainant operates, through a separate company, a website under the domain name <zackstrade.com> which allows individual investors both U.S. and international to actively trade.

The Complainant owns several trademark registrations containing the mark ZACKS and has provided services to customers throughout the United States as well as globally. The Complainant has also been using the domain name <zacks.com> since 1994 and the domain name <zackstrade.com> since 2008.

The disputed domain name is confusingly similar to the Complainant’s ZACKS mark: It only adds the term “trade” to it; the most dominant feature of the disputed domain name is “zacks” which is the primary component of the Complainant’s name and the ZACKS trademarks.

The Respondent lacks rights or legitimate interests in the disputed domain name: The Respondent is not affiliated or related to the Complainant in any way and is not licensed by the Complainant or otherwise authorized to use the ZACKS trademarks. Further, it is not commonly known by the disputed domain name and has not acquired any trademark or service mark rights in the ZACKS name or mark.

Finally, the Respondent registered and is using the disputed domain name in bad faith: The disputed domain name incorporates the Complainant's well-known ZACKS trademark, with the addition of the term "trade". Based on the Whois Report, the Respondent is also offering to sell the disputed domain name for USD 1,299 which is in excess to the typical cost of registrations.

At the time the Complaint was filed the disputed domain name resolved to a page which said, "Google Chrome Security Check" and then a page which said "Your Norton Anti-Virus subscription has expired". Additionally, the disputed domain name has active MX records which can be used to send emails.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (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 the disputed domain name; and
- (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 identity/confusing similarity involves a reasoned but relatively straightforward comparison between the complainant's trademark and the disputed domain name. 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 disputed domain name.

The Complainant submitted evidence, which incontestably and conclusively establishes rights in the mark ZACKS.

In the present case, the disputed domain name <zackstrade.co> is confusingly similar to the ZACKS mark in which the Complainant has rights since the Complainant's ZACKS mark is clearly recognizable in the disputed domain name. It has long been established under UDRP decisions that where the relevant trademark is recognizable within the disputed domain name the mere addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) will not prevent a finding of confusing similarity under the first element of the Policy (see section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

This is the case at present: The addition of the term "trade" in the disputed domain name does not prevent a finding of confusing similarity, since the mark ZACKS is clearly recognizable within the disputed domain name.

Finally, it has also long been held that generic or country code Top-Level Domains are generally disregarded when evaluating the confusing similarity under the first element.

Therefore, the Panel finds that the Complainant has satisfied paragraph 4(a)(i) of the Policy.

## B. Rights or Legitimate Interests

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 (see section 2.1 of the [WIPO Overview 3.0](#)). Here, the Complainant has put forward a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name, which has not been rebutted by the Respondent.

Furthermore, the nature of the disputed domain name, comprising the Complainant’s mark in its entirety together with the term “trade”, cannot be considered fair use as it falsely suggests an affiliation with the Complainant that does not exist (see section 2.5 of the [WIPO Overview 3.0](#)).

Noting the above and the Panel’s findings below, and in the absence of any Response or allegations from the Respondent, the Panel finds that the Complainant has satisfied paragraph 4(a)(ii) of the Policy.

## C. Registered and Used in Bad Faith

As stated in many decisions rendered under the Policy (e.g. *Robert Ellenbogen v. Mike Pearson*, WIPO Case No. [D2000-0001](#)) both conditions, registration and use in bad faith, must be demonstrated; consequently, the Complainant must show that:

- the disputed domain name was registered by the Respondent in bad faith, and
- the disputed domain name is being used by the Respondent in bad faith.

(i) In the present case the Complainant has rights and is the owner of the U.S. trademark registrations containing the mark ZACKS, which were registered before the registration of the disputed domain name. Moreover, the Complainant (and its subsidiaries) registered and is using the domain names <zacks.com>, <zacksim.com> and <zackstrade.com> to address its company (and of companies of the group of companies) websites.

It is inconceivable for this Panel that the Respondent registered or has used the disputed domain name without knowledge of the Complainant’s rights, which leads to the necessary inference of bad faith. This finding is supported by the fact that the disputed domain name incorporates the Complainant’s trademark ZACKS entirely, together with the suffix “trade” which clearly refers to the Complainant’s business and especially to the Complainant’s domain name <zackstrade.com>. All of which in fact indicate that the Respondent must have been aware of the Complainant’s business and trademark when registering the disputed domain name.

Therefore, the Panel is convinced that the disputed domain name was registered in bad faith by the Respondent.

(ii) The disputed domain name is also being used in bad faith. According to the evidence on record, the disputed domain name is offered for sale for USD 1,299; this figure is likely in excess of the Respondent’s out-of-pocket expenses and, in the circumstances of this case, reflects the Respondent’s bad faith.

Notwithstanding, and to the extent that it may be argued that the redirection referred to in the factual background amounts to a passive holding of the disputed domain name, as there is no evidence that the disputed domain name has been actively used in any other manner, previous UDRP panels have found that bad faith use under paragraph 4(a)(iii) does not necessarily require a positive act on the part of the respondent – the non-use of a domain name (including a blank or “coming soon” or resolving to a parking

page or an offer for sale page) would not prevent a finding of bad faith, since also inaction is within the concept of paragraph 4(a)(iii) under the doctrine of passive holding (see especially *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#); *Ladbroke Group Plc v. Sonoma International LDC*, WIPO Case No. [D2002-0131](#)).

This Panel further concludes that the disputed domain name is being used in bad faith, putting emphasis on the following:

- the Complainant's trademark ZACKS is used in several domain names to address the Complainant's websites, e.g. <zacks.com>, <zacksim.com> or <zackstrade.com>;
- the disputed domain name incorporates the Complainant's trademark in its entirety, and is thus suited to confuse users seeking or expecting the Complainant and its site, this is especially true with regard to the Complainant's domain name <zackstrade.com>; and
- as per the Complainant's evidence, the disputed domain name resolved to a webpage with an Internet browser security warning;
- there is no conceivable plausible reason for good faith use with regard to the disputed domain name.

Taking all these aspects and evidence into consideration and the fact that the Respondent failed to respond to the Complaint, these support the finding that the disputed domain name has been registered and is being used in bad faith under paragraph 4(a)(iii) 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.co> be transferred to the Complainant.

/Peter Burgstaller/

**Peter Burgstaller**

Sole Panelist

Date: July 31, 2023