

ADMINISTRATIVE PANEL DECISION

Avantax, Inc. v. Bora Şanlı
Case No. D2024-1493

1. The Parties

The Complainant is Avantax, Inc., United States of America (“US”), represented by Pryor Cashman, LLP, US.

The Respondent is Bora Şanlı, Türkiye.

2. The Domain Name and Registrar

The disputed domain name <avantaxinvestgroup.com> 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 April 8, 2024. On April 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 11, 2024, 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 April 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 5, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 6, 2024.

The Center appointed Christian Gassauer-Fleissner as the sole panelist in this matter on May 22, 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 management company that provides comprehensive financial services to families, individuals, and small businesses, including investment advice tailored to each client's unique tax situation. The company was formed in 1996, and as of December 31, 2022, the Complainant worked with a nationwide network of 3,109 financial professionals and supported USD 76.9 billion of total client assets, including USD 38.3 billion of advisory assets.

The Complainant is the owner of several trademarks for AVANTAX (the "AVANTAX trademark"), including:

- US Trademark Registration AVANTAX No. 6,398,089, registered on June 22, 2021; and
- US Trademark Registration AVANTAX No. 7,218,995, registered on November 14, 2023.

The Complainant is also the owner of the domain name <avantax.com>, registered on August 11, 2000.

The disputed domain name was registered on April 20, 2023. The Complainant has provided evidence showing (via wayback machine) that the disputed domain name previously resolved to an active website displaying the AVANTAX trademark and promoting investment advisory services. At the time of the decision, the disputed domain name resolves to an inactive page.

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.

On the first element of the Policy, the Complainant claims that the disputed domain name is identical or confusingly similar to the Complainant's AVANTAX trademark. The disputed domain name (i) wholly incorporates the AVANTAX trademark, (ii) is identical or confusingly similar to the AVANTAX trademark, (iii) merely incorporates the additional generic terms "invest" and "group" that are descriptive of the investment advisory services provided by the Complainant and (iv) is likely to cause confusion, mistake and/or deception among the consuming public.

On the second element of the Policy, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has never been authorized representatives, agents, or licensees of the Complainant. The Complainant does not have any type of business relationship with the Respondent. The Complainant has never consented to the Respondent's registration or use of the disputed domain name or website. Furthermore, the Complainant's adoption and use of the AVANTAX trademark precedes the Respondent's registration of the disputed domain name over three years. In addition, upon information and belief, the Respondent is not commonly known by the disputed domain name and does not have any rights in the AVANTAX trademark. Moreover, the Respondent's use of the disputed domain name cannot be considered a bona fide offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name because, upon information and belief, the disputed domain name's website (i) was used to fraudulently mislead visitors into depositing funds as investments but such funds were neither invested on their behalf nor returned, (ii) connected visitors with individuals posing as representatives of the Complainant, and (iii) prominently displayed the Complainant's AVANTAX trademark without the Complainant's authorization. Further, the Complainant discovered that the Respondent previously directed the disputed domain name to an infringing website by using wayback machine. Upon information and belief, the Respondent's website prominently stated "AVANTAX INVEST GROUP" and included drop-down menus for its purported services including for "Private Banking" and "Private Markets" as of July 22, 2023. It is evident that the Respondent has the intent to misleadingly divert consumers to the website associated with the disputed domain name. As noted above, the Respondent's use of the disputed domain name, which wholly incorporates the AVANTAX trademark and

is confusingly similar to the Complainant's domain name <avantax.com>, is likely to divert consumers to the Respondent's website, leading consumers to believe that the associated website is owned or authorized by the Complainant, when it is not. The addition of the terms "invest" and "group" in the disputed domain name further adds to the likelihood of confusion with the Complainant's AVANTAX trademark because such terms suggest products and services of the very kind for which the Complainant has registered its AVANTAX trademark, and these terms are associated with the Complainant's AVANTAX platform that is used by individuals and entities seeking investment advisory services.

On the third element of the Policy, the Complainant asserts that the Respondent has registered and used the disputed domain name in bad faith. The Respondent registered the disputed domain name on April 20, 2023, while the Complainant first used its widely-known AVANTAX trademark in US commerce at least as early as October 1, 2019. Therefore, there is doubt that the Respondent registered the disputed domain name without full knowledge of the Complainant's rights in the AVANTAX trademark, as evidenced by the facts that (i) the Complainant had used its AVANTAX trademark for more than three years before the Respondent registered the disputed domain name; (ii) the disputed domain name is confusingly similar to the Complainant's well-known AVANTAX trademark; and (iii) Respondent's previously active website purported to offer investment advisory services through the disputed domain name, which are similar services to the Complainant's services. Due to the renown of the AVANTAX trademark and its business, and in light of the Complainant's registration for the AVANTAX trademark, the Respondent knew or should have known of the Complainant's trademark rights. The Respondent used the AVANTAX trademark in the disputed domain name and added terms related to Complainant's investment advisory services increases the likelihood of confusion between the disputed domain name and the AVANTAX trademark, further warranting the conclusion that the Respondent knew of the Complainant and its trademark rights.

Furthermore, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the AVANTAX trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. The Respondent uses the AVANTAX trademark in the disputed domain name and on the previously corresponding active website to create initial interest confusion as to the ownership and/or sponsorship of the website to which the dispute domain name resolves. The addition of "invest group" to the AVANTAX trademark in the disputed domain name only further adds to the likelihood of confusion with the AVANTAX trademark because it indicates an awareness of the Complainant's services, which are related to investment advisory services. That Respondent used the AVANTAX trademark in connection with a website that promoted similar services to the Complainant's services, while making it appear that there were services available that required the deposit of funds, without any disclaimer or disclosure of the Respondent's lack of relationship with the Complainant, clearly gives Internet users the impression that the website was an official website of the Complainant, or at the very least was authorized by the Complainant, when no such relationship exists. The Respondent's former website offering visitors the ability to access services under and in connection with the AVANTAX trademark evidences the Respondent's intent to create a likelihood of confusion and to derive commercial gain by doing so. Moreover, the disputed domain name, upon information and belief, directed to a fraudulent website intended to mislead users into depositing funds that were neither invested on their behalf nor returned.

B. Respondent

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

6. Discussion and Findings

Paragraph 15(a) of the Rules requires that the Panel's decision be made "on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

It has been a consensus view in previous UDRP decisions that a respondent's default (i.e., failure to submit a response) would not by itself mean that the complainant is deemed to have prevailed; a respondent's

default is not necessarily an admission that the complainant's claims are true (see section 4.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

The Complainant must evidence each of the three elements required by paragraph 4(a) of the Policy in order to succeed on the Complaint, namely that:

- (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 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 3.0](#), section 1.7.

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 entirety of the mark is reproduced within the disputed domain name. Therefore, the Panel finds the mark is recognizable within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, the term "invest group") 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 mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

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 the 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 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.

Panels have held that the use of a domain name for illegal activity (here, claimed impersonation/passing off, such as by displaying the AVANTAX trademark and promoting investment advisory services) can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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 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 Panel notes that the Complainant's AVANTAX trademark was registered before the disputed domain name, and particularly considering the previous use to which the disputed domain name was put, the Panel finds that it is more likely than not that the Respondent registered the disputed domain name with knowledge of the Complainant's trademark, which indicates registration in bad faith.

The disputed domain name previously resolved to a website displaying the Complainant's AVANTAX trademark and purportedly offering investment advisory services. Therefore, by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website, by creating a likelihood of confusion with the AVANTAX trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or of services on the Respondent's website. Furthermore, the Complainant declares that the website at the disputed domain name fraudulently misled visitors into depositing funds as investment but such funds were neither invested on their behalf nor returned, to which has not been rebutted by the Respondent.

Panels have held that the use of a domain name for illegal activity (here, claimed impersonation/passing off, such as by displaying the AVANTAX trademark and promoting investment advisory services or other types of fraud) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes bad faith under the Policy.

The disputed domain name no longer resolves to an active website. Considering the reputation of the Complainant's mark, the previous use of the disputed domain name, and the lack of a response from the Respondent, the Panel finds that the current non-use of the disputed domain name does not prevent a finding of bad faith.

The Panel finds that the 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 <avantaxinvestgroup.com> be transferred to the Complainant.

/Christian Gassauer-Fleissner/

Christian Gassauer-Fleissner

Sole Panelist

Date: June 3, 2024