

## **ADMINISTRATIVE PANEL DECISION**

Fisher Asset Management, LLC v. Claudia Shaw, Claudia Shaw / Fisher Investments Private Client Group LLC  
Case No. D2024-1786

### **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 Claudia Shaw, Claudia Shaw, United Kingdom / Fisher Investments Private Client Group LLC, United States.

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

The disputed domain names <fisherinvestmentsltd.com> and <fisherprivateclientsgroup.com> are registered with DreamHost, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 29, 2024. On April 29, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 29, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Proxy Protection LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 30, 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 amended Complaint on May 3, 2024.

The Center verified that the Complaint, together with the amended 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 7, 2024. In accordance with the Rules, paragraph 5, the due date for Response was May 27, 2024. The Response was filed with the Center on May 26, 2024. The Complainant responded to the Response on May 30, 2024.

The Center appointed Jeremy Speres as the sole panelist in this matter on June 10, 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.

On June 7, 2024, an attorney representing the Respondent emailed the Center attaching a letter purporting to authorize the Respondent to register the disputed domain names on behalf of a third party. On June 10, 2024, the same attorney emailed the Center attaching a second response on behalf of the Respondent. The Complainant responded with a supplemental filing on June 14, 2024. The Respondent responded with supplemental filings on June 21, 23, and 24, 2024. The Complainant filed a supplemental filing on July 3, 2024. The Panel issued Procedural Order No. 1 on July 3, 2024, giving the Respondent until July 8, 2024, to substantiate certain claims made in its responses. On July 10, 2024, the Respondent emailed the Center, indicating that the Respondent's attorney will respond to Procedural Order No. 1 "this week". The Complainant objected to the Respondent's apparent request for an extension of time on the same day.

#### **4. Factual Background**

The Complainant, founded in 1979, is an investment advisory firm trading under the FISHER INVESTMENTS mark. The Complainant's mark has been recognized as being well known by prior UDRP panels. See *Fisher Asset Management LLC d/b/a Fisher Investments v. Sergey*, WIPO Case No. [D2018-0336](#).

The Complainant owns the domain names <fisherinvestments.com> and <fisherinvestments.org> from which it operates its primary website. The Complainant owns trademark registrations for its mark in various jurisdictions, including in the Respondent's jurisdictions of the United Kingdom, under Trademark Registration No. UK00913338595 FISHER INVESTMENTS in classes 16, 36, and 41, having a registration date of February 5, 2015, and the United States, under Trademark Registration No. 3103881 FISHER INVESTMENTS in class 36, having a registration date of June 13, 2006.

The disputed domain names were registered on February 1, 2024, and currently resolve to registrar parking pages.

#### **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 the Respondent must have registered and used the disputed domain names in bad faith in order to deceive Internet users as to the source of the disputed domain names given the repute of the Complainant's mark.

##### **B. Respondent**

The Respondent contends that the disputed domain names were registered on behalf of a Florida, United States, corporation founded in 2021, namely Fisher Investments Private Client Group LLC (the "Third Party LLC"), at the request of its proprietor, one Heather Fisher. The Respondent contends that the last name "Fisher" cannot be trademarked without the addition of other characteristics such as color or symbols incorporated into the design, and as such, the domains were properly and legally obtained...". The Respondent also contends that the Third Party LLC owns a United States trademark for its name.

## 6. Discussion and Findings

### 6.1 Preliminary Issues

#### A. Respondent's Identity

The named Respondent Claudia Shaw claims to have registered the disputed domain names on behalf of another party, namely the Third Party LLC, which has in turn stated that Claudia Shaw is its agent authorized to manage its domain names.

The Panel notes that paragraph 1 of the Rules defines "Respondent" as "the holder of a domain-name registration against which a complaint is initiated" and that the appointed panel retains discretion to determine the respondent against which the case should proceed. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.4.5.

In exercising their discretions in similar circumstances, previous panels generally considered, among others, (i) whether the identity of the beneficial holder is disclosed, (ii) whether the beneficial holder submits arguments explaining its position, or (iii) whether the relationship between the registrant of the domain name and the beneficial holder is clear. *Bryan Cave Leighton Paisner LLP v. Job*, WIPO Case No. [D2020-0592](#).

Here the identity of the claimed beneficial holder, namely the Third Party LLC, has been disclosed, and the Third Party LLC has come forward explaining its relationship with Claudia Shaw and responding to the Complainant's claims.

In the circumstances, on balance of probabilities it is likely that the Third Party LLC is the beneficial holder of the disputed domain names. Therefore, any reference to "the Respondent" in this decision shall be read as referring to both Claudia Shaw and the Third Party LLC.

#### B. Supplemental Filings

The Complainant and the Respondent each made unsolicited supplemental filings.

Paragraphs 10 and 12 of the Rules in effect grant the Panel sole discretion to determine the admissibility of unsolicited supplemental filings. Admissibility of supplemental filings is to be assessed based on relevance, foreseeability, the need to conduct the proceedings with due expedition, and the equal treatment of the parties so that each has a fair opportunity to present its case. Paragraph 10(b) of the Rules; *Société aux Loteries en Europe, SLE v. Take That Ltd.*, WIPO Case No. [D2007-0214](#); [WIPO Overview 3.0](#) at section 4.6.

Here the Parties' supplemental filings predominantly address matters that could not reasonably have been anticipated, and which are relevant to the dispute at hand.

The Panel therefore admits the Parties' supplemental filings.

#### C. Respondent's Extension Request

In its email of July 10, 2024, the Respondent apparently sought an extension of time to respond to Procedural Order No. 1, which set the Respondent's response deadline as July 8, 2024.

Paragraph 10(c) of the Rules empowers the Panel to extend periods of time "in exceptional cases". It also requires the Panel to ensure that these proceedings take place with "due expedition".

The issues raised in Procedural Order No. 1 were not complex and involved factual matters that would readily be within the Respondent's knowledge and not requiring further investigation. It would thus have been a simple matter for the Respondent to prepare a cogent response to Procedural Order No. 1, not one that would have required much time.

The Respondent has made no effort to explain its failure to meet the Panel's deadline or to explain why this is an exceptional case. There is also nothing in the record indicating that this is an exceptional case.

When Procedural Order No. 1 was issued, the Respondent had had the Complaint for almost two months and had, in that time, already filed multiple responses in which it could have addressed the issues raised in Procedural Order No. 1. The Respondent is represented by an attorney, and the issues raised in Procedural Order No. 1 were basic evidentiary matters that an attorney should have anticipated.

In the circumstances, the Panel denies the Respondent's request for an extension of time.

## **6.2 Substantive Issues**

### **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 one disputed domain name, and the dominant feature of the mark, namely "fisher", is reproduced within the other disputed domain name. Accordingly, the disputed domain names are 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 "ltd" and "privateclientsgroup", may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain names 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 names. The Complainant's mark was registered and well known long before registration of the disputed domain names, including in the Respondent's jurisdictions, the disputed domain names are confusingly similar to the Complainant's mark and the Complainant has certified that the disputed domain names are unauthorized by it.

The Respondent has failed, on a balance of probabilities, to meet its burden of production for the following reasons.

The Respondent seems to argue that it has rights or legitimate interests flowing from the surname of one Heather Fisher who is, it claims, the proprietor of the Third Party LLC. The evidence in the record shows that the Third Party LLC does in fact exist as a registered corporation in Florida, and that a Heather Fisher is associated with it in the corporation's official records.

It is well established that using one's surname as part of a domain name corresponds to a legitimate customary practice and, generally, is sufficient evidence of a right or legitimate interest in a domain name under paragraph 4(c)(ii) of the Policy. *Billerbeck Schweiz AG v. Peter Billerbeck*, WIPO Case No. [D2001-0825](#). In the present matter, however, the Respondent has failed to come forward with any of the usual evidence accepted in similar circumstances under paragraph 4(c)(ii), such as identity documents, birth certificates, drivers' licenses or the like for Heather Fisher (see [WIPO Overview 3.0](#) at section 2.3), bearing in mind that the burden of production is on the Respondent.

The Respondent produced what it claims is a "notarized affidavit" which it claims required Ms. Fisher to identify herself to the notary. However, that document is blurred in relevant parts, notably the ostensible stamp from the notary, and does not include any indication that an oath or affirmation was given or that the deponent was duly sworn by a mandated official.<sup>1</sup> No indication is given in the document itself that Ms. Fisher was required to identify herself.

On the eve of the drafting of this decision, the Respondent sent what purports to be a passport for Ms. Fisher, and even if it is assumed that Ms. Fisher exists, this does not change the outcome in relation to the second element. For the reasons addressed below in relation to bad faith, it is likely that the Respondent had the Complainant in mind when registering and using the disputed domain names. When considering a defense under paragraph 4(c)(ii), panels will typically assess whether there is a general lack of other indicia of cybersquatting. [WIPO Overview 3.0](#) at section 2.3. Having a particular surname cannot confer a legitimate interest in intentionally registering domain names corresponding to that surname that take advantage of a Complainant's mark in bad faith.

To the extent that the Respondent may claim rights or legitimate interests on the basis of the Third Party LLC's corporate name, the Panel agrees with those UDRP panels that have ruled that the mere registration of a company cannot per se demonstrate that a respondent has rights or legitimate interests. See *Barclays Bank PLC v. New City Resources Inc.*, WIPO Case No. [D2011-1584](#); *Chicago Mercantile Exchange Inc., CME Group Inc. v. Globex Biz Solutions*, WIPO Case No. [D2015-0671](#); and *Royal Bank of Canada v. RBC Bank*, WIPO Case No. [D2002-0672](#).

The Respondent has presented no evidence concerning the nature or extent of the business of the Third Party LLC, or of its intentions for the disputed domain names. Apart from the Florida corporation registration details dating back to 2021, noting its general powers articulated inter alia in paragraphs 10 and 12 of the Rules, the Panel can find no information on the Internet about the Third Party LLC whatsoever, including no indication that it has ever traded. No website can be found. Thus, no reliance can be placed on paragraph 4(c)(i) of the Policy. In any event, the Third Party LLC was registered in 2021, more than 40 years after the Complainant was founded, and, for the reasons raised in relation to bad faith below, it is likely that its name was chosen to take advantage of the Complainant's mark, which cannot confer rights or legitimate interests.

Finally, the Respondent claims that the Third Party LLC "owns a United States Trademark for their name (Trademark No. 88373A6C12)". No evidence is supplied in support of this contention, and the Panel can find no evidence of this trademark in the online records of the United States Patent and Trademark Office (the "USPTO") or in the records of the State of Florida's Division of Corporations.

The only relevant trademarks in the USPTO's records are pending applications for FISHER INVESTMENTS PRIVATE CLIENT GROUP (application no. 98542585) and FISHER INVESTMENTS PRIVATE CLIENT GROUP INTERNATIONAL (application no. 98542597) in the name of the Complainant.

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<sup>1</sup> The Panel has also searched the online records of the New York (purported location of Respondent per its letterhead, New Jersey (proximity to New York), and Texas (purported attorney location) notaries databases, and found no individual corresponding to the name given for the notary.

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.

For the following reasons, the Panel finds that it is more likely than not that the Respondent registered and has used the disputed domain names in order to take advantage of confusion with the Complainant's mark for the Respondent's commercial gain, falling squarely within paragraph 4(c)(iv) of the Policy.

The Complainant's evidence establishes that its mark was well known long before registration of the disputed domain name. UDRP panels have consistently found that the registration of a domain name that is confusingly similar to a well known trademark, as in this case, can by itself create a presumption of bad faith. [WIPO Overview 3.0](#) at sections 3.1.4 and 3.2.1. The Respondent has failed to rebut this presumption.

Here, the compositions of the disputed domain names relate to the Complainant's industry, which is an indicator of bad faith. [WIPO Overview 3.0](#) at section 3.2.1. One disputed domain name is almost identical to the Complainant's mark. The addition of "ltd", being a commonplace corporate designation, merely serves to cement the impression that that disputed domain name relates to the Complainant's corporate entity. The addition of "ltd" also raises a more serious problem for the Respondent. The Respondent claims that the disputed domain names were registered on behalf of the Third Party LLC. If that is the case, then why use the "ltd" corporate designation in the disputed domain name rather than the "LLC" corporate designation that actually forms part of the Third Party LLC's corporate name? This dissonance points to bad faith targeting.

The other disputed domain name as well as the name of the Third Party LLC correspond to the name of a division of the Complainant that is actually in use by the Complainant in the form of "Fisher Investments' Private Client Group". See "www.fisherinvestments.com/en-us/personal-wealth-management". According to the Panel's independent Internet searches, including of the Internet Archive, the Complainant has used this division name or variations of it since well before registration of the disputed domain names and the Third Party LLC's corporation. This again points to targeting of the Complainant.

Internet searches for the second level portions of the disputed domain names return results exclusively relating to the Complainant. In the circumstances and in light of the immense repute of the Complainant's mark, there is no conceivable good faith use of the disputed domain names that would not result in consumer confusion. This is an indicator of bad faith. [WIPO Overview 3.0](#) at section 3.1.4.

The Complainant points to a prior UDRP case that, according to the Complainant, involved the Third Party LLC targeting the Complainant, specifically *Fisher Asset Management, LLC v. Salvatore Carpanzano, Fisher Investments Private Cli*, WIPO Case No. [D2024-0561](#). The Respondent's "notarized affidavit" in the present case lists a telephone number and email address for the Respondent that were used for the respondent in the foregoing prior UDRP case. In that case, the respondent was found to have targeted the Complainant in bad faith. In the circumstances, it is reasonable to conclude that the same party is responsible for the disputed domain names in the present case, and that this case is merely a continuation of the Respondent's scheme of targeting the Complainant.

As addressed above, the Respondent claims that the Third Party LLC owns trade mark registrations corresponding to its name, which apparently do not exist. Submitting false statements is an indicator of bad faith. *CVS Pharmacy, Inc. v. Withheld for Privacy Purposes, Privacy service provided by Withheld for Privacy ehf / best man*, WIPO Case No. [D2021-1404](#).

The Respondent's mala fides are also indicated by a mistake that it made in one of its early responses. The Respondent produced an undated letter, on the letterhead of "Fisher Investments Private Client Group", signed by one Heather Saxon Fisher stating that Claudia Shaw has authority to register the disputed domain names "on behalf of Fisher Asset Management, LLC." The latter is the Complainant's name, not the Third

Party LLC's, and the mistake is repeated multiple times throughout the letter. In later filings, the Respondent puts this down to a clerical error. It is however somewhat unlikely that a bona fide corporation, operating in good faith, would repeatedly and substantially misstate its own name in the same letter. The Respondent appears to have been confused by its own scheme.

Panels have found that the non-use of a domain name would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names does not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put. [WIPO Overview 3.0](#), section 3.3. Here the Complainant's mark is well known, the Respondent has not submitted any convincing evidence of actual or contemplated good faith use, good faith use of the disputed domain names is implausible as aforesaid, and the evidence of bad faith targeting is substantial. The Panel therefore finds that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

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 names <fisherinvestmentsltd.com> and <fisherprivateclientsgroup.com> be transferred to the Complainant.

*/Jeremy Speres/*

**Jeremy Speres**

Sole Panelist

Date: July 18, 2024