

ADMINISTRATIVE PANEL DECISION

Guggenheim Capital, LLC v. Kaixin He, BuildHost Inc
Case No. D2024-4636

1. The Parties

The Complainant is Guggenheim Capital, LLC, United States of America ("United States" or "U.S."), represented by Snell & Wilmer, LLP, United States.

The Respondent is Kaixin He, BuildHost Inc, China.

2. The Domain Name and Registrar

The disputed domain name <guggenfund.com> is registered with Name.com, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on November 11, 2024. On November 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 12, 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 sent an email communication to the Complainant on November 13, 2024, providing the complete registrant contact information disclosed by the Registrar. The Complainant filed an amended Complaint on November 13, 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 November 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 9, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on December 10, 2024.

The Center appointed John Swinson as the sole panelist in this matter on December 18, 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 provides investment and financial advisory services. For over 20 years, the Complainant has owned and used, directly and through its subsidiary, Guggenheim Partners, LLC, the GUGGENHEIM mark. The Complainant operates at least 16 offices in six different countries and employs more than 2,200 employees worldwide. The Complainant currently manages over USD 335 billion in assets.

The Complainant owns registrations around the world for its GUGGENHEIM marks, including in the United States, for example, U.S. Reg. Nos. 3,121,127 that was registered on July 25, 2006.

Since at least as early as 2003, the Complainant has provided a website at <guggenheimpartners.com> where it uses its GUGGENHEIM marks to advertise its services.

The disputed domain name was registered on June 22, 2024. The disputed domain name does not resolve to an active website.

The Respondent did not file a Response, so little information is known about the Respondent. The Respondent was unsuccessful in a prior decision under the Policy in a case involving a fraudulent “adopt a cow” scheme. See *Saputo Dairy Products Canada G.P. v. ss ss, ggggggccgggcccc, and Kaixin He, BuildHost Inc*, WIPO Case No. [D2024-3618](#).

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 contends that the Complainant’s GUGGENHEIM marks are well-known worldwide in connection with the offering and sale of financial services, including financial advising, and therefore the disputed domain name is not one the Respondent “would legitimately choose unless seeking to create an impression of an association with Complainant.”

The Complainant asserts that Respondent’s use of the term “fund” in the disputed domain name refers to the financial services the Complainant offers under its well-known GUGGENHEIM marks and thus increases the confusing similarity between the Complainant’s mark and the disputed domain name.

There is no evidence that the Respondent is commonly known by Guggen or Guggen Fund.

Given the Complainant’s substantial international rights in its GUGGENHEIM marks, how well-known the GUGGENHEIM marks are worldwide, and the Complainant’s management of over USD 335 billion assets under its GUGGENHEIM marks, the Complainant submits that “it is . . . not plausible to conceive of a plausible circumstance in which the Respondent would have been unaware of [these facts]” at the time the Respondent registered the disputed domain name.

B. Respondent

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

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical 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; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The onus of proving these elements is on the Complainant.

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 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 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. The disputed domain name incorporates what the Panel perceives as a dominant portion of the Complainant's mark, since it corresponds to 6 out of the 10 letters of the Complainant's mark, and it is also the beginning of the Complainant's mark. See, for example, *Lima One Capital v. Chase Lima*, WIPO Case No. [D2024-2414](#); *Latham & Watkins LLP v. Victory Saga*, WIPO Case No. [D2023-5394](#).

Although the addition of other terms (here, "fund") 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.

The Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

Generally speaking, a finding that a domain name has been registered and is being used in bad faith requires an inference to be drawn that the respondent in question has registered and is using the disputed domain name to take advantage of its significance as a trademark owned by (usually) the complainant. *Instagram, LLC v. Domains By Proxy, LLC / Masud Rana, D-limit Ltd*, WIPO Case No. [D2022-0250](#).

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 has reviewed the Complainant's evidence and concludes that the Complainant has an international reputation in its field. In that field, the Complainant's GUGGENHEIM mark is well-known.

The Respondent did not file a Response. The Respondent does not assert that he was unaware of the Complainant and its trademark when he registered the disputed domain name. The disputed domain name includes the term "fund" which is a term that relates to the Complainant's services. The Panel concludes that it is likely that the Respondent was aware of the Complainant when he registered the disputed domain name and did so because of the Complainant's reputation.

There is no evidence of use of the disputed domain name. The Complainant asserts that the Respondent's use of the disputed domain name constitutes passive holding and that this passive holding constitutes bad faith. The leading case on passive holding is the long-standing decision of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0030](#) ("the *Telstra* case"). In the present case, the Complainant has presented evidence to satisfy the test set out in *Telstra*. The Complainant's trademark is somewhat unique and well-known, and the addition of the term "fund" points towards a targeting of the Complainant's trademark.

Considering a prior decision involving the Respondent, there is also a concern that the disputed domain name will be used for fraudulent purposes. *Saputo Dairy Products Canada G.P. v. ss ss, ggggggcccgggcccc, and Kaixin He, BuildHost Inc*, WIPO Case No. [D2024-3618](#).

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. [WIPO Overview 3.0](#), section 3.3. Having reviewed the available record, the Panel notes the distinctiveness or reputation of the Complainant's trademark, and the composition of the disputed domain name, and finds that in the circumstances of this case the passive holding of the disputed domain name does not prevent a finding of bad faith under the Policy.

The Panel finds the third element of the Policy has 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 name <guggenfund.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: December 26, 2024