

## **ADMINISTRATIVE PANEL DECISION**

Cresset Administrative Services Corporation and Cresset Partners LLC v.  
Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf /  
Joe William  
Case No. D2022-0019

### **1. The Parties**

The Complainants are Cresset Administrative Services Corporation and Cresset Partners LLC, United States of America (“United States”), represented by Fuksa Khorshid, LLC, United States.

The Respondent is Redacted for Privacy, Privacy Service Provided by Withheld for Privacy ehf, Iceland / Joe William, United States.

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

The disputed domain name <intelligentwealthmanagementinc.com> (the “Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 30, 2021. On January 4, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 5, 2022, 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 January 11, 2022. In accordance with the Rules, paragraph 5, the due date for Response was January 31, 2022. The Center received an email responding to the Complaint from the registrant email address confirmed by the Registrar dated January 11, 2022. On January 12, 2022, the Center sent a request for confirmation that this communication was meant to serve as

a Response. The Center received no reply, and on February 1, 2022, the Center confirmed that it would proceed to Panel Appointment.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on February 4, 2022. 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 Cresset Administrative Services Corporation (“CASC”) is a corporation organized under the laws of the State of Delaware, United States, and the Complainant Cresset Partners, LLC (“CP LLC”) is a Delaware limited liability company. It appears from the Complaint and the Complainant’s website at “www.cressetpartners.com” that these two entities are part of a group of related companies also including Cresset Capital Management, LLC and Cresset Asset Management, LLC to which the website Terms of Use apply. According to the “Trademarks” section of those Terms of Use, these entities are licensed to use the “Cresset” trademarks and other marks on the Complainant’s website. Therefore, for purposes of this proceeding, the Panel refers to the Complainants collectively as the “Complainant” unless otherwise indicated.

The Complainant offers “a variety of financial advisory and wealth management services” to “individuals and family offices”. According to the Complainant’s website, CP LLC and Cresset Asset Management, LLC are registered with the United States Securities and Exchange Commission (SEC) as investment advisors. The website claims USD 1.5 billion in “committed capital” and cites media recognition in national publications such as *Forbes*, *Bloomberg*, and *The New York Times*.

The “Wealth” page on the Complainant’s website is headed with the trademarked slogan INTELLIGENT WEALTH MANAGEMENT.

The Complainant CASC holds United States Trademark Registration Number 6364954 (registered May 25, 2021) for the standard character mark INTELLIGENT WEALTH MANAGEMENT (application filed April 4, 2019, claiming first use in commerce June 15, 2020). The registration disclaims exclusive rights to the term “wealth management” apart from the mark as shown.

According to the Registrar’s Whois database, the Domain Name was registered on September 7, 2021, in the name of the Respondent domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Joe William, with a postal address in California, United States. The Registrar requested that the domain privacy service be removed as a Respondent. Accordingly, Mr. William is referred to hereafter as the “Respondent”.

It does not appear that the Domain Name has ever been used for an active website. At the time of this Decision, it resolves to an error message. The Internet Archive’s Wayback Machine has no archived screenshots associated with the Domain Name.

Counsel for the Complainant sent a cease-and-desist letter to the Registrar on October 12, 2021 but received no reply from the Respondent.

#### **5. Parties’ Contentions**

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

The Complainant claims numerous United States trademark registrations held by either CASC or CP LLC, but the only directly relevant mark for this proceeding is the CASC registration for INTELLIGENT WEALTH

MANAGEMENT. The Complainant asserts that the Domain Name is confusingly similar to this mark, incorporating the mark in its entirety and adding the abbreviation "inc".

The Complainant states that the Respondent has no permission to use this mark or any other evident rights or legitimate interests in the Domain Name.

The Complainant suggests that the "Domain Name may have been registered or acquired primarily for the purpose of selling, renting, or otherwise transferring the domain name registrations to the Complainants or to a competitor of Complainants, for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the Domain Name." The Complainant states further, independently

"Upon information and belief, Respondent knowingly registered the Domain Name to capitalize on consumer recognition of the INTELLIGENT WEALTH MANAGEMENT mark."

The Complainant's argument is essentially that its mark is unique, and it is unlikely that the Respondent chose it for any reason but to "confuse and mislead consumers". The Respondent's failure to respond to communications supports an inference of bad faith.

## **B. Respondent**

Absent evidence to the contrary, the Panel assumes that the email to the Center from "Store Parts" dated January 11, 2022, was sent by someone associated with the Respondent and represents the Respondent's views noting that the registrant's email address as confirmed by the Registrar was used for such purpose. The Respondent never submitted a formal Response with a certification of completeness and accuracy as required by the Rules, paragraph 5(c)(viii). The Panel takes this into account in weighing the credibility of the Respondent's assertions and arguments.

The January 11, 2022, email argues as follows:

"Cresset Capital a.k.a. Intelligent Wealth Management has no rights to the intelligentwealthmanagementinc.com their trademark name is clearly 'intelligent wealth Management'

Cresset Capital has no rights for the trademarks intelligent wealth management inc, intelligent wealth management group, intelligent wealth management company, intelligent wealth management partners, intelligent wealth management incorporated.

This is a parked page for non profit and educational purposes.

This domain is not for sale and is not listed for sale.

There are no intentions to sell or to use the trademark 'intelligent wealth management' or provide financial services.

Therefore, NO trademark has been violated.

Please deny request by Cresset Capital.

This domain has not violated any trademark, and has not made any claims to be associated with Cresset Capital or Intelligent Wealth Management R

This domain is a parked page for non profit and educational purposes. We are not providing financial services.

Please deny request by Cresset Capital."

## 6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following:

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

Under paragraph 15(a) of the Rules, “[a] Panel shall decide a complaint 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”.

### A. Identical or Confusingly Similar

The first element of a UDRP complaint “functions primarily as a standing requirement” and entails “a straightforward comparison between the complainant’s trademark and the domain name”. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.7. The Complainant CASC holds, and the Complainant CP LLC uses, the registered standard character trademark INTELLIGENT WEALTH MANAGEMENT. This mark appears in its entirety in the Domain Name, which adds the common abbreviation for “incorporated”, “inc”. The addition of such an abbreviation for a legal term does not prevent a finding of confusing similarity. See *id.*, section 1.8. As usual, the generic Top-Level Domain (“gTLD”) “.com” is disregarded as a standard registration requirement. See *id.* section 1.11.2.

Contrary to the Respondent’s suggestion, the Domain Name need not be an exact replica of a trademark to be “confusingly similar” for purposes of the Policy, paragraph 4(a)(i). The Panel finds that the Domain Name is confusingly similar to the Complainant’s registered INTELLIGENT WEALTH MANAGEMENT trademark and concludes that the Complainant has established the first element of the Complaint.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent’s use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) that the respondent has been commonly known by the domain name, 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 domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has established trademark rights, a lack of permissive use, and the failure to make use of the Domain Name. Thus, the Complainant has made a *prima facie* case, and the burden of production shifts

to the Respondent.

The Respondent does not claim a corresponding personal or organizational name but asserts that “[t]his is a parked page for non profit and educational purposes”. However, the Respondent has held the Domain Name for over five months and offers no evidence of preparations to make use of the Domain Name for nonprofit and educational purposes and does not even explain what those might entail.

The Panel finds that the Respondent has not met the burden of production and concludes that the Complainant prevails on the second element of the Complaint.

### **C. Registered and Used in Bad Faith**

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following (in which “you” refers to the registrant of the domain name):

“(i) circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of your documented out-of-pocket costs directly related to the domain name; or

(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of your web site or location or of a product or service on your web site or location.”

The Complainant implies that these motivations might have been in contemplation when the Respondent registered the Domain Name, although the Respondent has not yet offered the Domain Name for sale or put it to any use.

The Complainant does not cite the “passive holding” doctrine articulated in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#), and succeeding decisions, although it might well have done. See [WIPO Overview 3.0](#), section 3.3:

“From the inception of the UDRP, panelists have found that the non-use of a domain name ... would not prevent a finding of bad faith under the doctrine of passive holding.

While 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.”

Here, the Complainant's mark is an English phrase, partially disclaimed and not long-established as a mark but nevertheless distinctive and copied in its entirety in the Domain Name. The Respondent, veiled at first through a domain privacy service, did not reply to a cease-and-desist letter. In the email communication to the Center, the party purporting to speak for the Respondent did not deny prior awareness of the Complainant's mark but instead argued unconvincingly that the Domain Name is not an exact duplication because it adds the corporate abbreviation “inc”. (The email also worryingly argued that other similar additions would avoid trademark or Policy infringement.) The Respondent claimed a nonprofit, educational interest in the Domain Name but offered no further explanation when invited to confirm its Response or make a further submission. The Complainant also offered at that point to discuss settlement with the Respondent. The Respondent made no further communication. On this record, the Panel does not find plausible the Respondent's claims of an unarticulated “educational” purpose for the Domain Name.

The Complainant has trademarked and used a unique slogan associated with its business. The Respondent subsequently registered a Domain Name featuring the same phrase. The Respondent has not yet put the Domain Name to active use, but the well-established “passive holding” doctrine indicates that the Complainant does not have to wait until the Respondent pulls the trigger and exploits the confusingly similar Domain Name by demanding an extortionate payment or misdirecting Internet users.

The Panel concludes that the third element of the Complaint, bad faith, is established within the meaning 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 Domain Name <intelligentwealthmanagementinc.com> be transferred to the Complainant.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: February 22, 2022