

## **ADMINISTRATIVE PANEL DECISION**

### **BlackRock Fund Advisors v. King Content Case No. D2024-0490**

#### **1. The Parties**

The Complainant is BlackRock Fund Advisors, United States of America (“United States”), represented by Day Pitney LLP, United States.

The Respondent is King Content, Thailand.

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

The disputed domain name <ishares.company> 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 February 1, 2024. On February 2, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 2, 7, and 9, 2024, the Registrar transmitted by email to the Center its verification responses, disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (REDACTED FOR PRIVACY, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 12, 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 February 17, 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 February 19, 2024. In accordance with the Rules, paragraph 5, the due date for Response was March 10, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on March 13, 2024.

The Center appointed Marilena Comanescu as the sole panelist in this matter on March 27, 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 and its affiliates, provide investment management, risk management, strategic advisory and enterprise investment system services to a broad base of clients, being one of the world's largest asset managers, with assets over USD 10 trillion under management.

One of the Complainant's brands ISHARES was launched in 2000, and the iShares funds have become globally renowned as the world's leading exchange traded funds ("ETFs") with USD 3.3 trillion under management.

The Complainant holds worldwide trademark registrations for or incorporating the term "iShares", such as the following:

- United States trademark registration number 5146723 for the ISHARES (word), filed on July 25, 2016, and registered on February 21, 2017, for services in International class 42; and
- European Union trademark registration number 001287705 for the ISHARES (word), filed on August 24, 1999 and registered on October 11, 2000, for services in International class 36.

The Complainant's official website is available under the domain name <ishares.com>, which was registered in 1998.

The disputed domain name <ishares.company> was registered on July 17, 2023, and, at the time of filing of the Complaint, it was used in relation to a "clone website" visually identical to the Complainant's official website, except for the fact that the language used was Thai. Also, on the website under the disputed domain name the Complainant's trademarks, ISHARES and BLACKROCK, were displayed, and there was login functionality available for visitors.

The Complainant claims that it sent several takedown notices and complaints to the webhost of the disputed domain name but no reaction was received.

#### **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 alleges that the disputed domain name incorporates its famous and distinctive trademark in its entirety; the disputed domain name comprises solely the ISHARES mark paired with the Top-Level Domain ".company" to replicate the Complainant's official website to falsely advertise BLACKROCK and ISHARES branded services in Thai language, and presents login functionality to visitors, this representing an incontrovertible evidence of bad faith; the Complainant's ISHARES trademark precedes the registration of the disputed domain name by two decades; the Respondent is not using the disputed domain name for any other purposes other than to impersonate the Complainant by replicating the Complainant's official website, presumably in order to add false legitimacy to otherwise unauthorized actions; by using a clone replication of the Complainant's actual website, the Respondent intentionally attempts to

attract, for commercial gain, the financial and personal information of potential BlackRock and iShares fund customers, by creating a likelihood of confusion between the Complainant's mark and the source of the website under the disputed domain name; the use of a privacy service and the suspect nature of the Respondent's name, suggest the Respondent may be fictitious, further evidencing the Respondent's bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under the Policy, the Complainant is required to prove on the balance of probabilities that:

- (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 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 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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

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.

According to the evidence provided in the Complaint, the Respondent has used the disputed domain name in connection with a website copying the look-and-feel of the Complainant's website, displaying its trademarks, and providing login functions. Panels have held that the use of a domain name for illegal activity (such as impersonation/passing off) can never confer rights or legitimate interests on a respondent.

[WIPO Overview 3.0](#), section 2.13.1.

Furthermore, the composition of the disputed domain name, being identical to the Complainant's mark, carries a high risk of implied affiliation. UDRP panels have largely held that such composition cannot constitute fair use if it effectively impersonates or suggests sponsorship or endorsement by the trademark owner. [WIPO Overview 3.0](#), section 2.5.1.

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.

In the present case, the Panel notes that the disputed domain name was registered in bad faith, with knowledge of the Complainant and its trademark particularly because the Complainant's registration of the ISHARES trademark and the corresponding domain name <ishares.com> predates the registration of the disputed domain name for more than two decades. Further, the use of the disputed domain name further enhances such conclusion.

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.

Paragraph 4(b)(iv) of the Policy provides that the use of a domain name to intentionally attempt "to attract, for commercial gain, Internet users to [the respondent's] 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 [the respondent's] web site or location or of a product or service on [the respondent's] web site or location" is evidence of registration and use in bad faith.

Given that the disputed domain name is identical to the Complainant's trademark, and the website operated under the disputed domain name provides a copycat version of the Complainant's website albeit in a different language - Thai, and displays the Complainant's trademarks, indeed in this Panel's view, the Respondent has intended to attract unsuspecting Internet users accessing the website corresponding to the disputed domain name who may be confused and believe that the website is held, controlled by, or somehow affiliated with or related to the Complainant, for the Respondent's commercial gain. This activity may also disrupt the Complainant's business and tarnish its trademark.

Further, panels have held that the use of a domain name for illegal activity (here, claimed impersonation/passing off) constitutes bad faith. [WIPO Overview 3.0](#), section 3.4.

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 <ishares.company> be transferred to the Complainant.

*/Marilena Comanescu/*

**Marilena Comanescu**

Sole Panelist

Date: April 9, 2024