Decision for dispute CAC-UDRP-107306

Case number	CAC-UDRP-107306
Time of filing	2025-02-14 09:42:18
Domain names	primalpetfood.com

Case administrator

Organization	Iveta Špiclová (Czech Arbitration Court) (Case admin)

Complainant

Organization	Primal Pet Foods, Inc.

Complainant representative

Organization	RODENBAUGH LAW LLC

Respondent

Organization	TotalDomain Privacy Ltd

OTHER LEGAL PROCEEDINGS

The Panel is not aware of any other legal proceedings which are pending or decided and which relate to the disputed domain name.

IDENTIFICATION OF RIGHTS

The Complainant has demonstrated ownership of rights in the PRIMAL PET FOODS trademark for the purposes of standing to file a UDRP Complaint.

In particular, the Complainant is the owner of trademark registrations for PRIMAL PET FOODS, including the following:

- International trademark registration No. 1401556 for PRIMAL PET FOODS registered on March 23, 2018; and

- United States trademark registration No. 4249017 for PRIMAL PET FOODS, registered on November 27, 2012.

The Panel notes that portion "PET FOODS" has been disclaimed in above cited trademarks. The effect of the declaimer on this dispute will be examined below within the section "Principal Reasons for the Decision".

In addition, the Complainant has provided certain evidence on common law rights in PRIMAL PET FOODS trademark before the formal registration of above listed trademarks.

The Complainant also refers to ownership over the domain name <primalpetfoods.com>, registered on August 29, 2001. This domain name incorporates the Complainant's PRIMAL PET FOODS trademark in its entirety and the same is used for a principal website of the Complainant where goods under the trademark PRIMAL PET FOODS are offered.

FACTUAL BACKGROUND

The Complainant was founded in 2001 in San Francisco, California, US under the name "Primal Pet Foods, Inc." which matches the Complainant's PRIMAL PET FOODS trademark. The Complainant is manufacturer of foods and treats for dogs and cats.

The disputed domain name was registered on May 14, 2008. However, based on the Whois history provided by the Complainant, the disputed domain name has changed the registrant several times after the initial registration date. Based on the available Whois history, the last traceable change of ownership occurred somewhere around January 16, 2019. The disputed domain name currently resolves to parking page with sponsored links (pay-per-clicks or PPC page), that display various links related to pet food, including the link that incorporates the Complainant's PRIMAL PET FOODS trademark in its entirety. The disputed domain name is also offered for sale.

PARTIES CONTENTIONS

The Complainant

The Complainant contends that the requirements of the Policy have been met and that the disputed domain name should be transferred to it. In particular, the Complainant argues that the disputed domain name is confusingly similar to its PRIMAL PET FOODS trademark in which the Complainant has earlier rights (date of first use of the Complainant's trademark in the US goes back to 2001). The disputed domain name differs from the Complainant's trademark only in omission of letter "s" at the end of PRIMAL PET FOODS. The addition or subtraction of one letter or misspelling of a word does not distinguish the disputed domain name from the Complainant’s trademark, rather it shows an attempt to engage in typosquatting upon the Complainant’s trademark.

Regarding the second UDRP element, the Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent is not commonly known by the disputed domain name. The Respondent has used the disputed domain name for competitive PPC advertising, which obviously, is not a bona fide use of the disputed domain name. The Respondent also has offered to sell the disputed domain name to the Complainant’s counsel for $9,899, an amount far exceeding its registration price.

With respect to the third UDRP element, the Complainant holds that it is certain that Respondent was aware of the Complainant’s rights given the similitudes with the disputed domain name as compared to the Complainant’s own domain, and the similarity of the products advertised in the pay-per-click links to the goods and services of the Complainant. The Respondent has made active use of a disputed domain name in an effort to divert Internet users to Complainant’s competitors. The Complainant holds that the Respondent is using the disputed domain name for no other reason than to disrupt the Complainant’s business by intentionally diverting Internet users, using Complainant’s PRIMAL PET FOODS family of marks in connection with pay-per-click links to alternative and competitive pet product providers. The Respondent has offered to sell the disputed domain name for almost $10,000, which is exponentially more than the domain registration fee. This is further evidence that Respondent is acting in bad faith. Finally, the Complainant claims that the Respondent is a serial cybersquatter that has lost 37 UDRP cases since April 2022.

On March 24, 2025 the Panel has issued Procedural Order No. 1 requesting from the Complainant to submit all relevant evidence on use in commerce of PRIMAL PET FOODS trademark before the registration of the disputed domain name on May 14, 2008. The Procedural Order was issued due to the circumstances that the Panel has noticed that the all trademarks of the Complainant on which the dispute is based are registered or applied for after the registration of the disputed domain name. The Panel has also noted that the Complainant has indicated for several US trademarks that the first use in commerce commenced in 2001, but no evidence proving such use was submitted.

In response to the Procedural Order No. 1, the Complainant has provided the Whois history for the disputed domain name and has argued that the disputed domain name, although registered on May 14, 2008, since then has changed ownership several times. The latest change of ownership appears to be on or before January 16, 2019. In accordance with this, the Complainant deems that its registered trademarks are earlier than the current registration of the disputed domain name (having in mind that change of ownership counts as a new registration in accordance with UDRP practice). For that reason, the Complainant holds that there is no need to prove the use of PRIMAL PET FOODS trademark before the registration of the disputed domain name, but has, nevertheless, decided to provide such evidence to Panel. The Complainant has accordingly provided evidence that the Complainant has had an online presence since at least 2002, and by 2008 had an online store and a significant presence in US grocery stores. The Complainant's Facebook presence began in early 2009. By 2018, when the disputed domain name was acquired by Respondent, the Complainant had an expansive website and was earning industry awards for its product innovation.

The Respondent

No administratively compliant Response has been filed.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Panel is satisfied that all procedural requirements under UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

On March 24, 2025 the Panel has issued Procedural Order No. 1 requesting from the Complainant to submit all relevant evidence on use in commerce of PRIMAL PET FOODS trademark before the registration of the disputed domain name on May 14, 2008. The Procedural Order was issued due to the circumstances that the Panel has noticed that the all trademarks of the Complainant on which the dispute is based are registered or applied for after the registration of the disputed domain name. The Panel has also noted that the Complainant has indicated for several US trademarks that the first use in commerce commenced in 2001 (more precisely, on October 1, 2001 according to the USPTO record for US trademark registration No. 4249017), but no evidence proving such use was submitted. By this Procedural Order, the Panel has also extended the projected decision date to April 2, 2025.

On March 29, 2025, the Complainant has provided the response to the Procedural Order which is satisfactory for the Panel to move forward with the decision.

PRINCIPAL REASONS FOR THE DECISION

According to 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." Paragraph 4(a) of the Policy stipulates that the complainant must prove each of the following:

1. that the disputed domain name registered by the respondent is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
2. that the respondent has no rights or legitimate interests in respect of the disputed domain name; and
3. that 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, as stipulated in section 1.7 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (“WIPO Overview 3.0”).

As indicated above, the Complainant is owner of several trademarks for PRIMAL PET FOODS in various countries. The disclaimer on portion "PET FOODS" of the Complainant’s trademark does not affect the Complainant's standing on the basis of a trademark, but the existence of such a disclaimer would be relevant to the Panel’s assessment of the second and third elements (WIPO Overview 3.0, sections 1.2.3 and 1.10). The Complainant has, therefore shown rights in respect of the PRIMAL PET FOODS trademark for the purposes of the Policy (WIPO Overview 3.0, section 1.2.1).

The second-level domain (SLD) of the disputed domain name "primalpetfood" is very close to the PRIMAL PET FOODS trademark and the only difference is lack of last letter "s" in the disputed domain name. The omission of the second letter "s" in the disputed domain name is insufficient to avoid a finding of confusing similarity and in this particular case, it merely represents singular form of word "food", comparing to its plural form "foods" in the Complainant's trademark. A domain name which consists of a common, obvious, or intentional misspelling of a trademark is considered by panels to be confusingly similar to the relevant mark for purposes of the first element (WIPO Overview 3.0, section 1.9).

In addition, it is well established that ".com", as a generic Top-Level Domain, can be disregarded in the assessment of the confusing similarity between the disputed domain name and the Complainant's trademark (WIPO Overview 3.0, section 1.11.1).

The Panel, therefore, finds that 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.

In particular, the Panel notes that there appears to be no relationship between the Respondent and the Complainant and that the Respondent is not a licensee of the Complainant, nor has the Respondent otherwise obtained an authorization to use the Complainant's PRIMAL PET FOODS trademark. There appears to be no element from which the Panel could infer the Respondent's rights and legitimate interests in the disputed domain name, or that the Respondent might be commonly known by the disputed domain name.

The Panel has accepted that relevant date for the registration of the disputed domain name should be around January 16, 2019 when the disputed domain name was acquired by the Respondent and rights and legitimate interests of the Respondent are observed in respect to such date. The Panel, however, notes that even if the original date of registration of the disputed domain name would be observed, the result would be the same, since, although the Complainant did not have registered trademark rights at that time, the Complainant has provided sufficient evidence that its trademark was in substantial use within that period. The Respondent, therefore, must have been aware of the Complainant and its trademark at the time of registration (or acquiring) of the disputed domain name. Although the portion "PET FOODS" is disclaimed in the Complainant's trademark as a generic portion that merely describes the goods of interest, the Panel holds that the PRIMAL PET FOODS trademark as a whole is sufficiently distinctive and it appears to be exclusively used by the Complainant. The Panel, in that sense, finds that the structure of the disputed domain name, which contains typo version of the Complainant's PRIMAL PET FOODS trademark, where only last letter "s" is omitted, carries a high risk of implied affiliation (see WIPO Overview 3.0, section 2.5.1).

The Panel also finds that the use of the disputed domain name for a parking page with pay-per-click links does not represent a bona fide offering having in mind that links in this case are related to pet food and therefore they compete with and capitalize on the reputation and goodwill of the Complainant's trademark and mislead Internet users (see WIPO Overview 3.0, section 2.9). Furthermore, even the Complainant's PRIMAL PET FOODS trademark appears within these links indicating clear connection of PPC links with the Complainant.

The Panel has also taken into account, the Complainant's arguments regarding the offer for sale of the disputed domain name for 9,899 USD, but is not convinced that such evidence can necessarily be attributed to lack of legitimate interest on the Respondent's side. Although, it is likely that the Respondent has determined the high value of the disputed domain name based on its connection with the Complainant's trademark, the communication regarding the offer was done between the Complainant's attorney and the Respondent's domain name broker and it is therefore not clear if the Respondent was even aware that the offer was made to the Complainant. The evidence on record does not disclose such details.

Furthermore, although the prior record of at least 37 lost UDRP cases would usually indicate the pattern of bad faith and lack of legitimate interest on the Respondent's side, in this case the Panel is not convinced that all these UDRP cases are necessarily related to the Respondent. Namely, the named Respondent in these proceedings and in 37 other proceedings listed by the Complainant appears to be a privacy shield, which means that there is an underlying registrant behind such privacy shield. Due to lack of information on underlying registrants, the Panel cannot know whether the same person was underlying registrant in all these cases and for that reason decides to give the Respondent benefit of the doubt regarding the prior UDRP record.

Nonetheless, despite the Panel's view on certain arguments raised by the Complainant, the Panel still holds that arguments regarding the absence of rights and legitimate interest in this case are prevailing, especially in the absence of the response from the Respondent that would provide any relevant counter arguments.

Having in mind the above, 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 the

disputed 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).

In the present case, the Panel notes that the Respondent must have been aware of the Complainant and its PRIMAL PET FOODS trademark, especially having in mind the structure of the disputed domain name. The fact that the Respondent has chosen the domain name that differs from PRIMAL PET FOODS trademark only in omission of single letter (creating the singular form of the word "food") indicates that the Respondent intentionally selected the domain name that is confusingly similar to the Complainant's trademark. Misspelling of trademark (the practice known as typosquatting) that enjoys certain reputation has been commonly recognized as evidence of bad faith by prior panels (see WIPO Overview 3.0, section 3.1.4). As indicated above, at the relevant date of acquiring of the disputed domain name by the Respondent, the Complainant already had well-established rights in PRIMAL PET FOODS trademark and the trademark itself was in use for over a decade at that time. The Complainant's PRIMAL PET FOODS trademark consists of three common and dictionary English words "primal", "pet" and "food", and even words "pet" and "food" are disclaimed from the Complainant's trademark. However, the combination of these words is unique and distinctive and appears to be exclusively used by the Complainant. It is, therefore, highly unlikely that the Respondent decided to register a domain name containing this trademark with omitted last letter "s" without having the Complainant in mind when doing so.

Due to the above, the Panel finds that the disputed domain name has been registered in bad faith.

As mentioned above, the disputed domain name resolves to a parking page with PPC links related to pet food (and even including the Complainant's PRIMAL PET FOODS trademark in its entirety), meaning that they compete with and capitalize on the reputation and goodwill of the Complainant's trademark. Therefore, the Panel deems that by such use of the disputed domain name, the Respondent has intentionally attempted to attract Internet users to its website for commercial gain, by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation or endorsement of its website according to paragraph 4(b)(iv) of the Policy. This constitutes bad faith use of the disputed domain name.

For the reasons explained in detail within section B, the Panel has not taken into account the offer to sell the domain name for 9,899 USD and the prior record of 37 lost UDRP cases, when considering bad faith on the Respondent's side. However, even when these circumstances are not taken into account, the Panel still holds that there is more than sufficient evidence indicating the bad faith of the Respondent.

The Panel finds that the disputed domain name has been both registered and is being used in bad faith, and consequently that the Complainant has established the third element of the Policy.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **primalpetfood.com** : Transferred

PANELLISTS

Name	**Stefan Bojovic**

DATE OF PANEL DECISION 2025-04-02

Publish the Decision