

ADMINISTRATIVE PANEL DECISION

Primark Limited v. Michael Nava, Domain Nerdz LLC
Case No. D2023-3528

1. The Parties

The Complainant is Primark Limited, Ireland, represented by SafeNames Ltd., United Kingdom.

The Respondent is Michael Nava, Domain Nerdz LLC, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <primark.org> is registered with Sav.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 21, 2023. On August 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 21, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on August 22, 2023, 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 August 25, 2023.

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 August 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was September 17, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on September 21, 2023.

The Center appointed Torsten Bettinger as the sole panelist in this matter on September 27, 2023. 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 is a multinational retailer of a diverse range of products such as women's, men's and children's clothing, as well as accessories, beauty products and homeware.

The Complainant was originally founded in Ireland in 1969. The Complainant began using the PRIMARK brand in 1973 when it expanded into the United Kingdom. There are now 408 stores across the United Kingdom, Europe, and the United States. The Complainant employs over 70,000 people and spans 14 countries.

The Complainant provided evidence of the following trademark registrations:

- PRIMARK No. 83740, Ireland, registered on April 8, 1974, in class 24;
- PRIMARK No. 83739, Ireland, registered on April 8, 1974, in class 25;
- PRIMARK No. 3P-280750, Switzerland, registered on February 10, 1976, in classes 22-27;
- PRIMARK No. UK00001282237, United Kingdom, registered on September 09, 1988, in classes 37,39;
- PRIMARK No. 000117838, European Union, registered on February 1, 1999, in classes 18, 24, 25;
- PRIMARK No. 003672441, European Union, registered on July 20, 2009, in classes 5, 14,16, 20-23, 26-28;

The Complainant provides information to online users about the Complainant's products and store locations at <primark.com>.

The disputed domain name has been registered on October 29, 2022, and redirects to the domain aftermarket website, "www.dan.com" where the disputed domain name is advertised for sale at a 'buy now' price of USD 1,988. The Respondent also advertises the disputed domain name for sale on the platform "www.afternic.com" for the same price.

5. Parties' Contentions

A. Complainant

The Complainant submits that its PRIMARK is a distinctive term used to represent the Complainant's goods and services.

With regard to the requirement of identity or confusing similarity between the trademark and the disputed domain name pursuant to paragraph 4(a)(i) of the Policy, the Complainant argues that:

- the disputed domain name is identical with the trademark PRIMARK as it contains the PRIMARK trademark in its entirety without alteration or adornment;
- the generic Top-Level domain ("gTLD") ".org" featured in the disputed domain name, should be disregarded under the first element as it is a standard registration requirement.

With regards to the Respondent having no rights or legitimate interests in the disputed domain name, the Complainant submits that:

- to the best of the Complainant's knowledge, the Respondent does not have any trademark rights to the term "primark";
- there is no evidence that the Respondent retains any unregistered trademark rights to the term "primark";
- the Respondent has not received any license from the Complainant to use a domain name featuring the PRIMARK trademark.

- there is no evidence of the Respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services;
- the Respondent's primary purpose for the disputed domain name's registration is to generate undue profit based on the disputed domain name's value as a trademark;
- the Respondent is not commonly known by the term "primark";
- the Complainant's mark PRIMARK is a fanciful term used to represent the Complainant's goods and services and there is no generic or common usage for the term "primark";
- the Respondent's offer to sell the disputed domain name at a 'buy now' price of USD 1,988, is clear evidence that the Respondent intends to generate substantial monetary revenue through the sale of the disputed domain name based on its value as a trademark.

Finally, with regards to the disputed domain name having been registered and being used in bad faith, the Complainant argues that:

- the "primark" name has garnered considerable popularity in its industry as a multinational retailer of a diverse range of products;
- the Respondent has chosen to ignore the cease-and-desist notice sent by the Complainant's representative on May 19, 2023;
- the Respondent also used the disputed domain name in bad faith prior to notice of the dispute;
- the Respondent has registered or acquired the disputed domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name registration to the Complainant;
- the Respondent uses the disputed domain name to redirect to the domain aftermarket website "www.dan.com", where the disputed domain name is listed for sale at a 'buy now' price of USD 1,988 which is a price far beyond what would reasonably be expected within the Respondent's out-of-pocket costs related to the disputed domain name;
- while the offer for sale has not been made directly to the Complainant, the circumstances surrounding the registration and use of the disputed domain name indicate bad faith and suggest the Respondent is aware of the value of the disputed domain name as a trademark, as the term "primark" has no inherent meaning beyond its status as an already established brand of the Complainant.
- the fact that the Respondent advertises the disputed domain name for sale on the platform "www.afternic.com" for the same price (USD 1,988) shows that the Respondent's primary intention is to sell the disputed domain name based on its trademark value;
- the Respondent primarily registered the disputed domain name with the view of selling it back to the Complainant or its competitors for a sum in excess of the Respondent's out-of-pocket costs, which is evidence of bad faith use.

B. Respondent

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

6. Discussion and Findings

Paragraph 4(a) of the Policy states that the Complainant must prove each of the three following elements:

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

A. Identical or Confusingly Similar

The Complainant has demonstrated that it has trademark rights through the multiple trademark registrations for the mark PRIMARK.

It is well-established that the test of identity or confusing similarity under the Policy is confined to a comparison of the disputed domain name and the trademark alone, independent of the products for which the trademark is used or other marketing and use factors usually considered in trademark infringement cases (See sections 1.1.2 and 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

As set forth in section 1.7 of the [WIPO Overview 3.0](#): “in cases where a domain name incorporates the entirety of a trademark [...] the domain name will normally be considered confusingly similar to that mark.” (See, e.g., *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#) (“the fact that a domain name wholly incorporates a complainant’s registered mark is sufficient to establish identity or confusing similarity for purposes of the Policy”)).

In this case, the disputed domain contains the Complainant’s PRIMARK trademark in its entirety without any alteration or addition.

Finally, it is well accepted in past UDRP decisions that the gTLD, such as (e.g., “.com”, “.club”, “.nyc”, “.tech”, etc.), is typically not to be taken into account when assessing the issue of identity and confusing similarity, except in certain cases where the applicable gTLD may itself form part of the relevant trademark (see section 1.11 of the [WIPO Overview 3.0](#)). This practice of disregarding the TLD in determining identity or confusing similarity is applied irrespective of the particular TLD (including with regard to “new gTLDs”).

The Panel therefore concludes that the disputed domain name is identical to the Complainant’s PRIMARK trademark in which the Complainant has exclusive rights.

B. Rights or Legitimate Interests

Pursuant to paragraph 4(c) of the Policy, a respondent may establish its rights or legitimate interests in the domain name, among other circumstances, by showing any of the following elements:

“(i) before any notice to you [the Respondent] of the dispute, your 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) you [the Respondent] (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or
(iii) you [the Respondent] are 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.”

The Complainant stated that the Complainant has never given its consent for the Respondent to use its PRIMARK trademark, nor any other similar sign such as PRIMARK in a domain name registration or in any other manner, and provided evidence that the disputed domain name redirected to the domain aftermarket website “www.dan.com”, where the domain name is listed for sale at a ‘buy now’ price of USD 1,988.

The Complainant also stated that its PRIMARK trademark is a fanciful term and that there is no generic or common usage for the term “primark”.

These assertions and evidence are sufficient to establish a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name.

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 disputed domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent chose not to contest the Complainant's allegations and has failed to come forward with any evidence to refute the Complainant's *prima facie* showing that the Respondent lacks rights or legitimate interests. The Panel therefore accepts these allegations as undisputed facts.

From the record in this case, the disputed domain name resolves to website where it is offered for sale, and there is no other evidence to support the assumption that the Respondent has used the disputed domain name in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use. Moreover, the nature of the disputed domain name, being identical to the Complainant's mark, carries a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

The Panel therefore concludes that the Respondent lacks rights and legitimate interests in the disputed domain name and that, accordingly, the Complainant has satisfied the requirements of paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides four, non-exclusive, circumstances 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:

- (i) circumstances indicating that the Respondent has registered or has acquired the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the disputed domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of the Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the disputed domain name; or
- (ii) the Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Respondent has engaged in a pattern of such conduct; or
- (iii) the Respondent has registered the disputed domain name primarily for the purpose of disrupting the business of a competitor; or
- (iv) by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on the Respondent's website or location.

The Complainant holds multiple trademark registrations for the PRIMARK mark in various jurisdictions that predate the registration of the disputed domain name.

Given that the Complainant's PRIMARK marks are widely known in many countries worldwide and the disputed domain name contains the PRIMARK in its entirety without alterations or additions, it is likely that the Respondent did not coincidentally register the disputed domain name but had knowledge of the Complainant's rights in the PRIMARK marks when registering the disputed domain name.

Based on the record in this proceeding, the Panel is satisfied that the Complainant's PRIMARK mark is well-known in many countries, including the United States of America where the Respondent appears to be located.

In addition, noting that the disputed domain name redirected to the domain aftermarket website "www.dan.com", where the disputed domain name is listed for sale at a 'buy now' price of USD 1,988, the Panel accepts the Complainant's contention that the disputed domain name was registered with the expectation of taking advantage of the reputation of the Complainant's trademark by selling the disputed domain name for commercial gain.

Furthermore, the Respondent has not replied to the Complainant's cease and desist letter and to the Complaint nor provided any evidence of actual or contemplated good faith use of the disputed domain name.

The Panel therefore finds that the circumstances, as described above, show that the Respondent's registration and offering for sale of the disputed domain name equals a bad faith registration and use of the disputed domain name and therefore the Complainant also 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, <primark.org> be transferred to the Complainant.

/Torsten Bettinger/

Torsten Bettinger

Sole Panelist

Date: October 12, 2023