

ADMINISTRATIVE PANEL DECISION

Primacarne, SL, Jorge, SL v. Paul Familiara, Innovate Strategic Resource Marketing Inc

Case No. D2023-4910

1. The Parties

The Complainants are Primacarne, SL, Jorge, SL, Spain, represented by Integra, Spain.

The Respondent is Paul Familiara, Innovate Strategic Resource Marketing Inc, New Zealand

2. The Domain Name and Registrar

The disputed domain name <primacarne.net> is registered with Wix.com Ltd. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 27, 2023. On November 27, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 29, 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 (Hidden for privacy reasons) and contact information in the Complaint. The Center sent an email communication to the Complainants on November 30, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint on December 4, 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 December 6, 2023. In accordance with the Rules, paragraph 5, the due date for Response was December 26, 2023. The Respondent did not submit any response by the due date. Accordingly, the Center notified the Respondent’s default on December 5, 2023. The Panel issued Procedural Order No. 1 on January 24, 2024, inviting the Complainants to file evidence

supporting certain contentions made in the Complaint. The Complainants responded with additional evidence on January 29, 2024. The Respondent submitted an informal Response on February 1, 2024.

The Center appointed Jeremy Speres as the sole panelist in this matter on January 15, 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 Complainants are domiciled in Spain and are part of the international Spanish meat group known as GRUPO JORGE.

The Complainants trade as, amongst others, a pork producer under the mark PRIMACARNE. Their website is located at <primacarne.com>. Complainant Jorge, SL owns European Union Trade Mark Registration No. 005325097 PRIMACARNE (stylised) in classes 29, 35, 39, and 40, having a registration date of August 14, 2007.

The disputed domain name was registered on September 23, 2021, and resolves to a website entitled “Prima Carne Philippines” for a business operating as an online meat store servicing the Philippines, offering meat sourced from various countries.

5. Parties’ Contentions

A. Complainant

The Complainants contend that they have satisfied each of the elements required under the Policy for a transfer of the disputed domain name. Notably, the Complainants contend that the Respondent has sought to impersonate the Complainants for its own commercial gain.

B. Respondent

In its informal Response, the Respondent denies that it has acted in bad faith. Notably, the Respondent contends that it selected the disputed domain name, and the name of its retail meat business in the Philippines – PRIMA CARNE – not in order to target the Complainants but because it sounds foreign and is attractive to Filipinos, and because the descriptive nature of the mark is understood by Filipinos. The Respondent also contends that it has not encountered the Complainants or any other PRIMACARNE mark in its market in the Philippines.

6. Discussion and Findings

A. Preliminary Issue – Consolidation – Multiple Complainants

The Panel notes that the Complainants are two entities within a group of related companies that have a specific common grievance. The Complainant Jorge, SL holds rights in the relevant trade mark registration, while the Complainant Primacarne, SL appears to be the trading company. As such the Complainants both have interests in the PRIMACARNE mark. It would be equitable and procedurally efficient to allow consolidation in these circumstances. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 4.11.1.

B. 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 Complainants' trademark and the disputed domain name. [WIPO Overview 3.0](#), section 1.7.

The Panel finds the Complainants have shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1. The Complainants' registered mark is recognisable within the disputed domain name. To the extent that the design element of the Complainants' mark is incapable of representation in domain names, this element is generally disregarded for purposes of assessing identity or confusing similarity. [WIPO Overview 3.0](#), section 1.10. 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 Panel finds the first element of the Policy has been established.

C. Rights or Legitimate Interests

Given the Panel's findings on bad faith, it is not necessary to consider the second element of the Policy.

D. Registered and Used in Bad Faith

The evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainants' trade mark, for the following reasons.

The Complainants state that their logo is reproduced exactly on the disputed domain name's website. The Complainants also state that there is "obvious fraud", and that the Respondent is using the Complainants' address and other content that impersonates the Complainants. The Panel can find no evidence of any of this, either in the screenshots provided by the Complainant, in the Internet Archive, or upon visiting the disputed domain name's website.

The Complainants also make much of the fact that they have been targeted, in bad faith, by numerous third parties in the past, and have succeeded in various domain name dispute forums. The Complainants state, without evidence, that the disputed domain name in this case is controlled by the same operators as in those prior cases. Again, the Panel can find no evidence of this in the record.

The Panel gave the Complainants an opportunity to comment on these issues in Procedural Order No. 1. The Complainants' response failed to address any of these issues at all, and the Panel assumes that the Complainants have thus abandoned these claims, which appear to be unsupported by any evidence in the record.

There is no evidence that the Complainants' mark is well-known in the Philippines or the Respondent's country, per the Whois record at least, of New Zealand. In response to Procedural Order No. 1, the Complainants adduced some evidence showing sales into the Philippines and New Zealand. However, the evidence for the Philippines starts in February 2021, and August 2021 for New Zealand. Given that the disputed domain name was registered in September 2021, the Complainants' evidence is far from sufficient to convince the Panel that their mark was well-known in either the Philippines or New Zealand when the Respondent registered the disputed domain name. Apart from sales in these territories for a few months prior to registration of the disputed domain name (only one month in relation to New Zealand) the Complainants have provided no other evidence showing the extent of their use and recognition of their mark in these territories. See [WIPO Overview 3.0](#), section 1.3. The Complainants have also not provided evidence sufficient for a finding that their PRIMACARNE mark is well-known in any territory at all, and the Panel's own cursory Internet searches would seem to confirm this.

The Complainants' mark is comprised of two dictionary words that are descriptive (and somewhat laudatory) of the Complainants' business. It is therefore not implausible that a trader in the same industry might adopt the same name for its semantic value, without any bad faith targeting of the Complainants. The Panel's independent searches of the TMView trade mark database show registrations incorporating PRIMA CARNE in the name of a few third parties in other jurisdictions, and the Panel's Internet searches show that there are uses of PRIMACARNE by third parties too.

The Complainants' mark is therefore not particularly inherently distinctive, and the Complainants have presented insufficient evidence showing that their mark has acquired distinctiveness or a reputation through use. In cases involving marks that are comprised of descriptive or dictionary terms which are not inherently distinctive, or which make the disputed domain name inherently attractive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning ([WIPO Overview 3.0](#), section 3.2.2).

In the circumstances, the Complainants cannot rely on a presumption of bad faith based on their mark being well-known or unique to them.

There is also no direct evidence suggesting that the Respondent was aware of or sought to target the Complainants. The disputed domain name would appear to be used for a legitimate meat (and cheese) business operating in the Philippines since 2021. Amongst others, the Respondent operates an active Facebook page showing ongoing, current trade as a meat retailer under the PRIMA CARNE mark in the Philippines. The only similarities with the Complainants are the adoption of a nearly identical mark, PRIMA CARNE, in a closely related industry. The Respondent's logo and other elements of its branding are very different to those of the Complainants, and there are no other indicia of impersonation or targeting.

The Respondent's Response does not comply with the Rules, paragraph 5(c). The Panel is, however, empowered by the Rules, paragraph 10(d), to determine the admissibility, relevance, materiality, and weight of the evidence. The Panel finds that the facts contained within the record and as independently affirmed by the Panel do not contradict the Response, which, prima facie, appears credible to the Panel, and, at the very least, equally as probable as the Complainants' version. Certainly, the Respondent's explanation as to why it chose the disputed domain name accords with the Panel's assessment of the nature of the Complainants' mark and its semantic appeal, as well as the absence of any clear indicia of targeting or impersonation. Nevertheless, the Panel notes that its view of the merits would not have been different absent the Response, thus there is no need for the Panel to rule whether the Response is to be admitted or not.

Given the available evidence, the probability that the Respondent selected the mark PRIMA CARNE for its semantic value or its inherent appeal as a brand name is at least equal to the probability that the Respondent sought to target the Complainant. Given that the burden is on the Complainants to prove their case on a balance of probabilities, the Complainants have failed to establish the third element of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Jeremy Speres/

Jeremy Speres

Sole Panelist

Date: February 2, 2024