

ADMINISTRATIVE PANEL DECISION

Black Foodie, Inc. v. Braxston Richmond, Black Chef / Black Foodie Finder Case No. D2022-3536

1. The Parties

The Complainant is Black Foodie, Inc., United States of America (“United States”), represented by Mitchell, Silberberg & Knupp, LLP, United States.

The Respondent is Braxston Richmond, Black Chef / Black Foodie Finder, United States, represented by Solace Law, United States.

2. The Domain Name and Registrar

The disputed domain name <blackfoodie.com> (the “Domain Name”) is registered with Google LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 23, 2022. On September 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 26, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name which differed from the named Respondent (Privacy Inc. Customer 7151571251) and contact information in the Complaint. The Center received the first amended Complaint on September 30, 2022. The Center sent an email communication to the Complainant on September 30, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed the second amended Complaint on the same date.

The Center verified that the Complaint together with the amended Complaints 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 October 6, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 26, 2022. The Response was filed with the Center on October 21, 2022.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on October 27, 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.

On November 1, 2022, the Complainant transmitted a Supplemental Submission to the Center, as discussed further below.

4. Factual Background

The Complainant is a Michigan corporation with its principal place of business in Detroit, Michigan, United States. The Complainant operates an online, international culinary platform featuring recipes, events, and food guides “through a black lens” at “www.blackfoodie.co” (the Complainant’s website), which states in its Terms and Conditions that it is subject to the laws of Canada. The Complainant’s website solicits donations, and it also advertises and sells some “BLACK FOODIE” branded merchandise such as T-shirts and sweaters.

The Complaint states that the “BLACK FOODIE” platform has been operating for seven years, since April 2015. The Panel notes that archived screenshots of the website are available through the Internet Archive’s Wayback Machine dated from October 2015 onward. However, the Panel notes that, according to the online database of the Michigan Secretary of State, the Complainant was incorporated on November 18, 2020. Thus, the Complainant’s website may have been operated by the Complainant prior to its incorporation or even by a predecessor that is not described in the Complaint.

The Complaint states that the Complainant’s website and “BLACK FOODIE” social media sites (with 220,000 followers) reach “millions” of entrepreneurs, home cooks, and others. The Complaint places particular emphasis on the Complainant’s videos sponsored by the Facebook / Meta Black Creator Program. The Complaint also cites (without documentation) media recognition and awards “such as *Good Morning America*, *The Daily Hive*, and the *Gothamist*”, and the BY BLACKS Social Media Influencer Award. The Complaint refers as well to participation in community and media events, festivals, and interviews, without supplying dates or citations.

The Complainant does not have a registered trademark. It has pending applications to register BLACK FOODIE as a standard character mark in the United States (Serial Numbers 90475313 and 90475356, both applications dated January 19, 2021). The application in Serial Number 90475356, for use in connection with merchandise, advertising, and events, claims first use in commerce on April 27, 2015 (the other application was made on the basis of intent to use). According to the online database of the United States Patent and Trademark Office (USPTO), both of those applications are currently suspended pending legal action, following refusals based on likelihood of confusion, the merely descriptive nature of the mark, and the identification of goods. The Complainant also has a pending application to register BLACK FOODIE as a standard character mark in Canada (Application Number 2096964, filed April 1, 2021). The online database of the Canadian Intellectual Property Office indicates that pre-assessment letters sent in 2022 commented that the goods or services as applied for were “not acceptable”.

The Registrar’s Whols database shows that the Domain Name was registered on June 17, 2009, in the name of a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Braxton Richmond, listing the organization as “Black Chef / Black Foodie Finder” with a postal address in Memphis, Tennessee, United States and a Gmail address as the contact email address. Black Foodie Finder, the organization listed by the Registrar, is Black Foodie Finder, LLC (“BFF LLC”), a director-managed Tennessee limited liability company established on May 1, 2020, according to the online database of the Tennessee Secretary of State. The Respondent Mr. Richmond is evidently the principal of the company; the Response filed by Mr. Richmond refers to BFF LLC as “his company”.

The Respondents Richmond and BF LLC have been operating a website (the “Respondent’s website”) and associated mobile app called “Black Foodie Finder” using the domain name <blackfoodiefinder.com> since 2020. The Respondent’s website features news, articles, and recipes focused on black cooking and entrepreneurs; the app provides information to users on nearby black-owned restaurants, food trucks, and eateries.

The Respondent BFF LLC applied on August 29, 2020, to register BLACK FOODIE FINDER as a United States standard character mark. That mark was registered (Trademark Number 6571099) on November 23, 2021, on the USPTO Supplemental Register, meaning that the mark was deemed descriptive but capable of acquiring secondary meaning over time. The Complainant has filed a petition with the USPTO Trademark Trial and Appeal Board (TTAB) seeking to cancel that registration.

It appears that the Respondents operate a similar website at “www.blackchef.com”. The Complaint also names “Black Chef” as a Respondent, although there is no evidence in the record that it is a legal entity. Unless noted otherwise, the Panel refers hereafter to Mr. Richmond and BFF LCC collectively as the “Respondent”.

On May 3, 2021, the Complainant’s representative sent the Respondent BFF LLC a cease-and-desist letter demanding that it cease using any confusingly similar name in connection with restaurant-related goods or services.

The Complaint attaches historical Whois records showing that a third party, Burtonworks Multimedia, held the Domain Name registration on January 18, 2022, and Wayback Machine screenshots from 2021 showing that the Domain Name resolved to a GoDaddy parking page with pay-per-click (“PPC”) advertising links and a link to inquire about purchasing the Domain Name. The domain history shows a change of registration in February 2022. By July 2022, screenshots of the website associated with the Domain Name show that visitors who interacted with the website were redirected to the Respondent’s website, which featured a “foodie directory” and encouraged visitors to download the Respondent’s mobile app.

An FAQ on the Respondent’s website explains the relationship between that website and the website associated with the Domain Name as follows, acknowledging that the Respondent acquired the Domain Name in 2022:

“Black Foodie Finder acquired BlackChef.com in 2021 and BlackFoodie.com in 2022. Both platforms operate separately, however in supportive alignment with Black Foodie Finder.”

In September 2022, when the Complaint was filed in this proceeding, the Domain Name resolved to a landing page with a “coming soon” message. At the time of this Decision, it resolves to a website similar to the Respondent’s website with culinary news and events and labelled with the Respondent’s BLACK FOOD FINDER logo.

5. Parties’ Contentions

A. Complainant

The Complainant asserts that the Domain Name is identical or confusingly similar to its unregistered BLACK FOODIE mark. The Complainant contends that the Respondent does not have permission from the Complainant to use its mark and has no rights or legitimate interests to use a confusingly similar Domain Name. The Complainant argues that the Respondent acquired the Domain Name in 2022, long after the Complainant began using the BLACK FOODIE mark, and that the Respondent Richmond was well aware of the mark, as he was registered as a follower of the Complainant’s social media.

The Complainant contends that the Respondent’s website, mobile app, and social media have offered little original content or functionality and exist only to confuse Internet users, “compete unfairly” with the

Complainant, and “steal ad revenue and partnership deals” from the Complainant.

In its supplemental filing, the Complainant protests that the Respondent has replaced its “coming soon” landing page with a full website since the Complaint was filed, “doubling down” on trademark and Policy infringement and creating greater confusion by using “Black Foodie” headers for content copied, with few changes, from other sources. The Complainant argues that the Respondent misleadingly gives the impression of a separate, long-term business use of the Domain Name that was in fact only recently “cobbled together”.

B. Respondent

The Respondent argues that neither the Complainant nor its Canadian principal, Eden Hagos, have demonstrated that they have acquired common law rights in a BLACK FOODIE trademark or service mark for purposes of the Policy or of the law of the United States or Canada. The Complaint offers only conclusory statements rather than evidence demonstrating that the term is uniquely associated with goods or services offered by the Complainant corporation. Third parties use the term “black foodie”, such as Black Foodie Friends, a merchandising company active on Instagram. The USPTO refusal to register the mark on the ground of mere descriptiveness reinforces the view that the mark has not acquired distinctiveness.

The Respondent argues that the Complainant’s website and social media serve primarily as a blog for Ms. Hagos to discuss food and events in Canada and elsewhere, while the Respondent uses the Domain Name for a website and mobile app that serve as a directory for food businesses and events, a kind of software as a service (SaaS) application. The Respondent argues that it has a legitimate interest in using the descriptive term “black foodie” for this service, as part of a “long-standing media enterprise” including the Respondent’s website and “www.blackchef.com”. “Respondent’s use does not refer to or relate to Complainant and the two brands co-exist in a wide-open genre and cultural demographic that cannot be sequestered or controlled by one party.” The Respondent argues that the parties focus on different content and are geographically separate, and each has a substantial but different audience. The Respondent states that its Instagram social media account alone has over 770,000 followers, demonstrating long-term development of its own brand and presence. The Respondent cites 2022 articles about its business in *Entrepreneur Magazine*, on *BlackNews.com*, *BlackBusiness.com*, and *Medium.com*.

The Respondent argues that it uses the term “black foodie” descriptively and in support of its own similar mark BLACK FOOD FINDER, rather than in an effort to confuse Internet users as to source or affiliation.

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”.

6.1 Preliminary Matter: Supplemental Filing

The Complainant submitted a supplemental filing in reply to the Respondent’s “fabrication of evidence and his submission of false materials”. The Complainant particularly addressed the website associated with the Domain Name, which the Respondent published after the Complaint was filed.

Neither the Rules nor the Supplemental Rules make provision for supplemental filings, except at the request of the panel (see Rules, paragraph 12). Paragraph 10 of the Rules enjoins the panel to conduct the proceeding “with due expedition”. Therefore, UDRP panels are typically reluctant to countenance delay

through additional rounds of pleading and normally accept supplemental filings only to consider material new evidence or provide a fair opportunity to respond to arguments that could not reasonably have been anticipated. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 4.6.

While much of the supplemental filing merely re-argues points made in the Complaint, the Panel accepts the supplemental submission to address the Respondent’s more recently published website associated with the Domain Name, as this would potentially reflect on the Respondent’s arguments concerning legitimate interests and bad faith.

6.2 Substantive Issues

A. Identical or Confusingly Similar

The threshold challenge for the Complainant is that it lacks a registered trademark and does not offer persuasive evidence that its claimed BLACK FOODIE mark has “become a distinctive identifier which consumers associate with the complainant’s goods and/or services”. See [WIPO Overview 3.0](#), section 1.7. The claimed mark is inherently descriptive: online dictionaries such as the Cambridge Dictionary define a “foodie” as “a person who loves food and is very interested in different types of food”. The Complainant uses the term “black foodie” in its literal sense, referring to black people who love food and are interested in talking and reading about it. The Panel notes that there are many instances of “black foodies” online in addition to the “Black Foodie Friends” site mentioned by the Respondent. “The Black Foodies” website at “[www.theblackfoodies.com](#)” highlights black-owned and -operated restaurants in the “Chicagoland area”. A culinary blog can be found at “[www.bloomingblackfoodie.com](#)”, and there is a “Black Foodies” page on the website “[www.feastdesignco.com/black-foodies](#)”. The website at “[www.blackfoodiefriday.com](#)” advertises black food events in Atlanta, Georgia. These websites typically link to social media sites as well, and there is probably more activity in this field in social media than on traditional websites. *Essence* Magazine published an article in 2020 titled, “24 Black Foodies to Follow On Instagram”. Notably, both the Complainant and the Respondent have large social media followings of “black foodies”.

In its August 6, 2022 Office Action refusing registration of the Complainant’s BLACK FOODIE mark on the ground that it is “merely descriptive”, the USPTO examiner observed that the applicant’s founder and owner is described in Toronto media as a “black foodie”, and the consumers of the Complainant’s goods or services meet the definition of “black foodies”. Citing precedents, the examiner concluded that “[a] mark that describes an intended user or group of users of a product or service is merely descriptive.”

In Policy terms, complainants must offer detailed supporting evidence to demonstrate that an unregistered mark has acquired distinctiveness and is protectable as a common law trademark or under similar legal theories:

“Relevant evidence demonstrating such acquired distinctiveness (also referred to as secondary meaning) includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys.

(Particularly with regard to brands acquiring relatively rapid recognition due to a significant Internet presence, panels have also been considering factors such as the type and scope of market activities and the nature of the complainant’s goods and/or services.)

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness/secondary meaning.”

([WIPO Overview 3.0](#), section 1.3; emphasis added.)

The Complainant here does not demonstrate historical sales and advertising of any particular goods or services under the asserted mark. The Complainant does not describe or quantify the “partnerships” or advertising arrangements to which it alludes or indicate how they are marketed under the claimed BLACK FOODIE brand. The Complainant offers little supporting documentation for its conclusory claims about the audience and media recognition for the Complainant’s website and social media sites. Importantly, the USPTO recently found that the asserted mark was not registrable because it is merely descriptive, and it appears that both United States and Canadian trademark offices found the Complainant’s attempts to identify its goods or services deficient. The Respondent itself registered a similar mark, BLACK FOODIE FINDER, but only on the USPTO Supplemental Register, presumably because that phrase is also descriptive. As noted above, the term “black foodie” is used online by many others.

On this record, the Panel finds that the Complainant has not demonstrated that the claimed mark BLACK FOODIE has acquired distinctiveness in identifying goods or services associated with the Complainant. Accordingly, the Panel concludes that the Complainant has failed to establish the first element of the Complaint.

B. Rights or Legitimate Interests

Given the Panel’s conclusion on the first element of the Complaint, it is not necessary to enter findings on the second element.

C. Registered and Used in Bad Faith

Given the Panel’s conclusion on the first element of the Complaint, it is not necessary to enter findings on the third element.

7. Decision

For the foregoing reasons, the Complaint is denied.

/W. Scott Blackmer/

W. Scott Blackmer

Sole Panelist

Date: November 10, 2022