

ADMINISTRATIVE PANEL DECISION

Compagnie Générale de Diététique v. Stephanie Luepold
(LUEPOLDS86211), The Garum Project
Case No. D2024-5042

1. The Parties

The Complainant is Compagnie Générale de Diététique, France, represented by Cabinet Lavoix, France.

The Respondent is Stephanie Luepold (LUEPOLDS86211), The Garum Project, Switzerland, represented by DTS Patent-und Rechtsanwälte PartmbB, Germany.

2. The Domain Name and Registrar

The disputed domain name <regarum.com> is registered with Ascio Technologies Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 6, 2024. On December 6, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 10, 2024, 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 (Not Disclosed) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 11, 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 December 12, 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 December 13, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 2, 2025. The Response was filed with the Center on December 23, 2024.

The Center appointed Steven A. Maier as the sole panelist in this matter on January 2, 2025. 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 company registered in France. It is a supplier of food supplements and related products.

The Complainant is the owner of trademark registrations comprising or incorporating the mark GARUM, including the following:

- France trademark registration number 1703642 for the word mark GARUM, registered on April 3, 1992, for goods and services including food supplements in International Classes 5 and 29; and

- European Union trademark registration number 018667986 for a figurative mark, comprising the name GARUM and a “fish” design upon a blue circular background (the “Figurative Mark”), registered on July 20, 2022, for goods and services including food and nutritional supplements in international Classes 1 and 5.

The disputed domain name was registered on January 16, 2024.

The disputed domain name has resolved to a website, operated by “The Garum Project”, promoting a range of food additives branded “re.garum”. The products are offered in “fish”, “veggie”, “beef”, “chicken” and “milk” varieties. The website includes the tagline: “Do you like it salty or tasty? Intensify the taste of your food in a natural way. Replace bouillon and salt with re.garum and unlock the taste components of your food.”

5. Parties’ Contentions

A. Complainant

The Complainant states that it sells products under the trademark GARUM through a website at “www.yalacta.com”. While it exhibits a printout of the relevant website, this does not appear to contain any reference to the mark GARUM. Beyond this, the Complainant does not provide any submissions or evidence concerning the use of its trademark GARUM in commerce, or that might otherwise be relevant to the reputation or recognition of that trademark.

The Complainant submits that the disputed domain name is confusingly similar to a trademark in which it has rights. It contends that the disputed domain name reproduces its GARUM trademark, and that the addition of the letters “re” does not prevent a finding of confusing similarity for the purposes of the first element under the Policy.

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the disputed domain name. It states that it has no relationship with the Respondent and has never authorized it to use its GARUM trademark, and that the Respondent is making neither bona fide commercial use nor legitimate noncommercial or fair use of the disputed domain name.

The Complainant produces evidence that, on November 15, 2023 (i.e., before the registration of the disputed domain name) it wrote to The Garum Project, demanding that it withdraw certain categories of goods from a European Union trademark application for the mark GARUM PROJECT. It states that The Garum Project did withdraw these categories, that the Respondent is the CEO and co-founder of The Garum Project, and that the Respondent was therefore aware of the Complainant’s trademark rights. The Complainant submits that, despite being aware of the Complainant’s trademark rights, the Respondent registered the disputed domain name and established a website selling products for which the Complainant’s trademarks are

registered. It contends in the circumstances that the Respondent's use of the disputed domain name is intended to divert Internet users potentially interested in the Complainant's products to the Respondent's website. The Complainant submits that such activity cannot amount to a bona fide offering of goods or services.

The Complainant submits that the disputed domain name was registered and is being used in bad faith. It states that the disputed domain name was registered some 33 years after the Complainant's first trademark filing, and that it has established that the Respondent was fully aware of the Complainant's trademark rights when it registered the disputed domain name. The Complainant submits, therefore, that the Respondent registered the disputed domain name in order to target the Complainant's trademark for commercial gain, and that it has used the disputed domain name to sell goods competing with those for which the Complainant's trademarks are registered.

The Complainant requests the transfer of the disputed domain name.

B. Respondent

The Respondent submits that the underlying respondent in the proceeding is The Garum Project.

The Respondent denies that the Complainant's GARUM trademark is widely known. It submits that the only marketing to include that trademark is for the Complainant's product "Stabilium 200", and that only more recent images of the packaging for that product include the Figurative Mark.

The Respondent submits that "garum" is a fermented fish sauce that has played a role in cuisine since Roman times. It contends that the term is used by numerous other businesses, both with and without additional elements, a number of which have been registered as trademarks.

The Respondent submits that The Garum Project represents a new way of thinking about garum, promoting its return to the kitchen as an ingredient. It states that it chose the name "re.garum" deliberately, to emphasise the concepts of rebirth or reimagination associated with the prefix "re".

The Respondent submits that it is the owner of European Union trademark registration number 018940401 for a figurative mark GARUM PROJECT, registered on February 3, 2024 (with a filing date of October 22, 2023) in International Classes 29 and 30. It also refers to a pending application for a European Union trademark for a figurative mark RE.GARUM, with an application date of March 26, 2024.

The Respondent submits that its website and other activities, prior to the Complainant's objection, provide credible evidence of bona fide preparations to use the disputed domain name, and contradict any suggestion of cybersquatting. It exhibits evidence of media coverage concerning The Garum Project dating from November 2023, and evidence that it secured a "CEFood Cycle" award for the South Tyrol region, at which its founders and its products were presented.

The Respondent denies that it is registered or has used the disputed domain name in bad faith and contends that none of the circumstances envisaged by paragraph 4(b) of the Policy are present. It reiterates that the term "garum" refers to a food product that is 2,000 years old, that the Complainant is not the exclusive user of that name, and that the Complainant only uses the term as a "sub-brand" in any event.

6. Discussion and Findings

In order to succeed in the Complaint, the Complainant is required to show that all three of the elements set out under paragraph 4(a) of the Policy are present. Those elements are 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 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 established that it is the owner of registered trademark rights in the mark GARUM. The disputed domain name wholly incorporates that mark, together with the letters “re” by way of prefix, which do not prevent the Complainant’s trademark from being recognizable within the disputed domain name. The Panel therefore finds that the disputed domain name is confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The Panel finds that the Respondent’s submissions in the proceeding, and the content of its website, give rise to a prima facie case that the Respondent is operating a bona fide business selling food additive products based on the dictionary term “garum”. In order to displace the Respondent’s case, it is necessary for the Complainant to establish that the Respondent is not operating a bona fide business by reference to the disputed domain name but has in fact established its business and/or website as a sham or pretext for targeting the Complainant’s trademark rights.

The Panel finds the name “garum” to be a dictionary term, and notes that the Oxford English Dictionary defines the word as “A sauce prepared from fermented fish, much used by the ancient Romans; in 16th and 17th centuries recommended (after classical writers) as a remedy...”¹ The Panel has also conducted a Google search against the term “garum”, the first several pages of results referring extensively to the dictionary meaning of the term and making no reference to the Complainant. In addition, a search of the WIPO Global Brands Database against the mark GARUM confirms the Respondent’s submission that the mark is registered by a number of businesses other than the Complainant, both on its own and in combination with other terms.

In the view of the Panel, the Complainant has failed in the circumstances to establish that the disputed domain name was registered or has been used to target its trademark. The Complainant does not argue that the Respondent’s website or business are a sham, but rather that they infringe the Complainant’s trademark rights in its GARUM trademarks. However, the UDRP is directed principally to cases of cybersquatting, and is not an appropriate forum for the resolution of trademark disputes between competing businesses. The Complainant provides no evidence of its own use or the reputation of its GARUM trademark, and based on the Respondent’s evidence of the Complainant’s minimal use of that trademark, and the Respondent’s use of the disputed domain name to reflect a renewed focus on the culinary product of that name, the Panel finds there to be no evidence on which to conclude that the Respondent registered the disputed domain name in order to target the Complainant’s trademark rights.

The Complainant has therefore failed to establish that the Respondent has no rights or legitimate interest in respect of the disputed domain name, and the Complaint must necessarily fail.

C. Registered and Used in Bad Faith

While the Panel’s findings in respect of the second element, above, are sufficient to dispose of the case, the Panel comments that, for similar reasons as set out above, it finds no evidence upon which to conclude that the Respondent either registered or has used the disputed domain name in bad faith.

¹ As noted in section 4.8 of WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), it has been accepted that a panel may undertake limited factual research into matters of public record if it would consider such information useful to assessing the case merits and reaching a decision.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Steven A. Maier/

Steven A. Maier

Sole Panelist

Date: January 15, 2025