

ADMINISTRATIVE PANEL DECISION

PRIMECAP Management Company v. Name Redacted
Case No. D2025-0252

1. The Parties

Complainant is PRIMECAP Management Company, United States of America (“United States” or “U.S.”), represented by Byron Raphael LLP, United States.

Respondent is Name Redacted¹.

2. The Domain Name and Registrar

The disputed domain name <primecap-management.com> (the “Domain Name”) is registered with IONOS SE (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 22, 2025. On January 23, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On January 24, 2024, 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 (CA, US, Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to Complainant on January 24, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on January 25, 2025.

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

¹ Respondent appears to have used the name of the Chief Compliance Officer of Complainant when registering the disputed domain name. In light of the potential identity theft, the Panel has redacted Respondent’s name from this decision. However, the Panel has attached as Annex 1 to this decision an instruction to the Registrar regarding transfer of the disputed domain names, which includes the name of Respondent. The Panel has authorized the Center to transmit Annex 1 to the Registrar as part of the order in this proceeding, and has indicated Annex 1 to this decision shall not be published due to the exceptional circumstances of this case. See *Banco Bradesco S.A. v. FAST-12785241 Attn. Bradescourgente.net / Name Redacted*, WIPO Case No. [D2009-1788](#)

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 Respondent of the Complaint, and the proceedings commenced on January 27, 2025. In accordance with the Rules, paragraph 5, the due date for Response was February 16, 2025. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on February 17, 2025.

The Center appointed John C. McElwaine as the sole panelist in this matter on February 24, 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

Complainant is a financial services company providing investment management services.

Complainant owns the following relevant trademark registrations:

- PRIMECAP, U.S. Reg. No. 2,965,219, registered on July 5, 2005, for financial services in Class 36;
- PRIMECAP ODYSSEY, U.S. Reg. No. 3,021,583, registered on November 29, 2005, for financial services in Class 36; and
- PRIMECAP ODYSSEY FUNDS, U.S. Reg. No. 2,984,864, registered on August 16, 2005, for financial services in Class 36.

The Domain Name was registered on December 29, 2024. The Domain Name does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

With respect to the first element of the Policy, Complainant asserts ownership of U.S. trademark registrations containing the PRIMECAP mark and multiple state registrations. Complainant also alleges that it has gained significant common law rights in the mark PRIMECAP through use, advertisement, and promotion of such marks in connection with its financial services. Collectively, these registered and common law rights are referred to as the “PRIMECAP Mark”. Complainant asserts that the Domain Name contains Complainant’s mark PRIMECAP Mark in its entirety and adds the suffix “management”, which is a descriptive term.

With respect to the second element of the Policy, Complainant alleges that Respondent has no rights or legitimate interests in the Domain Name. Complainant contends it has not licensed or authorized Respondent to use its marks. The Whois database does not reflect that Respondent is commonly known by the Domain Name. Additionally, Respondent’s passive holding of the Domain Name does not confer any rights or legitimate interests.

With respect to the third element of the Policy, Complainant asserts bad faith registration and use based on multiple factors. First, Complainant points out that Respondent fraudulently registered the Domain Name using the name and address of Complainant’s Chief Compliance Officer. Second, Complainant contends that its use of the PRIMECAP Mark for 20 years establishes that Respondent must have known of

Complainant and its PRIMECAP Mark. Lastly, Complainant asserts that Respondent used a privacy service to hide its identity, creating a presumption of bad faith.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

Even though Respondent has defaulted, paragraph 4(a) of the Policy requires that, in order to succeed in this UDRP proceeding, Complainant must still prove its assertions with evidence demonstrating:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) 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.

Because of Respondent's default, the Panel may accept as true the reasonable factual allegations stated within the Complaint and may draw appropriate inferences therefrom. See *St. Tropez Acquisition Co. Limited v. AnonymousSpeech LLC and Global House Inc.*, WIPO Case No. [D2009-1779](#); *Bjorn Kassoe Andersen v. Direction International*, WIPO Case No. [D2007-0605](#); see also paragraph 5(f) of the Rules ("If a Respondent does not submit a response, in the absence of exceptional circumstances, the Panel shall decide the dispute based upon the complaint"). Having considered the Complaint, the Policy, the Rules, the Supplemental Rules, and applicable principles of law, the Panel's findings on each of the above-cited elements are as follows.

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 Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7. Ownership of a trademark registration is generally sufficient evidence that a complainant has the requisite rights in a mark for purposes of paragraph 4(a)(i) of the Policy. [WIPO Overview 3.0](#), section 1.2. Here, the Panel finds that Complainant has established trademark rights in the PRIMECAP Mark by virtue of its multiple United States trademark registrations containing PRIMECAP.

As stated in section 1.8 of the [WIPO Overview 3.0](#), where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) does not prevent a finding of confusing similarity under the first element. The Panel finds the PRIMECAP trademark is recognizable within the Domain Name incorporating Complainant's PRIMECAP Mark in its entirety, with the addition of the term "management". Accordingly, the Domain Name is confusingly similar to Complainant's mark for the purposes of the Policy.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Complainant must make a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name, after which the burden of production shifts to Respondent to come forward with relevant evidence demonstrating rights or legitimate interests. See section 2.1 of the [WIPO Overview 3.0](#).

Here, Complainant has stated that it has not licensed or otherwise authorized Respondent to use its PRIMECAP Mark or to register domain names incorporating the mark. There is no evidence that Respondent has been commonly known by the Domain Name or that Respondent has acquired any trademark rights in the term "primecap". Respondent has not come forward with an explanation for choosing the Domain Name which consists of Complainant's well-known PRIMECAP Mark.

Having reviewed the available record, the Panel finds Complainant has established a prima facie case that Respondent lacks rights or legitimate interests in the Domain Name. Respondent has not rebutted Complainant's prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the Domain Name such as those enumerated in the Policy² or otherwise.

The Panel finds that Respondent's use of the Domain Name to resolve to a page empty of any content does not constitute a bona fide offering of goods or services or a legitimate noncommercial or fair use under the Policy. In this case, while no website resolves from the Domain Name, the potential for future use that infringes on Complainant's rights or could be used for fraud is evident. Of particular concern is the fact that Respondent registered the Domain Name using the name and address of an officer of Complainant. Respondent could have come forward with an explanation for its actions but did not.

The silence of a respondent may support a finding that it has no rights or legitimate interests in respect of the domain name. See *Alcoholics Anonymous World Services, Inc., v. Lauren Raymond*, WIPO Case No. D2000-0007; *Ronson Plc v. Unimetal Sanayi ve Tic.A.S.*, WIPO Case No. [D2000-0011](#). Additionally, previous UDRP panels have found that when respondents have not availed themselves of their rights to respond to complainant, it can be assumed in appropriate circumstances that respondents have no rights or legitimate interests in the domain name at issue. See *AREVA v. St. James Robyn Limoges*, WIPO Case No. D2010-1017; *Nordstrom, Inc. and NIHC, Inc. v. Inkyu Kim*, WIPO Case No. [D2003-0269](#).

Lastly, the Panel finds that Respondent is not making *any use*, let alone bona fide use, of the Domain Name under paragraph 4(c), as the Domain Name resolves to an inactive webpage. It is well established that inaction or passive holding can, in certain circumstances, constitute bad faith use. See *CBS Broadcasting Inc. v. Edward Enterprises*, WIPO Case No. [D2000-0242](#). Here, with no explanation from Respondent concerning its intent, and its use of false contact information, Respondent's passive holding of the Domain Name incorporating the PRIMECAP Mark does not amount to a bona fide use.

Based on the foregoing, Complainant has made a prima facie showing of Respondent's lack of any right or legitimate interest and Respondent has failed to come forward with evidence to rebut that showing. As provided for by paragraph 14 of the Rules, the Panel may draw such inference from Respondent's default as it considers appropriate. The Panel finds that Respondent does not have rights or legitimate interests in the Domain Name and that Complainant has met its burden under paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Under paragraph 4(a)(iii) of the Policy, Complainant must show that Respondent registered and is using the Domain Name in bad faith. A non-exhaustive list of factors constituting bad faith registration and use is set out in paragraph 4(b) of the Policy.

Bad faith registration can be found where a respondent "knew or should have known" of a complainant's trademark rights and nevertheless registered a domain name in which it had no right or legitimate interest.

² The Policy, paragraph 4(c), provides a non-exhaustive list of circumstances in which a respondent could demonstrate rights or legitimate interests in a contested domain name: "(i) before any notice to you 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 (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 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."

See *Accor v. Kristen Hoerl*, WIPO Case No. [D2007-1722](#). Based on Complainant's submissions, which were not rebutted by Respondent, Respondent must have known or had constructive notice of Complainant's PRIMECAP Mark when Respondent registered the Domain Name. Furthermore, and as also detailed above, Respondent is not commonly known by the Domain Name and does not have any legitimate interest in the Domain Name. Accordingly, on the record, there is no explanation or legitimate interest to justify Respondent's choice to register the Domain Name. With no response from Respondent, this claim is undisputed, and the Panel can infer bad faith, particularly in light of the other elements of bad faith discussed below.

Furthermore, the fact that the Domain Name does not resolve to a website and is being passively held does not obviate a finding of bad faith. When a domain name is being passively held, the question of bad faith use does not squarely fall under one of the aforementioned non-exhaustive factors set out in paragraph 4(b) of the Policy. Section 3.3 of the [WIPO Overview 3.0](#) instructs that panelists should examine the totality of the circumstances in each case and that the following factors that have been considered relevant in applying the passive holding doctrine: "(i) the degree of distinctiveness or reputation of the complainant's mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, (iii) the respondent's concealing its identity or use of false contact details (noted to be in breach of its registration agreement), and (iv) the implausibility of any good faith use to which the domain name may be put." *Id.*

Complainant submitted evidence that the PRIMECAP Mark has been registered for more than 20 years and that Respondent likely targeted Complainant's reputation. Respondent has not offered any evidence to rebut these assertions. Furthermore, by virtue of its failure to respond to the Complaint, Respondent provided no evidence of its intended use of the Domain Name. In fact, Respondent is not using the Domain Name in any manner to demonstrate a bona fide use or potential use. In addition, Respondent concealed its true identity by using false contact information. Lastly, with no response to explain its choice of word "management" in the Domain Name, it is apparent that Respondent sought to imply an affiliation with Complainant which was not true. In light of these factors, the Panel finds that Respondent's passive holding of the Domain Name satisfies the requirement of paragraph 4(a)(iii) of the Policy that the Domain Name was registered and is being used in bad faith by Respondent.

For the reasons set forth above, the Panel holds that Complainant has met its burden under paragraph 4(a)(iii) of the Policy and has established that Respondent registered and is using the Domain Name in bad faith.

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 Domain Name <primecap-management.com> be transferred to Complainant.

/John C McElwaine/

John C McElwaine

Sole Panelist

Date: March 10, 2025