

## **ADMINISTRATIVE PANEL DECISION**

### **PRIMECAP Management Company v. Orlando Maroko, Orlando LTD Case No. D2025-1449**

#### **1. The Parties**

The Complainant is PRIMECAP Management Company, United States of America ("United States"), represented by Byron Raphael LLP, United States.

The Respondent is Orlando Maroko, Orlando LTD, United Kingdom.

#### **2. The Domain Name and Registrar**

The disputed domain name <primecapglobal.com> (the "Disputed Domain Name") is registered with NameCheap, Inc. (the "Registrar").

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on April 9, 2025. On April 9, 2025, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On April 9, 2025, 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 April 10, 2025, 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 April 11, 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 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 April 15, 2025. In accordance with the Rules, paragraph 5, the due date for Response was May 5, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on May 6, 2025.

The Center appointed Nicholas Weston as the sole panelist in this matter on May 12, 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 incorporated in the United States that operates an investment management business with approximately USD 136.7 billion under management through its funds. The Complainant cites its registrations for the trademark PRIMECAP and variations of it in the United States, including, for example, United States trademark No. 2,965,219 for the mark PRIMECAP registered on July 5, 2005; United States registration No. 3,021,583 for the mark PRIMECAP ODYSSEY registered on November 29, 2005; and United States registration No. 2,984,864 for the mark PRIMECAP ODYSSEY FUNDS registered on August 16, 2005.

The Complainant owns the domain name <primecap.com>, which hosts its main website.

The Disputed Domain Name was registered on March 17, 2025, and is used to host an unauthorized financial services website.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the Disputed Domain Name.

Notably, the Complainant cites its trademark registrations in the United States for the trademark PRIMECAP, as prima facie evidence of ownership.

The Complainant submits that its rights in the mark PRIMECAP predate the Respondent's registration of the Disputed Domain Name. It submits that the Disputed Domain Name is confusingly similar to its trademark, because the Disputed Domain Name is comprised of the dominant part of the PRIMECAP trademark and that the addition of the word "global" and the TLD "com" is not sufficient to avoid the confusing similarity.

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name because "[b]ecause Complainant owns the PRIMECAP mark for financial services and has not licensed or otherwise authorized Respondent to use any domain name incorporating the PRIMECAP mark, Respondent has no rights or legitimate interests with respect to the [Disputed D]omain [N]ame" and infers that none of the circumstances set out in paragraph 4(c) of the Policy apply.

Finally, the Complainant alleges that the registration and use of the Disputed Domain Name was, and currently is, in bad faith, contrary to the Policy and the Rules having regard to evidence that points to knowledge of the Complainant and its trademarks, and, it submits that "[the] Respondent's bad faith registration and use are further demonstrated by the fact that it used the [D]isputed [D]omain [N]ame for an unlicensed and anonymous financial services company".

##### **B. Respondent**

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

#### **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, the Complainant has the burden of proving the following:

- (i) that the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and

(iii) that the Disputed Domain Name has been registered and is being used in bad faith.

### **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 the 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.

The Panel finds that the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. The requirements of the first element for purposes of the Policy may be satisfied by a trademark registered in any country. [WIPO Overview 3.0](#), section 1.2.1. The Complainant has produced sufficient evidence to demonstrate that it has registered trademark rights in the mark PRIMECAP.

Turning to whether the Disputed Domain Name is identical or confusingly similar to the PRIMECAP trademark, the Panel observes that the Disputed Domain Name is comprised of: (a) an exact reproduction of the Complainant's trademark PRIMECAP; (b) followed by the word "global"; (c) followed by the TLD ".com".

It is well established that the gTLD used as part of a domain name is generally disregarded under the first element confusing similarity test. [WIPO Overview 3.0](#), section 1.11. The relevant comparison to be made is with the second-level portion of the Disputed Domain Name, specifically: "primecapglobal".

The Panel finds the mark is recognizable within the Disputed Domain Name. Accordingly, the Panel finds that 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.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, 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 (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

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

The Panel notes that the Complainant has not licensed or otherwise authorized the Respondent to use its trademarks and that there is no relationship between the Complainant and the Respondent, let alone any accurate or prominent disclosure of that relationship, or absence of such, on its website. The use of the Complainant's trademark on the Respondent's website suggests either that the Respondent is actually aware of the Complainant's trademark, or that the Respondent is taking an unfair advantage of the mark PRIMECAP to make available its competing, albeit unlicensed, financial services. The Panel finds that the Respondent's activities do not represent a bona fide offering of goods or services, or a legitimate

noncommercial or fair use, given the substantial reputation and goodwill of the Complainant's mark or capacity to otherwise mislead Internet users.

Panels have held that the use of a domain name for illegal activity such as passing off, or other types of fraud, can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent's registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

In the present case, the Panel finds that the evidence in the case shows the Respondent registered and has used the Disputed Domain Name in bad faith.

On the issue of registration, taking into account the composition of the Disputed Domain Name and the Complainant's distinctive trademark, the Panel is satisfied that the Respondent deliberately targeted the Complainant's trademark PRIMECAP when it registered the Disputed Domain Name.

This Panel finds that there is no reason for the Respondent to have registered the Disputed Domain Name other than to trade off the reputation and goodwill of the Complainant's trademark. [WIPO Overview 3.0](#), section 3.1.4.

On the issue of use, the Complainant's evidence is that the Disputed Domain Name was used to host a website that appeared to compete with the Complainant's legitimate website.

Panels have held that the use of a domain name for unlawful activity here, attempted passing off, constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the Disputed Domain Name constitutes bad faith under the Policy.

The Panel finds that the Complainant has 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 <primecapglobal.com> be transferred to the Complainant.

*/Nicholas Weston/*

**Nicholas Weston**

Sole Panelist

Date: May 21, 2025