

ADMINISTRATIVE PANEL DECISION

Paladin Labs, Inc. v. Giovanni Cagnoli, PALADIN PHARMA SPA
Case No. D2024-1044

1. The Parties

The Complainant is Paladin Labs, Inc., Canada, represented by Cozen O'Connor, United States of America.

The Respondent is Giovanni Cagnoli, PALADIN PHARMA SPA, Italy.

2. The Domain Name and Registrar

The disputed domain name <paladinpharma.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on March 8, 2024. On March 11, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 11, 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 (Unknown Registrant) and contact information in the Complaint. The Center sent an email communication to the Complainant on March 12, 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 March 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 March 21, 2024. In accordance with the Rules, paragraph 5, the due date for Response was April 10, 2024. The Respondent sent informal email communications to the Center on March 15, and March 19, 2024. Accordingly, the Center informed the Parties of its commencement of Panel appointment process on April 14, 2024.

The Center appointed Andrew D. S. Lothian as the sole panelist in this matter on April 17, 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

Established in 1983, the Complainant is a pharmaceutical company focused on acquiring or licensing emerging pharmaceuticals. The Complainant claims unregistered trademark rights in the word and device mark PALADIN. The Complainant claims, but does not evidence, that it has been using such mark since 1990. The Complainant is the owner of the domain name <paladin-labs.com>. It states that it uses said domain name for its official website. The Panel notes that the said domain name was registered on February 10, 1999.¹

The Complainant illustrates the use of its alleged unregistered mark by way of various screenshots of its website at “www.paladin-labs.com”. One such screenshot shows press releases dating back to 2013 suggesting that the Complainant may have referred to itself as “Paladin” and/or “Paladin Labs” since at least that date. Another such screenshot provides a list of “Key products”. None of these bear the name “Paladin”.

The disputed domain name was registered on November 15, 2019. According to a screenshot produced by the Complainant dated March 8, 2024, the disputed domain name pointed at that time to a Registrar-provided parking page featuring linked advertisements for “Pharmaceutical Company”, “Pharma Companies”, and “Pharma Company”. When the Panel visited said website on April 19, 2024, it was still pointing to a Registrar-provided parking page, but this did not contain linked advertisements, and instead promoted the Registrar’s business.

The Respondent did not file a formal Response and did not participate directly in the administrative proceeding. Following the Registrar’s verification, the Whois record for the disputed domain name lists the Registrant Organization as “PALADIN PHARMA SPA” (capitalized as such in the record itself) having an address in Turin, Italy. The listed registrant email address uses the domain name <paladinpharma.it>. Two informal communications received by the Center, apparently on behalf of the Respondent, appear to emanate from a company named “Paladin Pharma SpA”, i.e., an Italian società per azioni or joint-stock company.

Modest research by the Panel via the “find a company” facility on the European E-Justice Portal at “e-justice.europa.eu” indicates that Paladin Pharma SpA is an economically active entity which has filed financial statements dating back to at least December 31, 1993, and which has a registered office address matching the address on the Whois details revealed by the Registrar’s verification. What appears to the Panel to be the principal domain name of said company, <paladinpharma.it>, as also used for the registrant email address for the disputed domain name, was registered on July 14, 2009, according to the related Whois record.

¹The Complainant referred to this domain name in the Complaint but did not provide a Whois lookup. The Panel therefore checked the Whois record itself in order to ascertain the registration date. As noted later in this decision, the Panel conducted certain other research from public sources on the strength of the content in the Whois record of the disputed domain name and the Respondent’s informal communications. On the topic of a panel conducting such independent research of publicly available sources, see section 4.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”). The Panel decided not to put its findings to the Parties as this would unduly delay the proceeding, and the information concerned was already available to the Complainant via the Whois record of the disputed domain name (if used in a search in the appropriate public register) and was likewise known to the Respondent because it relates to the Respondent’s business.

The Panel has viewed the live website at “www.paladinpharma.it”, which features both English and Italian language versions. The English language version states, “For over 30 years, Paladin Pharma has supported its clients’ well-being with dietary supplements, medical devices, and cosmetics, all formulated in Italy”. The website provides full details of said company’s registration and VAT numbers, address in Turin, Italy, and share capital of EUR 346,000. It also notes that the company is part of the Gruppo Carisma, a holding group said to own more than 20 organizations in many fields, such as food, real estate, and sportswear, which is claimed to produce revenue of around EUR 500 million annually and has a complement of more than 1,500 employees. The latter’s website is found, by way of a hyperlink on said website, at “www.holdingcarisma.it”. It appears to be based in Milan, Italy.

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 contends that it possesses unregistered trademarks in the PALADIN word and device marks through use, advertisement and promotion in connection with its pharmaceutical services and marketing services for third parties. It goes on to assert that the disputed domain name incorporates such mark as the leading element, together with a “pharma” element which it submits is a generic term lacking any distinctive qualities but which increases the likelihood of confusion as consumers may believe that the disputed domain name leads to an official website of the Complainant when it does not.

The Complainant asserts that the Respondent is not affiliated with the Complainant, and that there is no evidence that the Respondent has registered the disputed domain name to advance legitimate interests or for the bona fide offering of legitimate goods or services. The Complainant contends that the Respondent has registered the disputed domain name anonymously to avoid the consequences of registering a domain name for which it has no rights or legitimate interests, adding that the Respondent is Giovanni Cagnoli and is not commonly known as “Paladin”, that there is no evidence connecting the Respondent and the disputed domain name, that the Complainant has not authorized, licensed or endorsed the Respondent’s use of the disputed domain name, and that there is no content posted on the associated website. The Complainant submits that the entirety of the evidence demonstrates that the Respondent registered the disputed domain name illegitimately in an apparent attempt to syphon off the Complainant’s goodwill in its mark.

The Complainant asserts that the disputed domain name was registered and is being used in bad faith, and that the Respondent has attempted to take commercial advantage of the Complainant’s mark and reputation to trade off the Complainant’s goodwill. The Complainant submits that the Respondent had the Complainant in mind when it registered the disputed domain name long after the Complainant began use of the PALADIN mark. The Complainant contends that the use of the “pharma” descriptor in the disputed domain name suggests that the Respondent plans to use the disputed domain name in a website or as an email address to mislead consumers fraudulently into believing that it is an official domain name of the Complainant or to obtain confidential information illegally. The Complainant notes that the Respondent concealed its identity via a privacy service, asserting that this supports an inference of registration and use in bad faith. The Complainant concludes that given the degree of distinctiveness and reputation of its PALADIN mark, the concealment of the Respondent’s identity, and the implausibility of any good faith motivation on the Respondent’s part, the registration and use of the disputed domain name was and is in bad faith in contravention of the Policy.

B. Respondent

The Respondent did not reply formally to the Complainant’s contentions. However, as noted above, the Respondent issued two informal communications to the Center from an email address associated with the domain name <paladinpharma.it>. Each of these emails contained a signature line consisting of [name

redacted by the Panel], Marketing Manager, Paladin Pharma Spa, [telephone number with Italian international dialling code], [fax number with said code], personal and role-based email addresses at the domain name <paladinpharma.it> and website address at “www.paladinpharma.it”. The first of these communications stated that the sender did not understand the dispute. The second stated, “Good morning, the name of the company I work for is Paladin Pharma Spa. It seems more than consistent to me that the domain name of our company is <paladinpharma.com>. / We already own the domain paladinpharma.com as we operate in Italy but export worldwide. / I don't see how we can compete with Paladin Labs”.

6. Discussion and Findings

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 3.0](#), section 1.7.

Here, the Complainant seeks to establish for Policy purposes that it possesses unregistered trademark rights in the term “Paladin”, which is said to have been first used in 1990. The problem for the Complainant is that it has produced insufficient evidence to establish such mark for such purposes. The only relevant evidence before the Panel is the Complainant's domain name, and several screenshots of its website. These alone do not show that the mark has become a distinctive identifier which consumers associate with the complainant's goods and/or services. [WIPO Overview 3.0](#), section 1.3.

The said section notes that relevant evidence demonstrating a claimed mark's 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.

The said section also notes that specific evidence supporting assertions of acquired distinctiveness should be included in the complaint, and that conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning.

Here, the screenshots of the Complainant's website amount to self-generated material which does not serve to show whether consumers associate the alleged mark with the Complainant's goods and services. The Complainant's contention that it has been using the mark since 1990 is unsupported by any evidence (albeit that it appears to use the term “Paladin” in press releases dating back to 2013). Although the Complainant's domain name incorporating said mark has been in existence since 1999, the Complainant produced no evidence showing that it is the original registrant of such domain name and/or how it has been used, and more importantly, recognized by consumers, industry or media over the years.

There is limited evidence arising from the Respondent's website content (namely, the Registrar's advertising) that might have suggested that the Respondent is targeting the Complainant's rights. Such content can, in appropriate cases, support an assertion that the Complainant's mark has achieved significance as a source identifier. [WIPO Overview 3.0](#), section 1.15. However, in light of the Panel's assessment on the second and third elements of the Policy set out below, the Panel does not consider that the Respondent was in fact targeting the Complainant or its rights, so the point is moot.

The Panel finds the first element of the Policy has not been established. The Panel notes the longstanding use of the mark and domain name and imagines that if a better evidentiary record were presented by the Complainant, it might well satisfy this element; the Panel will therefore review the second and third elements of the Policy in brief for completeness.

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.

The Panel finds that the Respondent has been commonly known by a name corresponding to the disputed domain name. [WIPO Overview 3.0](#), section 2.3.

The Panel's modest review of publicly available sources, conducted on the basis of the Respondent's details as disclosed by the Registrar's verification and informal emails from the Respondent, indicates that the disputed domain name corresponds to the name of a business in Italy which appears to have its origins in the early 1990s. Its corresponding domain name, which it uses for its website, and which was listed in the Whois for the disputed domain name, was registered in 2009. There is nothing before the Panel that indicates that this business is not a legitimate, economically active entity, and/or that it is a pretext for cybersquatting. The name of the business, and its corresponding principal domain name, match the disputed domain name in material respects.

The elements of the Respondent's business name are "paladin" and "pharma". "Paladin" is a dictionary word with its origins from French and Italian, which can be used to denote a determined advocate or defender of a noble cause. "Pharma" is a descriptive term which is an abbreviation of "pharmaceutical," and is therefore often used in association with pharmaceutical companies. Given these facts, while the combination might be said to be unusual, it is conceivable that the fact that the Respondent's choice of name partially matches that of the Complainant is a coincidence. The Complainant's assertions, and the online evidence concerning the Respondent, suggest that each was founded in the early 1990s, before the modern commercial Internet age, and therefore that they were potentially unaware of one another until the registration of the disputed domain name.

According to the informal communications from a representative of the Respondent, the Respondent registered the disputed domain name for use in connection with its export business. Given the nature of the business described on the website at "www.paladinpharma.it", this strikes the Panel as reasonably plausible.

The Panel finds the second element of the Policy has not 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.

In the present case, the Panel notes that the Respondent appears to operate a legitimate business under a name corresponding to the disputed domain name, and that it does not appear to have set out to target any rights of the Complainant (such rights in any event not having been established in this administrative proceeding). The Complainant has not demonstrated that the Respondent registered the disputed domain name with the Complainant in mind or with intent to target it.

The Panel has identified evidence of contemplated good faith use on the Respondent's part. That said, if advertising provided by the Registrar on the parked page associated with the disputed domain name is causing issues for the Complainant, the Respondent would be well-advised to suppress this, or otherwise to point the disputed domain name to the Respondent's existing online content.

The extent to whether the Parties might or might not be able to lawfully coexist is a matter beyond the scope of the administrative proceeding. However, given the similarity in their respective names and the nature of their respective businesses, it is possible that the Parties might wish to enter into discussions regarding such potential coexistence.

The Panel finds the third element of the Policy has not been established.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Policy provides that, if after considering the submissions, the Panel finds that the Complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or to harass the domain-name holder, the Panel shall declare in its decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. The mere lack of success of the complaint is not, on its own, sufficient to constitute reverse domain name hijacking. [WIPO Overview 3.0](#), section 4.16.

The Panel wishes to record its concerns that the Complainant made serious allegations of bad faith against the Respondent, including asserting that the Respondent registered the disputed domain name for fraudulent purposes, when information was available to it suggesting that such allegations were not warranted. The Complainant made these allegations without fully investigating the details supplied to it following Registrar verification.

Notably, the available information included the Respondent's organization name and its principal domain name. These details should have led the Complainant to the Respondent's business, from which a good faith motivation for registering the disputed domain name might reasonably have been inferred. It would also have been open to the Complainant to reach out to the Respondent in order to discuss matters before filing the present Complaint. Nevertheless, despite the presence of clear evidence to the contrary in the Whois record itself, the Complainant asserted that "[...] there is no evidence connecting the Respondent and the disputed domain name", and that "[...] there is no evidence that the Respondent has registered the disputed domain name to advance legitimate interests or for the bona fide offering of legitimate goods or services".

While it is a close call in the present case, the Panel has determined that the Complainant's conduct (or more particularly, that of its representative) does not amount to Reverse Domain Name Hijacking, for the reason that the Registrar's advertising on the disputed domain name as demonstrated in the Complainant's screenshot might reasonably have led to the conclusion that the Respondent was targeting the Complainant. Given this fact, it is possible that the details on the Whois record might have been pretextual, such that the Complainant did not require to research the Respondent's identity any further than it did.

Nevertheless, this case illustrates the importance for complainants to conduct a comprehensive reinvestigation of the facts and circumstances that have given rise to their complaint once the respondent's underlying details are revealed.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Andrew D. S. Lothian/

Andrew D. S. Lothian

Sole Panelist

Date: May 1, 2024