

ADMINISTRATIVE PANEL DECISION

PHARMANUTRA S.P.A. v. Domain Administrator, DomainMarket.com
Case No. D2024-4579

1. The Parties

The Complainant is PHARMANUTRA S.P.A., Italy, represented by HOFFMAN Law Firm, Italy.

The Respondent is Domain Administrator, DomainMarket.com, United States of America (“United States”), represented by Brian H. Leventhal, United States.

2. The Domain Name and Registrar

The disputed domain name <pharmanutra.com> is registered with eNom, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 7, 2024. On November 7, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 8, 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 (eNom, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on November 8, 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 November 11, 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 November 15, 2024. In accordance with the Rules, paragraph 5, the due date for Response was December 5, 2024 and was further extended to December 9, 2024 upon the Respondent’s request in accordance with paragraph 5(b) of the Rules. The Response was filed with the Center on December 9, 2024.

The Center appointed Adam Taylor as the sole panelist in this matter on December 18, 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

The Complainant, which describes itself as “an Italian nutraceutical and pharmaceutical company”, has traded under the mark PHARMANUTRA in Italy since 2003, and abroad from 2013.

The Complainant was first listed on the Italian Stock Exchange in 2017 and it opened a new headquarters building in 2023. Currently, the Complainant is active in 89 countries worldwide, distributing and selling its products to pharmacies through sales representatives and distributors/wholesalers.

The Complainant owns a number of registered trade marks for PHARMANUTRA including Italian trade mark No. 0001457591, filed on April 28, 2011, registered on July 28, 2011, in classes 1, 3, 5, 29, 30, 40, and 44.

The Complainant operates a website at “www.pharmanutra.it”, having registered the domain name <pharmanutra.it> in 2004.

The Respondent states that it is in the business of “creating, buying and selling domain names comprised of descriptive, geographic, and generic terms, common phrases, acronyms, abbreviations, and combinations thereof as well as other brandable names suitable for a variety of potential uses.” The Respondent sells over 1,000 domain names per year and currently holds a portfolio of some 200,000 domain names.

The Respondent registered the disputed domain name on September 26, 2011.

As of November 4, 2024, the disputed domain name resolved to a website with a “DomainMarket.com / Claim Your Brand” logo, listing the disputed domain name as a “premium domain” for sale, with a “Request Price” button. The page included the following text:

“Pharmanutra.com is a powerful domain name for companies operating in the pharmaceutical or nutraceutical sector. Its unique combination of 'pharmacy' and 'nutra' signifies health, wellness, and advanced scientific solutions. This domain name's memorability will help you create a strong online presence, making it easier for potential customers to find and remember your business.

Pharmanutra.com is versatile and can be used by various businesses in the healthcare sector, including pharmaceutical companies, research institutes, nutraceutical brands, and more. Its short and easy-to-remember nature makes it an excellent choice for businesses looking to expand their online reach.

[...] Owning a domain like pharmanutra.com can significantly benefit your business by improving your online visibility, which in turn drives organic traffic and helps you establish a strong brand identity. A domain name is a crucial aspect of your digital marketing strategy, as it impacts how customers perceive your business and the level of trust they have in it.

Pharmanutra.com can help you rank higher in search engine results for relevant keywords due to its industry-specific nature. Having a domain that resonates with your business will enhance customer trust and loyalty by creating a professional and reliable online presence.”

Following a request by the Complainant via the Respondent's site for a price for the disputed domain name, the Respondent emailed the Complainant on June 10, 2024, stating that the disputed domain name cost USD 294,888. The Complainant responded the same day saying: “Wow... that's really too much. We cannot afford it. No need further talk.”

The Respondent sent chasers to the Complainant on June 12 and 17, and September 18, 2024.

The Complainant emailed the Respondent on October 15, 2024, asking the Respondent to propose a more realistic offer/quote and stating that the offer of USD 294,888 was “just an economic speculation”. The Complainant asked if the Respondent was “open to offer a significantly lower quote”.

The Respondent replied on October 15, 2024, stating that all of its domain names were evaluated “using multiple factors”, that the Respondent could “work with you and the seller” to find a mutually acceptable price and inviting the Complainant to make an offer.

The Complainant emailed the Respondent on October 16, 2024, saying that it was hesitant to make an offer and asking the Respondent to provide “a new very reasonable quote”. The Complainant also asked if the Respondent’s brokerage role involved any cost on the part of the Complainant and stated that it had understood that “Domain Market” was the seller.

The Respondent responded the same day saying that it did not charge additional fees to negotiate a deal with the Complainant and that the least that “we can accept” for the disputed domain name was USD 180,000.

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 is currently one of the most appreciated Italian and international companies in the pharmaceutical and nutraceutical sector”;
- the Respondent registered the disputed domain name some seven years after the Complainant registered the domain name <pharmanutra.it> and only five months after the Complainant’s first filing for the PHARMANUTRA trade mark, of which the Respondent must have been aware as the Italian Patent and Trademark office offers free online searches;
- in any case, by 2011 the Complainant’s mark was “already one of the most known nutraceutical and food supplement signs in Italy, for over 5 years”, being a market leader in the sale of iron supplements, which grew by 27 per cent between 2008 and 2015;
- the Complainant has not authorised the Respondent to use its mark;
- the Complainant’s use of the disputed domain name for a landing page with a “Request Price” button that was aimed at eliciting an offer from the Complainant to buy the disputed domain name constitutes neither a bona fide offering of services, nor a legitimate noncommercial or fair use of the disputed domain name;
- the Respondent, which had the Complainant’s mark in mind at the time, registered the disputed domain name primarily for the purpose of selling the disputed domain name to the owner of the identical trade mark, namely the Complainant, “in order to speculate and obtain the highest price”;
- the Complainant decided to file this Complaint because the Respondent offered the disputed domain name for sale at “exorbitant” prices, which are themselves evidence of bad faith registration and use of the disputed domain name;
- the registration of a domain name that is identical or confusingly similar to a well-known trade mark having a sufficiently good reputation by an unrelated entity is evidence of opportunistic bad faith; and
- the Respondent has set out to create a likelihood of confusion with the Complainant’s mark for commercial gain in that Internet users may be misled into thinking that the references to the pharmaceutical or nutraceutical industries on the Respondent’s website are associated with the Complainant’s business.

B. Respondent

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Respondent contends that:

- the Respondent's registration of the disputed domain name in connection with its legitimate business of reselling premium domain names is a bona fide offering of goods and services;
- the Respondent registered the disputed domain name because it was an obvious combination of two generic and descriptive prefixes or abbreviations representing the convergence of the pharmaceutical industry and nutrition, which were and are very large industries and whose convergence was widely known when the Respondent registered the disputed domain name;
- the Respondent has bought and sold hundreds of domain names over the past 17 years that start with the prefixes "pharma" or "nutra" prefix, including <pharmaherb.com>, <pharmapub.com>, <pharmaceuticalmed.com>, <pharmafuture.com>, <pharmaseeds.com>, <pharmauniversity.com>, <nutraceutico.com> and <nutraformula.com>, all of which were registered before the Complainant filed for its first registered trade mark;
- the Respondent, which is based in the United States, did not set out to target the Complainant, of which the Respondent was unaware until the Respondent received an email from the Complainant in June 2023;
- the mere offering of the disputed domain name for sale does not establish that it was registered to target the Complainant or its competitors; furthermore, the fact that the Respondent's website did not list a price for the disputed domain name in no way establishes that the Respondent set out to target the Complainant and indeed many of the Respondent's domain names have an unlisted price that is only available on enquiry;
- the Respondent never solicited the Complainant for sale of the disputed domain name;
- the Respondent's website has never used any pay per click ("PPC") or other advertising relating to the Complainant or its products or competitors but has only deployed stock marketing language used on all of its landing pages that highlights the generic and descriptive nature of the domain name and explains why domain names of that nature are valuable;
- the Complainant has provided no evidence of fame in Italy, let alone in the United States or worldwide, as of 2011;
- the Respondent registered the disputed domain name some two years before the Complainant expanded outside Italy;
- the existence of two Italian trade marks predating registration of the disputed domain name does not constitute evidence of bad faith; constructive notice is insufficient and, in any case, the Respondent had no reason to even consider searching the database of Italian trade marks;
- the Complainant has made no complaint during the Respondent's 13-year use of its landing page to offer the disputed domain name for sale; and
- the Complainant's pre-action purchase communications never asserted any claim in, or rights over, the disputed domain name.

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 trade mark 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 Complainant has shown rights in respect of a trade mark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is identical 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

It is unnecessary for the Panel to consider this element in light of the Panel's findings under the third element below.

C. Registered and Used in Bad Faith

For the following reasons, the Complainant has not convinced the Panel that, on the balance of probabilities, the Respondent registered the disputed domain name on September 26, 2011, with the Complainant in mind.

First, while on the face of it "pharmanutra" might seem like a somewhat distinctive name, the Respondent has established that "pharma" and "nutra-" are common prefixes denoting the pharmaceutical and nutrition industries, and that the combination of these terms in the disputed domain name was a reasonably obvious choice, particularly given that the respective industries had converged to some degree by the time of registration of the disputed domain name. Indeed, the Panel notes that the Complainant describes itself as operating in the "pharmaceutical and nutraceutical sector". Furthermore, the Respondent had dealt with a number of other "pharma" and "nutra" domains before it registered the disputed domain name. Accordingly, the Panel does not consider that the composition of the disputed domain name necessarily contradicts the Respondent's denial of knowledge of the Complainant at the relevant time.

Second, much of the information supplied by the Complainant relating to its reputation relates to the period after registration of the disputed domain name on September 26, 2011, and is therefore of little assistance. While the Complainant does claim to have been a market leader in the sale of iron supplements in Italy by 2011, all that the Complainant has provided in support are some statistics indicating 27 per cent growth of sales of a product called Sideral between 2008 and 2015. In the Panel's view, this evidence falls short of establishing that, as of 2011, the PHARMANUTRA mark had acquired substantial fame such as was likely to have come to the attention of the Respondent, located in the United States. Furthermore, the Complainant acknowledges that it did not begin to operate outside Italy until 2013.

Third, the Panel does not consider that the fact that the Complainant registered the domain name <pharmanutra.it> some seven years prior to the Respondent's registration of the disputed domain name assists the Complainant in the absence of any evidence that the Complainant's website located at "www.pharmanutra.it" had acquired significant fame by 2011. Nor does the pre-existence of the Complainant's Italian trade mark, and the availability of online searches for Italian trade marks, help the Complainant given that the Complainant has not provided any evidence of substantial fame or other reason why the United States-located Respondent should have considered searching the database of Italian trade marks before registering the disputed domain name. While it is true that the Respondent registered the disputed domain name only five months after the Complainant filed for its Italian trade mark, the overall circumstances of this case do not give the Panel any reason to conclude that this relatively short interval was anything other than a coincidence.

Fourth, the Panel considers that neither the fact that the Respondent has offered the disputed domain name for sale, nor the manner in which the Respondent has gone about doing so, indicate that the Respondent registered the disputed domain name for sale to the Complainant in accordance with paragraph 4(b)(i) of the Policy. [WIPO Overview 3.0](#), section 3.1.1.

In the Panel's view, the level of price sought by the Respondent for the disputed domain name does not – by itself – indicate that the Respondent was out to target the Complainant. Rather, in the circumstances of this case, the Panel believes that the (six-figure) price tag was more likely a feature of the Respondent's

assessment of the value of the disputed domain name, including its likely attractiveness to the pharmaceutical/nutraceutical industries as a whole, rather than evidence of a specific focus on the Complainant. Similarly, nothing turns on the fact that the price was only available on request, which the Panel understands is a common practice of domain name sellers in relation to claimed high-value domain names.

Nor does the Panel consider that the content of the Respondent's website quoted in section 4 above is indicative of an intent to target the Complainant, as claimed by the Complainant. Given the Respondent's stated purpose of registering the disputed domain name in the context of the convergence of the pharmaceutical and nutrition industries, discussed above, it is not surprising that the Respondent would thereafter promote the disputed domain name to businesses operating in those and related fields. The Panel sees nothing in the Respondent's language indicating that it was directed at the Complainant in particular, rather than the Complainant's industry in general.

Fifth, the Panel rejects the Complainant's assertion that the Respondent's landing page constitutes an attempt to create a likelihood of confusion with the Complainant's mark for the purpose of paragraph 4(b)(iv) of the Policy. In the Panel's view, the Respondent's website is clearly aimed at businesses in the pharmaceutical/nutraceutical and related sectors that may be interested in buying the disputed domain name, and is not directed at industry customers, still less those of the Complainant specifically.

For all of the above reasons, the Panel concludes that the evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's trade mark.

The Panel would add that it has noted that, in the course of the sale negotiations, the Respondent at one point apparently sought to give the impression that it was acting as a broker, whereas it was in fact the ultimate owner of the disputed domain name. While such conduct may have been a factor in the Panel's decision if the case had been closer, the Panel does not consider that it affects the Panel's conclusion in the circumstances here.

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

7. Decision

For the foregoing reasons, the Complaint is denied.

/Adam Taylor/

Adam Taylor

Sole Panelist

Date: January 2, 2025