

## **ADMINISTRATIVE PANEL DECISION**

Nicholas Graham Charles Clarkin v. John Toney, James May  
Case No. D2024-4267

### **1. The Parties**

- 1.1 The Complainant is Nicholas Graham Charles Clarkin, United Kingdom (“UK”), self represented.
- 1.2 The Respondent is John Toney, James May, UK.

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

- 2.1 The disputed domain name <palmarium.com> the (“Domain Name”) is registered with 123-Reg Limited (the “Registrar”).

### **3. Procedural History**

- 3.1 The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 9, 2024. In the Complaint the Complainant identified the registrant of the Domain Name as “The Hacker (Unknown)”. However, at that time publicly available Whois details did not identify the registrant of the Domain Name. The Complainant as initially filed related not just to the Domain Name, but also two other domain names.
- 3.2 On October 17, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name, and the other domain names identified in the Complaint. On October 17, 2024, the Registrar transmitted by email to the Center its verification response disclosing underlying registrant and contact information for these domain names.
- 3.3 The Center sent an email to the Complainant on October 22, 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 October 26, 2024. The amended Complaint was limited to the Domain Name.
- 3.4 The Center verified that 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”).

3.5 In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 29, 2024. In accordance with the Rules, paragraph 5, the due date for Response was November 18, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 19, 2024.

3.6 The Center appointed Matthew S. Harris as the sole panelist in this matter on November 22, 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.

3.7 On November 27, 2024, the Panel issued a procedural order ("Procedural Order No. 1"), seeking clarification of aspects of the Complainant's case, including further clarification as to the extent of the Complainant's use of the term "Palmarium". Procedural Order No. 1 also providing for the Respondent to file further submissions in this respect should the Respondent wish to do so. The Complainant filed a further submission in this respect on December 2, 2024. The Respondent did not do so.

3.8 On December 16, 2024, the Panel issued a second procedural order ("Procedural Order No. 2"), seeking original electronic copies of aspects of the evidence provided by the Complainant, and also seeking further information and material to verify that the Complainant was who he claimed to be. That material was provided by the Complainant on December 16, 2024. Again, the Respondent did not file any further submission in response to that Order.

#### **4. Factual Background**

4.1 The Complainant is an individual located in the UK. He described himself as the "owner" of Palmarium Capital Limited, a company incorporated in England and Wales on February 21, 2007. Documents filed at Companies House (the UK company registry) records the Complainant as one of two directors of Palmarium Capital Limited and one of two individuals with significant control of that company.

4.2 Palmarium Capital Limited is an investment and management company. The name of the company is derived from Latin and signifies excellence (literally translating as deserving of a "palm" or a prize). It has operated in a number of markets, including London, New York, Hong Kong, Dubai, Northern Ireland, and Singapore but the extent of those activities is not particularly clear. The services that it provides include the managing of financial transactions, including invoicing, on behalf of other UK registered companies that the Complainant owns or in which he has an interest.

4.3 Regardless of the extent of Palmarium Capital Limited historical activities, its business in recent years appears to have been modest. Accounts filed at Companies House for the year ended March 31, 2023, identify Palmarium Capital Limited as a "Micro-entity", with one employee.

4.4 The Complainant acquired the Domain Name on January 14, 2004. Internet Archive records show that the Domain Name has been used since at least 2013 (and perhaps earlier) for a website promoting the activities of "Palmarium Capital", "Palmarium Services" and "Palmarium Entrepreneurs". That website use ceased in or about late 2016. Since that date the Domain Name continued to be used as part of email addresses used in connection with Palmarium Capital Limited's activities, but again the extent of that use is unclear. Notwithstanding that the Domain Name was used by Palmarium Capital Limited, at the relevant time the Domain Name was held in the personal name of the Complainant.

4.5 In or about August 2018 the Complainant was approached by someone who enquired as to whether the Complainant was interested in selling the Domain Name. The Complainant responded that he was not.

4.6 The Respondent appears to have acquired control of the Domain Name on June 29, 2024. The circumstances surrounding that acquisition are addressed in greater detail later on in this decision.

However, it seems unlikely that either “John Toney” or “James May” represents the real name of the person who now controls the Domain Name.

4.7 The Complainant applied for a UK registered trade mark (no. UK00004077994) for PALMARIUM CAPITAL as a word mark in Class 36 on July 20, 2024. That trade mark proceeded to registration on October 11, 2024.

4.8 As at the time that this decision was being prepared, the Domain Name redirected Internet users to an online domain name marketplace operated by “atom.com”.

## **5. Parties’ Contentions**

### **A. Complainant**

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

5.2 In this respect the Complainant refers to his trade mark application and claims that this gives him relevant rights for the purposes of the Policy. He also contends that the proceedings have also been brought for and on behalf of Palmarium Capital Limited. He also claims to own goodwill and unregistered common law trade mark rights in the name “Palmarium” by reason of the use of this name for over 20 years. At times he refers to rights in the Domain Name <palmarium.com>, but it seems clear from other references in the Complaint to the “Palmarium brand”, that this claim also extends to the term Palmarium alone.

5.3 The Complainant essentially contends that he lost control of the Domain Name (and a number of other domain names) when an email address using the Domain Name was hacked. In support of that contention the Complainant has provided (a) receipts from the Registrar recording payment by the Complainant of registration fees in respect of the Domain Name in December 2023, and (b) a copy of an email dated July 10, 2024 sent by an individual at “Keybridge IT”, a company providing IT support to the Complainant and/or Palmarium Capital Limited, to Thames Valley Police setting out the circumstances of the alleged hacking incident. The email to Thames Valley Police sets out who Keybridge IT suspects was responsible for the hacking of the Domain Name. In his additional submissions filed pursuant to Procedural Order No. 1 and Procedural Order No. 2, the Complainant contends that this person was an individual who had previously provided services to the Complainant.

### **B. Respondent**

5.4 The Respondent did not reply to the Complainant’s contentions.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

6.1 It is generally 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.

6.2 In this case the Complainant relies upon a recent UK trade mark application for the term “PALMARIUM CAPITAL”, albeit alleging that this has been in use as a mark for a number of years. A pending trade mark application is generally considered not to establish trade mark rights within the meaning of UDRP. [WIPO Overview 3.0](#), section 1.1.4. However, in this case the application proceeded to grant on

October 11, 2024, which was before the Complainant filed its Amended Complaint and over two weeks prior to the formal commencement of these proceedings on October 29, 2024.

6.3 In *Validas LLC v. SMVS Consultancy Private Limited* WIPO Case No. [D2009-1413](#) (a decision expressly relied upon by the Complaint), the panel held that the complainant had relevant rights where a registered trade mark was granted after the relevant domain name had been registered, but before the complaint was filed. Section 1.13 of the [WIPO Overview 3.0](#) also states:

The fact that a domain name may have been registered before a complainant has acquired trademark rights does not by itself preclude a complainant's standing to file a UDRP case, nor a panel's finding of identity or confusing similarity under the first element.

6.4 The Panel sees no good reason, given the wording of paragraph 4(a) of the UDRP and the fact that the first element functions primarily as a standing requirement, why a complainant cannot also claim relevant rights where a registered mark has come into existence prior to the proceedings formally commencing pursuant to paragraph 4(f) of the Rules.

6.5 The Panel is, therefore, satisfied that the Complainant has shown rights in respect of a trade mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

6.6 The Domain Name comprises the term "PALMARIUM" combined with the ".com" generic Top Level Domain. Therefore, the dominant and most distinctive part of the Complainant's trade mark is reproduced within the Domain Name. Accordingly, the Domain Name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

6.7 Accordingly, the Panel finds the first element of the Policy has been established.

6.8 However, the Complainant applied for the trade mark after he lost control of the Domain Name, and it seems likely that the primary reason why the mark was applied for was to assist him in these proceedings. This is a factor that is potentially relevant when it comes to consideration of the second and third elements of the Policy. As section of [WIPO Overview 3.0](#) also records:

"Where a domain name has been registered before a complainant has acquired trademark rights, only in exceptional cases would a complainant be able to prove a respondent's bad faith."

6.9 With this in mind it is convenient (if not strictly necessary for the purposes of the first element of the Policy) also to consider the Complainant's claim that he has unregistered trade mark rights in respect of the term "Palmarium".

6.10 There are two issues with this claim. First, although it would appear that the Complainant started using this term prior to the incorporation of Palmarium Capital Limited, it would also appear that at least since that date, it is the company that has been using the term, and prima facie holds any such unregistered rights. Although the Complainant contends that he has brought these proceedings for and on behalf of Palmarium Capital Limited, Palmarium Capital Limited has not actually been formally identified as a joint Complainant in these proceedings. However, the Complainant is the owner of Palmarium Capital Limited, and in certain circumstances "affiliates" of a trade mark owner have been held to hold sufficient rights for the purposes of the Policy (see section 1.4.1 of the [WIPO Overview 3.0](#)). Further, the Complainant has at least used that term, albeit in the limited sense that at all relevant times he has held and permitted Palmarium Capital Limited to use a Domain Name that incorporates that term.

6.11 Second, and more significant is that, although the Complaint contains various statements as to use of the term "PALMARIUM" and alleged reputation in the same, those statements were for the most part conclusionary in nature rather than supported by evidence. Material from the Internet Archive suggested that the Domain Name had not been used in relation to a website since later 2016 and documents filed at Companies House, the register for UK companies, suggested that Palmarium Capital Limited trading

activities were not that extensive and indeed it was not at all clear whether Palmarium Capital Limited was trading at all.

6.12 Section 1.3 of the [WIPO Overview 3.0](#) summarises the position when it comes to showing unregistered or common law trade mark rights as follows:

“To establish unregistered or common law trademark rights for purposes of the UDRP, the complainant must show that its mark has become a distinctive identifier which consumers associate with the complainant’s goods and/or services.

Relevant evidence demonstrating such 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.

...

Specific evidence supporting assertions of acquired distinctiveness should be included in the complaint; conclusory allegations of unregistered or common law rights, even if undisputed in the particular UDRP case, would not normally suffice to show secondary meaning.”

6.13 Given this, the Panel sought further clarification of the use made of the term Palmarium in its Procedural Order No 1. In response to the Procedural Order No. 1, the Complainant filed further evidence in the form of invoices issued by Palmarium Capital Limited under the “Palmarium” name in August, September and October 2024, the total value of which was a little more than GBP 10,000 plus VAT.

6.14 The term “Palmarium” is clearly an unusual one that has no obvious ordinary meaning, and certainly is not descriptive of the services that Palmarium Capital Limited provide. Further, even though there has been a tendency for panelists to find unregistered rights for the purposes of the Policy in similar circumstances regardless of the location of the party claiming those rights, the concept of trade mark rights is one that is ultimately grounded in national law. It has long been the case that rights under the English law of passing off might provide unregistered trade mark rights for the purposes of the Policy (see for example *Margaret Drabble v. Old Barn Studios Limited*, WIPO Case No. [D2001-0209](#)), and the English courts have been prepared to accept that even a very modest business might possess sufficient goodwill that the use of its name by a third party might found a claim for passing off (see the discussion in paragraphs 3-31 to 3-38 of Wadlow on The Law Of Passing-Off 6th Ed.)

6.15 Given this, and although the material provided in this respect is limited, the Panel is prepared to accept, absent argument to the contrary, that at least Palmarium Capital Limited also possesses unregistered trade mark rights for the purposes of the Policy in the term “Palmarium”, and that the Complainant has a sufficient interest in those rights.

## **B. Rights or Legitimate Interests, and Registered and Used in Bad Faith**

6.16 It is usual for panels under the Policy to consider the issues of rights or legitimate interests, and registration and use in bad faith in turn. However, in this case it is more convenient to consider those issues together. [WIPO Overview 3.0](#), section 2.15.

6.17 The reason for this is that the Complainant contends that this is a case where the Domain Name has been effectively stolen or, to use the language of the Complaint, “Hijacked”. The Panel accepts on the basis of the undisputed material provided by the Complainant in this respect, that this is so. Further, the Panel accepts the Complainant’s contention that this hijacking was most likely carried out by someone who had previously provided services to Palmarium Capital Limited (or some other company with which the Complainant is associated).

6.18 A person who hijacks a domain name obviously has no right or legitimate interest in the domain name that he or she has “stolen”, and the Panel accepts that the acts of the Respondent in this respect are positive evidence of a lack of any such right or interest.

6.19 On the issue of bad faith the Complainant refers to a number of cases where a panel has held that the hijacking of a domain name involved the registration and holding was in bad faith. Not all of the cases identified by the Complainant involve domain name hijacking. However, the case of *PacketVideo Corporation v. PacketVideo Corporation* WIPO Case No. [D2023-2702](#), referred to by the Complainant is such an example. In that case the panel asserted:

“Hacking into the account of another to acquire domain names based on that party’s claimed trademarks for purposes of reselling them at an exorbitant price back to their original owner is not only malicious but a pure bad faith act of cyberpiracy.”

6.20 That said, the UDRP does not provide a forum for all cases of wrongdoing or allegations of illegality online or through the use of a domain name. The wrongful conduct must have a connection with the relevant trade mark rights relied upon, and, as a consequence the UDRP may not provide a remedy where there has been theft of a domain name that comprises a domain name which has no connection with any mark of the complainant. It does not matter in such a case how much one might disapprove of the offending conduct. The position is also not changed by the mere fact that after that theft of a domain name the entity or person from which that domain name has been stolen, has managed to obtain a registered trade mark, the primary purpose of which is to give the complainant rights for the purposes of the Policy. Furthermore, given the seriousness of the allegation of theft, a panel is ordinarily likely to expect that a complainant to provide clear and compelling evidence to support that allegation (see, for example, the comments of the Panel in this respect in *Total S.A. v. Gustavo Cerda*, WIPO Case No. [D2011-2073](#)).

6.21 In the present case, the Complainant only applied for and obtained a registered trade mark after, and seemingly in response to, the hijacking of the Domain Name. But this is not a case where the Domain Name had not been previously used in connection with any business. On the contrary, it had been used for a considerable number of years by a company owned by the Complainant, including by use of the Domain Name. Further, although the activities of that company appear at least in recent years to have been modest, as the Panel has already explained, such activities are sufficient to give that company and the Complainant trade mark rights for the purposes of the Policy.

6.22 The Respondent’s motives in hijacking the Domain Name are not particularly clear. However, given the Panel has accepted absent argument or evidence to the contrary, that the hijacker was likely to be a person who previously provided services to Palmarium Capital Limited (or some associated company), the Panel is satisfied that the hijacker took control of the Domain Name, at least in part because he was aware that was an asset of value to the Complainant and/or Palmarium Capital Limited by reason of Palmarium Capital Limited’s historic use of that name in a trade mark sense. In the view of the Panel, the hijacking of the Domain Name, therefore, seeks to take unfair advantage of relevant trade mark rights and this is sufficient for the Panel to conclude that the registration and use of the Domain Name was in bad faith.

6.23 Accordingly, the Panel finds the second and third elements of the Policy have been established.

## 7. Decision

7.1 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 <palmarium.com> be transferred to the Complainant.

*/Matthew S. Harris/*

Matthew S. Harris

Sole Panelist

Date: January 6, 2025