



NATIONAL ARBITRATION FORUM

DECISION

NaturaLawn of America, Inc. v. Jeff Edwards
Claim Number: FA1102001372111

PARTIES

Complainant is NaturaLawn of America, Inc. ("Complainant"), represented by John J. Dabney of McDermott Will & Emery LLP, Washington D.C., USA. Respondent is Jeff Edwards ("Respondent"), represented by James R. Duby of Duby & Associates, PLC, Michigan, USA.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <naturallawns.com>, registered with ADVANCED INTERNET TECHNOLOGIES, INC.

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

The Honourable Neil Anthony Brown QC as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on February 9, 2011; the National Arbitration Forum received payment on February 14, 2011.

On February 14, 2011, ADVANCED INTERNET TECHNOLOGIES, INC. confirmed by e-mail to the National Arbitration Forum that the <naturallawns.com> domain name is registered with ADVANCED INTERNET TECHNOLOGIES, INC. and that Respondent is the current registrant of the name. ADVANCED INTERNET TECHNOLOGIES, INC. has verified that Respondent is bound by the ADVANCED INTERNET TECHNOLOGIES, INC. registration agreement and has thereby agreed to resolve domain disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On February 15, 2011, the Forum served the Complaint and all Annexes, including a Written Notice of the Complaint, setting a deadline of March 7, 2011 by which Respondent could file a Response to the Complaint, via e-mail to all entities and persons listed on Respondent's registration as technical, administrative, and billing contacts, and to postmaster@naturallawns.com. Also on February 15, 2011, the Written Notice of the Complaint, notifying Respondent of the email addresses served and the deadline for a Response, was transmitted to Respondent via post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts.

A timely Response was received and determined to be complete on March 8, 2011.

On March 11, 2011, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed The Honourable Neil Anthony Brown QC as Panelist.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant

Complainant contends that the domain name <naturallawns.com>, should be transferred to it because it can make out each of the three criteria prescribed under paragraph 4(a) (i)-(iii) of the Policy. Complainant maintains, first, that the domain name <naturallawns.com>, is confusingly similar to Complainant's registered trademarks NATURALAWN, NATURLAWN and NATURALAWN OF AMERICA (and Sun Design) registered with the United States Patent and Trademark Office ("USPTO"). Complainant contends that the domain name is confusingly similar to the trademark NATURALAWN because it consists of the mark with the addition only of the letter L and the letter S which do not detract from the otherwise confusing similarity of the domain name to the trademark.

The Complainant further argues that the disputed domain name is confusingly similar to its domain name <naturalawn.com> because only the letter S has been added to that domain name and that it is virtually identical to others of its domain names such as <naturalawn.net>.

It further argues that the confusing similarity is compounded by the fact that the disputed domain name is registered in the same top level domain as domain names of Complainant incorporating its trademark NATURALAWN, for example <naturalawn.com>.

Finally, for this element, Complainant argues that consumers seeking information about Complainant and its goods and services are likely to believe falsely that the disputed domain name resolves to a website owned by Complainant and that it is an official source of information about Complainant and its business, goods and services.

To establish the second element Complainant argues, first, that the website to which the disputed domain name resolves, <homeharvest.com> sells products similar to those of Complainant and such use has not been approved by Complainant.

Complainant then argues that as the website to which the domain name resolves promotes goods and services of Complainant's competitors, this use is not a *bona fide* offering of goods or services or a legitimate or non-commercial fair use.

Moreover, the domain name hosts no website of its own and the site to which it resolves contains no reference to "natural", "lawn" or related terms.

It is also said that the Respondent is not "commonly known" by the domain name and that he registered it 12 years after Complainant began using the NATURALAWN trademarks, 3 years after Complainant registered its domain name <naturalawn.com> and a decade after the NATURALAWN trademarks had become well known for lawn care and pest control products and services.

With respect to the third element, Complainant argues that the use of the NATURALAWN trademark itself establishes bad faith, as does the use of the domain name to sell products in competition with Complainant and the fact that Respondent had constructive notice of Complainant's NATURALAWN trademarks.

B. Respondent

Respondent contends with respect to the first element that the disputed domain name is not confusingly similar to Complainant's trademarks because it consists of generic and descriptive words in common use and was registered in good faith.

Respondent secondly argues that it has a right or legitimate interest in the domain name because, before notice of the dispute, Respondent used the domain name for a *bona fide* offering of goods or services and has never used it in a trademark or service mark sense which is a fair use of the domain name within the meaning of the Policy, but has always used it in the generic sense. In particular, Respondent has never targeted anyone's trademark.

Moreover, Respondent argues that Complainant's delay of 11 years in bringing the Complaint, if it does not give rise to a defence of laches, gives rise to a legitimate interest on the part of Respondent

in the domain name.

As to bad faith, Respondent submits that the fact that the domain name consists of common generic and descriptive terms itself rebuts the allegations of bad faith registration and use.

Respondent in any event is not in direct competition with Complainant as it, Respondent, does not conduct commercial lawn care services.

Respondent also argues that there is no evidence that Respondent intended to attract consumers by creating a likelihood of confusion.

Respondent also contends that constructive notice is not sufficient to establish bad faith registration and use.

Respondent also argues that inordinate delay in bringing the Complaint also militates against a finding of bad faith registration and use.

FINDINGS

Complainant is the registered proprietor of the following service marks registered with the United States Patent and Trademarks Office ("USPTO"):

- (a) No. 1,414,588 for NATURALAWN , registered on October 21, 1986;
- (b) No. 2,543,921 for NATURLAWN, registered on March 5, 2002; and
- (c) No. 2,575,105 for NATURALAWN OF AMERICA (and Sun Design), registered on June 4, 2002.

The Respondent registered the disputed domain name on August 26, 1999.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

It is generally accepted that as these are civil proceedings, each of the above elements must be established on the balance of probabilities.

The Panel will therefore deal with each of them in turn.

Identical and/or Confusingly Similar

Complainant has relied on all 3 of the service marks referred to above and contends that the disputed domain name is confusingly similar to each of them.

The Panel finds that the domain name is not confusingly similar to the service mark NATURALAWN OF AMERICA (and Sun Design) as the mark includes additional features that are not embodied in the domain name, thus making it difficult to conclude that the two are similar, let alone confusingly so. An objective bystander, comparing the domain name with the mark would, on the balance of probabilities, conclude that the domain name is invoking a generalized concept of natural lawns, meaning lawns

cultivated and maintained by natural means, whereas the mark is invoking a specific enterprise that had styled itself NATURALAWN OF AMERICA , which is concerned with natural lawns, but is a specific brand and one that confined in its operations to the United States of America. Those features are not reflected in the domain name and it is thus unlikely that any bystander would think that the domain name was referring to the same entity as the mark.

It is more difficult, however, to decide whether the disputed domain name is confusingly similar to either of the other two service marks NATURALAWN and NATURLAWN.

Complainant argues that this is so because the domain name consists of the service mark with the addition “only” of the letter L and the letter S which do not detract from the otherwise confusing similarity of the domain name to the mark. Presumably, Complainant means that the domain name was for this reason confusingly similar to the service mark NATURALAWN. If it is argued that the domain name is also confusingly similar to the mark NATURLAWN because of the addition of a few letters, the Panel rejects that argument, as it is tantamount to arguing that the two are confusingly similar because the domain name consists of the mark with the addition of the letter A, the letter L and the letter S. The Panel’s opinion is that these additions constitute too many departures from and additions to the service mark to enable the conclusion to be reached that the domain name is confusingly similar to the mark.

The only real question is whether the domain name is confusingly similar to the mark NATURALAWN. It is here that Complainant submits that the two are confusingly similar because Respondent has taken the mark and only added an L and an S to create his domain name.

Small additions like this have been analysed by panels to show that if confusing similarity otherwise exists, it cannot be abrogated or ignored simply because the registrant has added or taken out a letter or two or converted a singular concept into a plural or *vice versa*. Indeed, Complainant has cited several decisions to that effect, such as *Humana, Inc. v. Cayman Trademark Trust* , D2006-0073(WIPO , March 7, 2006) where the letter “n” was added to the HUMANA trademark to make the domain name <humanna.com> and the panel rightly held that the domain name was still confusingly similar to the trademark despite that addition. But such exercises are dodges designed to create a difference without a distinction and indeed with the intention of creating confusion rather than removing it. Panels have rightly given short shrift to such attempts to pretend that, because of such minor changes, there is no confusing similarity. But in cases where panels have taken that course the additions or subtractions of a letter or two have not changed the meaning or colouration of the trademark or changed it in such a way that it sounds or looks like an entirely different concept. Thus in *Tire Discounters, Inc v. TireDiscounter.com* , No.679485 (NAF June 14, 2006) a 3 member panel was faced with the situation of the trademark TIRE DISCOUNTERS and the domain name <tirediscounter.com>, the issue being whether the domain name was confusingly similar to the trademark despite the only change between the two being the omission of the single letter “s” from the trademark and as a result the plural of the trademark being converted to the singular the domain name. The panel unanimously found that the domain name was not confusingly similar to the trademark. The Panel said:

“Because the mark is merely descriptive, small differences matter. In the Internet context, consumers are aware that domain names for different websites are often quite similar and that small differences matter. See *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1147 (9th Cir. 2002). The omission of the letter “s” from the mark is one of those small differences that matters in this context. Complainant has failed to meet its burden to establish that Respondent’s <tirediscounter.com> domain name is confusingly similar to Complainant’s mark within the meaning of Policy ¶4(a)(i). See *Men’s Warehouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16, 2002).” It was also noted to the same effect in *Webvan Group, Inc v. Atwood* , No D2000-1512 (WIPO Feb 20, 2001) that :

“However, when the mark is a relatively weak, non-distinctive term, courts have found that the scope of protection may be limited to the identical term and that the addition of other descriptive matter may avoid confusion.”

To the same effect are the remarks of another 3 person panel in *Board of Regents, The University of Texas System v. Vertical Axis Inc.*, No FA1004001322040 (NAF June 25,2010 where the panel considered the domain name <texasssports.org> and concluded :

“... by joining the word “Texas” with the descriptive term “sports,” the impression is much closer to that created by “Texas cities.” That is, “Texas sports” refers to virtually any athletic activities regularly taking place in the State of Texas, not just to activities sponsored by Complainant. Complainant has not suggested that it has developed any secondary meaning in the phrase “Texas sports.” The Panel agrees with Respondent’s view that Internet users, upon seeing the word “Texas” in Respondent’s Domain Name in combination with the word “sports,” will read it as referencing sports generally in connection with the State of Texas, not as a term identifying Complainant or its athletic teams. .. the Panel considers that consumers and Internet users understand that “Texas Sports” is a descriptive term referring to sports in Texas, and will not necessarily assume that <texassports.org> refers to Complainant simply because Complainant owns a TEXAS mark, which covers the presentation of sporting events.”

Those remarks are applicable to the present case and it seems to the Panel that this is also a case of where “small differences matter”. In the present case, Complainant has apparently either taken the invented word ‘natura’ and added to it the word ‘lawn’, to create a brand or trade name of Natura Lawn or compressed the two words ‘natural’ and ‘lawn’ into one word by omitting the letter ‘l’, thereby creating a brand or trade name Naturalawn. ‘ In contrast, the domain name undoubtedly consists of two common words that are descriptive and generic descriptions of the substance known as natural lawn which tell the reader that in the context of the internet it will lead to information about that general subject, namely natural lawn, but not to a brand name.

Thus the small differences from the trademark have changed its entire meaning; the addition of the letter L to service mark has changed a clear brand or trade name into a widely used and commonly used word, namely “natural” and thus into a common term, “natural lawns” and the addition of the letter S has established the notion that the domain name is and is intended to be a generic description of naturally grown and maintained laws in general.

It is thus unlikely that an objective bystander would think that such a domain name, clearly designed to invoke a substance and not a commercial product, was in fact not referring to it, but to a specific brand invoked by the trademark.

To paraphrase the panel’s remarks in *Board of Regents, The University of Texas System v. Vertical Axis Inc.*, (*supra*), the Panel considers that consumers and Internet users understand that “Natural Lawns” is a descriptive term referring to lawns cultivated and maintained by natural means, and will not necessarily assume that <naturallawns.com> refers to Complainant simply because Complainant owns a the NATURALAWN mark, which covers goods and services produced under that name. Accordingly, the Panel is unable to find that the domain name is confusingly similar to the NATURALAWN trademark.

Complainant also argued that the domain name was confusingly similar to the service mark because the domain name is confusingly similar to its domain name <naturallawn.com> and because it is registered in the same top level domain as domain names of Complainant including <naturalawn.com>. They are both interesting submissions, but the Panel is unable to accede to either of them. That is so because the test for this element under the Policy is clearly defined and the additional two arguments are not provided for in the Policy as relevant tests. The domain name must be shown to be identical to or confusingly similar to the trademark relied on by Complainant and not to a domain name or b y any other test.

Accordingly, Complainant has not been able to make out the first of the three criteria it must establish. Normally, that finding would be enough to dispose of the proceeding as a whole, but because the

parties have clearly invested time and effort into dealing with the other two criteria and because they raise significant issues, the Panel will on this occasion also deal with those two elements.

Rights or Legitimate Interests

Under paragraph 4(a)(ii), Complainant has the burden of establishing that Respondent has no rights or legitimate interests in respect of the domain name. But by virtue of paragraph 4(c) of the Policy, it is open to a respondent to establish its rights or legitimate interests in a domain name, among other circumstances, by showing any of the following elements:

(i) before any notice to you [Respondent] 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 [Respondent] (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 [Respondent] 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.

Thus, if the respondent proves any of these elements or indeed anything else that shows it has a right or interest in the domain name, the complainant will have failed to discharge its onus and the complaint will fail. It is also well established that the onus is on Complainant to show first of all that it has a *prima facie* case and then, if it does, the onus shifts to Respondent to show that it does have a right or legitimate interest in the domain name. The discussion below is designed to show that Complainant has not made out a *prima facie* case, or alternatively, if it has, then Respondent has successfully rebutted that case. The result is therefore that Complainant has not made out the second of the three elements that it must establish. The Panel's reasons for reaching these conclusions are as follows.

Complainant has argued that Respondent does not have a right or legitimate interest in the domain name because:

(a) the website to which the disputed domain name resolves, homeharvest.com sells products similar to those of Complainant and such use has not been approved by Complainant;

(b) as the website to which the domain name resolves promotes goods and services of Complainant's competitors, this use is not a *bona fide* offering of goods or services or a legitimate or non-commercial fair use;

(c) the domain name hosts no website of its own and the site to which it resolves contains no reference to "natural", "lawn" or related terms; and

(d) the Respondent is not "commonly known" by the domain name.

In reply, Respondent contends that the facts bring the case within paragraph 4(c) (i) of the Policy, for they show that before notice of the dispute, he used the domain name in connection with a *bona fide* offering of goods or services.

But Respondent also argues, as has been done successfully in a number of previous decisions on appropriate facts, that the domain name is a generic, descriptive expression consisting of commonly used words used in their generic sense and without targeting of Complainant and that this fact gives rise to a right or legitimate interest by itself.

Moreover, he says that such a use is a fair use coming within paragraph 4 (c)(iii) of the Policy.

The commencing point of this discussion must be the terms of the domain name itself and it is clear that it meets all three of the characterizations contended for it by Respondent; the combination of the two dictionary and generic words creates an expression that is in common use and which describes the product of lawns cultivated and maintained by natural means.

That being so, the domain name is a candidate for that category of domain names that are afforded legitimacy provided that they are used in a descriptive and generic sense and not used as a trademark

or in an attempt to target a trademark owner.

That principle has been stated conveniently in *Kaleidoscope Imaging, Inc. v. V Entertainment a/k/a Slavik Viner*, FA 203207(Nat. Arb. Forum Jan 5, 2004) where the following statement on the relevant principles was made:

Based on the evidence before us, Complainant has failed to establish that Respondent does not have rights or legitimate interests in the Disputed Domain Name. The word KALEIDOSCOPE is a generic English language word with the meaning demonstrated by the dictionary definition cited by Respondent in its submissions. As such, the first to register the word in a domain name can assert rights to that domain. *See Zero Int'l Holding v. Beyonet Servs.*, D2000-0161 (WIPO May 12, 2000) (stating, "[c]ommon words and descriptive terms are legitimately subject to registration as domain names on a 'first-come, first-served' basis"); *see also CRS Tech. Corp. v. Condenet, Inc.*, FA 93547 (Nat. Arb. Forum Mar. 28, 2000) (finding that "conciierge is not so associated with just one source that only that source could claim a legitimate use of the mark in connection with a website"). *See also* with respect to the generic nature of the term: *Car Toys, Inc. v. Informa Unlimited, Inc.*, FA 93682 (Nat. Arb. Forum Mar. 20, 2000) (finding that Respondent has rights and legitimate interests in the domain name where Complainant submitted insufficient evidence to establish either fame or strong secondary meaning in the mark such that consumers are likely to associate <cartoys.net> with the CAR TOYS mark); *see also Energy Source Inc. v. Your Energy Source*, FA 96364 (Nat. Arb. Forum Feb. 19, 2001) (finding that Respondent has rights and legitimate interests in the domain name where "Respondent has persuasively shown that the domain name is comprised of generic and/or descriptive terms, and, in any event, is not exclusively associated with Complainant's business"); *see also FilmNet Inc. v. Onetz*, FA 96196 (Nat. Arb. Forum Feb. 12, 2001) (finding that Complainant failed to establish that Respondent did not have rights or legitimate interests in the <filmnet.com> domain name where the disputed domain name was wholly comprised of generic words, even though Complainant is the owner of the FILMNET mark); *see also Sweeps Vacuum & Repair Ctr., Inc. v. Nett Corp.*, D2001-0031 (WIPO Apr. 13, 2001) (finding bona fide use of a generic domain name, <sweeps.com>, where Respondent used a legitimate locator service (goto.com) in connection with the domain name)."

There are other decisions to the same effect, but the principle is now well established. In the opinion of the Panel, the remarks just stated are equally applicable to the present proceeding. Having examined the evidence of the use to which the domain name has been put and the contents of the website to which the domain name has been directed, www.homeharvest.com, the Panel is of the opinion that the domain name is and has been used in the generic sense and not to identify trademarked goods. If one looks at the website, it is clear that it has promoted goods and products that meet the description of goods designed to produce natural lawns. Thus, it can be seen that the home page of the website, under the heading "Plant Food and Fertilizer" carries promotions for products for the natural treatment of "lawn & turf." Moreover, the search engine on the site, when activated to find entries on "natural lawns" produces a range of natural ingredients and substances referred to as being "natural" and as being for "lawn". It is therefore difficult to see how Complainant can say that the website www.homeharvest.com "does not contain a single reference to "natural", "lawn", or related terms", when in fact it contains many of both.

Annex A to the Response also lists an extensive range of products of Home Harvest that are essentially natural and which are specifically stated as being related to lawns and the evidence is that these products have been offered since 1988. They are promoted not because they are goods bearing the trademark NATURAL LAWNS but because they meet the generic description of goods described as relating to lawns and the natural cultivation and maintenance of lawns.

Accordingly the Panel is satisfied that the domain name consists of an easily understood common expression formed by generic words and used in a descriptive sense. That being so, the present case comes within the principle enunciated in *Kaleidoscope Imaging, Inc. v. V Entertainment a/k/a Slavik Viner*, (supra) and subsequently applied in other cases where the facts have justified it, as in *National Gardening Association, Inc. v. CK Ventures Inc* No: FA0911001294457(NAF, Feb 16, 2010), where

the panel said :

“The disputed domain name <gardeningwithkids.com> domain name is comprised entirely of common terms that have many meanings apart from their use by Complainant in its trademarks. The Panel believes that a respondent is free to register a domain name consisting of common terms, so long as they are used descriptively. It was held, for example, in *Zero International Holding v. Beyonet Servs.*, D2000-0161 (WIPO May 12, 2000) that “*Common words and descriptive terms are legitimately subject to registration as domain names on a ‘first-come, first-served’ basis.*”

The principle has also been restated recently in *Visual Systems Inc. v. Development Services Telepathy, Inc.* FA 100400131863(NAF, June 25, 2010).

There is also no evidence that Respondent has used the domain name to target Complainant. The domain name itself does not readily bring Complainant’s name or trademark to mind and its emphasis is clearly on the notion of the generic concept of natural lawns. Respondent’s evidence is also to the effect that it registered many other domain names of a gardening genre and that the expression is subject to very wide third party use in the generic sense, both of which factors tend to suggest that the expression in the domain name was used in a generic sense and would be so interpreted by users of the internet. Moreover, there is no evidence of any reference to Complainant having been made by Respondent either on the website <homeharvest.com> or elsewhere or of any fact at all that could be interpreted as an attempt to trade on Complainant’s name, pretend that it is Complainant or that its products are those of Complainant.

Accordingly, Respondent has met the requirement to show that the domain name is a generic or descriptive expression and that it is being used in the generic sense, not as a trademark and not in any other sense illegitimately or inappropriately.

The evidence also shows that Respondent has used the domain name in this sense for many years and prior to the date when it can fairly be said that the dispute was brought to his notice. In this regard the evidence is that lawyers acting for Complainant sent a cease and desist letter to Respondent dated April 15, 2002, to which Respondent replied, denying Complainant’s claim, on April 25, 2002. The matter was then apparently left up in the air and Respondent was probably entitled to think from April 25, 2002 that there was no dispute, as Complainant certainly did not press its claim until it filed the present Complaint on February 9, 2011. In any event, even if the time when the dispute was brought to the notice of Respondent is to be taken as April 15, 2002, the Panel has observed by using the Wayback Machine at <archive.org> that, prior to that date and as early as the year 2000, the domain name was pointed to <homeharvest.com>, as it is today and was used then for promoting goods and products including fertilizer described as being suitable for “turf and lawns.”

Accordingly, Respondent has made out its case that, within the meaning of paragraph 4(c)(i) of the Policy, before any notice to it of the dispute, it used the domain name in connection with a *bona fide* offering of goods or services.

On the basis of these two grounds, Complainant has not made out its *prima facie* case or alternatively, if it has, then Respondent has rebutted that case and has thus shown that it has a right or legitimate interest in the disputed domain name.

Registration and Use in Bad Faith

Complainant must prove on the balance of probabilities both that the domain name was registered in bad faith and that it is being used in bad faith: *Telstra Corporation Limited v. Nuclear Marshmallows*, [WIPO Case No. D2000-0003](#).

Further guidance on how to implement this requirement is to be found in paragraph 4(b) of the Policy, which sets out four circumstances, any one of which shall be evidence of the registration and use of a domain name in bad faith, although other circumstances may also be relied on, as the four circumstances are not exclusive.

The four specified circumstances are:

(i) circumstances indicating that the respondent has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of that complainant, for valuable consideration in excess of the respondent's documented out-of-pocket costs directly related to the domain name; or

(ii) the respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the respondent has engaged in a pattern of such conduct; or

(iii) the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) by using the domain name, the respondent has intentionally attempted to attract, for commercial gain, Internet users to the respondent's website or other on-line location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on the site or location.

Complainant argues that the use of the NATURALAWN trademark itself establishes bad faith, as does the use of the domain name to sell products in competition with Complainant and the fact that Respondent had constructive notice of Complainant's NATURALAWN trademarks.

Respondent relies on its general position that the fact that the domain name consists of common generic and descriptive terms itself rebuts the allegations of bad faith registration and use and that there is no evidence that Respondent intended to attract consumers by creating a likelihood of confusion.

The Panel has already found that Respondent has a right or legitimate interest in the domain name and that finding itself goes a long way to rejecting the submission that he has been guilty of bad faith registration and use.

See Lockheed Martin Corp. v. Skunkworx Custom Cycle, D2004-0824 (WIPO Jan. 18, 2005) (finding that the issue of bad faith registration and use was moot once the panel found the respondent had rights or legitimate interests in the disputed domain name); *see also Vanguard Group Inc. v. Investors Fast Track*, FA 863257 (Nat. Arb. Forum Jan. 18, 2007) ("Because Respondent has rights and legitimate interests in the disputed domain name, his registration is not in bad faith.").

In addition, the Panel is unable to find on the totality of the evidence that Respondent registered and subsequently used the <naturallawns.com> domain name in bad faith, as Respondent has not violated any of the factors listed in paragraph 4(b) of the Policy 4(b) or engaged in any other conduct that would constitute bad faith registration and use. *See Societe des Produits Nestle S.A. v. Pro Fiducia Treuhand AG*, D2001-0916 (WIPO Oct. 12, 2001) where the panel noted that the respondent had not attempted to sell the domain name for profit, had not engaged in a pattern of conduct depriving others of the ability to obtain domain names corresponding to their trademarks, was not a competitor of the complainant seeking to disrupt the complainant's business and was not using the domain name to divert Internet users for commercial gain. It seems to the Panel that Respondent in the present proceedings has likewise not engaged in any such conduct and, indeed, that its registration of a generic expression and of many similar generic expressions in the course of conducting a legitimate business and promoting a wide range of goods coming within the meaning of the domain name does not show bad faith in any sense.

As to the specific arguments of Complainant, the Panel finds that that Respondent did not use the NATURALAWN trademark in the domain name, but a generic expression with a specific and easily understood meaning and one that would not confuse the reader and that he did not use the domain

name with the intention of competing with Complainant by confusing potential customers of Complainant. The totality of the evidence shows that for many years Respondent has sought to attract customers by using a generic expression in his domain name where the plain meaning is that if they follow the domain name it will lead the internet user to a website where goods and services will be found that come within the generally accepted meaning of the domain name. That does not amount to bad faith either in registration or use of the domain name.

It should also be said that constructive, rather than actual notice of a Complainant's trademarks is required to succeed in such a claim. In the present case, Respondent maintains that he did not know of Complainant or its trademark at the time of registration of the domain name. Although it is difficult to reach conclusions on such questions of fact in UDRP proceedings, there is nothing to suggest that Respondent would have known of Complainant's trademarks. It is far more likely that Respondent would want to register a domain name, as it did with so many others, that actually described its products, which it did, such as natural products to establish and maintain lawns.

At the essence of the requirement to prove bad faith is an intention to act in a deleterious way towards the trademark owner and in the present case there is no evidence that Respondent did so over the many years that he has conducted his business or that he would want to.

Accordingly, Complainant has not shown that the domain name was registered and has been used in bad faith.

LACHES

On the question of laches, the Panel merely wishes to say that as a result of the decision in *The New York Times Company v. Name Administration Inc. (BVI)*, NAF Claim No. FA1009001349045, laches is "a valid defence in any domain dispute where the facts so warrant." In the present case, however, the Panel is of the view that the case should be decided on the substantive issues already expounded and that it is unnecessary to go into a long discussion on whether the facts warrant a finding on the issue of laches.

DECISION

As Complainant has not established all three elements required under the ICANN Policy, the Panel concludes that relief shall be denied.

Accordingly, it is Ordered that the <naturallawns.com> domain name remain with Respondent.

The Honourable Neil Anthony Brown QC Panelist
Dated: March 16, 2011

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