



NATIONAL ARBITRATION FORUM

DECISION

Superior Growers Supply, Inc. v. Ronnie Strobel
Claim Number: FA0504000452438

PARTIES

Complainant is **Superior Growers Supply, Inc.** (“Complainant”), represented by **James R. Duby of Duby & Associates, PLC**, 2510 Kerry Street, Suite 210, Lansing, MI 48912. Respondent is **Ronnie Strobel** (“Respondent”), 732 Orchard Ct., Algonquin, IL 60102.

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**superiorgrower.com**> and <**sgs-hydroponics.com**> (the “Domain Names”), registered with **Go Daddy Software, 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.

Michael Albert as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on April 7, 2005; the National Arbitration Forum received a hard copy of the Complaint on April 8, 2005.

On April 8, 2005, Go Daddy Software, Inc. confirmed by e-mail to the National Arbitration Forum that the domain names <**superiorgrower.com**> and <**sgs-hydroponics.com**> are registered with Go Daddy Software, Inc. and that Respondent is the current registrant of the name. Go Daddy Software, Inc. has verified that Respondent is bound by the Go Daddy Software, Inc. registration agreement and has thereby agreed to resolve domain name disputes brought by third parties in accordance with ICANN’s Uniform Domain Name Dispute Resolution Policy (the “Policy”).

On April 12, 2005, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of May 2, 2005 by which Respondent could file a Response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent’s registration as technical, administrative and billing contacts, and to postmaster@superiorgrower.com and postmaster@sgs-hydroponics.com by e-mail.

A timely Response was received and determined to be complete on April 28, 2005.

A timely Additional Submission was received from Complainant on May 3, 2005 and was determined to comply with Supplemental Rule 7. A response to this Additional Submission was received from Respondent on May 6, 2005. Both Additional Submissions were considered by the Panel.

On May 5, 2005, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Michael Albert as Panelist.

RELIEF SOUGHT

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

PARTIES' CONTENTIONS

A. Complainant

Complainant contends that it has established rights in the SUPERIOR GROWERS SUPPLY mark, for which it has obtained U.S. Trademark Registration No. 2,671,925 (issued January 7, 2003, with a date of first use in 1983), and the SGS mark (Reg. No. 1,844,001 issued July 12, 1994, with a date of first use in 1986).

Complainant uses these marks in connection with retail services featuring hydroponic gardening products and related goods.

Complainant contends that Respondent registered the domain names for use in a directly competing business relating to gardening and hydroponic products; that the marks are confusingly similar; and that Respondent has no license or other right to Complainant's marks.

While the domain names are not yet in use for the intended purpose, they redirect users to the website <drugfree.org>.

B. Respondent

Respondent contends that the intended purpose of the domain names will be to provide a question and answer site for gardeners on one of them, and the second "will be used for the business of selling specially designed hydroponic systems."

Respondent claims that his websites will be on-line in 12-18 months, and denies that Complainant can be harmed in the interim by redirecting traffic to <drugfree.org>.

Respondent further contends that the mere similarity of domain names does not amount to bad faith and cites examples of other domain names allegedly similar to well-known trademarks.

C. Additional Submissions

In its Additional Submission, Complainant noted that Respondent had failed to include the required certification.

Complainant further noted that the Response admits that Respondent intends to use the domain names for goods and services that compete directly with Complainant.

Respondent's Additional Submission provides the missing certification, takes issue with the analysis of certain prior cases cited by Complainant, and cites an additional case holding the domain name <teainc.com> to be generic or descriptive in light of the failure of the complainant in that case to offer proof of secondary meaning.

FINDINGS

The Panel finds that Complainant has established that it owns federally-registered trademark rights in the marks SUPERIOR GROWERS and SGS in connection with gardening, hydroponics, and related goods and services. The Panel further finds that the domain names are confusingly similar to Complainant's trademarks; that Respondent lacks legitimate rights or interests in these confusingly similar domain names; and that

Complainant has demonstrated that the domain names were registered and used in bad faith.

DISCUSSION

Paragraph 15(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (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;
- (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.

Identical and/or Confusingly Similar

Complainant’s federal registrations establish its rights in the SUPERIOR GROWERS SUPPLY (Reg. No. 2,671,925 issued January 7, 2003) and SGS (Reg. No. 1,844,001 issued July 12, 1994) marks going back at least to these registration dates, and indeed with common-law rights likely going back to the date of first use of each mark in commerce in the 1980s. *See Men’s Wearhouse, Inc. v. Wick*, FA 117861 (Nat. Arb. Forum Sept. 16, 2002) (“Under U.S. trademark law, registered marks hold a presumption that they are inherently distinctive and have acquired secondary meaning.”); *see also Janus Int’l Holding Co. v. Rademacher*, D2002-0201 (WIPO Mar. 5, 2002) (finding that Panel decisions have held that registration of a mark is *prima facie* evidence of validity, which creates a rebuttable presumption that the mark is inherently distinctive. Respondent has the burden of refuting this assumption).

The <superiorgrower.com> domain name registered by Respondent is confusingly similar to Complainant’s SUPERIOR GROWERS SUPPLY mark, because the domain name contains the dominant portion of Complainant’s mark and merely deletes the generic term “supply” and the letter “s” from the word “growers” in Complainant’s mark. Respondent’s omissions of one generic term and one plural “s” are insufficient to negate confusing similarity under Policy ¶ 4(a)(i). *See Asprey & Garrard Ltd v. Canlan Computing*, D2000-1262 (WIPO Nov. 14, 2000) (finding that the domain name <asprey.com> is confusingly similar to Complainant’s ASPREY & GARRARD and MISS ASPREY marks); *see also Wellness Int’l Network, LTD v. Apostolics.com*, FA 96189 (Nat. Arb. Forum Jan. 16, 2001) (finding that the domain name <wellness-international.com> is confusingly similar to Complainant’s WELLNESS INTERNATIONAL NETWORK mark); *see also Hammond Suddards Edge v. Westwood Guardian Ltd.*, D2000-1235 (WIPO Nov. 6, 2000) (finding that the domain name, <hammondsuddards.net>, is essentially identical to Complainant’s mark, HAMMONDS SUDDARDS EDGE, where the name “Hammond Suddards” identifies Complainant independently of the word “Edge”).

Similarly, the <sgs-hydroponics.com> domain name merely adds a hyphen and a generic or descriptive term that identifies Complainant’s goods or services to Complainant’s registered SGS mark. The addition of a hyphen and the term “hydroponics” to Complainant’s mark does not defeat a finding of confusing similarity. If anything, adding a term which describes the goods or services provided by Complainant is likely to enhance, rather than diminish, the risk of confusion between the domain name and Complainant’s mark. *See Chernow Communications, Inc. v. Kimball*, D2000-0119 (WIPO May 18, 2000) (holding “that the use or absence of punctuation marks, such as hyphens, does not alter the fact that a name is identical to a mark”); *see also Space Imaging LLC v. Brownell*, AF-0298 (eResolution Sept. 22, 2000) (finding confusing similarity where the respondent’s domain name combines the complainant’s mark with a generic term that has an obvious relationship to the complainant’s business); *see also Marriott Int’l, Inc. v. Café au lait*, FA 93670, (Nat. Arb. Forum Mar. 13, 2000) (finding that Respondent’s domain name <marriott-hotel.com> is confusingly similar to

Complainant's MARRIOTT mark).

Respondent directs the Panel's attention to a case which found the term "teainc" to be generic or descriptive for tea. That case, however, turned largely on the absence of any showing by the complainant of secondary meaning (i.e. an association between the mark and its business or product in the minds of the consuming public). Here, by contrast, Complainant has two longstanding federal trademark registrations, which provide presumptive evidence of such secondary meaning. Further evidence of such secondary meaning is provided in the form of Complainant's \$50 million in sales of goods and services under its marks over twenty-two years, as well as significant advertising expenditures. If Respondent is suggesting that the marks here are generic, the U.S. Patent and Trademark Office disagreed, and that decision has stood unchallenged long enough for the marks to become incontestable.

Rights or Legitimate Interests

Once Complainant makes a *prima facie* showing under Policy ¶ 4(a)(ii), the burden shifts to Respondent to establish rights or legitimate interests in the disputed domain name. *See G.D. Searle v. Martin Mktg.*, FA 118277 (Nat. Arb. Forum Oct. 1, 2002) (holding that where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is "uniquely within the knowledge and control of the respondent"); *see also Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (finding that once the complainant asserts that the respondent has no rights or legitimate interests with respect to the domain, the burden shifts to the respondent to provide credible evidence that substantiates its claim of rights and legitimate interests in the domain name).

Complainant claims that Respondent is not commonly known by the <superiorgrower.com> or <sgs-hydroponics.com> domain names. Indeed, Respondent offers no evidence to suggest that it is commonly known by either of these names. Respondent thus has not established rights and legitimate interests pursuant to Policy ¶ 4(c)(ii). *See RMO, Inc. v. Burbridge*, FA 96949 (Nat. Arb. Forum May 16, 2001) (interpreting Policy ¶ 4(c)(ii) "to require a showing that one has been commonly known by the domain name prior to registration of the domain name to prevail"); *see also Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name).

Complainant asserts (and Respondent does not deny) that Respondent has used the <superiorgrower.com> and <sgs-hydroponics.com> domain names to redirect Internet users to a website at the <altgarden.com> domain name, which promotes the sale of gardening and hydroponic products in competition with Complainant. The use of the domain names in a manner likely (as noted above) to confuse or divert Internet users searching for Complainant's products and services is not a use in connection with a *bona fide* offering of goods or services pursuant to Policy ¶ 4(c)(i), or is it a legitimate noncommercial or fair use pursuant to Policy ¶ 4(c)(iii). *See Computerized Sec. Sys., Inc. v. Hu*, FA 157321 (Nat. Arb. Forum June 23, 2003) (holding that the respondent's appropriation of the complainant's mark to market products that compete with the complainant's goods does not constitute a *bona fide* offering of goods and services); *see also Chip Merch., Inc. v. Blue Star Elec.*, D2000-0474 (WIPO Aug. 21, 2000) (finding that the disputed domain names were confusingly similar to the complainant's mark and that the respondent's use of the domain names to sell competing goods was illegitimate and not a *bona fide* offering of goods); *see also Am. Online, Inc. v. Fu*, D2000-1374 (WIPO Dec. 11, 2000) ("[I]t would be unconscionable to find a *bona fide* offering of services in a respondent's operation of web-site using a domain name which is confusingly similar to the Complainant's mark and for the same business.").

Moreover, the mere fact that Respondent, pending the development of his directly-competing e-commerce site, is apparently redirecting traffic from the domain names to a nonprofit organization <drugfree.org>, is likewise not a use of the domain names in connection with a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the domain names pursuant to Policy ¶¶ 4(c)(i) and (iii). *See State Farm Mut. Auto. Ins. Co. v. LaFaive*, FA 95407 (Nat. Arb. Forum Sept. 27, 2000) ("[U]nauthorized providing of information and services under a mark owned by a third party cannot be said to be the *bona fide* offering of goods or services."); *see also Toronto-Dominion Bank v. Karpachev*, 188 F.Supp.2d 110, 114 (D. Mass. 2002)

(finding that, because the respondent's sole purpose in selecting the domain names was to cause confusion with the complainant's website and marks, its use of the names was not in connection with the offering of goods or services or any other fair use). Indeed, Respondent admits that he intends to use the domain names to develop goods or services strikingly similar in nature to Complainant's.

Respondent's contention that it intends to provide wholesale, rather than retail, services in the area of gardening and the sale of hydroponic systems is not a sufficient distinction to undermine likelihood of confusion or to create a legitimate interest. While channels of trade is indeed a factor to be considered in evaluating likelihood of confusion, it is only one of many such factors; and here, the striking similarity of both the marks and the proposed goods and services overwhelms any arguable distinction to be drawn between the provision of wholesale and retail services.

Registration and Use in Bad Faith

The Panel agrees with Complainant that the evidence strongly suggests that Respondent has used the domain names in an attempt to profit by intentionally attracting Internet users interested in locating Complainant's products and services who inadvertently leave out or add an "s" at the end of Complainant's <superiorgrowers.com> and <sgs-hydroponic.com> domain names. Complainant further contends that diverted Internet users are redirected to a competing gardening website at the <altgarden.com> domain name. Under Policy ¶ 4(b)(iv), this is evidence that Respondent has registered and used the domain names in bad faith to attempt to divert Internet users for commercial gain by attracting users to Respondent's website through a likelihood of confusion with Complainant's SUPERIOR GROWERS SUPPLY and SGS marks. *See Identigene, Inc. v. Genetest Lab.*, D2000-1100 (WIPO Nov. 30, 2000) (finding bad faith where the respondent's use of the domain name at issue to resolve to a website where similar services are offered to Internet users is likely to confuse the user into believing that the complainant is the source of or is sponsoring the services offered at the site); *see also Luck's Music Library v. Stellar Artist Mgmt.*, FA 95650 (Nat. Arb. Forum Oct. 30, 2000) (finding that the respondent had engaged in bad faith use and registration by linking the domain name to a website that offers services similar to the complainant's services, intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the complainant's marks); *see also eBay, Inc v. Progressive Life Awareness Network*, D2000-0068 (WIPO Mar. 16, 2001) (finding bad faith where the respondent is taking advantage of the recognition that eBay has created for its mark and therefore profiting by diverting users seeking the eBay website to the respondent's site).

Furthermore, Respondent appears to be in competition with Complainant. Respondent has used confusingly similar versions of Complainant's marks in the domain names to divert business from Complainant to Respondent's competing business. Such usage is evidence of bad faith registration and use pursuant to Policy ¶ 4(b)(iii). *See Lubbock Radio Paging v. Venture Tele-Messaging*, FA 96102 (Nat. Arb. Forum Dec. 23, 2000) (concluding that confusingly similar domain names were registered and used in bad faith where the respondent and the complainant were in the same line of business in the same market area); *see also S. Exposure v. S. Exposure, Inc.*, FA 94864 (Nat. Arb. Forum July 18, 2000) (finding the respondent acted in bad faith by attracting Internet users to a website that competes with the complainant's business); *see also EthnicGrocer.com, Inc. v. Unlimited Latin Flavors, Inc.*, FA 94385 (Nat. Arb. Forum July 7, 2000) (finding that the minor degree of variation from the complainant's marks suggests that the respondent, the complainant's competitor, registered the names primarily for the purpose of disrupting the complainant's business).

Respondent is not saved by its (admittedly temporary) redirection of the domain names to the <drugfree.org> website. Diversion to a third-party website unrelated to Complainant is evidence of bad faith registration and use under Policy ¶ 4(a)(iii). *See McClatchy Mgmt. Servs., Inc. v. Please DON'T Kill Your Baby*, FA 153541 (Nat. Arb. Forum May 28, 2003) ("By intentionally taking advantage of the goodwill surrounding Complainant's mark to further its own political agenda, Respondent registered the disputed domain names in bad faith."); *see also Journal Gazette Co. v. Domain For Sale Inc.*, FA 12202 (Nat. Arb. Forum Oct. 9, 2002) (finding "Respondent chose the domain name to increase the traffic flowing to the <abortionismurder.org> and <thetruthpage.com> websites").

Respondent's own Response is telling evidence of bad faith as well. In it, Respondent claims that "if [his] goal was to infringe on [Complainant's] trademark" he would have purchased <sgshydroponic.com> or <superiorgrowerssupply.com>, both of which, he notes, were available for purchase at the time of the Response. First of all, Complainant correctly rebuts that argument by noting that a complainant need not purchase an entire library of domain names confusingly similar to its own mark in order to be entitled to the protections of the Policy. Secondly, Respondent actually did purchase domain names strikingly similar to the ones that he concedes would be evidence of the "goal" of infringement. The distinctions between the domain names he did purchase and the ones he admits would evidence bad faith is narrow (in one case, the difference is a hyphen and an "s"). By deliberately choosing domain names confusingly similar to Complainant's to steer Internet traffic to his directly competing business, Respondent has engaged in bad faith under the Policy.

Respondent offers examples of other domain names which he suggests differ from famous marks only by the omission or addition of the letter "s" (e.g. <wendy.com>; <mcdonald.com>; <icanns.com>; <fords.com>; <hondas.com>). Those cases are not before this Panel, and the reasons why ownership of those domain names may differ from ownership of the corresponding distinctive trademark (even assuming such ownership does differ) are not in evidence in the record of this proceeding. Indeed, Respondent does not suggest that, in any case decided under the Policy, these issues were presented to a Panel (or other tribunal) and decided favorably to the registrant.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**superiorgrower.com**> and <**sgs-hydroponics.com**> domain names be **TRANSFERRED** from Respondent to Complainant.

Michael Albert, Panelist

Dated: May 22, 2005

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