

ADMINISTRATIVE PANEL DECISION

Weeds, Inc. v. Registration Private, Domains By Proxy, LLC / Innovation HQ, Inc.

Case No. D2017-1517

1. The Parties

Complainant is Weeds, Inc. of Aston, Pennsylvania, United States of America (“United States”), represented by Technology & Entrepreneurial Ventures Law Group, PC, United States.

Respondent is Registration Private, Domains By Proxy, LLC of Scottsdale, Arizona, United States / Innovation HQ, Inc. of St Johns, Antigua and Barbuda, represented by Muscovitch Law P.C., Canada.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on August 3, 2017. On August 4, 2017, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On August 7, 2017, 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 and contact information in the Complaint. The Center sent an email communication to Complainant on August 9, 2017 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on August 18, 2017. Complainant filed a second amended Complaint on September 6, 2017.

The Center verified that the Complaint together with the amended Complaints 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 Respondent of the Complaint and amended Complaints, and the proceedings commenced on September 20, 2017. In accordance with the Rules, paragraph 5, the due date for Response was October 10, 2017. On September 27, 2017,

Respondent requested the automatic four calendar day extension for response under paragraph 5(b) of the Rules. The Center notified the Parties that the new due date for Response was October 14, 2017. The Response was filed with the Center on October 13, 2017.

The Center appointed Roberto Bianchi, W. Scott Blackmer and Adam Taylor as panelists in this matter on November 9, 2017. The Panel finds that it was properly constituted. Each member of 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

Complainant Weeds, Inc. is a Pennsylvania, United States, corporation, incorporated on September 28, 1966. The company specializes in industrial and commercial weed control. It mostly operates in the mid-Atlantic and mid-Western states of the United States.

Complainant owns a United States trademark registration for WEEDS, Reg. No. 3,308,883, Reg. Date October 9, 2007, filed on September 19, 2005, covering vegetative and weed control services in International Class 44, and claiming August 3, 2007 as date of first use and first use in commerce.

Complainant also owns a United States trademark registration for W WEEDS INC., Reg. No. 2,819,572, Reg. Date March 2, 2004, filed on May 1, 2002, covering weed control services in International Class 44, and stating December 21, 2000 as date of first use / first use in commerce. There is a disclaimer stating, "No claim is made to the exclusive right to use "weeds" and "Inc." apart from the mark as shown."

Respondent is in the business of investing in generic and descriptive domain names for resale and for development as website businesses.

According to the Whois data provided by the Registrant, the record for the disputed domain name was created on August 8, 1998. According to a printout from the corresponding Whois database as reported by Domain Tools, Respondent registered the disputed domain name in 2001 or on November 12, 2004 at the latest.

Presently, the initial page of the website at the disputed domain name, entitled "Weeds.com" displays the following related links: "Container Gardening", "Fine Gardening", "Flora", "Gardening", "Green Plants", "Herb Gardening", "Home Gardening", "Horticulture", "Horticulture Magazines" and "House Plants". The webpage also includes a link with a legend stating, "Click here to buy Weeds.com for your website name!"

5. Parties' Contentions

A. Complainant

Complainant contends as follows:

The disputed domain name is identical to the WEEDS trademark mark in which Complainant has rights. Complainant has been using the mark WEEDS at common law since September 28, 1966, and owns United States trademark Reg. No. 3,308,883 for WEEDS, declared incontestable, duly renewed and valid subsisting (Annexes 11, 12 and 13).

Respondent has no rights or legitimate interests in respect of the disputed domain name. Respondent is acting including, but not limited to, in a manner that violates not only the UDRP, but also the United States Anticybersquatting Consumer Protection Act (“ACPA”), 15 U.S.C. § 1125(d).¹

Respondent is offering the disputed domain name for sale (See Annexes 4–6), and without any *bona fide* use (See Annexes 7–9). The disputed domain name has been acquired for no other purpose but unlawful brokering, sale and/or auction, for exorbitant prices, in an extortive manner. Moreover, the uses and indexing are commonly used by United States residents, but Respondent uses a proxy registrant outside of the United States, with additional extra payment made for secrecy and anonymity, concealing the true identity of the substantive registrant and beneficiary.

At no time whatsoever, including neither at the time of initial registration, nor at any time of additional registration by renewal, has Respondent: (i) used or demonstrably prepared to use, the disputed domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; (ii) ever has been commonly known by the disputed domain name, nor acquired trademark or service mark rights; or (iii) made a legitimate commercial, noncommercial or fair use of the disputed domain name, but only intending for illegal commercial profit, gain and to misleadingly divert consumers or to tarnish the trade mark or service mark at issue as a mechanism to extort such profit and gain from the owner of the validly subsisting US Trademark Registration who clearly and incontestably has a legitimate interest in the disputed domain name.

The disputed domain name was registered in bad faith and is continuing to be used in bad faith. Complainant acquired common law trademark rights in the United States in the year 1966 and has been using the WEEDS brand continuously since 1966, for more than 50 years in intrastate and interstate commerce, acquiring common law rights thereby, and has used the brand in multiple different states within the United States. (See Annex 14–15.) Respondent recently registered the disputed domain name after Complainant acquired common law trademark rights, and after the date of Complainant’s United States trademark registration. (See Annexes 1–3, Annex 11.)

Respondent is tarnishing Complainant’s brand and incontestable US Trademark Registration. Respondent did not acquire, and did not register by renewal, the disputed domain name with any *bona fide* intention of commercial usage, has expressly offered the disputed domain name for sale at an exorbitant price, and simply registered the disputed domain name for the purpose of extracting a profit payment from Complainant in gross without any appurtenant commercial value, which is not permissible under the law of trademarks.

Respondent registered the disputed domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant who is the owner of the trademark or service mark, or to a competitor of Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name.

Respondent has registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name. Respondent has registered the disputed domain name, primarily for the purpose of disrupting the business of a competitor within the context of the domain name usage and acquisition, by not holding the domain name silently for use or while developing a commercial enterprise with relevant trademark rights, but re-directing visitors to other sites. By using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to another website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

¹ In this regard, the Panel notes that the Complainant filed a federal action against Respondent in the United States District Court for the Western District of Pennsylvania on November 22, 2017, in which the Complainant alleged Respondent also violated the United States Lanham Act and in particular the ACPA.

Lastly, Respondent clearly registered and has used the disputed domain name in bad faith and with the intent of making commercial gain by unlawful brokering, sale and/or auction, for exorbitant prices, in an extortive manner, and clearly evidenced by “for sale” in gross and not appurtenant to any substantive enterprise. (See Annexes 4 – 9.)

B. Respondent

Respondent contends the following:

Complainant relies on its USPTO registered trademark, Registration No. 3,308,883, for WEEDS in connection with “vegetative and weed control services”, registered October 9, 2007, with a claimed date of first use August 3, 2007. Complainant did not mention its other USPTO registered trademark, Registration No. 2,819,572, for W WEEDS INC. & Design, registered March 2, 2004, which featured a disclaimer as follows: “No claim is made to the exclusive right to use “weeds” and “Inc.” apart from the mark as shown.” Thus Complainant disclaimed the term “weeds”. Complainant however, also claims to have “been using “WEEDS” at common law since September 28, 1996, more than 50 years ago” (See Complaint at page 6, paragraph 12). First, it is obvious that 1996 is not quite “50 years ago”, although in fairness sometimes things feel much longer than they actually are. Secondly, however, Complainant’s allegation of common law rights predating its trademark registration is curious, considering by its own express admission to the USPTO, Complainant first used WEEDS on August 3, 2007. Accordingly, either Complainant breached its certification to the Panel in this proceeding or it breached its certification to the USPTO. In any event, Complainant has not provided an iota of evidence to support its claim of common law trademark rights, and as such can only rely upon its aforementioned registered trademark rights.

Respondent acknowledges that Complainant’s registered trademark for WEEDS is identical to the disputed domain name as understood by the UDRP, and as such Complainant meets the first part of the three-part UDRP test.

As to rights or legitimate interests in respect of the disputed domain name, although Complainant curiously failed to even mention that the word “weeds” is an extraordinarily common and well-known dictionary word, this fact is indisputable. It has been long-held in UDRP disputes, that where a domain name is a ‘generic’ dictionary word, the first person to register it in good faith is entitled to the domain name and this is considered a “legitimate interest”.

Complainant’s main “point” that Respondent has no rights or legitimate interests in the disputed domain name appears to be that the disputed domain name was “acquired for no other purpose but unlawful brokering, sale and/or auction, for exorbitant prices, in an extortive manner” (See Complaint at page 7, paragraph B(ii)). It has long been held that speculating in and trading in generic or descriptive domain names such as the disputed domain name, can indeed constitute a legitimate interest under the Policy (See *Havanna S.A. v. Brendhan Hight, Mdnh Inc*, WIPO Case No. D2010-1652, and *Allocation Network GmbH v. Steve Gregory*, WIPO Case No. D2000-0016, “such a practice may constitute *use of the domain* name in connection with a *bona fide* offering of goods or services (*i.e.* the sale of the domain name itself)”). If a respondent’s interest in the dictionary word domain name is unrelated to Complainant’s trademark, a legitimate interest may be found (See *Kis v. Anything.com Ltd.*, WIPO Case No. D2000-0770). As stated by the majority of the panel in *HP Hood LLC v. hood.com*, NAF Claim No. 0313566, “an established domain name resale enterprise that restricts its portfolio in a good faith effort to avoid misleading the public qualifies has a legitimate interest and a defense under Section 4(c)”.

When a domain name is descriptive, and is being used by a respondent as a descriptor of the site’s intended content or theme, a complainant will have failed to show a lack of rights or legitimate interests in a disputed domain name (See *Advanced Drivers Educ. Prods. & Training, Inc. v. MDNH, Inc.*, NAF Claim No. 0567039). As clearly shown in Annex “T”, *supra*, Respondent, prior to notice of any dispute, has used the disputed domain name for informative articles related to the dictionary meaning of weeds. See *Ministre des Relations internationales, de la Francophonie et du Commerce extérieur (Minister of International Relations, La*

Francophonie and External Trade), acting in this proceeding for and on behalf of the Government of Québec v. *Anything.com, Ltd.*, WIPO Case No. D2013-2181 (the use of a descriptive term for a corresponding informational website is a legitimate interest). Respondent has also used the disputed domain name for advertising related to same. Pursuant to the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), section 2.6, “Panels have generally recognized that use of a domain name to post parking and landing pages or PPC links may be permissible in some circumstances”, particularly where “the PPC links genuinely relate to the generic meaning of the domain name at issue”.

The general ‘for sale notice’ that Complainant complains of is not evidence of a lack of rights or legitimate interest whatsoever – in fact it is evidence of the opposite. As held in *Havanna S.A. v. Brendhan Hight, Mdnh Inc.*, WIPO Case No. D2010-1652, selling domain names with commercial value can itself be a *bona fide* offering of goods or services, and a “general offer” to sell a generic domain name is not evidence of bad faith, “absent any specific intent derived from exploitation of the goodwill associated with an incidental trademark”.

Complainant complains that Respondent’s use of a privacy service somehow demonstrates a lack of rights or legitimate interests, with no explanation at all. As held by the unanimous panel in *Mediaset S.p.A. v. Didier Madiba, Fenicius LLC*, WIPO Case No. D2011-1954, the use of privacy services in general is not objectionable. Respondent never hindered legal proceedings, and Respondent’s registration was openly registered for at least 12 years until July 2, 2015, as shown in Response Annex V. It was cutting down on spam that led to the use of a privacy service, not any intention of hindering legal proceedings.

Lastly, upon registration of the disputed domain name, the only person who had any rights or legitimate interests in the disputed domain name was Respondent since Complainant had no trademark rights at that time.

As to bad faith, Complainant accuses Respondent of having “recently registered the Domain Name after Complainant acquired common law trademark rights and federal trademark rights and registration” (See Complaint at page 8, paragraph C(ii)). This allegation is false. Complainant has not established any common law rights predating its 2007 trademark and its claimed 2007 date of first use. Complainant’s Annex 14 is merely a certificate of incorporation and provides no basis for finding common law trademark rights. In any event, Complainant has already admitted that it only started using its mark in 2007 as per its trademark registration. Moreover, the single current screenshot of its website that Complainant provides in its Annex 15 does nothing to demonstrate any basis for common law trademark rights that pre-date its trademark registration. Accordingly, Respondent’s registration of the disputed domain name in 2001 or 2004 at the latest pre-dated Complainant’s trademark rights.

It is well-established that in general, a finding of bad faith registration cannot be made with respect to a trademark that did not exist at the time of registration of the disputed domain name (See WIPO Overview 3.0, section 3.8.1). UDRP panels routinely determine that a domain name could not have been registered in bad faith when the registration pre-dates a trademark right (See *Telecom Italia S.p.A. v. NetGears LLC*, NAF Claim No. 0944807 (finding Respondent could not have registered or used the disputed domain name in bad faith where Respondent registered the disputed domain name before Complainant began using the mark)).

Respondent submits that since the disputed domain name was registered in 2001 or 2004 at the very latest and years before Complainant even commenced use of its mark in 2007, there can be no finding of registration in bad faith, and the Complaint can be dismissed on that basis alone.

Moreover, absent proof that a generic domain name was registered for the purpose of profiting from a complainant’s trademark rights, there can be no finding of bad faith registration and use. See *Ultrafem, Inc. v. Warren Royal*, NAF Claim No. 0097682).

Complainant also claims, without any explanation or proof whatsoever, that Respondent is “tarnishing” its brand. Indeed, it is inexplicable how this could even be so considering that Complainant has no monopoly

over the common term, “weeds”. It is important to bear in mind the limited scope of the ICANN UDRP. The UDRP is not intended to serve as a means of broadly enforcing trademark rights, nor is it intended to address claims of “tarnishment” or “dilution” (See, e.g., Second Staff Report on Implementation Documents for the UDRP and also *Intel Corporation v. Intelsitio Mexico, Jesús Guerrero Jiménez*, WIPO Case No. D2012-0718).

Complainant also alleges that Respondent “simply registered the domain name for the purpose of extracting a profit payment from Complainant in gross without any appurtenant commercial value which is not permissible under the law of trademarks” (See Complaint at page 8, paragraph C(iv)). As held in *Havanna S.A. v. Brendhan Hight, Mdnh Inc.* WIPO Case No. D2010-1652, selling domain names with commercial value can itself be a *bona fide* offering of goods or services, and a “general offer” to sell a generic domain name is not evidence of bad faith, “absent any specific intent derived from exploitation of the goodwill associated with an incidental trademark”.

At no time did Respondent solicit the sale from Complainant; it was the other way round — Respondent, via a domain name broker, responded to an offer to purchase initiated by Complainant. This, however, was never disclosed by Complainant. As shown in Response Annex W, on February 13, 2005, the Vice-President of Complainant, with an email address of [xx]@weedsinc.com, made an inquiry regarding the purchase of the disputed domain name. He was advised of the purchase price of USD 294,118, and responded that he was not interested in the disputed domain name at that price. He made no reference to any purported trademark rights or claim, and apparently just wanted to purchase the disputed domain name.

Responding to an offer to purchase is not considered bad faith (See *Murad, Inc. v. Stacy Brock*, NAF Claim No. 1430865). Furthermore, an offer to sell a domain name that a party otherwise has rights to, is not bad faith; rather, it is nothing more than a legitimate effort to sell property properly owned by the party (See *Personally Cool v. Name Administration*, NAF Claim No. 1474325). If a registrant has a legitimate interest in a domain name and did not register it in bad faith, as in this case, the registrant is entitled to offer its business asset for sale at market price and this is not bad faith (See *Etam, plc v. Alberta Hot Rods*, WIPO Case No. D2000-1654). The price quoted was entirely in line with market prices for a descriptive word domain name, and no evidence has been offered to the contrary. As can be readily seen from NameBio and DNJournal, there is an active secondary market for such domain names containing generic terms (See Annex “Y”). As the lawful registrant, Respondent has the right to sell the domain name for whatever price it deems appropriate regardless of the value that Complainant or an appraiser may ascribe to the domain name (See *Personally Cool, supra*).

Complainant makes an obtuse reference at Page 8, Paragraph C(iv)(a) and (v) of the Complaint to ‘renewal’ of the Domain Name, and makes a similar reference, without explanation at Page 7, Paragraph B(v). It is well established that renewal of a domain name by the same registrant does not amount to a new registration for the purposes of the Policy (See WIPO Overview 3.0, section 3.9).

Aside from the fact that Complainant had no trademark rights when the disputed domain name was registered (so any search *would not* have revealed them), it is well-established that Respondent was under no obligation to search the records of foreign trademark offices, and that foreign trademark registrations do not put domestic domain name registrants on constructive notice of foreign trademarks (See for example, *uwe GmbH v. Telepathy, Inc.*, WIPO Case No. D2007-0261).

Even if Respondent had knowledge of Complainant, which is denied, that would not have prevented Respondent from registering the domain name in good faith since the domain name corresponded to such a common term, without any monopoly or fame held by Complainant. In fact, in Complainant’s own state of Pennsylvania, there are numerous ‘weeds’ businesses, including Weed’s Inn, Weeds & Seeds Inc., Weed’s Corners Holding Company Inc., Weeds Flower Shop, and Weeds Studio, to name a few (See Annex “Z”; Pennsylvania Secretary of State Search results).

Given the abundant evidence of common descriptive usage of “weeds” and in the absence of any evidence of targeting Complainant or its mark whatsoever, there is no evidentiary basis for concluding that Respondent registered the disputed domain name in bad faith (See *Nationwide Mutual Insurance Company v. Tim Parker*, WIPO Case No. D2014-0655 (where a respondent registers a domain name consisting of “dictionary” terms because Respondent has a good faith belief that the domain name’s value derives from its generic or descriptive qualities, the use of the domain name consistent with such good faith belief may establish a legitimate interest).

Lastly, Complainant has not even made any express and specific allegation of bad faith use, other than that the oblique allegation that the disputed domain name was being offered for sale to the general public. Complainant did not even allege that there is anything wrong with Respondent’s use of the disputed domain name for contextual advertising or its prior use for articles and information about weeds. Accordingly, there is no real allegation to be rebutted in this regard, but for the sake of completeness, the appropriateness of pay-per-click (“PPC”) use of a generic domain name was discussed at length in *McMullen Argus Publishing Inc. v. Moniker Privacy Services/Jay Bean, MDNH, Inc.*, WIPO Case No. D2007-0676 and is confirmed in the WIPO Overview 3.0, section 2.9.

That is precisely what has occurred here. Even examining Complainant’s own evidence (*i.e.* the screenshot of weeds.com at Complainant’s Annex 7), it is obvious that all the links are related to gardening and plants, and not even to weed removal, although even that would be fine, since Respondent was not using “weeds” as a trademark, but rather as a descriptor. Respondent was using the domain name not in the trademark sense, but in the descriptive sense, and was entitled to do so (See; *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*, WIPO Case No. D2001-0031 (<sweeps.com>). As held in *Harvard Lampoon, Inc. v. Reflex Publishing Inc.*, WIPO Case No. D2011-0716 (<lampoon.com>), “the Policy was not intended to permit a party who elects to register or use a common term as a trademark to bar others from using the common term in a domain name, unless it is clear that the use involved is seeking to capitalize on the goodwill created by the trademark owner” (and also see *N2COM v. Whois Privacy Services / Domain Admin, Xedoc Holding SA*, WIPO Case No. D2017-1220).

Reverse Domain Name Hijacking. Initiating domain name dispute resolution proceedings necessarily involves putting the parties to a considerable expenditure of time and in many cases cost and the Policy must not be used unless Complainant has a reasonable and credible belief it is entitled to succeed. In particular, proceedings must not be commenced in a brash and totally unjustifiable attempt to pressure a domain name owner into releasing a legitimately held domain name that considerably pre-dates any trademark rights held by Complainant (See *Proto Software, Inc. v. Vertical Axis, Inc/PROTO.COM*, WIPO Case No. D2006-0905).

Allegations of reverse domain name hijacking have been upheld in circumstances where a respondent’s use of a domain name could not, under any fair interpretation of the facts, have constituted bad faith, and where a reasonable investigation would have revealed the weaknesses in any potential complaint under the Policy (See *Rohl, LLC v. ROHL SA*, WIPO Case No. D2006-0645). Where a complainant should have known its case was fatally weak and was represented by counsel and filed no evidence beyond a mere assertion, it may be concluded that the arguments and evidence advanced by Complainant fall well short of those required to establish a colorable right, and RDNH may be found (See *Zenni Optical, LLC. v. DNS Administrator / Cykon Technology Limited*, WIPO Case No. D2009-1594). Where a complaint was brought in knowing disregard of the likelihood that Respondent possessed legitimate interests because a domain name is generic, RDNH may be found (See *Dan Zuckerman v. Vincent Peeris*, WIPO Case No. DBIZ2002-00245 (<shoes.biz>)). Where a complainant is represented by intellectual property counsel who even on a rudimentary examination of the Policy and its application in this area should have appreciated that the complaint could not succeed since Respondent’s domain name had been registered prior to any trade-mark rights being acquired, RDNH may be found (See for example, *Software, Inc. v. Vertical Axis, supra*). It is also noteworthy that the Complaint did not reference or rely upon a single case, demonstrating a likely willful blindness to the easily available case law which would have been immensely helpful in appreciating that there was no merit to Complainant’s contentions.

This is a classic “Plan B” case, as described by *TOBAM v. M. Thestrup / Best Identity*, WIPO Case No. D2016-1990, *i.e.* “using the Policy after failing in the marketplace to acquire the disputed domain name”. Complainant wanted to buy the disputed domain name and it was only after that didn’t work, that it concocted this Complaint and proceeded headlong without conducting any basic due diligence.

6. Discussion and Findings

A. Identical or Confusingly Similar

With a printout from the USPTO’s trademark database for Reg. No. 3,308,883, Complainant has shown to the satisfaction of the Panel that for purposes of Policy paragraph 4(a)(i) it has rights in the WEEDS service mark.

Complainant contends and Respondent acknowledges that Complainant’s registered trademark for WEEDS is identical to the disputed domain name. The Panel agrees that the disputed domain name is identical to Complainant’s registered mark WEEDS. The first element of the Policy is thus met.

B. Rights or Legitimate Interests

Given the Panel finding on bad faith below, the Panel need not consider the issue of rights or legitimate interests in the disputed domain name. See *Tufco Technologies, Inc., Tufco LP, Hamco Manufacturing and Distributing LLC v. Hamco Alabama, LLC*, WIPO Case No. D2011-1451 (“The [p]anel declines to rule on this element of the Policy, since the [p]anel finds (below) that the [d]omain [n]ame was not registered and is not being used in bad faith”).

C. Registered and Used in Bad Faith

The Panel notes there is a consensus among UDRP panels that for a domain name to be registered in bad faith, the registrant must have known of, and targeted, the trademark in issue at the time of the domain name registration. In the present case, Respondent denies that it was aware of Complainant’s WEEDS mark when the disputed domain name was registered. In the opinion of the Panel, the record on the case file supports this claim of Respondent for various reasons.

First, it appears that Respondent registered the disputed domain name on November 12, 2004 at the latest, before Complainant filed, on September 19, 2005, its application for its WEEDS mark Reg. No. 3,308,883, which registered on October 9, 2007. The Panel notes that absent special circumstances or scenarios, this timeline does not suggest registration in bad faith. See WIPO Overview 3.0, section 3.8, “Can bad faith be found where a domain name was registered before the complainant acquired trademark rights? 3.8.1 [...] Subject to scenarios described in 3.8.2 below, where a respondent registers a domain name before the complainant’s trademark rights accrue, panels will not normally find bad faith on the part of the respondent. (This would not however impact a panel’s assessment of a complainant’s standing under the first UDRP element.)”.

In this regard, the Panel notes that – as mentioned by Respondent – Complainant also owns a United States trademark registration for W WEEDS INC., Reg. No. 2,819,572, Reg. Date March 2, 2004, filed on May 1, 2002, and claiming December 21, 2000 as date of first use / first use in commerce. In particular, the Panel also notes that in this mark the term “weeds” is disclaimed.

Second, Complainant contends that it has been using the mark WEEDS at common law since September 28, 1966, the date of incorporation of Complainant Weeds, Inc. However, Complainant fails to submit persuasive evidence that the term “weeds” had acquired secondary meaning at the time of the

registration of the disputed domain name. Having in mind that “weed” is a descriptive, dictionary word,² such specific evidence is essential for a complainant invoking a common law mark. See WIPO Overview 3.0, section 1.3 (“What does a complainant need to show to successfully assert unregistered or common law trademark rights? 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. In cases involving unregistered or common law marks that are comprised solely of descriptive terms which are not inherently distinctive, there is a greater onus on the complainant to present evidence of acquired distinctiveness / secondary meaning.”)

As to the use of the disputed domain name, the Panel notes that presently, the homepage of the “www.weeds.com” website, entitled “Weeds.com”, displays the following related links: “Container Gardening”, “Fine Gardening”, “Flora”, “Gardening”, “Green Plants”, “Herb Gardening”, “Home Gardening”, “Horticulture”, “Horticulture Magazines” and “House Plants”. The webpage includes a link stating, “Click here to buy Weeds.com for your website name!” The disputed domain name is very much a generic word, and Respondent has a business of registering generic words and using them for PPC advertising portals. In the Panel’s view, it does not seem probable that the owners of a Caribbean company that purchases and sells generic domain names, and generates revenue from them through relevant pay-per-click advertising links, would be aware of a regional weed-control company and find their brand an appealing target for cybersquatting. Respondent denies such knowledge and intent, and the Panel does not see sufficient reason to disbelieve it, on the present record.

Complainant also contends that the disputed domain name has been acquired for unlawful brokering, sale and/or auction, for exorbitant prices, in an extortive manner, and primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to Complainant or to a competitor of Complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the domain name. Complainant submits as evidence of Respondent’s bad faith purpose a printout of the website at the disputed domain name showing that the domain name is being offered for sale at USD 250,000.

To this, Respondent replies that selling domain names with commercial value can itself be a *bona fide* offering of goods or services, and a “general offer” to sell a generic domain name is not evidence of bad faith, absent any specific intent derived from exploitation of the goodwill associated with an incidental trademark. Respondent adds that it did not solicit the sale from Complainant, and that it was Complainant’s Vice-President who made an inquiry regarding the purchase of the disputed domain name. Respondent further contends that it simply responded via a domain name broker to this offer initiated by Complainant, a fact that Complainant never disclosed. Complainant’s Vice-President was advised of the purchase price of USD 294,118, and responded that he was not interested in the purchase at that price, making no reference to any purported trademark rights or claim.

The Panel concludes that Complainant failed to prove that Respondent has registered the disputed domain name primarily for the purpose to sell it to Complainant or to a competitor of Complainant, which indicates that Policy paragraph 4(b)(i) is not applicable. See *BERNINA International AG v. Domain Administrator, Name Administration Inc. (BVI)*, WIPO Case No. D2016-1811 (“[T]here is no evidence that the Respondent

² As a noun, “weed” means, *inter alia*, “a wild plant growing where it is not wanted and in competition with cultivated plants; any wild plant growing in salt or fresh water; Cannabis (informal); Tobacco (informal). As a verb, it means, “remove unwanted plants from (an area of ground)”. See English Oxford Living Dictionaries at “www.oxforddictionaries.com/definition/weed” (visited on November 16, 2017).

was purposefully trying to sell the disputed domain name to the Complainant to take advantage of the Complainant's trade mark rights. Nor was this offer, made in response to a general, anonymous inquiry, evidence that the Respondent's acquisition of the disputed domain name, some nine years earlier, was for the purpose of sale to the Complainant – which is a fact that the Complainant must establish if the Complainant wants to prove bad faith registration as to its trade mark rights under paragraph 4(b)(i) of the Policy.”)

The Panel believes that offering for sale a domain name registered for its value as a generic and descriptive term and without targeting a mark should not be considered an evidence of bad faith, in particular where the registrant used the domain name in its meaning as a generic / descriptive / dictionary word. *i.e.*, in a non-distinctive sense, as appears to have consistently done Respondent since the domain name registration in 2004. See WIPO Overview 3.0, section 3.1.1 (“How does a complainant prove that a respondent has registered or acquired a domain name primarily to sell the domain name to the complainant (or its competitor) for valuable consideration in excess of the respondent’s costs related to the domain name? [...] “The use to which the domain name is put, particularly the absence of circumstances indicating that the respondent’s aim in registering the disputed domain name was to profit from or exploit the complainant’s trademark, can inform a panel’s assessment of the respondent’s intent. Such circumstances notably include credible pre-complaint website content corresponding to a dictionary meaning of the term comprising the domain name, as opposed to targeting the trademark owner or its competitor.”) See also *Diltex, S.A. de C.V. v. Domain Administration, Web Development Group Ltd / Privacydotlink Customer 269486*, WIPO Case No. D2015-0082 (“Respondent has conceded that it registered the disputed domain name because it might have a resale value greater than the cost of registration. Respondent has conceded that it is a “domainer”. Registering domain names for the purpose of resale is not bad faith under the Policy. In order to prove bad faith registration and use, Complainant must demonstrate that Respondent knew or reasonably should have known of its trademark rights at the time Respondent registered the disputed domain name, and that Respondent nonetheless registered the disputed domain name to sell based on goodwill value associated with Complainant’s trademark. Respondent is within its rights to register a generic or commonly descriptive term in expectation or hope that it will prove to have a value to a third party and may eventually be sold at a profit.”)

Complainant also contends that Respondent registered the disputed domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, that Respondent registered the disputed domain name primarily for the purpose of disrupting the business of a competitor, and that by using the disputed domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to another website or other online location, by creating a likelihood of confusion with Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location. The Panel notes that Complainant failed to submit any evidence whatsoever in support of such contentions, which are denied by Respondent.

In sum, the Panel concludes that Complainant failed to establish that the disputed domain name was registered and is being used in bad faith.

D. Reverse Domain Name Hijacking

The Panel notes that Complainant is represented by IP counsel. Thus it should have been quite clear from the outset that Respondent had registered a domain name consisting of a common, descriptive, dictionary word, before Complainant filed its application for the WEEDS mark.

In addition, it is well established that invoking a common law mark – as did Complainant – requires providing the Panel with concrete evidence of secondary meaning / acquired distinctiveness, which Complainant failed to submit.

Lastly, while Complainant contended that Respondent registered the disputed domain name primarily to sell it to Complainant, it made no mention of the fact that it was Complainant's Vice-President who had first contacted Respondent to make an inquiry about the purchase of the disputed domain name.

For these reasons, the Panel finds that the Complaint is an attempt at Reverse Domain Name Hijacking.

7. Decision

For the foregoing reasons, the Complaint is denied.

In addition, the Panel finds that the Complaint is an attempt at Reverse Domain Name Hijacking.

Roberto Bianchi
Presiding Panelist

W. Scott Blackmer
Panelist

Adam Taylor
Panelist
Date: November 23, 2017