



NATIONAL
ARBITRATION
FORUM

DECISION

Del Laboratories, Inc. v Nett Corp.
Claim Number: FA0202000104555

PARTIES

The Complainant is **Del Laboratories, Inc.**, Uniondale, NY (“Complainant”) represented by **Jeffrey L. Eichen**, of **Schnader, Harrison, Segal & Lewis, LLP**. The Respondent is **Nett Corp.**, Tallahassee, FL (“Respondent”) represented by **Howard M. Neu**, of **Law Offices of Howard Neu, P.A.**

REGISTRAR AND DISPUTED DOMAIN NAMES

The domain names at issue are <**lacross.com**> and <**cornsilk.com**>, registered with **Verisign - Network Solutions, Inc.**

PANEL

The undersigned certify that they have acted independently and impartially and, to the best of their knowledge, have no known conflict in serving as Panelists in this proceeding.

M. Scott Donahey Esq., Peter L. Michaelson Esq. and Alan L. Limbury Esq. as Panelists.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum (“the Forum”) electronically on February 6, 2002; the Forum received a hard copy of the Complaint on February 8, 2002.

On February 8, 2002, Verisign - Network Solutions, Inc. confirmed by e-mail to the Forum that the domain names <**lacross.com**> and <**cornsilk.com**> are registered with Verisign - Network Solutions, Inc. and that the Respondent is the current registrant of the names. Verisign - Network Solutions, Inc. has verified that Respondent is bound by the Verisign - Network Solutions, 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 February 11, 2002, a Notification of Complaint and Commencement of Administrative Proceeding (the “Commencement Notification”), setting a deadline of March 4, 2002 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@lacross.com, postmaster@cornsilk.com by e-mail.

A timely Response was received and determined to be complete on March 4, 2002.

Additional submissions were received from Complainant on March 11, 2002.

On March 15, 2002, pursuant to Complainant’s request to have the dispute decided by a three-member Panel, the Forum appointed M. Scott Donahey Esq., Peter L. Michaelson Esq. and Alan L. Limbury Esq. as Panelists.

RELIEF SOUGHT

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

PARTIES’ CONTENTIONS

A. Complainant

Primarily through national chain retail stores throughout the United States, including Tallahassee, Florida, where Respondent is located, Complainant sells La Cross® nail tools and implements and Corn Silk® makeup. Worldwide sales last year exceeded \$40 million and \$10 million, respectively.

Complainant’s La Cross® brand is a household name and the market leader in the category of nail tools and implements. It has been in use continuously since 1919. The words “la cross” and “lacross” do not have any meaning in English, other than signifying Complainant’s brand name, and do not appear in the standard English dictionary. The American Heritage College Dictionary (Third Edition) contains an entry for the word “**lacrosse**”—a game of Native American origin in which the participants use a long-handled stick with a webbed pouch to maneuver a ball into the opposing team’s goal—but the game lacrosse, unlike Complainant’s trademark La Cross®, is spelled with a final “e”.

Among consumers, Corn Silk® is best known as the brand of makeup to use for oily skin. Complainant’s Corn Silk® brand is a household name and widely known among consumers. It has been in use continuously since 1965. The words “corn silk” appear in the American Heritage College Dictionary (Third Edition) with the following definition—“the styles and stigmas that appear as a silky tuft or tassel at the tip of an ear of corn.” Complainant’s Corn Silk® brand makeup, however, does not include any form of corn, silk or corn silk and shares no

qualities or features in common with any of them, so that, as used by Complainant, the Corn Silk® mark is entirely arbitrary.

Over the past 10 years alone, Complainant has spent approximately \$18.3 million in advertising and promoting La Cross® and Corn Silk® brand products to retailers and consumers.

Complainant currently maintains two United States Federal trademark registrations relating to its La Cross® brand—Registration Numbers 164,538 (registered February 20, 1923) and 1,661,383 (registered October 22, 1991)—and three United States Federal trademark registrations relating to its Corn Silk® brand—Registration Number 799,233 (registered November 23, 1965), 1,193,832 (registered April 20, 1982), and 1,457,919 (registered September 22, 1987). All these are valid, in force and incontestable.

In August 2000, upon discovering Respondent’s registration of the domain name <lacross.com>, Complainant’s counsel wrote to Respondent, requesting a price to purchase that domain name. When Respondent sought a “reasonable offer”, Complainant’s counsel informed Respondent of Complainant’s ownership of the trademark La Cross® and demanded that the domain name be transferred to Complainant for no more than the amount that Respondent had expended in registering the domain name—as is appropriate under the Anti-Cybersquatting Protection Act, 15 U.S.C. § 1125(d). Complainant did not receive any response.

On December 6, 2001, the Complainant having learned that Respondent had registered Corn Silk® as a domain name, Complainant’s counsel wrote again to Respondent, confirming Complainant’s ownership of the trademarks La Cross® and Corn Silk® and requesting transfer of both domain names to Complainant. Respondent’s counsel replied that Respondent’s domain name <lacross.com> is named for the game of lacrosse—even though the game lacrosse is spelled with an “e” and there are no references at all to the game on Respondent’s web site. Similarly, he also claimed that the domain name <cornsilk.com> is named for “a generic product”—even though there are no references at all to corn silk on Respondent’s web site.

Respondent is owned and controlled by Roy Messer, a well-known domain name cybersquatter. Among other things, Complainant found news articles describing Mr. Messer’s grabbing <kerrey2004.net>, <bayh2004.net>, <biden2004.net> before the politicians of the same name could register these domain names for their own campaigns, grabbing <acrobat.com> when Adobe Systems failed to pay renewal fees for its well-known domain name, and grabbing and exploiting <owenhart.com> after the popular professional wrestler of the same name died at a WWF event in 2000. Mr. Messer is also owner of <harrypottergames.org>—although Mr. Messer certainly has no legitimate rights or interests whatsoever in the name “Harry Potter.”

Identity

The disputed domain names are identical to the Federally registered, incontestable marks LA CROSS and CORN SILK owned by Complainant.

Legitimacy

Respondent has no rights or legitimate interests with regard to either domain name.

Respondent has not used and is not using the disputed domain names in connection with a bona fide offering of goods or services. Instead, Respondent's web page at <**lacross.com**> contains only a generic list of links to other web sites. At the top of the web page is the message "This Site Has Not Yet Been Developed." This message and the list of links to other websites have apparently not changed or been updated since August 2000. Likewise, Respondent has been using (and continues to use) <**cornsilk.com**> to direct users to a web page with no content other than a generic list of links to other web sites and the message "This Site Has Not Yet Been Developed."

A number of Policy decisions have held that lists of generic links to other web sites do not represent a "bona fide offering of goods or services." See, e.g., *Multimatic, Inc. v. Heinz Jakob/Effecta*, AF-0264 (eResolution Sept. 6, 2000); *Workplace Safety and Ins. Bd. v. Kleinman*, FA 96611 (Nat. Arb. Forum Mar. 13, 2001); *Dollar Fin. Group, Inc. v. VQM Net*, FA 96101 (Nat. Arb. Forum Jan. 25, 2001); and *Club Mediterranee v. Beaufort Holding, Ltd.*, D2000-1564 (WIPO Feb. 1, 2001).

Respondent is not commonly known by either of the disputed domain names and certainly has not taken any steps to apply for Federal trademark registration for either of them.

Respondent is not making any legitimate noncommercial or fair use of either domain name. Instead, Respondent's use of the domain names is limited to minimal, "place holder"-type web sites that promise more content in the future—without ever providing any. This can hardly be called legitimate noncommercial or fair use of the domain names.

Bad faith

Respondent has registered and is using the domain names in bad faith.

Respondent admitted in *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*, D2001-0031 (WIPO Apr. 13, 2001) that it is the registered owner of over 400 domain names, a number of which are identical to well-known, Federally registered trademarks belonging to other parties, namely:

<studebaker.org>
<pokemonsounds.com>
<jaguarxjs.com>
<chynawwf.com>
<wwfwarzone.com>
<hillary2004.net>
<futurama.com>

Respondent does not appear to carry out any legitimate business or noncommercial activity on any of its web sites. Apparently, the sole purpose of these web sites is to act as “place holders” for the many domain names owned by Respondent. The web sites all show similar lists of generic links to other web sites and imply that more content will be available in the future, without ever actually providing any real content. This is strong evidence that Respondent and its owner, Roy Messer, are actually in the business of cybersquatting—registering domain names identical to well-known trademarks and then using these registrations to deny the trademark owners the use of the domain name. Ownership of over 400 domain names, many of which are identical to well-known names or trademarks, is incontestable proof that Respondent is engaged in a pattern of this conduct.

Respondent’s claim, through its attorney, that its registration of the name <**lacross.com**> is based on the game of lacrosse is further proof of its bad faith. The game of lacrosse is spelled with a final “e”—as anyone with any legitimate interest in the game would know. There are no references, links or information at all to the game of lacrosse on Respondent’s web site. Respondent’s claim appears to be concocted in a feeble attempt to distance Respondent from a claim of cybersquatting. Respondent’s false statements regarding the reasons for registering this domain name are further proof of Respondent’s bad faith.

Respondent’s claim, also through its attorney, that it registered the name <**cornsilk.com**> to use in the generic sense (the silky tuft at the top of an ear of corn) is ludicrous. At the time that Respondent registered <**cornsilk.com**> (September 2001), Respondent had already received a letter from Complainant’s counsel demanding the return of <**lacross.com**>. The timing of Respondent’s registration of <**cornsilk.com**> suggests that Respondent, having previously locked horns with Complainant over the transfer of <**lacross.com**>, was looking for other Complainant trademarks to register as domain names. Certainly, Respondent cannot claim that its registration of both <**lacross.com**> and <**cornsilk.com**> is sheer coincidence. Claiming this would be beyond belief and is further convincing evidence of Respondent’s bad faith. And if Respondent did not register both names through sheer coincidence, then Respondent must have done so intentionally—again, convincing evidence of Respondent’s bad faith.

B. Respondent

Prior to the receipt of this Complaint, Respondent had no knowledge of the existence of Complainant or any trademarks owned by the Complainant.

Respondent is in the business of warehousing and utilizing domains primarily of a generic nature and at no time has Respondent sought to sell or transfer any such domains to any other party including Complainant.

Respondent registered the disputed domain names and has used them continuously since that date as a search engine.

Respondent has never utilized the domain <**lacross.com**> to sell nail tools or implements, nor used the domain <**cornsilk.com**> to sell makeup.

A search of "Google" search engine for the word "LACROSS" reveals 10800 listings for the word.

Although the proper dictionary spelling of the sport "lacrosse" is with an "e" at the end, the sport is commonly described with or without the "e". The LACROSS name is very popular. It is the name of at least 3 cities (Lacross, Wisconsin, Kansas and Washington), a brand of boots, a brand of shower door enclosures, a brand of ties, the surname of thousands of individuals, a commercial & industrial electrical contractor company, a pattern of carpeting, and a brand of grooming equipment, to name just a few of its uses.

A search of the AOL SEARCH reveals that there are 9398 listings of the word "CORNSILK", and a search of the GOOGLE search engine reveals a total of 45,900 listings. The CORNSILK name is also very popular. In addition to its definition as a part of an ear of corn, there is the cornsilk fly, cornsilk duvet cover, sold by TARGET®, cornsilk capsules used by herbalists, the Cornsilk (tm) Rose, the cornsilk finish, Coleco's CORNSILK KIDS (tm), various person's surnames and Cornsilk's Indian Crafts Mall, to name just a few of its uses.

Respondent denies that it has not used and is not using the domain names for any legitimate business purpose or "other non-commercial activity". Respondent has a legitimate business interest in creating traffic to web sites on the Internet and utilizes these domains among others to do so. Further, Respondent did not acquire these domains to either compete with Complainant or sell them to Complainant or anyone else as evidenced by Respondent counsel's letter to Complainant's counsel indicating that the domains were not for sale.

Respondent denies that it registered or has ever used the disputed domain names in bad faith. At no time has Respondent utilized Complainant's trademarks of the words LACROSS or CORNSILK. Respondent specifically denies each of the circumstances specified in paragraph 4(b) of the Policy.

Complainant points out various other domains allegedly owned by Respondent including six out of 400 that are similar to registered trademarks. Thus, Complainant would automatically brand Respondent as a cybersquatter because of the 1.5% of his domains that are similar to registered trademarks. However, Complainant fails to show how any of these other domains are relevant to this case or how ownership thereof may be considered to be cybersquatting.

Significantly, Complainant refers to *Sweeps Vacuum & Repair Center, Inc. v. Nett Corp.*, D2001-0031 (WIPO Apr. 13, 2001). The holding in that case was in favor of RESPONDENT, wherein the Panel decided that although Respondent's domain <sweeps.com> was identical to Complainant's mark, Respondent had a legitimate business interest in the domain and ruled for Respondent.

Although the Respondent has registered and used in its business <lacross.com> since March 22, 1999, <lacross.net> was only registered by Hakon Haugnes of London, England, in January 2001, which provided Complainant with ample time to acquire that domain, but failed to do so.

Although Complainant was cognizant of Respondent's registration of <lacross.com> in September 2000, by virtue of the letter it wrote to Respondent, it made no attempt to "protect" its trademark "corn silk" by registering the domain <cornsilk.com>. Although Respondent didn't register <cornsilk.com> until September 12, 2001, <cornsilk.net> and all other TLDs are available to Complainant as of the date of filing this response.

Other Administrative Panels have held that resolving domains to search engines comprises a "legitimate business purpose". In *Howard B. Srevens, Inc. dba PCProfessor v. The PC Professor*, D2001-1282 (WIPO Dec. 21, 2001) respondent contended that it "was providing free information services at the web site to which the domain name resolves" (i.e. search engine). The Panel held that "the domain name registered by Respondent is identical to the mark in which the Complainant has rights, but that the Respondent has rights or legitimate interest in respect of the domain name at issue, and that the Respondent's domain name has not been registered and is not being used in bad faith".

The terms "lacross" and "cornsilk" are generic and, although trademarked by Complainant, are in general use by the general public. Thus, they are not "famous", enough for purposes of the Policy, to allow Complainant exclusive use of the words. See *The Clorox Co. v. Marble Solutions*, D2001-0923 (WIPO Nov. 20, 2001) and *Virgin Enter., Ltd. v. Internet Domains*, D2001-1008 (WIPO Oct. 16, 2001).

Complainant cannot and has not exhibited any evidence of “bad faith” registration and use under the Policy, paragraph 4(b)(i) by Respondent.

In *General Mach. Prod. Co., Inc. v. Prime Domains*, FA 92531 (Nat. Arb. Forum Mar. 16, 2000) where the facts were similar, complainant asserted that respondent had no trademark or other intellectual property rights to the domain name; the domain names were not the legal name of respondent; respondent had no prior lawful use of the domain names; respondent was not doing business under the domain name <craftwork.com>; respondent was not using nor were there any demonstrable preparations to use the domain name <craftwork.com> in connection with a bona fide offering of goods or services; respondent as an individual, business or other organization was not commonly known under the domain names; and respondent did not have a legitimate non-commercial fair use of the domain names. All of these allegations are contained in the instant Complaint. Complainant failed to prove that Respondent had no rights or legitimate interest in respect to the domain name.

In the instant case, Complainant’s trademark is not fanciful or arbitrary and Complainant has submitted no evidence to establish either fame or strong secondary meaning in its mark such that consumers are likely to associate <lacross.com> or <cornsilk.com> only with Complainant. See also *Grodberg v. Rugly Enter., LLC.*, FA 92975 (Nat. Arb. Forum Mar. 2, 2000) (where there was no showing that “phonespell” had acquired any secondary meaning).

In *CRS Tech. Corp. v. Condenet, Inc.*, FA 93547 (Nat. Arb. Forum Mar. 28, 2000) the panel found that even though the domain <concierge.com> was identical to complainant’s mark, the mark was not famous or distinctive, and further that “CONCIERGE is not so associated with just one source that only that source could claim a legitimate use of the mark”. Additionally, complainant argued that respondent lacked a legitimate interest in the name because it was never known as CONCIERGE prior to using the domain name and was notified of complainant’s objections before it commercially launched its site. The Panel found those arguments to be without merit.

It has been held that a complainant is required to prove not only that the domain has been registered in bad faith, but that it is also being used in bad faith.

Identity/confusing similarity

It is obvious that Complainant’s trademarks “LACROSS” and “CORNSILK” and Respondent’s domains <lacross.com> and <cornsilk.com> are virtually identical. However, there is nothing independently famous about Complainant’s trademarks. The words “lacross” and “cornsilk” are common words with a number of uses. Thus, even though the domains are similar to the trademarks, no confusion is generated.

Legitimacy

Respondent can prove that it has “rights or a legitimate interest in respect to the domain names” in that they are being used in its business. The fact that some other domain names

registered by Respondent may be identical to trademarks owned by others is, in itself, insufficient evidence of the intent to profit from or otherwise abuse such trademark rights.

Bad faith

Complainant cannot provide any evidence to indicate that Respondent knew or should have known of its trade name use or trademark registrations such as a direct relationship or wide reputation of or extensive publicity in connection with Complainants' trade name or trademarks. Respondent affirmatively alleges that it had no such knowledge when registering the domain names <lacross.com> and <cornsilk.com>, nor does it have such knowledge in the use of that domain.

There is no evidence in the Complaint or in its attachments that Respondent registered the disputed domain names for the purpose of disrupting the business of a competitor. Nor can the Complainant show that Respondent intentionally attempted to create a likelihood of confusion with Complainants' mark.

C. Additional Submissions

Complainant

Complainant has presented:

- documentary proof that Complainant's brand names LA CROSS® and CORN SILK® are the subject of five Federal trademark registrations, all of which are valid, in force, incontestable and owned by Complainant;
- documentary proof that Respondent has no rights or legitimate interests with regard to either domain name—and, in fact, that Respondent does not even use the domain names except to direct users to two minimal "place holder" web pages that contain nothing but a list of links to generic search topics; and finally
- documentary proof that Respondent has registered and is using the two domain names in bad faith—and specifically, that Respondent is in the business of cybersquatting on famous trademarks owned by others, like those owned by Complainant.

These three facts are the only ones necessary for this Panel to grant Complainant's request for transfer of the domain names under the Policy. Respondent does not present evidence to contradict any of these three facts. Specifically, Respondent does not deny that Complainant's Federal trademark registrations are valid, in force, incontestable and owned by Complainant, that the two domain names resolve to minimal "place holder" web sites, or that Respondent is the owner of a number of domain names that are identical to famous trademarks owned by others.

Nor does Respondent offer any explanation or evidence as to how or why it chose to register two domain names identical to well-known trademarks owned by Complainant or

why it continues to use them despite knowledge of Complainant's rights in these names. Respondent's silence on these issues is further proof of its bad faith.

Instead, Respondent offers only a string of half-truths and irrelevancies that do not contradict the documentary proof presented in Complainant's complaint. Each of them is discussed separately below.

First, Respondent identifies itself as being "in the business of warehousing and utilizing domains primarily of a generic nature" and "creating traffic to web sites on the Internet." As it turns out, however, all of Respondent's domain names (or at least all of the ones located by Complainant) resolve to virtually identical web pages; in none of which is there anything to suggest that Respondent is engaged in any legitimate business at all. The web sites do not offer any advertising, text, pictures, video or any other sort of recognizable content. Instead, all of the web pages contain the same list of generic links and state "This Site Has Not Yet Been Developed," as though Respondent plans to add content to the site in the future. However, no such content has ever been added. How can Respondent claim that it is in the business of "utilizing" domain names such as <lacross.com> and <cornsilk.com> and "creating traffic" for its web sites when its domain names resolve to web sites that are nothing more than identical, minimal "place holders"? The Panel can safely reject these claims as completely unsupported by the facts.

Interestingly, however, Complainant has been able to locate some clues as to Respondent's true business—registering and reselling domain names. Complainant recently located a web site at the address <domainsforsale.com> that is virtually identical to that reached through the disputed domain names. The domain name <domainsforsale.com> is registered to a Cayman Islands corporation, so information about the true owner of this web site is not readily available. However, the similarities between this web site and Respondent's other web sites are striking. And the name of the web site—"domains for sale"—describes Respondent's business exactly. It would be difficult to imagine how two completely unrelated entities came up with web sites as closely matched as these two. The Panel should reject Respondent's self-serving but inaccurate description of its business.

Next, Respondent claims that prior to its receipt of Complainant's Complaint, Respondent "*had no knowledge of the existence of Complainant . . . or any trademarks owned by the Complainant.*" But—as Respondent knows—this statement is completely false. In September 2000, Complainant's counsel wrote a formal demand letter to Respondent in which counsel identified Complainant, listed the trademarks owned by Complainant, and demanded that Respondent transfer the domain name <lacross.com> to Complainant for cost. Complainant's counsel even wrote a second letter to Respondent in December 2001, after discovering that Respondent had also grabbed the domain name <cornsilk.com>. Based on these documents, it is clear that Respondent did indeed know of Complainant and its trademarks since September 2000 and the Panel should reject Respondent's claimed ignorance of Complainant and its marks.

Then, Respondent goes to some length in describing various occurrences of the words “lacross” and “corn silk” on the Internet. But, while it may be true that the words “lacross” or “corn silk” appear elsewhere on the Internet, this fact is completely irrelevant to the issues in this case. As Respondent does not dispute, Complainant owns five valid and incontestable Federal trademark registrations for its brands LA CROSS® and CORN SILK®—which have been in force over 80 years and over 30 years, respectively. In the past 10 years alone, Complainant has spent over \$18 million in advertising and promoting these two brands—through consumer and trade magazine advertising, trade shows, samples, point-of-sale displays and radio and television advertising. And Complainant’s promotions and advertising have resulted in significant sales—over \$50 million in worldwide sales for these two brands alone. Under these circumstances, there is no argument that—regardless of occasional, unrelated use of these words by others on the Internet—Complainant has legitimate and significant rights in the two marks.

Nor is occasional use of the words “lacross” and “corn silk” by others evidence of Respondent’s supposed “good faith” in this matter. Apparently, Respondent offers evidence of other people’s innocent use of these words in the hope that the Panel will assume that Respondent had something else in mind besides Complainant’s trademarks when it registered these marks as domain names. But shouldn’t Respondent itself be able to tell the Panel exactly what it had in mind when it registered these two domain names? In other words, if Respondent registered <lacross.com> to refer to a city in Wisconsin (which is spelled La Crosse, incidentally), Respondent could have simply said so in its papers. Or if, for example, Respondent registered <cornsilk.com> to refer to “cornsilk capsules used by herbalists,” again, Respondent could have simply said so. Yet there is no such explanation at all.

And for good reason too—Respondent cannot explain how it arrived at these two domain names because Respondent’s only explanation is that it was intentionally copying trademarks owned by Complainant for the purpose of profiting from these marks. What else would Respondent say—that, just by coincidence, it registered a misspelling of a popular college sport and a part of a corn plant and, completely by chance, somehow ended up owning domain names identical to two of Complainant’s best-known consumer brand names?? This is so unbelievable that even Respondent knows to leave it out of its papers. And so Respondent does not give this Panel any explanation at all as to how it arrived at these two domain names.

Respondent’s failure to explain how it arrived at these domain names is particularly damning here, where there is already persuasive evidence of Respondent’s bad faith in this matter. Complainant has already uncovered and presented to the Panel reliable, documentary evidence showing that Respondent is the owner of a number of domain names identical to famous trademarks owned by others, including <jaguarxjs.com>, <pokemonsounds.com>, <harrypottergames.org> and <chynawwwf.com>. Respondent does not dispute any of this evidence or offer any other explanation showing any good faith in this matter. Given all these facts and Respondent’s silence on this issue,

Complainant respectfully suggests to the Panel that there can be no honest debate over Respondent's bad faith registration and use of the domain names in this case.

Finally, Respondent claims that it cannot be accused of being a cybersquatter because only 1.5% (6 out of 400) of its domain names are similar to famous names or trademarks registered to others. But this is simply false—as Respondent well knows. First, Complainant has identified at least 15 domain names that are owned by Respondent or its principal Roy Messer and are identical to famous names or trademarks owned by others. Second, and more importantly, no one other than Respondent has access to Respondent's complete list of domain names—so no one can say whether there aren't other domain names like <jaguarxjs.com> besides the 15 already found by Complainant in Respondent's portfolio. (Searches on Network Solutions' WHOIS database are now limited to the first 10 results, so that no one other than Respondent can retrieve a complete list of its domain names.) In other words, Respondent may claim in its papers that only 1.5% of the domain names it owns are identical to famous trademarks owned by others, but it is hard to believe this assertion when Respondent fails to reveal the complete list of domain names that it owns. At the very least, Complainant's evidence shows that Respondent has invested its time and money into registering and maintaining a number of domain names whose only value is their connection to famous marks owned by others—marks in which Respondent has no legitimate right or interest. And this pattern of cybersquatting on famous marks owned by others is highly relevant in evaluating Respondent's behavior in this case.

There may be others using the words “lacross” and “corn silk” on the Internet in a manner that is completely innocent and does not infringe upon any of Complainant's rights in these trademarks. However, other people's use of these words is not at issue here. Instead, the sole question before this Panel is whether Complainant has satisfied the three elements of the ICANN Policy and thus is entitled to the transfer of these domain names.

FINDINGS

The Panel finds that the disputed domain names are identical to trademarks in which the Complainant has rights; the Respondent has no rights or legitimate interests in respect of the disputed domain names and that those names were registered and are being 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.” Since both parties and the Registrar are resident in the United States, it is appropriate to apply principles of United States law.

Paragraph 4(a) of the Policy requires that the 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 the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (2) the 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

Essential or virtual identity is sufficient for the purposes of the Policy: see *The Stanley Works and Stanley Logistics, Inc v. Camp Creek. Co., Inc.*, D2000-0113 (WIPO Apr. 13, 2000), *Toyota Jidosha Kabushiki Kaisha v. S&S Enter. Ltd.*, D2000-0802 (WIPO Sept. 9, 2000); *Nokia Corp. v. Nokiagirls.com*, D2000-0102 (WIPO Apr. 18, 2000) and *Blue Sky Software Corp. v. Digital Sierra Inc.*, D2000-0165 (WIPO Apr. 27, 2000).

See also *Sporty's Farm L.L.C. v. Sportsman's Market, Inc.*, 202 F.3d 489, 497-98 (2d Cir. 2000) (the differences between the trademark "sporty's" and the domain name <sportys.com> – specifically, an apostrophe in the trademark and the addition of .com in the domain name – are "inconsequential", such that the domain name is "indistinguishable" from and "certainly 'confusingly similar' to the protected mark"); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999) (differences between the domain name <moviebuff.com> and the mark "MovieBuff" are "inconsequential"). See also *Public Serv. Co. v. Nexus Energy Software, Inc.*, 36 F.Supp.2d 436 (D. Mass. 1999) (<energyplace.com> and "Energy Place" are virtually identical); *Minnesota Mining & Mfg. Co. v. Taylor*, 21 F.Supp.2d 1003, 1005 (D.Minn. 1998) (<post-it.com> and "Post-It" are the same); *Interstellar Starship Services Ltd. v. EPIX, Inc.*, 983 F.Supp. 1331, 1335 (D.Or. 1997)(<epix.com> "is the same mark" as EPIX); *Planned Parenthood Federation of America, Inc. v. Bucci*, No. 97-0629, 1997 WL 133313, at *8 (S.D.N.Y. Mar. 24, 1997) (<planned-parenthood.com> and "Planned Parenthood" are essentially identical), *aff'd*, 152 F.3d 920 (2d Cir. 1998), *cert. denied*, 525 U.S. 834, 119 S.Ct. 90, 142 L.Ed.2d 71 (1998).

The Respondent acknowledges that the Complainant's trademarks and the disputed domain names are virtually identical and the Panel so finds. The Complainant has established this element.

Rights or Legitimate Interests

On the material before the Panel it appears that Respondent, Nett Corporation, is not commonly known by either of the disputed domain names. It is clear from the Complaint and from the correspondence between the parties that Complainant has not licensed or otherwise authorized Respondent to register the disputed domain names nor to use its trademarks. Those marks have been registered in the United States for many years in

connection with Complainant's goods and those registrations are incontestable. The widespread availability over many years of Complainant's goods in national retail chain stores throughout the United States and the large volume of such of inexpensive articles required to generate over US\$50 million in annual worldwide sales leads the Panel to conclude that the Complainant's marks are well-known amongst consumers, including consumers in Tallahassee, Florida, where Respondent is located, and have become distinctive, in the fields of nail implements and makeup, of Complainant's products.

These circumstances are sufficient to constitute a *prima facie* showing by Complainant of absence of rights or legitimate interest in the disputed domain names on the part of Respondent. The evidentiary burden therefore shifts to Respondent to show by concrete evidence that it does have rights or legitimate interests in those names: *Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) and the cases there cited.

Respondent contends the terms "lacross" and "cornsilk" are generic and, although trademarked by Complainant, are in general use by the public and are thus not "famous" enough for purposes of the Policy, to allow Complainant exclusive use of the words. It cites as authority for this proposition *The Clorox Co. v. Marble Solutions*, D2001-0923 (WIPO Nov. 20, 2001) and *Virgin Enter., Ltd. v. Internet Domains*, D2001-1008 (WIPO Oct. 16, 2001). Neither of those cases supports that proposition.

In *Clorox* the Panel specifically rejected the submission that the word Clorox had become generic for bleach and also found for Complainant on the issue of legitimacy. In *Virgin* the domain name <virginmail> was found not to be identical or confusingly similar to the trademark VIRGIN. Moreover, respondent was found to have a legitimate interest in the domain name because of the use to which that name was put (an adult website featuring sexually inexperienced females). That use had some connection with the domain name, a feature notably absent here.

In any event, the proposition is untenable. Respondent appears to concede that words in common use are not barred from registration or use as trademarks where, as here, they are arbitrary in relation to the goods or services in connection with which they are used. In requiring a complainant to establish both rights in a trademark and absence in the respondent of any rights or legitimate interests in the domain name, the Policy contemplates that a complainant may succeed in the absence of an entitlement to exclusive use of the words comprising the mark.

Respondent points to *General Mach. Prod. Co., Inc. v Prime Domains*, FA 92531 (Nat. Arb. Forum Mar. 16, 2000) as factually similar, where complainant failed to establish this element. The registered mark in that case was stylized and the relevant passage in that case was:

"General Machines has not proven, however, that Prime Domains has no legitimate interests in respect of the domain name craftwork.com. General Machines' trademark is not fanciful or arbitrary, and General Machines has

submitted no evidence to establish either fame or strong secondary meaning in its mark such that consumers are likely to associate craftwork.com only with General Machines. As Prime Domains has demonstrated, the term "craftwork" is in widespread use in a descriptive sense. The Panel finds therefore that Prime Domains has rebutted General Machines' arguments and has proven that it is in the business of selling generic and descriptive domain names such as craftwork.com. As a result, Prime Domains does have a legitimate interest in the domain name. That Prime Domains has offered to sell this descriptive, non-source identifying domain name does not make its interest illegitimate”.

Here, Complainant has submitted evidence of its use and advertising of the marks (Complaint Ex. B, D and F) and Respondent has not contradicted Complainant’s assertions as to the value of its annual sales, its advertising expenditure and nationwide distribution. Respondent has noted the dictionary meanings of lacrosse and corn silk but has pointed in particular to the use of these terms by others as brands.

The Panel is of the view that “la cross” (without a final “e”) is not descriptive at all and that “corn silk” is not in widespread use as a descriptive expression to the same degree as craftwork. It finds on the evidence and on Complainant’s uncontradicted assertions that CORN SILK has achieved secondary meaning amongst consumers in the United States as denoting Complainant’s makeup products and that LA CROSS denotes Complainant’s nail products. Accordingly the Panel considers that the facts of this case differ from those found in *General Machines*. For the same reason the Panel does not find Respondent’s citations of *Grodberg v. Rugly Enterprises, LLC*, FA 92975 (Nat. Arb. Forum Mar. 2, 2000) <phonespell.com> or *CRS Technology Corp. v. Condenet, Inc.*, FA 93547 (Nat. Arb. Forum Mar. 28, 2000)<concierge.com> to be persuasive.

Respondent states that prior to receipt of this Complaint, it had no knowledge of the existence of Complainant or of any trademarks owned by Complainant (Response [5.1]). In light of Complainant’s counsel’s letters to Respondent dated September 8, 2000 (Complaint Ex. I) and December 6, 2001 (Complaint Ex.K) the Panel does not accept this assertion.

Respondent describes its business as warehousing and utilizing domain names primarily of a generic nature [emphasis added by the Panel]. It does not deny Complainant’s assertion that it has also registered some domain names incorporating the well-known trademarks of others. It states that it has used the disputed domain names continuously since registration as a search engine. It claims a legitimate business interest in creating traffic to web sites on the Internet and that it utilizes the disputed domain names, among others, to do so. Although no detail is provided as to how the generation of such traffic constitutes a business, the Panel accepts that Respondent derives commercial gain from this activity.

Respondent has several web sites displaying virtually identical layout and content, in no case mentioning or having anything explicitly to do with the domain name that leads to

the site (such as lacross, cornsilk, studebaker, jaguarxjs, chynawwf, wwfwarzone and futurama) (Complaint Ex. H, J and N) but in each case stating “This Site Has Not Yet Been Developed” and offering arriving Internauts opportunities to reach other web sites in which they might have an interest.

To arrive at Respondent’s sites connected to the disputed domain names in the first place, the Internaut must be looking for <**lacross.com**> or <**cornsilk.com**>. It is possible that some Internauts might be interested in the sport of lacrosse and omit to type the final “e”, either by design or by accident. It is possible that others might be interested in the silky tuft or tassel at the tip of an ear of corn. The absence from those sites of any content relating to the common English meanings of the disputed domain names leads the Panel to conclude that, contrary to its assertions, Respondent did not have those meanings in mind when it registered the disputed domain names and that Respondent’s use of the disputed domain names to resolve to search sites unrelated to the names themselves is not bona fide use. See, e.g *Multimatic, Inc. v Heinz Jakob / Effecta*, AF0264 (eResolution Sept. 16, 2000):

“Far more is needed to show use or proper preparation for such use, on which legitimacy can be predicated, than merely linking, through a third-party site, a contested domain name to a page containing a list of links”.

Respondent cites *Howard B. Srevens, Inc. dba PCProfessor v. The PC Professor*, D2001-1282 (WIPO Dec. 21, 2001) as authority for the proposition that resolving domain names to search engines comprises a legitimate business purpose. The domain name in that case did not resolve to a search engine but to a web site at which respondent answered questions related to personal computers without charge for the inquiry.

Having regard to Complainant’s well-known, longstanding trademarks and the widespread availability in the United States of its products, the Panel concludes that most Internauts arriving at Respondent’s sites <**lacross.com**> and <**cornsilk.com**> are looking for a site associated with Complainant’s products and that Respondent derives commercial benefit from this traffic. Since the volume of traffic likely to be generated from seekers of information about the game of lacrosse and about tassels on the tips of ears of corn is minuscule by comparison with that likely to be generated from persons interested in Complainant’s products, the Panel regards it as highly improbable, to say the least, that Respondent was unaware of the reputation enjoyed by Complainant’s trademarks when registering the disputed domain names. The Panel finds Respondent was so aware.

Use which intentionally trades on the fame of another cannot constitute a “bona fide” offering of goods or services: *Ciccione, p/k/a Madonna v. Parisi and “Madonna.com,”* D2000-0847 (WIPO Oct. 12, 2000).

Respondent has not demonstrated by concrete evidence that it has rights or legitimate interests in respect of the disputed domain names. Complainant has established this

element.

Registration and Use in Bad Faith

Respondent points to other users of the words lacross, lacrosse and corn silk and to the interests of others in those words as trademarks or domain names. The Policy does not call upon the Panel to consider nor to adjudicate the rights of others not present in the proceeding. The Panel is instructed to evaluate only the rights, interests, and conduct of the parties. In this regard the Panel respectfully adopts the dissenting opinion in *First Am. Funds, Inc. v Ult. Search, Inc.*, D2000-1840 (WIPO Apr. 20, 2001).

In *SportSoft Golf, Inc. v. Hale Irwin's Golfers' Passport*, FA 94956 (Nat. Arb. Forum July 11, 2000) a finding of bad faith was made where the respondent "knew or should have known" of the registration and use of the trade mark prior to registering the domain name. Likewise *Marriott Int'l, Inc. v. Marriot*, FA 94737 (Nat. Arb. Forum June 15, 2000); *Canada Inc. v. Ursino*, AF-0211 (eResolution July 3, 2000) and *Centeon L.L.C./Aventis Behring L.L.C. v. Ebiotech.com*, FA 95037 (Nat. Arb. Forum July 20, 2000).

Here the Panel finds Respondent had actual knowledge of Complainant's marks and did not register the disputed domain names with the common dictionary meanings of lacrosse or corn silk in mind. Under these circumstances Respondent's reliance upon dictionary meanings is of no avail:

"The statement that "madonna" is a word in the English language, by itself, is no more of a defense than would be the similar statement made in reference to the word "coke". Respondent has not even attempted to tie in his web site to any dictionary definition of madonna. The only plausible explanation for Respondent's actions appears to be an intentional effort to trade upon the fame of Complainant's name and mark for commercial gain": *Cicccone, p/k/a Madonna v. Parisi and "Madonna.com,"* D2000-0847 (WIPO Oct. 12, 2000).

The Panel finds that, in generating traffic to his web sites, with knowledge of Complainant's marks, Respondent has used the disputed domain names intentionally to attract, for commercial gain, Internauts to his web sites by creating a likelihood of confusion with Complainant's marks as to the source, sponsorship, affiliation or endorsement of Respondent's web sites. This is evidence of both bad faith registration and use under paragraph 4(b)(iv) of the Policy.

Complainant has established this element.

DECISION

Pursuant to Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel directs that the

domain names <**lacross.com**> and <**cornsilk.com**> be **transferred** to Complainant.

Alan L. Limbury
Presiding Panelist

M. Scott Donahey
Panelist

Peter L. Michaelson
Panelist

Dated: March 26, 2002

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