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Unearthed truth: lack of evidence from complainant means success for respondent

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- The owner of the TRU EARTH mark sought the transfer of the domain name 'mytrueearth.com' under the UDRP
- The panel found that the respondent had made demonstrable preparations to use the domain name in connection with a *bona fide* offering of goods/services before notice of the dispute
- The evidence was insufficient to give rise to a finding of registration in bad faith

In a recent [decision](#) under the [Uniform Domain Name Dispute Resolution Policy](#) (UDRP) before WIPO, a panel has denied the transfer of the domain name 'mytrueearth.com', finding that the complainant failed to provide sufficient evidence to demonstrate that the respondent lacked rights or legitimate interests in the domain name and that the domain name was registered and used in bad faith.

Background

The complainant was My Passion Media Inc, incorporated in British Columbia, Canada. The complainant offered laundry detergents and products under the TRU EARTH trademark and sold Tru Earth-branded detergent internationally. The complainant's other Tru Earth-branded products included eco-strips laundry detergent, wool dryer balls, multi-surface cleaner, stainless steel straws, bamboo cutlery sets, beeswax food wraps and reusable cotton mesh product bags. For use in connection with its products, the complainant had obtained trademark registrations for TRU EARTH, including US Trademark Registration No 6206861 for the word mark TRU EARTH, filed on 16 August 2019 and registered on 24 November 2020, showing a claimed date of first use in commerce of 3 April 2019. In 2020 the complainant enjoyed notoriety in the Canadian business media in light of its substantial business growth. The complainant also enjoyed a substantial following on social media.

The respondent was Constantina Anagnostopoulos, Mytrueearth of the United States.

The evidence on record indicated that, between October 2018 and September 2020, the respondent had been engaged in the development of a cleaning product. In March 2019 the respondent entered into discussions with a graphic designer for the respondent's business, and in June 2019, it engaged in correspondence with an attorney regarding the use of the name True Earth Company, including a search on the Illinois companies database for the same. The disputed domain name, 'mytrueearth.com', was created on 10 July 2019. Since 5 October 2019, the domain name was used by the respondent for a website entitled "TRUE EARTH", which initially offered True Earth-branded multi-surface cleaner for sale and later added True Earth-branded wool dryer balls. On 30 November 2020 the respondent received a trademark infringement notice. On 4 December 2020 the respondent removed the dryer balls from its online store.

To be successful in its complaint, a complainant must satisfy the three elements set forth under Paragraph 4(a) of the UDRP:

- The domain name registered by the respondent is identical, or confusingly similar, to a trademark or service mark in which the complainant has rights;
- The respondent has no rights or legitimate interests in respect of the domain name; and
- The domain name has been registered and is being used in bad faith.

Decision

Paragraph 4(a)(i)

The panel found that the complainant had UDRP-relevant registered rights in the trademark TRU EARTH.

In comparing the disputed domain name and the trademark, on a straightforward side-by-side basis, the panel found that the domain name was confusingly similar to the complainant's trademark. The domain name added the letter 'e' to make the dictionary word 'true' and prefixed the word 'my'. Such additional elements did not change, for the panel, the fact that the complainant's mark was sufficiently recognisable in the domain name.

The panel further noted that both the domain name and the complainant's trademark were aurally identical. In these circumstances, the complainant had satisfied the first element set out in Paragraph 4(a) of the UDRP.

Paragraph 4(a)(ii)

Ways in which a respondent may demonstrate rights or legitimate interests in a domain name are set forth in Paragraph 4(c) of the UDRP.

In this case, the panel's findings on the issue of rights and legitimate interests focused upon the respondent's conduct in its registration and use of the disputed domain name. The panel asked itself whether the evidence on record tended to indicate that the respondent had registered the domain name with knowledge of the rapid growth and success of the complainant's business, operating under the then-unregistered trademark TRU EARTH.

The panel found that the respondent had engaged in demonstrable preparations to use the disputed domain name, and that when the respondent registered the domain name, it could not have known of the complainant's registered trademarks, which were filed one month after the date of registration of the domain name.

In determining whether the respondent might have otherwise known of the complainant, the panel noted that a "degree of suspicion" might have arisen regarding the unusual approach that the respondent engaged in when it registered the disputed domain name - restricted to consulting the Illinois state database. Absent a more generalised search, such a restrictive inquiry could have suggested that the respondent intended not to find the complainant's existence by looking at source materials where the respondent knew that the complainant could not be found. Nevertheless, the panel emphasised that this was not enough for it to conclude, on balance, that the respondent had any such intention. The panel noted in this regard that the complainant's evidence failed to provide adequate detail as to its probable notoriety at the material time. The panel also took note of a list of some 17 URLs produced by the respondent, indicating many brands using 'tru', 'true' or 'earth' in domain names relating to environmentally-conscious and sustainable businesses.

The panel was satisfied that the respondent had made demonstrable preparations to use the disputed domain name and corresponding brand name in connection with a bona fide offering of goods and services before notice of the dispute. The panel found that the complainant had failed to prove that the respondent had no rights and legitimate interests in the domain name and had therefore not satisfied the second element of the UDRP.

Paragraph 4(a)(iii)

The panel noted that many of its findings in relation to the circumstances in which the domain name was registered, as noted under the preceding element, were also relevant to the third element. The panel stressed that, while certain attempts have been made to imply the concept of retroactive bad faith, the current UDRP jurisprudence is clear in that no such approach is permissible and that the respondent must be shown to have known of, and to have targeted, the complainant's trademark at the date of registration of the disputed domain name. In the present case, the evidence before the panel was insufficient to give rise to a finding of registration in bad faith, as the complainant had not proved that the registration was made with the requisite knowledge or intent.

In light of its findings in relation to the second element of the UDRP, and noting the complainant's failure to demonstrate bad-faith registration of the domain name, the panel considered it unnecessary to reach a definitive finding on the question of whether the domain name was used in bad faith.

The panel went on to note that the parties may have a wider trademark dispute, going beyond the registration and use of the disputed domain name. The complaint was therefore denied.

Comment

This decision illustrates the importance for complainants to convincingly establish the existence of their trademarks or their reputation at the time a disputed domain name was registered, in order to prove bad faith, rather than at the time that commercial use is being made of the domain name. It also underlines the relatively narrow scope of the UDRP, intended to resolve instances of abusive domain name registration and use, rather than broader trademark infringement disputes.

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