

ADMINISTRATIVE PANEL DECISION

Redgrass SA v. Domain Admin, HugeDomains.com
Case No. D2022-2433

1. The Parties

The Complainant is Redgrass SA, Switzerland, represented by Riccardo Ciullo, Spain.

The Respondent is Domain Admin, HugeDomains.com, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <redgrass.com> is registered with TurnCommerce, Inc. DBA NameBright.com (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 5, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On July 7, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the disputed domain name.

The Center verified that the Complaint 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 the Respondent of the Complaint, and the proceedings commenced on July 13, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 2, 2022. The Response was filed with the Center August 2, 2022.

The Center appointed Matthew Kennedy, Rodolfo Rivas Rea and The Hon. Neil Brown Q.C. as panelists in this matter on August 24, 2022. The Panel finds that it was properly constituted. Each member of the Panel has submitted a 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

The Complainant, Redgrass SA, sells miniature paintings. It was established in Switzerland on June 23, 2020 for certain purposes related to art, in particular painting. Its legal representative is Mr. Fabrice Massad. It operates a website at "www.redgrassgames.com" where it provides information about itself and its products, including wet palettes and desk lamps. According to evidence provided by the Complainant, it has registered several industrial designs since August 2020 and it applied for a patent for a wet palette in September 2021. In the 2021 financial year it declared sales of over CHF 1 million. The Complainant holds multiple trademark registrations in multiple jurisdictions, including the following:

- Chinese trademark registrations numbers 40362378 and 40362379, both for REDGRASS and device, registered on August 14, 2020 and March 28, 2020, respectively, specifying goods in classes 16 and 8, respectively;
- Chinese trademark registrations numbers 40362380 and 40362381, both for REDGRASSGAMES, both registered on March 28, 2020, specifying goods in classes 16 and 8, respectively;
- European Union trademark registrations numbers 018322289 and 018322296 for REDGRASSGAMES and REDGRASS, respectively, both registered on March 24, 2021, both specifying goods in classes 2, 8, 11, 16, and 28; and
- United States trademark registrations numbers 6,599,673 and 6,599,674 for REDGRASS and REDGRASSGAMES, respectively, both registered on December 28, 2021, specifying goods in classes 2, 11, and 16, and classes 2 and 16, respectively.

The above trademark registrations remain current.

Previously, in December 2015, Mr. Massad established a French company named Redgrass SAS for the purpose of software publishing. On June 9, 2017, Mr. Massad established another French company named RedgrassGames SAS for purposes related to accessories and applications for board games and figurines. RedgrassGames SAS registered one industrial design in September 2017 and several more in November 2018. "Redgrass" launched a Kickstarter campaign for an "Everlasting Wet Palette" for miniature painting in September or October 2017. "RedGrassGames" is a YouTube channel that publishes various videos about miniature painting. Redgrass SAS was voluntarily liquidated in April 2019.

The Respondent is a reseller of domain names. According to evidence provided by the Respondent, it has a large portfolio of domain names, including many that begin with "red", some of which end with a plant species, including <redalmond.com>, <redchestnut.com>, <redclove.com>, <redflax.com>, <redmoss.com>, <redhay.com>, <redhedge.com>, <redlavender.com>, <redlupin.com>, <redpeach.com>, <redpistachio.com>, <redrhubarb.com>, and <redrye.com>. It also owns many domain names that end with "grass". According to information provided by the Complainant, panels in certain prior UDRP proceedings have found that the Respondent registered and was using other domain names in bad faith. However, evidence provided by the Respondent shows that it was not the respondent in one of those UDRP proceedings and that the decision in another such proceeding was set aside by a Court.

The disputed domain name was created in 1999. According to an undisputed assertion by the Respondent, it was acquired by the Respondent on June 22, 2017. The disputed domain name resolves to the Respondent's website. It is advertised for sale on that website for the price of USD 14,095.

The Complainant, through its legal representative, sent an email to the Respondent dated February 23, 2021 claiming that the Complainant should legitimately own the disputed domain name but could not move forward with its project due to the passive holding and "disproportionate sale costs" imposed by the Respondent; it also alleged that it was suffering economic losses as a result. The Respondent replied on the following day, disputing the Complainant's claim, providing the timeline of the registrations, dictionary definitions of "redgrass" and "red grass", and evidence of third parties' use of those terms. The Parties

exchanged further emails on March 1, 2021, in which the Complainant made an offer to buy the disputed domain name for USD 3500 and the Respondent made a counter-offer of USD 13,995, or a payment plan of up to 12 months based on the list price.

5. Parties' Contentions

A. Complainant

The Complainant is the right holder of the trademarks REDGRASS and REDGRASSGAMES. The Complainant's company names registered in 2015 and 2017 qualify as relevant prior rights "on a two commercial name and/or earlier unregistered trademark rights" acquired by the Complainant at least two years prior to the acquisition of the disputed domain name by the Respondent. The disputed domain name is identical to the Complainant's protected sign REDGRASS and is highly similar to the Complainant's protected sign REDGRASSGAMES.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has been passively holding the disputed domain name since 2017 without any evidence of active use in the market. Its main business is the reselling of domain names without offering goods or services. The Respondent has not been commonly known by the disputed domain name. The fact that the disputed domain name is on sale for such a high price reinforces the fact that the Respondent is making an unfair commercial use not allowing the legitimate right holder of trademarks identical and akin to the disputed domain name to use it in a fair way for commercializing goods and services in the online market. It is also interesting to note that a period of five years has already passed since the Respondent's acquisition of the disputed domain name without any use of it in the market. Five years is exactly the grace period established by several trademark laws in relation to the legal obligation to use the mark. This means that, by analogy, the inactivity of the Respondent would not be justified either from the perspective of international trademark law. It is not true that the name REDGRASS is generic. The name in question is clearly a fanciful sign which can perfectly work as an indication of commercial origin of products and services and specifically of the products commercialized by the Complainant. A cursory worldwide trademark search for REDGRASS returns only 13 hits, most of which are owned by the Complainant.

The disputed domain name was registered and is being used in bad faith. The Respondent has registered the disputed domain name solely for the purpose of reselling it for valuable consideration in excess of documented out-of-pocket costs. In circumstances where the disputed domain name holder is making no legitimate use of it and the advertised price is far more than the Respondent's out-of-pocket costs, bad faith can exist even if no direct business relationship existed between the Complainant and the Respondent at the time of the disputed domain name acquisition. It is clear that the Complainant had a legitimate interest in the disputed domain name as its established business has been running since 2015, using the name "redgrass" for both companies in 2015 and 2017, and protected as European and International trademarks, extending to Canada, Switzerland and the United States (apart from additional protection in China, dating back to 2019). It is interesting to notice that the Respondent owns a series of domain names including the suffix "grass". Most of them are on sale at a high but still "relatively reasonable" price (ranging from USD 1,895 to USD 4,095) if compared with the absolutely disproportionate purchase price of the disputed domain name which is still USD 14,095. In the present case, there is an obvious intention to abuse and monetize the right holder's commercial need to own the disputed domain name identical to its brand, which is now not possible due to the Respondent's passive holding. The Complainant is the entity that should legitimately own the disputed domain name.

B. Respondent

The Respondent acquired the generic disputed domain name more than three years before the Complainant applied for its first trademark application. The 2015 French company registration has been cancelled and that company operated in the field of computer programming, not miniature painting. The 2017 French company registration is for "redgrassgames", not "redgrass". The Complainant does not have an exclusive

worldwide right to the term “redgrass” and in June 2017 it did not have any registered trademark rights for “redgrass”. “Red grass” or “redgrass” is defined in the Merriam-Webster Dictionary as a “southern African grass, used for pasture and forage”. “Red” and “grass” both have their own dictionary meanings and when combined can have several meanings. Numerous books cite “red grass”. “Redgrass” was not first coined by the Complainant and it is not a unique phrase used solely by the Complainant. The Complainant lacks the trademark rights that would justify the filing of this Complaint.

The Respondent has legitimate interests in the disputed domain name. The Respondent is using the disputed domain name in connection with a *bona fide* offering of goods and services. The Respondent is a reseller of generic and descriptive domain names. Selling generic domain names is a legitimate business practice. The Respondent is not required to operate an active website nor to operate or be known as “redgrass” nor to offer goods that bear the mark corresponding to a domain name. The Respondent owns many domain names that are similar to the disputed domain name. “Redgrass” is generic and dictionary-defined and used by hundreds of businesses, organizations, and individuals.

The disputed domain name was not registered and is not being used in bad faith. The Respondent cannot be found to have engaged in both registration and use in bad faith as it has a legitimate interest in this generic domain name. The Complainant’s arguments and annexes lack any evidence to support the Complainant’s unresearched statements. The Complainant does not have a trademark for “redgrass” that predates the Respondent’s June 2017 registration of the disputed domain name. The Complainant is overreaching in basing its claim on a cancelled computer programming foreign business registration and a foreign business registration for the longer term “redgrassgames”. The Complainant’s annexes show that it operates under the name “redgrassgames” or “redgrass games”; using this term for its online business in no way gives it an exclusive right to the shorter generic term “redgrass” nor does it justify filing the Complaint. The Complainant cannot claim that the Respondent registered the disputed domain name with the intent to sell it to the Complainant; the Respondent had never heard of the Complainant until contacted in February 2021. The Respondent never reached out to the Complainant to try to sell the Complainant the disputed domain name, nor did it target the Complainant or its business in any way. The Respondent purchased the disputed domain name because it was a unique, generic, and dictionary-defined term.

It is clear that the Complainant filed its Complaint in bad faith with the intent to steal the disputed domain name. It must be assumed that the Complainant, who is represented by legal counsel, would have at least read the UDRP Rules and Policy before filing its Complaint and, as such, should have known that it was unable to prove that the Respondent lacks rights in the disputed domain name. The Complainant’s sole basis for filing the Complaint is that it is upset that the Respondent owns a domain name that it wants. It operates under “redgrassgames” and would like to rebrand under the shorter term “redgrass”. This is a clear case of the Complainant filing a bad faith complaint in abuse of the UDRP in order to obtain a domain name that the Complainant could not purchase through negotiation.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove each of the following elements with respect to each disputed domain name:

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

The burden of proof of each element is borne by the Complainant.

A. Identical or Confusingly Similar

Based on the evidence presented of trademark registrations, the Panel finds that the Complainant has rights in the REDGRASS and REGRASSGAMES marks. Given that the first element of paragraph 4(a) of the Policy is expressed in the present tense, the Panel considers it sufficient for the purposes of this element that the Complainant's rights in these marks existed at the time of filing the Complaint, as is the case here. The Panel will address the timing of the accrual of the Complainant's trademark rights in its evaluation of the third element in paragraph 4(a) of the Policy set out below.

The Complainant also claims rights based on company registrations. However, the Panel recalls that the first element of paragraph 4(a) of the Policy requires the Complainant to demonstrate that it has rights in a trademark or a service mark. Rights in a company name *per se* do not provide standing for a complaint under the Policy.

The disputed domain name wholly incorporates the REDGRASS mark. It also incorporates the dominant feature of the REDGRASSGAMES mark, *i.e.*, "redgrass", which is clearly recognizable in the disputed domain name, while it omits the word "games" in that mark.

The only additional element in the disputed domain name is a generic Top-Level Domain extension (".com") which, as a standard requirement of domain name registration, may be disregarded in the comparison between the disputed domain name and the REDGRASS trademark.

Therefore, the Panel finds that the disputed domain name is identical to a trademark, and confusingly similar to another trademark, in which the Complainant has rights. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Given the Panel's findings below regarding the third element in paragraph 4(a) of the Policy, it is unnecessary to evaluate the second element.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. While these circumstances are not exhaustive, a conclusion that a domain name was registered in bad faith requires a finding that the respondent targeted a complainant's mark.

Given that the Respondent is not the original registrant of the disputed domain name, the Panel will evaluate the existence of any bad faith regarding registration as of the date on which the Respondent acquired the registration, which was June 22, 2017.

The Respondent acquired the registration of the disputed domain name over two years before the earliest registration of any of the Complainant's trademarks, which occurred on March 28, 2020. The Panel recalls that, where a disputed domain name was registered before a complainant's trademark rights accrue, panels will not normally find bad faith on the part of a respondent.

The Complainant claims that it held unregistered trademark rights prior to the Respondent's acquisition of the disputed domain name. The Panel begins by noting that the Complainant was not incorporated until three years later, in June 2020, and that the earliest applications for any of its marks were not filed until August 2019. Although the Complainant refers to a French company founded by Mr. Massad in 2015 named Redgrass SAS, that company was liquidated in March 2019, over a year before the Complainant was incorporated. The Complainant also refers to a French company founded by Mr. Massad in 2017 named RedgrassGames SAS. The Complaint does not show that the business of these companies is now carried on by the Complainant. In any case, the Complainant does not demonstrate that either of these companies

held any trademark rights prior to the registration of the disputed domain name. The Complaint provides certificates of company registrations, without evidence of the companies' activities prior to the registration of the disputed domain name. In pre-Complaint correspondence, the Complainant alleged that its domain name <redgrassgames.com> was registered in February 2017 by Redgrass SAS but it provides no evidence of the content of any associated website. The Complainant also refers to the registration of an industrial design, the launch of a Kickstarter campaign, and the uploading of videos to a YouTube channel but it does not allege that any of these events occurred prior to the second half of 2017. In sum, there is no evidence of use of "Redgrass" or "Redgrassgames" that could show that either became a distinctive identifier that consumers associated with goods or services of a particular trader prior to the registration of the disputed domain name. Accordingly, on the basis of the present record, the Panel is unable to find that any unregistered trademark rights in REDGRASS or REDGRASSGAMES existed prior to the Respondent's acquisition of the disputed domain name. Nor are there any exceptional circumstances in this case whereby the Respondent could be said to have registered the disputed domain name in anticipation of the Complainant's trademark rights.

The Respondent submits that it had never heard of the Complainant until it was contacted in February 2021 and the Panel accepts that submission. The Panel takes note that the disputed domain name is a combination of two dictionary words that forms part of series of "red~" and "~grass" formative domain names registered by the Respondent. The Respondent also points out that the disputed domain name is identical to a botanical term defined in at least one English dictionary. Based on the record of this proceeding, the Panel considers that the most plausible explanation for the identity and similarity between the disputed domain name and the later-registered REDGRASS and REDGRASSGAMES trademarks is that this was a coincidence.

Therefore, the Panel does not find that the disputed domain name has been registered in bad faith. Accordingly, it is unnecessary to consider whether the disputed domain name is being used in bad faith. The Complainant has failed to satisfy the third element in paragraph 4(a) of the Policy.

D. Reverse Domain Name Hijacking

The Respondent submits that the Complaint constitutes an attempt at Reverse Domain Name Hijacking.

"Reverse Domain Name Hijacking" is defined in paragraph 1 of the Rules as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name". Paragraph 15(e) of the Rules provides that if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding".

The Panel notes that the Complainant has legal representation in this proceeding. The Complaint suffers from a serious defect with respect to the timing of the accrual of the Complainant's trademark rights. The Respondent gave the Complainant full notice of the timing of its acquisition of the disputed domain name and its position on the merits of this case over a year before the filing of the Complaint. The Complainant has sought to remedy this defect by reference to two company name registrations and evidence of later events when it knew, or should have known, that the Complaint could not succeed under any fair interpretation of the facts. The Panel finds that this constitutes an abuse of the administrative proceeding.

Further, the Complaint is motivated by the Complainant's dissatisfaction with the price of the disputed domain name and the Respondent's unwillingness to offer a substantial discount. In the Panel's view, the record indicates that the Complainant resorted to the Policy as "Plan B" in case it failed to gain control over the disputed domain name in the marketplace or to increase its bargaining leverage. Either is a highly improper purpose for a complaint under the Policy and constitutes a further basis to find Reverse Domain Name Hijacking. See, for example, *BERNINA International AG v. Domain Administrator, Name Administration Inc. (BVI)*, WIPO Case No. D2016-1811.

Therefore, the Panel declares that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Matthew Kennedy/

Matthew Kennedy
Presiding Panelist

/Rodolfo Rivas Rea/

Rodolfo Rivas Rea
Panelist

/The Hon Neil Brown Q.C./

The Hon Neil Brown Q.C.
Panelist

Date: September 5, 2022

Separate decision of The Hon Neil Brown QC

General

The Complainant has no case in this proceeding, not even an arguable one, and that should be said at the outset. The Complainant succeeds only in a formal sense on the first element, but fails on the other elements under the Policy and also on the additional issue of Reverse Domain Name Hijacking. The Complainant has clearly misdirected itself as to what the proceeding is about and what it should be about, which is not what the Complainant and its advisers seem to think it is about. The Complainant is pre-occupied with the price of the domain name and how unjust it is said to be because it is too high for its liking. That is nothing to do with a panel, as the value of a domain name is, like beauty, all in the eye of the beholder; the price is a matter of opinion and on what market forces will support. There is nothing wrong in haggling for a lower price, but there is a lot that is wrong with it if those doing the haggling let it control their position on the case and allow themselves to think it can determine the outcome of the case, which it cannot. The Complainant also claims that it is “entitled” to the domain name, which is not the question under the UDRP Policy. Next, as well as its alleged registered trademarks, it has claimed it has common law rights to REDGRASS, but the Complainant seems to be unaware of the fact that if that argument is to be used, there must at least be some evidence of it or something that looks like evidence and none was put forward in the present case that was even plausible. It also seems not to grasp that it is almost impossible to prove bad faith registration and consequently bad faith use, if the domain name was registered before the trademark that is relied on. That is because bad faith is not a concept floating around in the air, but an act that has to be directed at some one or some thing before it can be good, bad, or indifferent. In this proceeding the domain name was registered on June 22, 2017. By that date, the Complainant did not even exist. It was incorporated 3 years later, on June 23, 2020. When the domain name was acquired on June 22, 2017, the Complainant had not obtained any registered trademark rights. It did not even apply for them until October 16, 2020 and its first trademark was not registered until March 24, 2021. Its half-hearted attempt to show that it had common law trademark rights before June 22, 2017 failed utterly because there was no evidence that it had those rights. Thus, unless the Respondent is a clairvoyant, it could hardly have foreseen on June 22, 2017 that the Complainant would be incorporated three years later or that it would then apply for a

trademark. How then could the Respondent be motivated by bad faith on June 22, 2017? All of this was explained generously by the Respondent to the Complainant before the Complaint was filed, but to no avail as, for the Complainant, it seems that all issues were coloured by its preoccupation with the price, and how unfair the Respondent was in not reducing the price to one that was more palatable to the Complainant. Thus, the Complainant misdirected itself and that misdirection has led to its final tactic, Plan B, the last resort of a disgruntled buyer of domain names, to try to harass and intimidate the Respondent to surrender the domain name under the threat of proceedings, a tactic which has failed, as it should.

I will now turn to some aspects of each of the elements that have to be proved under the Policy.

Identical or Confusingly Similar

I would express the findings that should be made by the Panel under this heading in a somewhat different manner from my colleagues. When that is done, the Complainant's trademarks give it a much more tenuous and limited standing to bring this proceeding than it seems to think that it has.

The registered trademarks relied by the Complainant as the foundation of its case, as has already been pointed out, were all registered well after the registration of the disputed domain name and will therefore be of little value to the Complainant in the overall result of this proceeding, as will be seen. However, all that the Complainant has to do at this stage under the somewhat odd way in which the UDRP is expressed, is to show that it "has" a trademark, not that it "had" one at any earlier or relevant time. In that regard, it is true that the Complainant "has" trademarks for both REDGRASS and REDGRASSGAMES because it has them today.

Having done that, it also has to show that the disputed domain name is identical to one of those trademarks or confusingly similar to one of them.

The Complainant argues first that the domain name is identical to the REDGRASS mark.

The domain name, being confined to "redgrass" as it is, is identical to the REDGRASS trademark because they are identical words that are used in the domain name and in the trademark. It is more than similar to the trademark as it is identical to it. Therefore, it is not necessary to inquire if it is confusingly similar to the REDGRASS trademark as well as identical.

However, when it comes to the other trademark relied on, REDGRASSGAMES, it is a different story. So different is it that the Complainant cannot rely on it even for the limited purpose of giving it standing to bring the Complaint. First, the domain name is not identical to the REDGRASSGAMES trademark because the words in the domain name and the trademark are different and they therefore cannot be identical.

Nor is the domain name confusingly similar to the REDGRASSGAMES mark, which the complainant seems to be arguing. It simply cannot be said that "redgrass" is confusingly similar to redgrassgames, that is because the objective internet user would not be confused into wondering if the domain name was invoking the notion of "red grass" by itself or whether it was invoking the far more specific notion of "red grass games". There is no reason why an internet user should interpret the domain name in that way. The respondent has adduced evidence that "redgrass" has a meaning, and the user would probably give it that meaning, just as the unchallenged evidence shows that it is widely used in trade and commerce in that meaning. In any event, the Internet user would only need to look at the word "redgrass" in the domain name to see that it is concerned with nothing but red grass, because it says so. It is therefore more likely than not, that anyone presented with the domain name would think that it was conveying its actual meaning, rather than something different from its actual meaning, namely some far more specific object, "redgrass games". In my view, the internet user would be far more likely to interpret the domain name by giving it the meaning everyone would assume that it had, namely red grass, and not some other meaning that it does not have. In other words, an internet user would not be confused. It would probably take the same attitude that the majority of the panel took in *The California Milk Processor Board of San Clemente v. Domains by Proxy, LLC / Del Polikretis*, WIPO Case No. D2012-2285 (February 19, 2013), namely: "the panel majority concludes that an internet

user confronted with this domain name is likely to be grinning, or groaning, or nonplussed – not confused.”

Thus, on the limited basis articulated, the complainant has made out the case that the domain name is identical to its redgrass trademark, but not identical or confusingly similar to its redgrassgames trademark.

Rights and Legitimate Interests

I am of the view that the Panel should deal with and reach conclusions on the issue of rights and legitimate interests, as it concerns some important and relevant issues raised by the parties that should be resolved. It shows by itself that the Complainant's case is baseless and that the Respondent has a strong case for being entitled to retain the domain name. Moreover, this should be done if a finding of Reverse Domain Name Hijacking is being contemplated, which in the case of this panelist, it is.

I would find that the Respondent has shown that it has a right and legitimate interest in the domain name and not by a narrow margin, but by a wide margin, thus giving it a complete defence to this proceeding.

In the first place, the Respondent has a very good argument showing why it has a right or legitimate interest in the domain name. That is because the Respondent has registered it and was entitled to do so on the principle that applies to all domain names, namely that first come is first served, giving the registrant an unlimited right and legitimate interest unless it is negated in some way. Certainly, there was no trademark standing in the way of the Respondent acquiring a complete right and interest in the domain name. The Complainant cannot show that it has any right to the domain name at all, because when it was registered by the Respondent on June 22, 2017, the Complainant did not exist and had not obtained any relevant trademark rights. Nor had it applied for a relevant trademark. It did not do that until October 16, 2020, by which time the domain name was in the embrace of the Respondent. Accordingly, when the Respondent was minded to acquire the disputed domain name, it came to a virgin field, and when it acquired the domain name it did not then or subsequently target the Complainant or do anything else that was inconsistent with the Complainant's rights, trademark or otherwise.

Secondly, the disputed domain name is <redgrass.com>, a generic expression which, by itself, gave the Respondent the right to register it and the legitimate interest in keeping it, provided of course that it was not used as a guise to trample on the rights of a trademark owner or engage in any other untoward or inappropriate conduct of which there is no evidence in this case at all. The domain name is generic because the word itself is generic and it is made up of two generic words. It would be seen by most users of the English language as generic because it can be used to apply not to a specific item or person but generically to all objects that can be accurately described as being within the genre “redgrass”. It is obviously not in as frequent use as some other generic words are, but the Respondent has provided unchallenged evidence of actual uses that are made of the word. Thus, it is a dictionary word in the renowned Merriam-Webster dictionary defined as a particular type of grass and it is used widely in horticultural practices. In any event “red” is clearly generic, as is “grass” and there seems to be no reason why anyone could claim that the combined word is not generic when it clearly is. Accordingly, the Complainant cannot claim that it has an exclusive right to a word, or in this case two words, which are available to all the world to use legitimately, as the Respondent has done.

As a generic word, it is additionally regarded as legitimate in the domain name field as a *bona fide* offering of goods and services when it is used in a domain name that is available for sale. The evidence that this is exactly what the Respondent has been doing, and that it is legitimate, is overwhelming. Not only is the unchallenged evidence that the domain name itself is part of the Respondent's stock in trade, but it also has a stock of similar domain names invoking both the word “red” and the word “grass”. Thus, for instance, the fact that the Respondent owns 8058 domain names starting with the word “red” would suggest that it acquired one more to add to its stock simply because it started with the word “red”. It is fanciful to suggest that the Respondent would have bought the domain name not for this obvious reason but for the eccentric reason that it wanted to undermine the Complainant's work in the field of miniature painting. The retention of <redgrass.com> by the Respondent as part of its stock in trade as a buyer and sell of domain names is therefore entirely consistent with this established and legitimate business practice.

Of course, it is sometimes claimed as a “principle” that a generic word does not give rise to a right or legitimate interest in a domain name unless there is evidence that it is being used within its generic meaning. This seems to be what the Complainant is submitting when it says in the Complaint:

“The domain name REDGRASS is not a generic/common name of free disposition, either is descriptive of the service offered by the Defendant (domain name reselling activities).”

That is not the law and it is not in the UDRP, and it would be contrary to law and common sense to submit that there can be such a limitation on the public’s right to use part of the ordinary language of mankind, particularly when the alleged trademark rights relied on to stifle the use of this language have arisen after the word has been registered and used legitimately. In any event, in the present case, the domain name is in fact being used by the Respondent legitimately because it is part of its stock in trade as a buyer and seller of domain names.

The foregoing remarks are consistent with the conclusions reached by UDRP panels and embodied in a long list of decisions cited by the Respondent in its submission and which it is not necessary to repeat here.

Finally, not the least reason why the domain name is generic is the very concerning way in which the Complainant has argued to the contrary. It has said and has certified that what it is saying is true and correct and in good faith. Under cover of that certification it says that not only is “redgrass” not generic, when it clearly is, but that it is “an indication of commercial origin of products and services, and specifically of the products commercialised by the Complainant.(.)” which it clearly is not. Such a statement, so obviously false and without any evidence cited to establish it, could only be made irresponsibly and is a grave departure from the obligations of counsel to assist the Panel by presenting a good faith argument.

These serious matters, in combination and separately, show that the Respondent has both a right and a legitimate interest in the domain name, giving it a complete defence to this proceeding.

Bad Faith

I agree with the statements of the majority under the heading of bad faith, with one exception, where I would go further. The Panel should find that as well as the domain name not having been registered in bad faith, it was also not used in bad faith.

On the evidence, the Respondent’s use of the domain name by retaining it and making it available for sale was regular and legitimate in every way and that fact should be recognised and stated.

Reverse Domain Name Hijacking (RDNH)

I agree with the finding of the majority of the Panel on this issue but wish to add my own remarks.

The Complainant has clearly sought to intimidate and harass the Respondent into surrendering and handing over the domain name under threat of having proceedings brought against it and has done so by relying on false allegations and bald assertions for which there is no evidence and never was, and without presenting a plausible argument.

It would not be the first claimant to adopt that tactic and it will probably not be the last, but it is certainly one of the most egregious attempts to do so. In its letter of demand to the Respondent of February 23, 2021, which it calls its “formal” letter and in which it gave its whole case away in advance, its whole tenor is that it holds registered trademark rights, which it did not at that time; that unless the Respondent lowered its price to an acceptable level, proceedings would be brought; that the price of the domain name showed that the Complainant “should legitimately own the domain name”; and that the Respondent had acted in bad faith, when the Complainant must have known that the Respondent had done nothing of the sort.

In its Complaint, the Complainant asserts that the Respondent replied to this letter, explaining its case, on February 24, 2022. That is not correct, as it was 2021, not 2022. This must surely be a typo, which says

something about the care and attention given to the submission. Be that as it may, the Respondent explained its position in detail and the Complainant would have been well advised to stop and take some notice of what it was being told. But it did not. Instead, it wrote again to the Respondent on March 1, 2021.

In its letter of March 1, 2021 letter, described as “another formal letter”, it changed its case to make the allegation not that it actually “held” trademark registrations, but that it “has pending trademark applications that **will be** registered...” (emphasis added). It also alleged that its name REGRASS had been registered and protected in France on December 9, 2015 by means of a company registration. But it omitted to state that its own evidence (Annex 1) showed (in the French language, although the proceeding is supposed to be in the English language, the language of the registration agreement) that the company that allegedly conferred this registration had been dissolved or deregistered in 2019; together with the ever present threat of proceedings if the price were not reduced. As a specific issue, the Respondent asserted that it had “strong unregistered rights, including Common Law rights” in REDGRASS, before the domain name was registered. Not only was this assertion unsupported by any evidence, but it was used to intimidate the Respondent within the meaning and ambit of the definition of RDNH.

The Respondent has also shown that the Complainant’s use of prior UDRP decisions was misleading, as was its misuse of the terms of the Policy itself and its Rules. Nor has the Complainant made any effort to present a plausible argument.

Looking at the whole of the evidence, it is no exaggeration to say that this proceeding was an ill-advised attempt to steal the domain name from the Respondent.

Accordingly, I would make a finding of RDNH for those reasons.

The Hon Neil Brown Q.C.