



D2003-0447 (the Policy does not contemplate a defense of laches, which is inimical to the Policy's purposes). See also *Tom Cruise v. Network Operations Center/ Alberta Hot Rods*, WIPO Case No. D2006-0560 (finding no meaningful precedent under the Policy for refusing to enforce trademark rights based on delay in bringing a complaint).

4. As noted by past UDRP Panelists, with applicability directly to trademark actions and the Lanham Act in district courts, the defense of laches bars the recovery of damages incurred before the filing of suit, but is inapposite to injunctive relief in a trademark action seeking to avoid confusion among customers in the future. See 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §31:10 (4<sup>th</sup> ed. 2005) (and cases cited therein).

5. This is consistent with the recommendation in the WIPO Final Report that “a time bar to the bringing of claims in respect of domain names (for example, a bar on claims where the domain name registration has been unchallenged for a designated period of years) should not be introduced.” Paragraph 197. In fact, a “time bar” was rejected in a coda to “Time Limitations for Bringing Claims.” This is the view accepted by Panelists in the formative decisions. They held that “there is no room for general equitable doctrines under the Policy such as would be possessed by Courts in common law jurisdictions.” *Edmunds.com, Inc. v. Ult. Search Inc.*, D2001-1319 (WIPO February 1, 2002).

6. Moreover, laches is never an available defense to an equitable claim unless the defendant demonstrates prejudice caused to him by the delay. See, e.g., *American Steamship Owners Prot. & Indemnity Assoc. v. Dann Ocean Towing*, 756 F.3d 314 (4<sup>th</sup> Cir. 2014) (“Laches is an equitable doctrine that can be raised by a defendant as an affirmative defense to a claim, and requires that the defendant show “(1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense.”); *Bristol Company, LP v. Bosch Rexroth, Inc.*, 758 F.Supp 1172, 1177-78, (D.Col. 2010) (“Application of the laches defense requires that there be (1) unreasonable and unexcused delay in bringing the claim, and (2) material prejudice or injury to the defendant as a result of the delay.”); *Donjaq LLC v. Sony Corp.*, 263 F.3d 942 (9<sup>th</sup> Cir. 2001), “To demonstrate laches, the defendant must prove both an unreasonable delay by the plaintiff and prejudice to itself.”) Defendant does not demonstrate, nor even suggest prejudice from the delay. Indeed, he asserts he had been expecting an action to be filed arising out of the use of the Mark.<sup>1</sup>

**b. The Disclaimer on Respondent's Website Does Not Obviate Confusing Similarity with the Disputed Domain.**

7. Respondent devotes all of his argument in ¶ 4(a) of his Response to the assertion that there is no confusing similarity because the website contains a disclaimer “designed to be very visible yet Mr. Moxon ignored it in his complaint.” Respondent misunderstands the UDRP Complaint, process, and citations of Complainant. Complainant alleged in ¶ 4(f)(2) of its

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<sup>1</sup> The Second Circuit holds “laches is not a defense against injunctive relief when the defendant intended the infringement.” *Harlequin Enterprises Ltd. v. Gulf & W. Corp.*, 644 F.2d 946, 950 (2d Cir.1981) (affirming a preliminary injunction because laches did not bar the claims); see also *Hermes Int'l v. Lederer de Paris Fifth Ave., Inc.*, 219 F.3d 104, 107 (2d Cir.2000) (reversing the grant of partial summary judgment to the defendants because “intentional infringement is a dispositive, threshold inquiry that bars further consideration of the laches defense, not a mere factor to be weighed in balancing the equities, as the district court did in this case”); *Société Des Bains De Mer Et Du Cercle Des Etrangers a Monaco v. MGM Mirage*, No. 08-cv-0315, 2008 WL 4974800, at \*6 (S.D.N.Y. Nov. 24, 2008).

Complainant that the Defendant did not put any textual elements in the Disputed Domain that would distinguish it from Complainant's mark, or identify it as a gripe site. Respondent misunderstands that a domain name is different from a website, and the existence of a disclaimer on the website is irrelevant to the analysis of confusingly similarity of the domain name in WIPO Overview 2.0 discussed by Complainant.<sup>2</sup>

**c. Complainant's Service Mark is KENDRICK MOXON.**

8. Respondent argues that Complainant's actual service mark is KMOXONLAW.COM only because that expression is found in Complainant's email address. Respondent then goes on to argue that Complainant forfeited his rights in the Disputed Domain because he failed to register it before Respondent.

9. Of course, the point of the Policy is to remedy bad faith registration. If the logic of Respondent were adopted by the Panel, all complainants would lose their UDRP cases because each had failed to register the domains underlying their disputes first.

**d. Monetary Damages Cannot be Awarded in UDRP Cases.**

10. Respondent's assertion that Complainant failed to seek money damages because there were no damages demonstrates a misunderstanding of the UDRP process. As explained above, money damages cannot be awarded by UDRP panels. It is because the panel can only award injunctive relief that monetary relief was not sought. Complainant's actual damages have been substantial, but Complainant recognizes attempting to quantify them in this proceeding would be irrelevant to the Panel's analysis of the Policy.

**e. Respondent Has Not Carried His Burden.**

11. Once a complainant establishes a *prima facie* case in support of its allegations, the burden shifts to the Respondent to show that it does have rights or legitimate interests pursuant to Policy ¶ 4(a)(ii). *See Do the Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that it is incumbent on the Respondent to provide concrete evidence rebutting the Complainant's assertion because this information is "uniquely within the knowledge and control of the respondent"); *see also Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000) (finding that the mere assertion by the Complainant that the Respondent has no right or legitimate interest in the domain name can be sufficient to shift the burden of proof to the Respondent to demonstrate that such a right or legitimate interest does exist).

12. Respondent has not carried his burden in this proceeding, and the Disputed Domain should be transferred to Complainant.

**2. CERTIFICATION**

Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under

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<sup>2</sup> The Response is replete with numerous other unsubstantiated allegations which are completely irrelevant to the Policy, which Complainant sees no reason to re-analyze, and to which Respondent will therefore refrain from responding.

these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted,  
**KENDRICK MOXON,**  
By his attorney,

/s/ 

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