

ADMINISTRATIVE PANEL DECISION

Just Vacations Inc. v. Isaac Labkovsky, Tower Enterprises USA, JustVacation LLC

Case No. D2023-1983

1. The Parties

Complainant is Just Vacations Inc., United States of America (“United States”), represented by Hanson Law Group LLP, United States.

Respondents are Isaac Labkovsky, Tower Enterprises USA, United States and JustVacation LLC, United States, represented by Garson, Ségal, Steinmetz, Fladgate LLP, United States.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on May 3, 2023. On May 4, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On May 4, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on May 11, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on May 16, 2023.

The Center verified that the Complaint together with the amended 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 Respondent of the Complaint, and the proceedings commenced on May 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was June 6, 2023. The Response was filed with the Center on June 6, 2023.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on June 14, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Complainant has registered the service mark JUST VACATIONS, with the United States Patent and Trademark Office ("USPTO"). Complainant has provided copies of its two registrations:

- JUST VACATIONS (word mark – “vacations” disclaimed), registration no. 4,316,552, registered April 9, 2013, with first use in commerce on January 1, 2002.
- JUST VACATIONS INCORPORATED (design mark – “vacations incorporated” disclaimed), registration no. 4,316,553, registered April 9, 2013, with first use in commerce on January 1, 2002.

These marks are used in connection with the following services: coordinating travel arrangements for individuals and for groups; organization of excursions, sightseeing tours, holidays, tours and travel; travel and tour information service; travel guide services; travel planning for individuals, families, and groups for special occasions such as destination weddings and honeymoons; travel, excursion and cruise arrangement.

The Domain Name was registered on October 12, 2002. It resolves to a website that purports to offer services related to vacation packages and travel deals under the brand name “JustVacation!”.

5. Parties’ Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant states the Domain Name and the brand used on the connected site, “JustVacation!”, is confusingly similar to Complainant’s registered service mark JUST VACATIONS. Neither the removal of the “s” at the end of Complainant’s mark nor the replacement of the “s” with a “!” changes the impression of the mark in the mind of consumers.

Complainant submits Respondent’s website purports to offer travel services in the same channels (online) as Complainant’s services, and is trading on Complainant’s goodwill.

(ii) Rights or legitimate interests

Complainant claims that Respondent, by use of a confusingly similar name in the Domain Name, is trading off the goodwill of Complainant. The true name and nature of Respondent is unknown as Respondent has registered the website linked to the Domain Name under a proxy, and the entity listed on the website as the service provider (JustVacation LLC) is not an entity registered to do business in New Jersey where the P.O. box listed on the website is located, nor in any other jurisdiction Complainant has searched. Complainant states the phone number listed on the website is not in service and no response was received to mail sent to the P.O. box. Respondent has not registered the trade name with the USPTO and has not challenged Complainant’s trademark registrations.

Complainant claims the website linked to the Domain Name has clearly been set up for profit and is not a legitimate noncommercial site.

(iii) Registered and used in bad faith

Complainant contends that by using the Domain Name, Respondent has intentionally attempted to attract for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website. Respondent is using a confusingly similar mark to market travel services online in direct competition with Complainant.

Complainant states Respondent has also acted in bad faith by attempting to conceal its identity to avoid the consequences of the blatant violation of Complainant's service mark. The website linked to the Domain Name was registered with a proxy service which masks the true identity of the actor. The phone number listed on the website is inactive and no response was received to correspondence sent to the P.O. box listed or the email address listed on the website. The entity listed on the website as the operator of the business – JustVacation LLC – is not an entity registered to do business in New Jersey (where the purported mailing address is located) or in any other jurisdiction Complainant searched.

B. Respondent

(i) Identical or confusingly similar

Respondent contends that Complainant's assertions that Respondent's offerings are similar and that they traverse the same channels, and thus trading on its goodwill, miss the mark. Respondent states the proper test is a comparison between the trademark and the Domain Name to assess likelihood of confusion. Here, Respondent's use of its Domain Name does not create a likelihood of confusion or association with Complainant's trademark, JUST VACATIONS, when both are scrutinized in their entireties and when considering the weakness of Complainant's trademark.

Respondent claims the Domain Name is markedly distinct from Complainant's trademark JUST VACATIONS. Not only is there a clear absence of the plural form, but its syntactical construction is also different. Respondent's Domain Name, also its company name, is a singular, uninterrupted term- "justvacation". This differs significantly from Complainant's two-word trademark. This one-word formation uniquely sets Respondent's Domain Name apart and dispels any potential for confusion with Complainant's two-word trademark.

Further, Respondent argues Complainant's trademark demonstrates substantial evidence of dilution and inherent weakness. This is evidenced by the numerous variations of the "just vacations" formative domain names prevalent on the Internet. Consequently, Respondent explains Internet users, frequently encountering these myriad domain names, have instinctively developed the ability to differentiate between them based on subtle discrepancies. In light of the above, Respondent maintains that Respondent's Domain Name usage does not engender any likelihood of confusion with Complainant's trademark.

(ii) Rights or legitimate interests

Respondent refers to paragraph 4(c) of the Policy, where a respondent may demonstrate its rights and interests in a contested domain name by showing its use of, or demonstrable preparations to use, the contested domain name or a name corresponding to it in connection with a *bona fide* offering of goods or services before any notice of the dispute.

Respondent states it operates its website linked to the Domain Name from the state of New Jersey. Respondent did not receive notice that the Complaint had been filed against it until May 17, 2023, when it received written notice. In fact, Respondent claims that it was unaware of the existence of Complainant until it received a baseless cease and desist letter from Complainant's attorneys on or around March 1, 2023. Both notices were received well after Respondent started operating its website at the Domain Name.

Contrary to Complainant's claims, Respondent states it uses the Domain Name for *bona fide* service offerings, and such use predates the notification of this Complaint. Operating as "JustVacation!", Respondent provides pre-packaged deals that Internet users can independently purchase. Respondent has been offering its pre-packaged deal service since at least July 26, 2022. Based on the evidence presented, Respondent has clearly demonstrated its rights, legitimate interests, and prior use of the Domain Name. Complainant's assertions of bad faith and confusion are unfounded, as the Domain Name and Respondent's brand name and offerings are distinct and clearly differentiated from any under Complainant's trademark.

Therefore, Respondent respectfully requests that the Panel deny the remedies sought by Complainant and uphold Respondent's rights to the Domain Name.

(iii) Registered and used in bad faith

Respondent contends that Complainant's allegation of bad faith rests on a baseless assertion: the insinuation that Respondent sought to evade legal consequences by obscuring its identity. This allegation, however, is without any merit.

Respondent states that in March 2023, Respondent received a cease-and-desist letter from the attorneys for Complainant. In response, Respondent sent a comprehensive reply via email on March 30, 2023. In its response letter, Respondent rejected any notion of infringement on Complainant's purported rights and clearly delineated the stark differences between its publishing services and Complainant's travel services. Furthermore, Respondent communicated its willingness to maintain and highlight the distinctions between the two brands, ensuring harmonious coexistence.

Notwithstanding the lack of reciprocation from Complainant to Respondent's letter, Respondent emphasizes that Complainant strikingly omitted any acknowledgment of this communication in the Complaint. Respondent argues this omission and apparent aversion to engage in meaningful dialogue or negotiation prior to instigating legal action, especially when Respondent has displayed a clear openness to arrive at an amicable resolution, insinuates a motivation geared more towards harassment than the protection of legitimate trademark rights.

Furthermore, Respondent's commitment to good faith is further demonstrated by the distinctiveness of the brand name showcased on the website linked to the Domain Name, namely, "JustVacation!" This brand name stands apart from any trademark owned by Complainant. As explained in detail in Respondent's letter dated March 30, 2023, the brand name adopted by Respondent is notable for its use of the singular form of the word "vacation" and the inclusion of an exclamation point. Respondent states this unique combination creates a memorable brand name that encourages consumers to take a break from their busy lives and "Just Vacation!" Moreover, the inclusion of an exclamation point elevates the term from a mere description of travel services to a compelling call-to-action, urging consumers to seize the opportunity and find a vacation with JustVacation!

Given the foregoing, Respondent contends it is apparent that Complainant, rather than Respondent, has exhibited bad faith. By proceeding with this action, notwithstanding their clear awareness of Respondent's unique brand name and thoughtful response, Complainant has disregarded Respondent's good faith and legitimate use of the Domain Name.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights;

- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

A. Identical or Confusingly Similar

Complainant has demonstrated that it has rights in its JUST VACATIONS trademark through its USPTO registration of the mark on April 9, 2013. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.2.1, providing "[w]here the complainant holds a nationally or regionally registered trademark or service mark, this *prima facie* satisfies the threshold requirement of having trademark rights for purposes of standing to file a UDRP case".

The Domain Name incorporates the JUST VACATIONS mark, while leaving out the plural "s". The Panel finds that the Domain Name is confusingly similar to Complainant's JUST VACATIONS mark. See [WIPO Overview 3.0](#), section 1.7 ("This test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.... While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.").

Accordingly, the Panel finds that the Domain Name is identical or confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

In view of the Panel's determination regarding the third element of the Policy, whether the Domain Name was registered and used in bad faith, the Panel makes no finding on whether Respondent has any rights or legitimate interests in the Domain Name.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith. Here, the Panel determines that Complainant has failed to satisfy this requirement.

The Whois look-up information for the Domain Name indicates that it was registered in October 2002, a little more than nine months after Complainant's indicated its first use of its JUST VACATIONS trademark, and approximately 11 years prior to Complainant's actual registration of that mark in April 2013. Complainant has failed to provide any evidence or arguments to indicate that the Domain Name was registered in bad faith – for example, there is no allegation made that Respondent targeted Complainant's trademark when registering the Domain Name or at any time thereafter. Respondent has stated that it was unaware of the existence of Complainant until it received the cease and desist letter from Complainant's attorneys around March 1, 2023. Moreover, Complainant has failed to provide any evidence of the strength of its JUST VACATIONS trademark – in particular in 2002 when the Domain Name was registered, such that an inference (whether based on actual or constructive notice) might be made that Respondent knew, or should have known, of Complainant's trademark when registering the Domain Name. Respondent acknowledges it has only been offering its pre-packaged travel services since July 26, 2022. It is this recent use of the Domain Name that appears to have garnered Complainant's attention. Nonetheless, aside from Complainant claiming broadly that Respondent has intentionally attempted to attract for commercial gain, Internet users to Respondent's website or other online location, by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website, Complainant has simply provided no evidence that Respondent, through registration and use of the Domain Name, has targeted Complainant or its trademark in bad faith; at the same time, Respondent suggests there is a crowded field, that Complainant has weak mark, and claims consumer sophistication/lack of confusion.

Complainant's allegations that Respondent used a proxy service for the Domain Name, with an inactive phone number and lack of registration of Respondent's business in New Jersey, without more, does not demonstrate bad faith with respect to the Domain Name. Further, it appears that Complainant omitted to refer to Respondent's responsive letter to Complainant's cease-and-desist letter, which apparently identified Respondent to Complainant.

Finally, and to be clear, the Panel's finding that Complainant has failed to demonstrate bad faith has no bearing on whether Respondent's use of the Domain Name and its JustVacation! brand might constitute trademark infringement under relevant United States law. The standards for bad faith registration and use under the UDRP are different from national law concerning infringement.

Accordingly, on the evidence presented by Complainant in this case, the Panel is unable to find bad faith registration and use of the Domain Name under the Policy, and Complainant has therefore failed to satisfy the third element of the Policy.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: July 17, 2023