

## **ADMINISTRATIVE PANEL DECISION**

### **R. Josephs Licensing Inc. v. Gerald Justice, Laguna Clothing Company Case No. D2024-3655**

#### **1. The Parties**

The Complainant is R. Josephs Licensing Inc., United States of America (“United States”), represented by Erik M. Pelton & Associates, PLLC, United States.

The Respondent is Gerald Justice, Laguna Clothing Company, United States, self-represented.

#### **2. The Domain Name and Registrar**

The disputed domain name <lagunaclimbingcompany.com> 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 September 11, 2024. On September 12, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 12, 2024, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (“Unknown”) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 13, 2024, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on September 13, 2024.

The Center verified that the Complaint together with the amendment to 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 September 17, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 7, 2024. The Respondent received an additional four days in which to respond to the Complaint, pursuant to paragraph 5(b) of the Rules. The Response was filed with the Center on October 8, 2024.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on October 16, 2024. 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

The Complainant is a California, United States corporation that holds trademarks related to outdoor casual clothing for men, women, and children. The Declaration of Ronald Josephs, president and owner of the Complainant, explains that Mr. Josephs owned a sportswear company and became aware of the LAGUNA sportswear brand, which had been used since the 1940s, and purchased the brand in 1989 on behalf of his company R. Josephs Sportswear Inc. That company then transferred all rights in the LAGUNA brand, including all trademark rights, to the Complainant in “approximately 2003”. According to the Josephs Declaration, goods branded with LAGUNA marks are sold by such national retailers as Amazon, Walmart, Big 5 Sporting Goods, Macy’s, and Ross.

The Complaint states that the Complainant has registered at least 133 domain names that contain “Laguna” and link to the Complainant’s main website at “www.lagunausa.com” (the “Complainant’s website”). The Panel notes that this domain name was created in August 2011, according to the Whois database. The Complainant’s website is actually a single page with apparently inoperative links to “Our Collections” and does not identify the website operator. The Complainant’s website indicates some categories of clothing that the Complainant sells, such as swimwear and graphic tees, but there are no accompanying product photos or descriptions, and the website has no ecommerce features to purchase goods, only a contact form. The website also does not point to any retailers where LAGUNA products can be purchased. The copyright notice is simply in the name of “Laguna”, and “Privacy Policy” at the bottom of the page does not link to a document or identify the site operator.

The Complainant holds LAGUNA or LAGUNA-formative United States trademark registrations including the following:

Mark	Registration Number	Registration Date	Goods or Services
LAGUNA (word)	1541125	May 30, 1989	International Class 25, clothing (swimsuits, sport shirts, t-shirts, hats, underwear, etc.)
LAGUNA (stylized letters)	606116	May 17, 1955	International Class 25, clothing (shirts, t-shirts, swimwear, etc.)
LAGUNA (figurative, word with wave design)	4886056	January 12, 2016	International Class 25, swimsuits, t-shirts, etc.

The Registrar reports that the disputed domain name was created on March 18, 2009, and was registered in the name of a domain privacy service. After receiving notice of the Complaint in this proceeding, the Registrar identified the underlying registrant as the Respondent Gerald Justice, of the organization Laguna Clothing Company, Irvine, California, United States, with a Hotmail contact email address. The Respondent acknowledges in the Response that he acquired the disputed domain name in March 2009 and states that he has maintained it without interruption since, to use in connection with his business to be located in Laguna Beach, California, near his residence.

The Respondent launched the associated website shortly thereafter and also used the same name, “Laguna Clothing Company”, for an eBay Store, a Facebook page, a Pinterest Page, and a Twitter (now X) page, as reflected in the record. The Panel notes that archived screenshots from the Internet Archive’s Wayback Machine dated as early as 2010 show that the disputed domain name redirected to the Respondent’s eBay

Store page headed “Laguna Clothing Company” and subsequently (by at least 2018) resolved to an early version of the Respondent’s website. Neither of these was focused on swimwear or other products similar to the Complainant’s.

At the time of this proceeding the disputed domain name resolves to a website (the “Respondent’s website”) headed “Laguna Clothing Company”, advertising clothing, jewelry, and accessories, health and beauty products, candles and air fresheners, and gift cards, with “free shipping worldwide”. According to the “About Us” page, Laguna Clothing Company (“LCC”) is based in Laguna Beach, California and was established in 2008. LCC is evidently not a legal entity but an alter ego for the Respondent Mr. Justice, who filed the Response in this proceeding as “Gerald Justice D/BA/ [doing business as] Laguna Clothing Company”. Hence, the Panel refers to Mr. Justice hereafter exclusively as the “Respondent”.

## **5. Parties’ Contentions**

### **A. Complainant**

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is confusingly similar to its registered LAGUNA trademarks, as “Laguna” is the dominant element of the disputed domain name. The Complainant states that the Respondent has never been a licensee of the Complainant and began using the disputed domain name “decades” after the Complainant and its predecessors began using the LAGUNA marks for clothing goods. Thus, according to the Complainant, there can be “no legitimate basis” for the Respondent to use a domain name that is confusingly similar. The Complainant argues that “it is highly likely” that the Respondent was aware of the Complainant’s LAGUNA marks when registering the disputed domain name, because the LAGUNA brand had been in use for more than 60 years and the word mark was registered in 1989, which “put the public on notice” of the Complainant’s rights, in the same industry (clothing goods) in which the Respondent is active. The Complainant cites the Policy, paragraph 4(b)(iv), referring to the Respondent’s bad faith as an instance of attempting to misdirect Internet users to a competing website for commercial gain by creating a likelihood of confusion with the Complainant’s trademark.

### **B. Respondent**

The Respondent contends that the Complainant has not satisfied all three of the elements required under the Policy for a transfer of the disputed domain name. The Respondent disputes that the Complainant “owns all rights” to “laguna” (a Spanish word meaning a salt pond or bay), which is found in many place names, including Laguna Beach, California, the city where the Respondent is located. The Respondent points out that many businesses in that city and in other similarly named places use “Laguna” as part of their business name, as he does. The Respondent contends that he is not a direct competitor of the Complainant, which evidently is a designer and manufacturer of certain kinds of clothing that it sells to retailers. In contrast, the Respondent uses the disputed domain name for a website that retails more than 2,000 distinct products to customers online. The Respondent denies prior awareness of the Complainant and claims a legitimate interest in using the disputed domain name based on the name of the place where he established his business in 2008. The Respondent suggests that he wanted the business and the associated domain name to reflect the inspiration of this artistic and naturally beautiful locale.

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between

the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark (the registered LAGUNA marks) for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here, "clothing company") may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

### **B. Rights or Legitimate Interests**

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name

The Panel finds that, before notice to the Respondent of the dispute, the Respondent used the disputed domain name in connection with the offering of goods, specifically an ecommerce website offering a wide range of retail products over the course of several years. This would represent a bona fide offering of goods for purposes of the Policy, unless the Complainant presented convincing evidence that the Respondent selected his "D/B/A" (the name used for the website and social media platforms and in trading with vendors and consumers) not for its geographic meaning but to falsely suggest an association with the Complainant. That possibility is best addressed in the following section on bad faith.

### **C. Registered and Used in Bad Faith**

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The Complainant argues that the Respondent was likely aware of the Complainant's LAGUNA mark when the Respondent registered the disputed domain name in 2009 and cites the example of bad faith given in the Policy, paragraph 4(b)(iv), intentionally attempting to attract Internet users for commercial gain by creating a likelihood of confusion with the Complainant's mark.

However, the evidence in the case file as presented does not indicate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's trademark. The LAGUNA word mark is not highly distinctive, given that it is a dictionary word and appears in many place names, and the Respondent's business is located in Laguna Beach. The Respondent denies prior awareness of the Complainant and its LAGUNA mark, and this is not implausible, even though some of the Respondent's thousands of product offerings overlap with the Complainant's narrower range of swimwear and casual wear clothing. The Panel notes that the Complainant's website does not appear in the first several pages of Internet search results for the word "laguna", which is used in the names of many unrelated companies and trademarked products. Thus, there is insufficient evidence to conclude that the Respondent chose the disputed domain name to exploit the Complainant's mark rather than in reference to the Respondent's location. Overall, the claims made in this case do not bear the hallmarks of a cybersquatting case, but the Panel does not opine on whether the Complainant may have any claim under trademark law in court.

Accordingly, the Panel finds the third element of the Policy has not been established. For the same reasons, the Panel also finds that the second element of the Policy has not been established.

## 7. Decision

For the foregoing reasons, the Complaint is denied.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: October 30, 2024