

ADMINISTRATIVE PANEL DECISION

Black in Travel, LLC v. Jerry Alexidor
Case No. D2023-0916

1. The Parties

Complainant is Black in Travel, LLC, United States of America (“United States” or “US”), represented by Santos Legal Group, PLLC, United States.

Respondent is Jerry Alexidor, United States, represented by Greg Butler Law, United States.

2. The Domain Names and Registrar

The disputed domain names <blacktulum.com> and <blacktulumgroup.com> are registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on March 2, 2023. On March 2, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On March 3, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (BLACK TULUM, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on March 8, 2023 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amendment to the Complaint on March 8, 2023.

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 Respondent of the Complaint, and the proceedings commenced on March 17, 2023. In accordance with the Rules, paragraph 5, the due date for Response was April 6, 2023. The Response was filed with the Center on April 6, 2023.

The Center appointed Georges Nahitchevansky as the sole panelist in this matter on April 20, 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, Black in Travel, LLC, is a Delaware limited liability company incorporated on January 21, 2021. Complainant provides a variety of travel, concierge and event related services in various locations, including Tulum, Mexico. Complainant has used the name and mark BLACK IN TULUM in connection with its services and offerings in Tulum, Mexico and operates a website at <blackintulum.com>. Complainant also filed an application in the United States for the BLACK IN TULUM mark on April 23, 2021 with a date of first use of July 27, 2020 and a first use in commerce date of September 19, 2020. Complainant's application matured to registration on the Supplemental Register of the United States Patent and Trademark Office ("USPTO") on March 15, 2022 (Registration No. 6,674,295).

Respondent, Jerry Alexidor, owns and operates a company called Black Tulum LLC. That company was incorporated in the State of California on February 4, 2021. Respondent's company offers a variety of travel, concierge and events services in Tulum, Mexico that are similar to those offered by Complainant. Respondent registered the <blacktulum.com> disputed domain name on November 3, 2020 and the <blacktulumgroup.com> disputed domain name on December 22, 2020. At some point thereafter, Respondent used the disputed domain names for a website promoting Respondent's services.

On January 4, 2023, Complainant's attorney sent a demand letter to Respondent's company concerning the disputed domain names and Respondent's use of the BLACK TULUM name and mark for similar services. By letter dated January 20, 2023, Respondent's attorney responded to Complainant's letter and rejected Complainant's demands. On January 26, 2023, Complainant's representative sent a further letter to Respondent's attorney concerning the matter. No further communications appear to have occurred between the parties and this proceeding was initiated by Complainant on March 2, 2023.

Currently, Respondent's <blacktulum.com> disputed domain name does not resolve to an active website whereas the <blacktulumgroup.com> disputed domain name continues to resolve to Respondent's website.

5. Parties' Contentions

A. Complainant

Complainant maintains that it owns rights in the BLACK IN TULUM mark by virtue of its United States trademark registration and by virtue of the fact that Complainant has provided goods and services with that mark since July 1, 2020.

Complainant asserts that the disputed domain names are identical or confusingly similar to Complainant's BLACK IN TULUM mark because of the similarities between Complainant's BLACK IN TULUM mark and Respondent's BLACK TULUM mark and because the services of the parties under their respective marks are essentially the same.

Complainant argues that that Respondent has no rights or legitimate interests in the disputed domain names as (i) Complainant has not licensed or otherwise permitted Respondent to use any of its trademarks; (ii) Respondent is not commonly known by the disputed domain names and has not acquired any trademark rights in BLACK TULUM; and (iii) "Respondent is acting with malice intent for commercial gain" and to tarnish Complainant's rights in its trademark.

Lastly, Complainant contends that Respondent has registered and is using the disputed domain names in bad faith as Respondent had been aware of Complainant's rights in BLACK IN TULUM for at least five months prior to the time Respondent registered the disputed domain names and did so in order to appear

related to Complainant for the profit of Respondent. Complainant also asserts that because the disputed domain names use the words “black” and “Tulum”, offer similar services as those under Complainant’s BLACK IN TULUM mark, and are used with a website with similar imagery, layout and style as Complainant’s website, Respondent is attempting to attract and divert consumers to Respondent’s website by creating a likelihood of confusion with Complainant’s BLACK IN TULUM Mark. In that regard, Complainant maintains that there have been instances of consumer confusion.

B. Respondent

Respondent rejects Complainant’s contentions.

Respondent primarily argues that Complainant does not have rights in its claimed trademark sufficient to establish standing under the Policy, given that Complainant only owns a registration for BLACK IN TULUM on the USPTO Supplemental Register. Respondent further argues that because Complainant’s claimed BLACK IN TULUM mark has been deemed geographically descriptive and Complainant has never proven that its mark has acquired distinctiveness or secondary meaning, the mere use of such mark by Complainant does not provide Complainant with exclusive proprietary rights over the descriptive terms “Black Tulum” or “Black in Tulum” under the trademark laws of the United States.

Respondent also contends that Complainant waited two years before sending Respondent a demand letter and that during that time Respondent developed significant goodwill in the disputed domain names and Respondent’s associated business. Respondent notes that for over two years it has made a *bona fide* offering of goods and services and that as a result it is now known as Black Tulum and has “developed its own clientele independent of Complainant’s services”.

Respondent further asserts that Complainant’s claimed rights in the BLACK IN TULUM mark are undermined by the fact that many other parties use the terms “black” and “Tulum” to describe their clientele and the location of their services.

Lastly, Respondent rejects Complainant’s assertion that Respondent uses a similar logo and style on its website. Respondent contends that its logo and website are distinct from those of Complainant and that Respondent was not aware of any of Complainant’s claimed rights when it “chose the Disputed Domain Names because they are highly descriptive of Respondent’s services”.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed Complainant must satisfy the Panel that:

- (i) the disputed domain names are 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 disputed domain names; and
- (iii) the disputed domain names were registered and are being used in bad faith.

A. Identical or Confusingly Similar

The inquiry under the first element can be broken down into two parts, namely (i) whether a complainant has UDRP-relevant rights in a trademark, and (ii) whether the disputed domain name is identical or confusingly similar to the complainant’s claimed trademark. Not satisfying either of these two parts can result in a failure to meet the requirements of paragraph 4(a)(i) of the Policy.

It is undisputed that for purposes of the first element the disputed domain names are at least confusingly similar to Complainant's claimed BLACK IN TULUM mark. The primary issue in contention, though, is to what extent Complainant owns trademarks rights in BLACK IN TULUM.

Complainant principally bases its claim of owning rights in the name and mark BLACK IN TULUM by virtue of having obtained a trademark registration for that mark on the USPTO Supplemental Register. Complainant also claims that it has been providing services and goods with its BLACK IN TULUM mark since July 2020.

Whether Complainant has established trademark rights in the phrase BLACK IN TULUM as such is perhaps beyond the scope of this limited proceeding. Respondent is technically correct in arguing that a mark on the Supplemental Register does not per se establish trademark rights for purposes of the Policy. The implication of an applicant placing a mark on the Supplemental Register, under US trademark law, is tantamount to an acknowledgement that at the time of registration the mark in question is merely descriptive of the goods and services, lacks distinctiveness, and does not yet function as a mark. As such, reliance on a mark on the Supplemental Register does not in and of itself establish rights in a mark under the Policy. See section 1.2.2 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0").

But this does not end the analysis, a Complainant relying on a mark that is on the Supplemental Register, whether for a proceeding under the Policy or in an enforcement action, needs to establish that its claimed mark has through use acquired secondary meaning. Put another way, a complainant must show that its mark has transcended its descriptive or non-distinctive character and has now become a distinctive identifier which consumers associate with the complainant's goods and/or services.

Relevant evidence that can demonstrate secondary meaning includes a range of factors such as (i) the duration and nature of use of the mark, (ii) the amount of sales under the mark, (iii) the nature and extent of advertising using the mark, (iv) the degree of actual public (e.g., consumer, industry, media) recognition, and (v) consumer surveys. *Id.* at section 1.3. Mere unsupported or conclusory statements without any supporting evidence do not satisfy this requirement of proof.

Here, based on what evidence there is in the record, the Panel cannot determine whether the phrase or designation BLACK IN TULUM has acquired secondary meaning. Complainant has provided little evidence in that regard apart from its current use of BLACK IN TULUM on Complainant's website at <blackintulum.com> and some alleged instances of confusion involving Respondent's services. Notably, while Complainant claims to have used BLACK IN TULUM since July 2020, Complainant did not submit any evidence that would support that assertion, apart from its unilateral claim of first use in its registration for BLACK IN TULUM on the Supplemental Register. To be sure, that claim without any other supporting evidence does not show the type of use made by Complainant of BLACK IN TULUM, the extent of such use, the geographic scope of the use (*i.e.*, market penetration) and whether consumers perceive BLACK IN TULUM as a trademark associated with Complainant and its good and service. Simply put, the record before the Panel does not readily to support the notion that BLACK IN TULUM has acquired distinctiveness or attained secondary meaning.

Nevertheless, a review of Complainant's website at <blackintulum.com> along with the linked to social media pages, including a Facebook page with over 23,000 members, and Complainant's alleged consumer confusion evidence does suggest that perhaps after some years of use Complainant has now developed some rights in BLACK IN TULUM. As such, in the Panel's view there is an open question as to whether and to what extent Complainant in 2023 owns rights in the mark and name BLACK IN TULUM and, if so, when those rights may have arisen. However, given that Complainant's complaint fails on the third element, the Panel does not need to make determination on this issue at this time.

B. Rights or Legitimate Interests

Given that Complainant's Complaint fails on the third element, as discussed below, the Panel does not need to address whether Respondent has rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

Under Paragraph 4(a)(iii) of the Policy, a complainant must establish the conjunctive requirement that the respondent registered and used the disputed domain name in bad faith. The question of whether a disputed domain name was registered in bad faith has to be assessed at the time of the registration of the disputed domain name by the respondent. See generally WIPO Overview 3.0 at section 3.1.1.

Here, the disputed domain names were registered on November 3, 2020 and December 22, 2020. At that time, it is questionable whether Complainant owned any trademark rights in BLACK IN TULUM. While Complainant claims to have made first use of BLACK IN TULUM in July 2020, as noted above, no evidence was provided to support that contention. Moreover, it is questionable whether Complainant had any trademark rights in BLACK IN TULUM in 2020 given that Complainant did not own a trademark registration for BLACK IN TULUM at that time, filed its application for BLACK IN TULUM on April 23, 2021 and then allowed its registration to be placed on the Supplemental Register in 2022 without ever arguing that its BLACK IN TULUM mark had acquired distinctiveness or secondary meaning.

To the extent that Complainant is suggesting that it held some common law rights in BLACK IN TULUM when Respondent registered the disputed domain names, an argument not directly made by Complainant, such is unsupported by any evidence. To be sure, a party claiming common law or unregistered rights not only bears the burden of establishing that its claimed mark has become a distinctive identifier which consumers associate with the complainant's good and/or services, but also needs to establish with concrete evidence when such rights arose. WIPO Overview 3.0 at section 1.3. The lack of such evidence here undermines any contention that Complainant held common law rights in BLACK IN TULUM in 2020. Those rights may have arisen thereafter, but do not appear to have existed when Respondent registered the disputed domain names.

It should be noted that there appears to be a dispute as to whether or not Respondent was aware of Complainant when Respondent registered the disputed domain names. Respondent maintains that it was not aware of Complainant and its claimed rights when the disputed domain names were registered, and Complainant claims that Respondent had been in touch with Complainant five months prior to registering the disputed domain names. As there is no documentary evidence in the record on that issue, the Panel cannot assess the conflicting claims. Indeed, it is possible that Respondent was fully aware of Complainant, its business and choice of name and seized on the idea to create a competing business with a closely similar name. If that were the case, then perhaps Complainant would have a basis for claiming an anticipatory registration of the disputed domain names by Respondent in bad faith. See, *e.g.*, WIPO Overview 3.0 at 3.8.2. But, as noted above, the limited record before the Panel does not support such an inference.

To be sure, to the extent that Complainant believes it may have a claim against Respondent for trademark infringement or unfair competition based on Respondent's registration and use of the disputed domain names, such a claim belongs in another forum and is beyond the scope of this UDRP proceeding. In such an action, it would be assumed that a full record of the past dealings between the parties would be developed, that the strength or lack thereof of Complainant's trademark rights in BLACK IN TULUM would be assessed, and that the parties could be cross examined as to their contentions. Here, however, as it has not been established by Complainant that Respondent registered the disputed domain names in bad faith, Complainant's complaint fails.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Georges Nahitchevansky/

Georges Nahitchevansky

Sole Panelist

Date: May 4, 2023