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Lodging Kit Company, Inc.,	:	
13492 Route 12	:	
Bonnville, NY 13309	:	Domain Name in Dispute:
	:	
Complainant,	:	lodgingkits.com
	:	
v.	:	Case Number:
	:	
LodgingKits	:	FA-090900-1283398
177 Ascension Street	:	
Passaic, NJ 07055	:	
	:	
Respondent	:	
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RESPONSE

[1.] Respondent was sent a Notification of Complaint and Commencement of Administrative Proceeding on September 2, 2009. The Notification stated that Complainant had submitted a Complaint for decision in accordance with the Uniform Domain Name Dispute Resolution Policy, adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on August 26, 1999 and approved by ICANN on October 24, 1999 (ICANN Policy), and the Rules for Uniform Domain Name Dispute Resolution Policy (ICANN Rules), adopted by ICANN on August 26, 1999 and approved by ICANN on October 24, 1999, and the National Arbitration Forum (NAF) Supplemental Rules (Supp. Rules). ICANN Rule 4.

[2.] RESPONDENT INFORMATION

[a.] Name: Lodging Kits, New Jersey
Naftalie Soffer

[b.] Address: 177 Ascension Street, Passaic, NJ 07055
PO Box 503, Clifton, NJ 07055

[c.] Telephone: 973/955-4040

[d.] Fax: 973/955-4035

[e.] E-Mail: customerservice@lodgingkits.com [but see note below]

Respondent's authorized representative in the administrative proceeding is:

[a.] Name: The Manevitz Law Firm , LLC

[b.] Address: 128 Boulevard, Suite 13 Passaic, New Jersey, 07055

[c.] Telephone: 973/594-6529

[d.] Fax:
[e.] E-Mail: ben@manevitzlaw.com
ICANN Rule 5(b)(ii).

The Respondent's preferred method for communications directed to the Respondent in the administrative proceeding: ICANN Rule 5(b)(iii).

Electronic-Only Material

[a.] Method: email
[b.] Address: ben@manevitzlaw.com
[c.] Contact: Ben D. Manevitz

Material Including Hard Copy

[a.] Method: post
[b.] Address/Fax: 128 Boulevard, Suite 13 Passaic, New Jersey, 07055
[c.] Contact: Ben D. Manevitz

The Respondent chooses to have this dispute heard before a single-member administrative panel as stated in the Complainant's Complaint. ICANN Rule 5(b)(iv).

[3.] **RESPONSE TO FACTUAL AND LEGAL ALLEGATIONS MADE IN COMPLAINT**

This Response specifically responds to the statements and allegations contained in the Complaint and includes any and all bases for the Respondent to retain registration and use of the disputed domain name. ICANN Rule 5(b)(i).

[a.] **The domain name is NOT identical or confusingly similar to the trademarks in which the Complainant has rights.**
ICANN Rule 3(b)(ix)(1); ICANN Policy ¶ 4(a)(i).

In order to successfully make out its claims, Complainant does not have to demonstrate only a similarity between the disputed domain and the claimed mark; Complainant must adequately demonstrate that it has rights in the claimed mark. Complainant has not and can not demonstrate such rights.

Complainant has not obtained a *prima facie* claim to rights in the mark based on its May 2009 registration on the Supplemental Register of the USPTO. Complainant originally sought registration on the Principal Register, but that application was refused by the Trademark Office explicitly because the LODGING KIT phrase was "merely descriptive" and was not associated in the minds of the public with Complainant. The PTO Refusal is attached hereto as Annex B. In its response to the Trademark Office, Complainant neither made any argument nor submitted any evidence tending to show an actual secondary meaning in the mark, but rather simply acquiesced and amended its application to seek registration on the Supplemental Register. Complainant's Acquiescence is attached hereto as Annex C.

Further, Complainant in the instant complaint has similarly neither argued nor submitted evidence showing any secondary meaning, except for the unsupported (and unsupported) naked assertion of same in the last paragraph of Complaint 5[a]. Even that statement is not directed to claiming secondary meaning as of the date of Respondent's registration. Nor could Complainant convincingly do so, in light of its submissions to the Trademark Office.

Without a showing of secondary meaning, Complainant's registration on the Supplemental Register does not confer rights in the mark under Policy ¶ 4(a)(i). *See, Martha Stewart Living Omnimedia, Inc. v. Joe Perez*, FA 259275 (Nat. Arb. Forum June 24, 2009) (holding that Supplemental Register registration of EVERYDAY FOOD did not confer rights to Complainant under the Policy); *see also, CyberTrader, Inc. v. Bushell*, D2001-1019 (WIPO Oct. 30, 2001) (stating that Supplemental Register "provides the Complainant with no protectable rights" in its marks); *see also Chiappetta v. Morales*, D2002-1103 (WIPO Jan. 20, 2003) (holding that the complainant's registration of the DISCOUNT HYDROPONICS mark on the Supplemental Register did not confer any rights under the UDRP).

The Complaint does not actually include any argument or assertion of rights stemming from common law usage of the mark, but even looking to the 1998 registration as forming the basis of some imaginable argument on those lines, Complainant would still fall short of the necessary mark: The Trademark Office has explicitly determined that no such secondary meaning has been established, and Complainant itself has acquiesced in that determination. *See, Bar Code Disc. Warehouse, Inc. v. Barcodes, Inc.*, D2001-0405 (WIPO July 27, 2001) ("Although Complainant might eventually overcome [the USPTO's] initial refusal with adequate evidence of secondary meaning in its proposed mark, the USPTO refusal is certainly material to this proceeding as evidence of the descriptive character of Complainant's proposed mark, and Complainant should have disclosed this refusal to the Panel."); *see also, Martha Stewart Living*, FA 259275 (Nat. Arb. Forum June 24, 2009). Indeed, the very fact that Complainant sought registration on the Supplemental Register directly supports a contention that there were no rights at common law at the time of the application. *See, John Gard v. Francesco Spina*, DBIZ2002-00167 (WIPO July 27, 2002) (holding same under STOP concerning SCUBA.BIZ).

[b.] Respondent has rights or legitimate interests in respect of the domain name.

ICANN Rule 3(b)(ix)(2); ICANN Policy ¶ 4(a)(ii).

Complainant presented no evidence supporting its assertion that Respondent has no rights or legitimate interests with regard to LODGINGKITS.COM. The Complaint simply restates the language of the Policy and points to the argued similarity of the two domain names.

The Policy and Rules are clear that the initial burden, though light, still rests "squarely on the shoulders of Complainant to show that Respondent has no rights or legitimate interest

in respect of the domain name. Once Complainant has at least demonstrated enough indication, then, but only then does the burden shift to Respondent's shoulders to rebut or explain." *Stream International Inc. v. dotPartners LLC*, FA0112428 (Nat. Arb. Forum May 2, 2002) (decision under STOP); *see also, The Wharton School of the University of Pennsylvania v. Motherboards.com*, FA0161274 (Nat. Arb. Forum June 13, 2003) ("Complainant failed to support its contentions with evidence and just limited to copy parts of the provisions of the Policy without further explanation. A mere allegation of the lack of rights or interests of the Respondent is not enough under the scope of the Policy to find a Complaint successful.")

Even while Complainant has failed utterly to carry its burden of proof, Respondent nevertheless presents the following to demonstrate that it has rights or legitimate interests in the disputed domain name.

Respondent is using the domain name in connection with a bona fide offering of goods or services:

The term "Lodging Kits" is clearly descriptive of (unsurprisingly) kits – assemblies, packages, or combined materials or goods – designed for use in or connected to the lodging industry. A lodging organization seeking a kit of cleaning or maintenance material would readily describe its needs in those terms. This assertion is further supported by the opinion of the Trademark Office with regard to LODGING KIT, noted above. As made clear in the Soffer Declaration (Annex A), Respondent has been making use of the domain name in question in order to sell exactly those goods, to wit: kits (of maintenance supplies) directed to temporary residence suppliers. Soffer Decl. ¶¶ 14-19. Even the Complainant's own documents reflect that bona fide offering of goods. "Respondent operates <LODGINGKITS.COM>, an online store which offers household maintenance products, including, but not limited to, kitchen products, small appliances, food storage containers, housekeeping supplies, janitorial supplies, and other products useful for households and other facilities." (Complaint, p.4)

That is precisely the sort of bona fide offering of goods or services contemplated by the Policy. *The Curvon Corporation v. Lauren Kallareou, The Tack Box*, D2001-0565 (WIPO June 21, 2001) ("It is not apparent to the Panel why a dealer's registration of a domain name which is descriptive of a product he or she sells should be viewed as lacking in legitimacy.")

Further, Complainant nowhere asserts – and of course provides no evidence that might possibly support an assertion – that the offering of the goods by Respondent is done with the intent to infringe on Complainant's rights, which showing would be necessary to undermine the *bona fide* status of that offering. *See, American Eyewear, Inc. v. Thralow, Inc.*, D2001-0991 (WIPO Oct. 24, 2001) ("In the absence of contradictory facts suggesting a deliberate intent to infringe . . . Respondent's use of the Domain Name was bona fide."); *see also, Rapido TV Limited v. Jan Duffy-King*, D2000-0449 (WIPO Aug. 17, 2000) (finding Respondent had legitimate interests in the domain name because Complainant failed to demonstrate a "clear and unjustifiable misappropriation of Complainant's mark.")

Respondent has been using LODGINGKITS.COM for almost four years before the sudden ambush of Complainant, which fact also supports use of the domain name in connection with a bona-fide offering of goods. *Datastream Int'l Ltd. v. Micro Management Systems*, FA094382 (Nat. Arb. Forum May 11, 2000) (The mere existence of Complainant's trademark insufficient to trigger the "dispute" for these purposes; Respondent's use of the domain name in offering services for three years before being contacted by Complainant established Respondent's rights or legitimate interest in the domain name.) Further supporting that determination is the strongly descriptive character of LODGING KIT. *Car Toys, Inc. v. Informa Unlimited*, FA 093682 (Nat. Arb. Forum March 20, 2000) (Complainant "submitted no evidence to establish either fame or strong secondary meaning" in its claimed mark, and Respondent was in the business of dealing with such terms; Respondent's had established a legitimate interest in the name); *see also, Chattel Mortgage, Inc. v. Top Sites*, FA0114710 (Nat. Arb. Forum August 23, 2002) ("Because the terms are generic and descriptive, Respondent has an equal right to use the terms in its domain name, and the Panel therefore rules that Respondent does have a legitimate interest in using and registering the domain name at issue.")

Respondent is now and has been commonly known by the domain name:

Respondent established LODGING KITS as a d/b/a for its parent company Daft LLC in 2005, and has been doing business under that name continuously since then. Soffer Decl. ¶¶ 2, 16, 18. Respondent has maintained a website offering the relevant goods for sale continuously since that time, and has taken any number of orders from many different individuals and entities from multiple states in the US. Soffer Decl. ¶¶ 14-19.

The website to which LODGINGKITS.COM resolved has, since its inception, included the LODGING KITS term prominently, and any of the many people visiting the site has thus been made to know the company by the domain name in question. Soffer Decl ¶¶ 14-19.

To the extent that the business entity is associated with the disputed domain name, then since its very inception in 2005 that business entity has certainly and clearly been "known by" the domain name, since the domain name is identical to the business name. Respondent, then, clearly has rights and legitimate interests in the LODGINGKITS.COM domain name.

Other factors demonstrating Respondent's legitimate interest:

The website at LODGINGKITS.COM has never resolved to a parking site, has never been offered for sale to Complainant (or anyone else), has never made any reference to the Complainant's websites or goods, and has never been merely "bait" for users who were otherwise looking for the Complainant's site. Soffer Decl. ¶¶ 20-24. The LODGINGKITS.COM site has similarly never included metatags referring to LODGING KIT or LODGINGKIT.COM, and

has, since very soon after its registration, resolved to an actual working website selling Respondent's goods. Soffer Decl. ¶¶ 20-24.

[c.] **Respondent did not register and use the domain name in bad faith.**
ICANN Rule 3(b)(ix)(3); ICANN Policy ¶ 4(a)(iii).

The Complainant has similarly completely failed to meet the burden of proof of bad faith registration and use under Policy ¶ 4(a)(iii). *See, Starwood Hotels & Resorts Worldwide, Inc. v. Samjo CellTech, Ltd.*, FA0406512 (Nat. Arb. Forum Mar. 9, 2005) (mere assertions of bad faith are insufficient for a complainant to establish Policy ¶ 4(a)(iii); *see also, Graman USA Inc. v. Shenzhen Graman Indus. Co.*, FA0133676 (Nat. Arb. Forum Jan. 16, 2003) (general allegations of bad faith without supporting facts or specific examples do not supply a sufficient basis upon which the panel may conclude that the respondent acted in bad faith).

Respondent's registration of the disputed domain name in 2005 predated Complainant's rights in the mark: Complainant has not obtained any significant distinctiveness, as verified by the USPTO rejection of the recent application for descriptiveness and as ratified by Complainant itself by its amendment of the application to the Supplemental Register. Complainant does not have sufficient rights in its mark that predate the registration of the disputed domain name, therefore Respondent necessarily lacked the requisite intent to register the disputed domain name in bad faith under Policy ¶ 4(a)(iii). *See, California Association of Marriage and Family Therapists v. Mir Internet Marketing, Inc. c/o Charles Newton*, FA1256835 (Nat. Arb. Forum June 1, 2009) (Complainant's registration on the Supplemental Register did not invest Complainant with sufficient rights such that Respondent could not have the requisite intent for bad faith in later domain name registration); *see also, Interep Nat'l Radio Sales, Inc. v. Internet Domain Names, Inc.*, D2000-0174 (WIPO May 26, 2000) (finding no bad faith where the respondent registered the domain prior to the complainant's use of the mark); *see also, Open Sys. Computing AS v. degli Alessandri*, D2000-1393 (WIPO Dec. 11, 2000) (finding no bad faith where the respondent registered the domain name in question before application and commencement of use of the trademark by the complainant); *California Association of Marriage and Family Therapists v. Mir Internet Marketing, Inc. c/o Charles Newton*, FA1256835 (Nat. Arb. Forum June 1, 2009)

Therefore, the Respondent did not register the Domain Name in bad faith. *See, Ode v. Intership Ltd.*, D2001-0074 (WIPO May 1, 2001) (“[W]e are of the unanimous view that the trademark must predate the domain name.”); *see also, SPB Software House v. SPB Online Servs., Ltd.*, FA1067638 (Nat. Arb. Forum Oct. 17, 2007) (“When a domain name is registered before a trademark right is established, the registration of the domain name is not in bad faith under Policy ¶ 4(a)(iii) because the registrant could not have contemplated the complainant's non-existent right.”); *see also, The Mrs. Fields' Brand, Inc. v. John Edwards*, FA1234524 (Nat. Arb. Forum Dec. 26, 2008) (same).

Complainant does make a vague assertion of 4(a)(iii) bad faith under paragraph 4(b)(iv) of the Policy. However, Complainant simply parrots the legal standard under that paragraph, but cites no evidence whatsoever to support the accusation that Respondent registered the Domain Name with knowledge of Complainant's mark and to cause confusion with Complainant's mark. Such unsupported assertions are simply insufficient to carry the day for Complainant. *See, Displays Depot, Inc. v. GNO, Inc.*, D2006-0445 (WIPO June 29, 2006.)

Even analyzing the facts at hand in light of Paragraph 4(b)(iv) would not serve Complainant's purposes. Evidence which can support a finding of bad faith under 4(b)(iv) includes (a) evidence undermining a reasonable explanation for the choice of domain name except for its similarity to the Complainant's marks, (b) an offer to sell the domain name to the Complainant, (c) presentation of the mark on the Respondent's website that is similar in nature to the use by the Complainant of its mark or marks, (d) any pattern of conduct by the Respondent indicating a willingness to register domain names opportunistically. *See, BasicNet S.P.A. v. Jinpoong, Park Myung Hwan*, D2008-0308 (WIPO May 6, 2008); *The Neiman Marcus Group, Inc. v. David Ball*, FA 1159811 (Nat. Arb. Forum May 2, 2008).

Complainant has made no showing whatsoever as to any of the elements listed, and Respondent hereby categorically denies those elements. ¶¶ 9-12, 21-22.

In light of the foregoing, Complainant should NOT be granted any of the relief it seeks, and Respondent should be allowed to continue to use and control LODGINGKITS.COM.

[4.] **OTHER LEGAL PROCEEDINGS**

Respondent is not aware of any other proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the Complaint. ICANN Rule 5(b)(vi).

[5.] **RESPONSE TRANSMISSION**

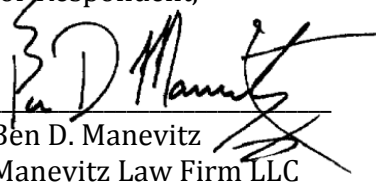
The Respondent asserts that a copy of the Response, as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Complainant, in accordance with ICANN Rule 2(b). ICANN Rule 5(b)(vii); NAF Supp. Rule 5.

[6.] The Respondent respectfully requests that the Administrative Panel denies the remedy requested by the Complainant.

[7.] **CERTIFICATION**

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



Ben D. Manevitz

Manevitz Law Firm LLC
September 29, 2009