

## **ADMINISTRATIVE PANEL DECISION**

Mi Cocina, Ltd. v. Melinda Garcia  
Case No. D2023-4014

### **1. The Parties**

Complainant is Mi Cocina, Ltd., United States of America (“United States”), represented by Munsch Hardt, Kopf & Harr, P.C., United States.

Respondent is Melinda Garcia, United States.

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

The disputed domain name <micocinafoodtruck.com> (hereinafter “Domain Name”) is registered with Register.com (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 25, 2023. On September 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 29, 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 (PERFECT PRIVACY, LLC) and contact information in the Complaint. The Center sent an email communication to Complainant on September 29, 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 September 29, 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 October 3, 2023. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2023. Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on October 24, 2023.

The Center appointed Lawrence K. Nodine as the sole panelist in this matter on November 3, 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**

Since 1991, Complainant uses the trademark MI COCINA (the Mark), which translates as “My Kitchen”, in association with a restaurant business. Complainant owns four United States Trademark Registrations:

- United States Trademark Registration No. 2,315,142 (registered on February 8, 2000) (standard word mark) (restaurant services)
- United States Trademark Registration No. 2,315,143 (registered on February 8, 2000 (stylized design and lettering) (“restaurant services”)
- United States Trademark Registration No. 2,315,144 (registered on February 8, 2000) (stylized lettering) (restaurant services)
- United States Trademark Registration No. 5,889,603 (registered on October 22, 2019) (standard word mark) (for class 29 and 30.)

Complainant owns the domain name <micocina.com> where Complainant promotes its restaurant and food truck business.

Complainant offered no allegations or evidence about the geographical extent of the Parties’ business operations. Accordingly, the Panel visited the websites of both Parties. It appears that Complainant’s restaurant business is based in Texas, primarily in the Dallas Fort Worth Area, although it also has a restaurant in Oklahoma City.

Respondent operates a food truck in Fountain, Colorado. The Domain Name was registered December 11, 2022. A simple search indicates that Respondent has been in business for at least 10 years.

#### **5. Parties’ Contentions**

##### **A. Complainant**

Complainant contends that it owns trademark rights in the Mark, which it began using the term MI COCINA in connection with its restaurant chain in 1991 and for which it secured several trademark registrations as noted above. Complainant contends that the Domain Name includes an identical reproduction of Complainant’s Mark.

Complainant contends that Respondent infringes its trademark rights, and that it has given Respondent actual notice of the dispute starting in January 2023.

In March 2023, Complainant’s counsel asked Facebook to remove Respondent’s Facebook page, explaining:

“I represent Mi Cocina, Ltd., a Texas limited partnership that has owned the federal trademark in the words, “Mi Cocina” since 2000. (Registration No. 2315142) This trademark prevents all third-parties from using the words “Mi Cocina” together in any form or style. Mi Cocina, Ltd. also owns additional trademarks in various “Mi Cocina” logos, but the above-referenced infringer is not using those logos. It is, however, using the words “Mi Cocina” as part of its username and throughout all of its posts and related content, which constitutes trademark infringement. Thus, we request that its Facebook account be immediately taken down”.

In April 2023, Facebook removed or disabled Respondent's Facebook page.

Complainant contends that, because Respondent had constructive notice of Complainant's trademark registrations, it registered and used the Domain Name in bad faith.

Complainant also adduces evidence of a 2019 lawsuit filed against an Arizona company using a "mi cocina" mark for a restaurant, and also provides evidence of an injunction issued by an Arizona court; the Panel notes that this judgement was based on a default under the applicable rules of civil procedure.

## **B. Respondent**

Respondent did not reply to the Complaint.

## **C. Panel Order**

The Panel notes that Respondent began her business under the name "Mi Cocina" approximately ten years ago. Specifically, the Panel notes Facebook references to Respondent and her "Mi Cocina" food truck, including a profile of Respondent Melinda Garcia that describes her as "owner and CEO of Mi Cocina Food Truck 13 November 2011 to present." The Panel also noted a second link to a recent posting promoting "Mi Cocina's 10th Annual Thanksgiving Tamales."

Because this evidence was not in the record, the Panel invited both parties to respond to the evidence.

Complainant responded that the second link (to the "Mi Cocina's 10th Annual Thanksgiving Tamales" posting) was inoperable, and included a screenshot indicating that "this page isn't available." Complainant did not address the first link to Respondent's profile. Because Complainant reported that the first link was not operable, the Panel issued a second Procedural Order attaching a copy of the "Mi Cocina's 10th Annual Thanksgiving Tamales" posting and gave the Parties another opportunity to respond, but neither Party did so.

Complainant did not offer any facts to contradict or call into question the factual inference that Respondent began her "Mi Cocina Food Truck" business approximately ten years ago.

Instead, Complainant argued that it obtained a federal trademark registration twenty years ago in 2000, which was before Respondent began her business, even if that was ten years ago. Complainant did little more than reemphasize its constructive notice argument. Complainant also contended that Facebook's removal of Respondent's "Mi Cocina food truck" page gave Respondent actual knowledge of Complainant's trademark rights, and, consequently, that any continued use of "Mi Cocina" on Facebook was evidence of bad faith. Complainant also argued that the length of time the Respondent has used "Mi Cocina" is irrelevant because the doctrine of laches does apply to actions under the Policy and,

Respondent did not respond to the Panel Order.

## **6. Discussion and Findings**

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

The Panel finds that the Domain Name is confusingly the Mark in which Complainant has rights as demonstrated by Complainant's trademark registrations.

The addition of "foodtruck" does not avoid this finding as the Mark is still recognizable within the Domain Name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

The Panel finds that Complainant has satisfied Policy paragraph 4(a)(i)

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

Complainant's contention is that, because Respondent infringes its trademark under United States law, Respondent has no rights or legitimate interests under the Policy. This allegation is not sufficient to prove that Respondent has no rights or legitimate interest in the Domain Name. Allegations of infringement under national law would not carry any particular weight under the Policy. In *Walbro Engine Management, LLC v. Registration Private, Domains By Proxy, LLC /shahrokh Gabbaypour, Express Fuel Pumps*, WIPO Case No. [D2021-2409](#), the Panel observed that "ICANN Second Staff Report on Implementation Documents for the Uniform Dispute Resolution Policy states, Paragraph 4.1(c) that 'Except in cases involving 'abusive registrations' made with bad-faith intent to profit commercially from others' trademarks (e.g., cybersquatting and cyberpiracy), the adopted policy leaves the resolution of disputes to the courts [. . .] and calls for registrars not to disturb a registration until those courts decide.'" See also., *Board of Trustees of the University of Arkansas v. FanMail.com, LLC*, WIPO Case No. [D2009-1139](#) ("this case illustrates well the widely recognized principle that the Policy is designed to deal with clear cases of cybersquatting", citing, *Clockwork IP LLC, One Hour Air Conditioning Franchising, LLC v. Elena Wallace*, WIPO Case No. [D2009-0485](#) ("UDRP proceedings are for clear cases of cybersquatting, not for resolving trademark infringement and/or trademark dilution disputes or other matters more appropriately dealt with through the courts").

Facebook's takedown of Respondent's page is not relevant because there is no basis for equating Facebook's takedown criteria – which it is noted, are not known, or to the extent they are, they are not articulated in the evidence provide by Complainant – with the elements of the Policy. Facebook's answer to Complainant's takedown request does not provide any information whatsoever about the process or criteria Facebook used to make its decision (nor is it clear if there is an appeal route).

Complainant does not allege facts or offer evidence directed at the relevant issue, which is whether Respondent is targeting and/or impersonating Complainant; it cannot be overlooked here that while Complainant does enjoy a federal trademark registration, the terms comprising the mark mean "my kitchen" and, accordingly have a descriptive connotation. Consequently, it is plausible that Respondent adopted the Domain Name to exploit its descriptive meaning without any intention to target Complainant.

The Panel has compared the Parties' websites and finds no evidence that Respondent is impersonating or targeting Complainant. While there are some similarities in the color schemes and layout, the Parties use their own very different logos. Not surprisingly, some of the menu items are similar, but most are different and the layout of the menus is different.

It also appears that Respondent began her business about 10 years ago in Fountain, Colorado, which is more than 700 miles from Complainant's base in Dallas, Texas. The Panel reviewed Complainant's "Locations" page to determine that Complainant's business is primarily in Dallas, although it has a location in Oklahoma City. There is no evidence that that Complainant does business in or enjoys any reputation in Colorado where Respondent operates her food truck.

The Panel also notes that Respondent began her business at least 10 years ago. This is clear by looking at the evidence that Complainant submitted to Facebook (which it provided in its pleading). Complainant did not say when it discovered Respondent's Facebook page or how long it had been in operation. To understand the Facebook evidence, the Panel found Facebook references to Respondent and her "Mi Cocina" food truck and located several references, including a profile of Respondent Melinda Garcia that describes her as "owner and CEO of Mi Cocina Food Truck 13 November 2011 to present.". The Panel also notes a recent posting promoting "Mi Cocina's 10th Annual Thanksgiving Tamales."

In a Procedural order, the Panel invited the Parties to address this evidence. When it responded to the Procedural Order, Complainant did not offer any evidence or reason to doubt the apparent fact that Respondent seems to have began her business under the "Mi Cocina Food Truck" business about ten years

ago, other than to state that the link to the “Mi Cocina’s 10th Annual Thanksgiving Tamales” was inoperable. The Panel issued a second Panel Order, instructing the Center to provide a copy of an excerpt from the Facebook page to Complainant. Complainant did not respond to the second Panel Order.

This evidence is sufficient to support the Panel’s finding that it is more probable than not that Respondent began her business many years ago in Colorado where Complainant does not do business and where it is unlikely that Respondent would derive any benefit from impersonating or otherwise targeting Complainant.

It is not dispositive that that Complainant owns a federal registration that predates Respondent’s adoption of the Domain Name or her much earlier adoption of the tradename. Complainant may or may not have an infringement claim,<sup>1</sup> but the question here is whether Respondent is targeting Complainant in a clear case of cybersquatting. This is not such a case. By all appearances, Respondent has been running a real business for many years and there is no evidence of cybersquatting intent. See *Papa Gyros Inc. v. Registration Private, Domains By Proxy, LLC/ GEORGIOS BATIOS*, WIPO Case No. [D2022-2256](#). This satisfies Policy paragraph 4(c)(i). The Panel also notes that the evidence seems to indicate that for some 10 years Respondent has been known in the Fountain, Colorado area by the name Mi Cocina. This satisfies Policy 4(c)(ii).

Complainant argues that, because laches is not generally recognized as a defense to valid claims under the Policy, it does not matter how long Respondent has used “Mi Cocina Food Truck.” This misses the point. The Panel is not finding that laches bars Complainant claim. Rather, the Panel is simply applying the text of the Policy paragraph 4(c)(i) and 4(c)(ii), and finding that it is more probable than not that, before notice of this dispute, Respondent began using “a name corresponding to the domain name in connection with a bona fide offering of goods or services” and that Respondent has been commonly known by a name corresponding to the Domain Name.

Accordingly, the Panel finds that Complainant has not satisfied Policy paragraph 4(a)(ii).

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

Complainant offers neither argument nor evidence to supply a basis for inferring that Respondent had knowledge of Complainant or its rights, or that Complainant was so well known that Respondent was probably aware of Complainant. Complainant does not allege that Respondent has engaged in any of the conduct identified in Policy paragraph 4(b) as indicative of bad faith. Instead, to prove bad faith registration and use, Complainant relies solely on the assertion that, because both Parties are located in the United States, “the principle of constructive notice can be applied.” Notably, Complainant does not offer evidence that, apart from constructive notice, Respondent should have known of Complainant’s rights when she registered the Domain Name.

The Panel rejects this contention.

The Panel does not consider it appropriate in the circumstances of this case to apply the concept of United States constructive notice; even if it did, it would not ultimately assist Complainant.

Although the Policy makes no mention of constructive notice, the Panel has discretion to consider “any rules and principles of law that it deems applicable.” Rules 15(a). [WIPO Overview 3.0](#) section 4.15. This discretion is broad, and the Panel has the option to consider the potential relevance of constructive notice;

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<sup>1</sup> Although it is not for this Panel to adjudicate Complainant’s infringement claims, neither should the Panel imply that Complainant’s trademark infringement claims are valid. Although Complainant has a federal trademark registration, under United States law, it cannot claim “infringement” of its rights until it does business in a market area. Referring to the so-called “*Dawn Donut* Defense,” Professor McCarthy explains: “While a federal registration grants a nationwide exclusive right, the federal registrant cannot obtain an injunction against a local junior use until a likelihood of the registrant’s expansion into that local area is proven, either by reputation or sales. This is called a “Dawn Donut” defense asserted by a local junior user. The federal registrant has a nationwide right, but not a local remedy until there is a likelihood of confusion caused by the localized use.” 5 McCarthy on Trademarks and Unfair Competition § 26:31 (5th ed.)

here a few observations are relevant.

First, the UDRP does not supplant national law—either party is free to seek remedies or protection in the national courts—but the UDRP is, nonetheless, governed by its own law and rules. “Panels have broadly noted that insofar as the UDRP system is designed to operate in a global context, while rooted in general trademark law principles, in its own terms UDRP jurisprudence generally would not require resort to particular national laws [ . . .]” [WIPO Overview 3.0](#), section 4.15. The “sole lodestar for a Panel must be the Policy... WIPO decisions have steadfastly maintained that the laws of any particular country do not apply to the dispute,” *Edmunds.com v. Ult*. Search, WIPO Case No. [D2001-1319](#); the UDRP “operates within its own unique context,” *Diet Center Worldwide v. Jason Akatiff*, WIPO Case No. [D2012-1609](#).

Second, United States law does not require that United States law be followed in UDRP proceedings. The constructive notice provisions of the United States federal trademark law— the Lanham Act—apply to proceedings pursuant to that law, but not to other proceedings under other laws. Moreover, in the United States courts, it is well understood that the elements of a UDRP claim are different than the elements of claims based on United States law. Consequently, when a United States court rules on a claim filed pursuant to the United States Anticybersquatting Consumer Protection Act (“ACPA”), 15 U.S.C. 1125(d), to stop a transfer ordered by a UDRP decision, the United States court is not required to defer to a UDRP decision. See *Diet Center Worldwide, Inc. v. Jason Akatiff*, WIPO Case No. [D2012-1609](#) (see footnote 13, discussing *Barcelona.com, Inc. v. Excelentísimo Ayuntamiento de Barcelona*, 330 F.3d 617, 624–26 (4th Cir.2003)).

Given that the UDRP is supra-national law and, further, that United States law does not require adherence to United States law when deciding UDRP cases, it is not required that the Lanham Act’s constructive notice provisions be applied in UDRP proceedings between United States residents. Instead, under Rule 15(a), the Panel has the option, but not the obligation, to consider constructive notice.

Third, and instructively, constructive notice is often not sufficient to resolve the UDRP questions it is called on to address. For example, constructive notice of Complainant’s trademark is not notice “of the dispute” under the Policy section 4(c)(i). *The Zoological Society of San Diego, Inc. v. Affinity One, LLC*, WIPO Case No. [D2006-1458](#). More generally—and of particular relevance here—the consequence in any given case of assuming constructive notice “may depend in part on the complainant’s reputation and the strength or distinctiveness of its mark, or facts that corroborate an awareness of the complainant’s mark.” [WIPO Overview 3.0](#), section 3.2.2. Where there is no corroborating evidence of cybersquatting or targeting—which is the case here—constructive notice may not be sufficient to sustain Complainant’s burdens of proof. *FN Funding Inc. v. Nick Mofford, 80 Eighty*, WIPO Case No. [D2023-3537](#).

Even if Respondent here were charged with constructive notice, the Panel would nonetheless find that mere notice of Complainant’s trademark rights is not alone sufficient to prove bad faith registration or use. There is no evidence of targeting or impersonation. Furthermore, “mi cocina” which translates to “my kitchen” in English has descriptive qualities which support the inference that Respondent adopted the Domain Name in good faith and without any intention to target Complainant. Finally, and fundamentally, Complainant has not alleged any conduct that satisfies any of the factors identified in Policy paragraph 4(b) or which otherwise demonstrate cybersquatting intent or targeting of Complainant by Respondent; to the contrary, given the descriptive qualities of the term at issue here, the Panel believes that the evidence presented shows that Respondent has adopted such term independently of Complainant.

In its response to the first Procedural Order, Complainant also argued that Facebook’s removal of Respondent’s Facebook page served as actual notice of Complainant’s rights and that, if Respondent was continuing to use “Mi Cocina” on Facebook, then this was evidence of bad faith. As noted above, the Panel finds the Facebook proceedings of limited, if any, relevance, especially with respect to the claim of actual notice. Complainant had already sent Respondent written notice of its rights before it filed a report with Facebook, so the Panel does see that Facebook’s removal decision adds anything. More importantly, the question is whether Respondent acted in bad faith when she registered the Domain Name, which happened before the Facebook dispute began.

The Panel finds that Complainant has not satisfied Policy paragraph 4(a)(iii).

## **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Lawrence K. Nodine/*

**Lawrence K. Nodine**

Sole Panelist

Date: December 9, 2023