

## **ADMINISTRATIVE PANEL DECISION**

Mundo Natural, Inc. v. Alexander Lerman d/b/a AL Enterprises  
Case No. D2022-4958

### **1. The Parties**

The Complainant is Mundo Natural, Inc., United States of America (“United States”), represented by Beléndez Law Offices, Puerto Rico.

The Respondents are Alexander Lerman d/b/a AL Enterprises, United States, represented by John Berryhill, Ph.d., Esq., United States.

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

The disputed domain name <mundonatural.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 December 22, 2022. On December 23, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 27, 2023, 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 (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 28, 2023, 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 December 28, 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 the Respondent of the Complaint, and the proceedings commenced on January 9, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 29, 2023, which was extended to February 2, 2023. The Response was filed with the Center February 2, 2023.

The Center appointed Evan D. Brown, Dennis A. Foster, and Richard G. Lyon as panelists in this matter on March 9, 2023. The Panel finds that it was properly constituted. Each member of 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.

On March 21, 2023, the Complainant submitted unsolicited supplemental filings to the Center, purporting to address issues raised in the Response. On March 27, 2023, the Panel issued a procedural order to afford the Respondent five (5) days to comment on whether the Complainant's supplemental filings should be admitted. The Respondent timely objected to the supplemental filings.

#### **4. Factual Background**

The Complainant is in the business of providing vitamins and supplements and services related to those products. The Complainant uses the mark MUNDONATURAL on and in connection with its goods and services and enjoys the benefits of United States Reg. No. 6,830,299 for the mark MUNDONATURAL (and Design). The registration certificate that the United States Patent and Trademark Office issued on August 30, 2022 contains the Complainant's allegation that the mark was first used in commerce as early as September 15, 1998 for "vitamins and natural dietary supplements".

The Respondent is a domain name investor and asserts that it acquired the disputed domain name in 2015 because of its value as an everyday phrase; mundo natural means "natural world" in English. It does not appear that the Respondent has used the disputed domain name in connection with any active website but has listed the disputed domain name for sale using a Registrar-provided page.

#### **5. Parties' Contentions**

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

The Complainant contends that the disputed domain name is identical or confusingly similar to the Complainant's trademark; that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and that the disputed domain name was registered and is being used in bad faith.

##### **B. Respondent**

In general, the Respondent denies each assertion of the Complainant. Of particular note, relevant to each of the three elements, is the Respondent's argument that the record is void of meaningful evidence that the Complainant's rights in the MUNDO NATURAL mark existed prior to the 2015 date on which the Respondent acquired the disputed domain name.

#### **6. Discussion and Findings**

To succeed, the Complainant must demonstrate that all of the elements listed in paragraph 4(a) of the Policy have been satisfied: (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights, (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (iii) the disputed domain name has been registered and is being used in bad faith.

##### **A. Procedural Issue – Supplemental Filings**

The Panel has reviewed the supplemental filings and the arguments of the Respondent relating thereto and finds that the supplemental filings should not be accepted. Accordingly, the Panel delivers its decision here without regard to the supplemental filings.

Paragraph 10 of the Rules vests the Panel with the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition. Unsolicited supplemental filings are generally discouraged, unless specifically requested by the Panel. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.6.

"A Complainant should 'get it right' the first time and should have provided all the information necessary to prove its case from the material contained in the Complaint and its annexes alone. There is no right of reply under the Rules." *Grove Broadcasting Co. Ltd v. Telesystems Communications Limited*, WIPO Case No. [D2000-0703](#). The Panel notes that the Complainant is represented by counsel, who ostensibly should know the Rules and be aware of the norms concerning thoroughness as expressed in the *Grove Broadcasting* case. The Panel notes that the supplemental filings submitted by the Complainant seem to be some sort of an attempt to rebut some of the arguments raised in the Response, and finds nothing in the proposed supplemental filings that could not have been raised in the initial Complaint or the amendment thereto.

## **B. Identical or Confusingly Similar**

This first element under the Policy functions primarily as a standing requirement. [WIPO Overview 3.0](#), section 1.7. This element requires the Panel to consider two issues: first, whether the Complainant has rights in a relevant mark; and second, whether the disputed domain name is identical or confusingly similar to that mark.

A registered trademark provides a clear indication that the rights in the mark shown on the trademark certificate belong to its respective owner. See *Advance Magazine Publishers Inc., Les Publications Conde Nast S.A. v. Voguechen*, WIPO Case No. [D2014-0657](#). The Complainant has demonstrated its rights in the MUNDONATURAL mark by providing evidence of its trademark registration.

The disputed domain name incorporates the MUNDONATURAL mark in its entirety. This is sufficient for showing identity or confusing similarity under the Policy.

Accordingly, the Panel finds that the Complainant has established this first Policy element.

## **C. Rights or Legitimate Interests**

The Panel evaluates this element of the Policy by first looking to see whether the Complainant has made a *prima facie* showing that the Respondent lacks rights or legitimate interests in respect of the disputed domain name. If the Complainant makes that showing, the burden of production of demonstrating rights or legitimate interests shifts to the Respondent (with the burden of proof always remaining with the Complainant). See [WIPO Overview 3.0](#), section 2.1; *AXA SA v. Huade Wang*, WIPO Case No. [D2022-1289](#).

On this point, the Complainant asserts that: (1) the Respondent does not have any *bona fide* offering of goods and services, (2) the Respondent is not commonly known by the disputed domain name, nor is the respondent making legitimate fair use of the disputed domain name, (3) the Respondent's intent in maintaining the disputed domain name is to profit from the sale of the disputed domain name to the Complainant, (4) the Respondent is not an authorized distributor or retailer of the Complainant's goods, nor has it been authorized by the Complainant to use the MUNDONATURAL trademark in a domain name, and (5) the Respondent has not secured or sought to secure any trademark rights in the term "Mundo Natural" as to confer any rights or legitimate interests in the disputed domain name.

The Respondent's assertions and evidence successfully rebut any notion of a *prima facie* showing on the part of the Complainant. The record shows that the words "mundo natural" mean "natural world" in Spanish. This is a commonly used phrase. The Panel credits the Respondent's evidence that it is making a general public offer to sell a common descriptive phrase as a domain name, and that that does not violate any cognizable right of the Complainant. The Respondent meaningfully asserts that the Complainant has not shown how the Respondent's acquisition of this common phrase and its offer for sale on the secondary

market has either targeted the Complainant, was based on the Complainant's claimed rights, or violates any cognizable right of the Complainant.

Accordingly, the Panel finds that the Complainant has failed to satisfy this second element under the Policy.

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

The Complainant argues that the Respondent registered and used the disputed domain name on the basis of (1) the Respondent concealing its identity through a privacy service, (2) the offering of the disputed domain name for sale via the Registrar, (3) the Respondent's purported registration of the disputed domain name for the main purpose of selling, renting or otherwise transferring it to the Complainant, for valuable consideration in excess of the Respondent's out-of-pocket costs directly related to the disputed domain name, and (4) the Respondent's purported knowledge of the Complainant's registered mark when the Respondent registered the disputed domain name.

As the Respondent points out, and as discussed above, the words "mundo natural" mean "natural world" in Spanish and comprise a commonly used phrase. The fact that a company has used a trade name for many years in itself is not sufficient to show that the trade name functions as a trademark. *Baltimore Gas and Electric Company v. National Material Supply Co., LLC*, WIPO Case No. [D2001-0315](#). To serve as a trademark, the name must be used in a manner so that the public can come to recognize it as an indication of source. *Id.* The Complainant has not provided evidence on which to conclude that the commonly-used words MUNDONATURAL functioned as a trademark prior to the Respondent's acquisition of the disputed domain name.

Subject to certain exceptions not relevant here, where a respondent registers a domain name before the complainant's trademark rights accrue, panels will not normally find bad faith on the part of the respondent. [WIPO Overview 3.0](#), section 3.8.1.

Moreover, even if the Complainant had established that its trademark rights accrued before the registration of the disputed domain name, the Panel finds no evidence in the record that the Respondent had the Complainant or the Complainant's mark in mind when the Respondent registered the disputed domain name. For these reasons, the Panel cannot find bad faith on the part of the Respondent.

#### **E. Reverse Domain Name Hijacking ("RDNH")**

Paragraph 15(e) of the Rules provides that, if "after considering the submissions the panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding". RDNH is furthermore defined under the Rules as "using the UDRP in bad faith to attempt to deprive a registered domain-name holder of a domain name".

The Panel finds that this situation is one in which a finding of RDNH is appropriate. As already noted in the discussion above about the supplemental filings, the Complainant is represented by counsel who should be familiar with the relevant aspects of UDRP practice. More specifically, in this case, there was essentially no evidence in support of the necessary facts, most notably facts relating to trademark rights arising pre-trademark registration. Similarly, the Complainant did not address how the disputed domain name was initially registered prior to any proven trademark rights. And the Complainant should have, but did not, address whether the Respondent targeted the Complainant. Finally, the Panel believes that the Complainant's failure to address longstanding precedent that states that trafficking in domain names consisting of dictionary terms or commonly used phrases (as it is the case here) is not *per se* illegitimate contributed to the abusive nature of this proceeding.

## 7. Decision

For the foregoing reasons, the Complaint is denied and the Panel finds that the filing of the Complaint constitutes an abuse of the administrative proceeding.

*/Evan D. Brown/*  
**Evan D. Brown**  
Presiding Panelist

*/Dennis A. Foster/*  
**Dennis A. Foster**  
Panelist

*/Richard G. Lyon/*  
**Richard G. Lyon**  
Panelist  
Date: April 14, 2023