

## **ADMINISTRATIVE PANEL DECISION**

Mi Cocina, Ltd v. Eldan Shkolnikov  
Case No. D2023-0765

### **1. The Parties**

The Complainant is Mi Cocina, Ltd, United States of America (“United States”), represented by James R. Ray, III, United States.

The Respondent is Eldan Shkolnikov, United States.

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

The disputed domain name <ordermicocinamexican.com> is registered with Dynadot, LLC (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 20, 2023. On February 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On February 22, 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 (Dynadot Privacy Service) and contact information in the Complaint. The Center sent an email communication to the Complainant on February 22, 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 March 1, 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 March 2, 2023. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2023. Apart from sending three emails on March 1 and March 9, 2023, the Respondent did not submit any response. Accordingly, the Center notified the Parties that it would proceed with the panel appointment on March 23, 2023.

The Center appointed W. Scott Blackmer as the sole panelist in this matter on April 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**

The Complainant is a limited partnership formed under the law of the State of Texas and headquartered in Irving, Texas, United States. The Complainant operates a chain of Mexican restaurants and catering services in Texas, with a website at “www.micocina.com”, linked social media sites, and online sales of salsa in jars, apparel, and gifts.

The Complainant holds three United States trademark registrations for MI COCINA (Spanish for “my kitchen”), all registered on February 8, 2020: Registrations numbers 2315142 (standard characters, claiming first use in commerce in 1991), 2315143 (words and design), and 2315144 (stylized letters).

According to the Registrar’s Whois database, the disputed domain name was registered on October 24, 2022. The disputed domain name was registered in the name of a domain privacy service, but after receiving notice of this dispute the Registrar identified the underlying registrant as the Respondent Eldan Shkolnikov, listing no organization and showing a postal address in the State of New York, United States and an email address in the domain name <simplemenu.com>. That domain name resolves to what appears to be the landing page for an undeveloped food delivery website, a template or placeholder with little content and no identification of the website operator.

Screenshots show that the disputed domain name resolved in February 2023 to a website (the “Respondent’s former website”) advertising a restaurant and catering service called “Mi Cocina Mexican Food” in Avondale, Arizona.

At the time of this decision, the disputed domain name does not resolve to an active website.

The Complaint attaches a copy of the Judgment Order and Permanent Injunction issued by the United States District Court for the District of Arizona on October 25, 2019 in *Mi Cocina Limited v. Mi Cocina Mexican Food LLC*, No. CV-19-04446-PHX-GMS. That order granted a permanent injunction in favor of the Complainant in the current proceeding against a defendant operating a restaurant called “Mi Cocina Mexican Food” at the same address shown on the Respondent’s former website with the same name, “Mi Cocina Mexican Food”. The injunction prohibits the defendant from “[o]perating any restaurant, domain name, website or social media account” using that name or making any “colorable imitation” or the Complainant’s registered trademarks.

#### **5. Parties’ Contentions**

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

The Complainant asserts that the disputed domain name incorporates “an identical reproduction” of the Complainant’s registered MI COCINA mark and is likely to cause confusion.

The Complainant acknowledges that it is unclear whether the Respondent is the defendant subject to the 2019 permanent injunction in the judicial proceeding. Nevertheless, the Complainant concludes that because the Respondent’s former website evidently directed visitors to the defendant’s restaurant in violation of the injunction, “any continued use of ‘Mi Cocina’ in connection with the Restaurant is illegitimate and is done in bad faith.”

## B. Respondent

The Respondent did not reply to the Complainant's contentions. In emails to the Center, the Respondent stated only, "I don't own this domain anymore".

## 6. Discussion and Findings

Paragraph 4(a) of the Policy provides that in order to divest a respondent of a domain name, a complainant must demonstrate each of the following: (i) the domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) the respondent has no rights or legitimate interests in respect of the domain name; and (iii) the domain name has been registered and is being used in bad faith. Under paragraph 15(a) of the Rules, "[a] Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

### A. Identical or Confusingly Similar

The first element of a UDRP complaint "functions primarily as a standing requirement" and entails "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 holds trademark registrations for MI COCINA, which is incorporated in its entirety in the disputed domain name, omitting the space between the words that cannot be included in domain name system (DNS) addresses for technical reasons. As usual, the addition of the Top-Level Domain ".com" may be disregarded as a standard registration requirement (see *id.* section 1.11.1).

The Panel finds that the disputed domain name is confusingly similar to the Complainant's mark and concludes that the Complainant has established the first element of the Complaint.

### B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy gives non-exclusive examples of instances in which a respondent may establish rights or legitimate interests in a domain name, by demonstrating any of the following:

- (i) before any notice to it of the dispute, the respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent has been commonly known by the domain name, even if it has acquired no trademark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

Because a respondent in a UDRP proceeding is in the best position to assert rights or legitimate interests in a domain name, it is well established that after a complainant makes a *prima facie* case, the burden of production on this element shifts to the respondent to come forward with relevant evidence of its rights or legitimate interests in the domain name. See [WIPO Overview 3.0](#), section 2.1.

The Complainant has demonstrated trademark rights and demonstrates that a court had already ordered a defendant not to use a corresponding name online to advertise a restaurant with the same name at precisely the location advertised on the Respondent's former website, because of the Complainant's senior trademark

rights. This militates against any rights or legitimate interests that the Respondent could likely assert, and the Respondent has not come forward with any alternative claims. To the contrary, the Respondent merely states that he no longer owns the disputed domain name.

The Panel finds that the Respondent has failed to meet its burden of production and concludes that the Complainant prevails on the second element of the Complaint.

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

The Policy, paragraph 4(b), furnishes a non-exhaustive list of circumstances that “shall be evidence of the registration and use of a domain name in bad faith”, including the following:

“(iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to your web site or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of your website or location or of a product or service on your website or location.”

The Panel notes that while “mi cocina” is a common Spanish phrase, the overall impression of the disputed domain name is nearly identical to the Complainant’s mark, as the Complainant’s mark is associated with Mexican cuisine, and both the Complainant and the Respondent’s former website provide for online “order” facilities. The Panel further notes that the terms added to the trademark are in English, not in Spanish, which further points to the Respondent registering the disputed domain name for its trademark value in connection with the trademark MI COCINA, and not for any dictionary meaning in Spanish. The disputed domain name creates a likelihood of confusion with the Complainant’s established, registered mark, and the screenshot of the Respondent’s former website shows that the disputed domain name was used to attract Internet users for commercial gain, advertising “Mi Cocina Mexican Food”. While the relationship between the Respondent and “Mi Cocina Mexican Food” remains unknown, the Respondent as the registrant remains responsible under the ICANN registration agreement for the use of the disputed domain name. It is improbable that this registration and use was made without prior awareness of the Complainant’s trademark, as the domain name was registered three years after “Mi Cocina Mexican Food” was ordered not to continue infringing the Complainant’s trademark.

The Panel finds bad faith on this record and concludes that the Complainant has established the third element of the Complaint.

## **7. Decision**

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <ordermicocinamexican.com> be transferred to the Complainant.

*/W. Scott Blackmer/*

**W. Scott Blackmer**

Sole Panelist

Date: April 17, 2023