



NATIONAL ARBITRATION FORUM

DECISION

Mamacita's v. DNS Market
Claim Number: FA0710001103216

PARTIES

Complainant is **Mamacita's** ("Complainant"), represented by **Dwayne K. Goetzel**, 700 Lavaca, Suite 800, Austin, TX 78701. Respondent is **DNS Market** ("Respondent"), 304 Griffin Road, Belton, SC 29627.

REGISTRAR AND DISPUTED DOMAIN NAME

The domain name at issue is <**mamacitas.net**>, registered with **Enom, Inc.**

PANEL

The undersigned certifies that he or she has acted independently and impartially and to the best of his or her knowledge has no known conflict in serving as Panelist in this proceeding.

Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

PROCEDURAL HISTORY

Complainant submitted a Complaint to the National Arbitration Forum electronically on October 24, 2007; the National Arbitration Forum received a hard copy of the Complaint on October 26, 2007.

On October 24, 2007, Enom, Inc. confirmed by e-mail to the National Arbitration Forum that the <**mamacitas.net**> domain name is registered with Enom, Inc. and that Respondent is the current registrant of the name. Enom, Inc. has verified that Respondent is bound by the Enom, Inc. registration agreement and has thereby agreed to resolve domain-name disputes brought by third parties in accordance with ICANN's Uniform Domain Name Dispute Resolution Policy (the "Policy").

On November 6, 2007, a Notification of Complaint and Commencement of Administrative Proceeding (the "Commencement Notification"), setting a deadline of November 26, 2007 by which Respondent could file a response to the Complaint, was transmitted to Respondent via e-mail, post and fax, to all entities and persons listed on Respondent's registration as technical, administrative and billing contacts, and to postmaster@mamacitas.net by e-mail.

Having received no response from Respondent, the National Arbitration Forum transmitted to the parties a Notification of Respondent Default.

On November 30, 2007, pursuant to Complainant's request to have the dispute decided by a single-member Panel, the National Arbitration Forum appointed Houston Putnam Lowry, Chartered Arbitrator, as Panelist.

Having reviewed the communications records, the Administrative Panel (the "Panel") finds that the National Arbitration Forum has discharged its responsibility under Paragraph 2(a) of the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules") "to employ reasonably available means calculated to achieve actual notice to Respondent." Therefore, the Panel may issue its decision based on the documents submitted and in accordance with the ICANN Policy, ICANN Rules, the National Arbitration Forum's Supplemental Rules and any rules and principles of law that the Panel deems applicable, without the benefit of any response from Respondent.

RELIEF SOUGHT

Complainant requests that the domain name be transferred from Respondent to Complainant.

PARTIES' CONTENTIONS

A. Complainant makes the following assertions:

The trademarks on which the Complaint is based on the following registrations, the registration date for which precedes Respondent's registration of the Domain Name:

1.	MAMACITA'S	Texas Reg. No. 58256
2.	MAMACITA'S & Design	Texas Reg. No. 58255
3.	MAMACITA'S MEXICAN RESTAURANT & Design	Texas Reg. No. 48816
4.	MAMACITA'S MEXICAN RESTAURANT	U.S. Reg. No. 2,593,367
5.	MAMACITA'S MEXICAN RESTAURANT	U.S. Reg. No. 2,600,518
6.	MAMACITA'S MEXICAN RESTAURANT	U.S. Reg. No. 2,616,990
7.	MAMACITA'S MEXICAN RESTAURANT & Design	U.S. Reg. No. 2,593,368

FACTUAL AND LEGAL GROUNDS

This Complaint is based on the following factual and legal grounds:

“Mamacita’s” is a Texas partnership engaged, since at least 1987, in providing Mexican food services, catering, clothing and drink mixers. Mamacita’s registered its mark federally and in Texas (“Mark”).

In addition to the registered Mark, Complainant owns substantial common law rights to the single formative “Mamacita’s” in connection with such goods and services, which has been in continuous use since at least 1987, as indicated by the Texas state trademark registration referenced above.

Respondent has no affiliation or relationship with Complainant that would allow Respondent to claim trademark rights or interests in Complainant’s Mark or the Domain Name that incorporates Complainant’s Mark. There is no reason for Respondent to register the domain name “mamacitas.net,” other than to trade on the goodwill inherent in Complainant’s mark for Respondent’s own commercial gain, to impede Complainant’s rights and duties, and to hold onto such Domain Name in hopes of selling it for a profit.

Respondent has no legitimate interests in the Domain Name. Respondent is not commonly known by the domain name “mamacitas.net.” Respondent’s web site using the Domain Name has no affiliation with “Mamacitas,” and only serves as a general linking site for various categories. In addition, Respondent’s web page indicates, at the bottom left portion of the page, that the Domain Name “may” be for sale, which is a transparent attempt to invite third party bids.

Respondent’s registration of the Domain Name impermissibly suggests that Complainant has sponsored, approved, or is otherwise affiliated with Respondent, and constitutes an unauthorized trading upon the goodwill in and to the Mark, in violation of Complainant’s rights.

Respondent has, without regard to the goods or services of the parties, a bad faith intent to profit from the Mark, and has registered, trafficked or used a domain name that is identical, confusingly similar or dilutive of the Mark. The activities of Respondent are and have been without authorization from Complainant and were taken in bad faith as the following facts illustrate:

- 1) Respondent’s lack of use of the Domain Name in association with a bona fide offering of goods or services.
- 2) Respondent’s lack of use of the Domain Name as a trade name to refer to itself;
- 3) Respondent has no trademark or intellectual property rights in the Domain Name, whereas Complainant does.
- 4) Respondent has disrupted Complainant’s business, and diverted consumers from Complainant to a site accessible under the Domain Name

that could harm the goodwill represented by the Mark, either for commercial gain or with the intent to tarnish or disparage the Mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site;

- 5) Respondent registered the Domain Name, which Respondent knew was identical or confusingly similar to Complainant's trademark rights.
- 6) Respondent's passive holding of the Domain Name presents a likelihood of confusion to relevant consumers, will frustrate consumers, and prevents consumers from accessing Complainant's web site to obtain Complainant's goods and services. Further, Respondent's passive holding of the Domain Name indicates Respondent has no legitimate rights in same. New Hampshire Sweepstakes Commission v. We Web Well, Inc., FA 197499 (Nat. Arb. Forum Nov. 3, 2003).
7. Respondent's failure to respond to Complainant's demand letter to cease use of the Domain Name.

Respondent is not offering any bona fide goods or services in association with its Internet web site that utilizes the Domain Name. See Edmunds.com, Inc. v. Ult. Search, Inc., D2001-1319 (WIPO Feb. 1, 2002); Ohio Lottery Commission v. John Barbera, FA 96571 (Nat. Arb. Forum March 1, 2001); Ohio Lottery Commission v. Private, FA 97642 (Nat. Arb. Forum July 23, 2001); Boeing Co. v. Bressi, D2000-1164 (WIPO Oct. 23, 2000); Canadian Imperial Bank of Commerce v. D3M Virtual Reality, Inc. and D3M Domain Sales, AF-0336 (eResolution Sept. 23, 2000), and cases cited therein; Stephanie Seymour v. Jeff Bugar d/b/a Stephanie Seymour Club, FA 97112 (Nat. Arb. Forum May 29, 2001); Kevin Spacey v. Alberta Hot Rods, FA 114437 (Nat. Arb. Forum Aug. 1, 2002); Paul Petrovich v. Jazz Melody, FA 290894 (Nat. Arb. Forum Sept. 10, 2004).

The domain name "mamacitas.net" is confusingly similar to the Mark. Consumers will presume that the Domain Name is affiliated with Complainant. See Perot Sys. Corp. v. Perot.net, FA 95312 (Nat. Arb. Forum Aug. 29, 2000). "Mamacitas.net" is also confusingly similar to Complainant's own domain name, "mamacitas.com," through which Complainant offers its goods and services.

In light of Respondent's registration of "mamacitas.net," consumers are likely to believe that Complainant has licensed the Mark to Respondent, licensed use of the Domain Name to Respondent, or that there is some other affiliation between the two.

Consumers are likely to be initially confused because they may utilize "mamacitas.net" in the belief that it is associated with Complainant. Consumers will be further confused and become frustrated if the site associated with the Domain Name is not in fact related to Complainant or its services, which may reflect poorly upon Complainant and affect the purchasing decisions of consumers. Further, the use of the Domain Name will tarnish the

rights and goodwill that Complainant has in its own Marks, thereby causing further injury and harm to Complainant and its business.

B. Respondent failed to submit a Response in this proceeding.

FINDINGS

Complainant, Mamacita's, is a Texas general partnership that operates Mexican restaurants and also provides catering, clothing, and drink mixers. Complainant has been using the MAMACITA'S mark since 1987 in connection with these goods and services. Complainant holds a registration for the mark MAMACITA'S MEXICAN RESTAURANT with the United States Patent and Trademark Office ("USPTO") (Reg. No. 2,593,367 issued July 16, 2002), and also holds a registration for the MAMACITA'S mark with the State of Texas (Reg. No. 58,255 issued November 5, 1998). Complainant also currently operates a website promoting its restaurant located at the <mamacitas.com> domain name.

Respondent registered the <mamacitas.net> domain name on July 17, 2003. Respondent's disputed domain name resolves to a website featuring links to various third-party websites unrelated to Complainant's business.

DISCUSSION

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable."

In view of Respondent's failure to submit a response, the Panel shall decide this administrative proceeding on the basis of Complainant's undisputed representations pursuant to paragraphs 5(e), 14(a) and 15(a) of the Rules and draw such inferences it considers appropriate pursuant to paragraph 14(b) of the Rules. The Panel is entitled to accept all reasonable allegations and inferences set forth in the Complaint as true unless the evidence is clearly contradictory. *See Vertical Solutions Mgmt., Inc. v. webnet-marketing, inc.*, FA 95095 (Nat. Arb. Forum July 31, 2000) (holding that the respondent's failure to respond allows all reasonable inferences of fact in the allegations of the complaint to be deemed true); *see also Talk City, Inc. v. Robertson*, D2000-0009 (WIPO Feb. 29, 2000) ("In the absence of a response, it is appropriate to accept as true all allegations of the Complaint.").

Paragraph 4(a) of the Policy requires that Complainant must prove each of the following three elements to obtain an order that a domain name should be cancelled or transferred:

- (1) the domain name registered by Respondent is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (2) Respondent has no rights or legitimate interests in respect of the domain name; and
- (3) the domain name has been registered and is being used in bad faith.

Identical and/or Confusingly Similar

The Panel finds Complainant's registration of the MAMACITA'S MEXICAN RESTAURANT mark with the USPTO sufficiently establishes Complainant's rights in the mark pursuant to Policy ¶4(a)(i). *See Innomed Techs., Inc. v. DRP Servs.*, FA 221171 (Nat. Arb. Forum Feb. 18, 2004) ("Registration of the NASAL-AIRE mark with the USPTO establishes Complainant's rights in the mark."); *see also U.S. Office of Pers. Mgmt. v. MS Tech. Inc.*, FA 198898 (Nat. Arb. Forum Dec. 9, 2003) ("[O]nce the USPTO has made a determination that a mark is registrable, by so issuing a registration, as indeed was the case here, an ICANN panel is not empowered to nor should it disturb that determination.").

Complainant asserts Respondent's <mamacitas.net> domain name is confusingly similar to Complainant's MAMACITA'S MEXICAN RESTAURANT. The Panel agrees with this assertion, as the disputed domain name merely omits the terms "mexican" and "restaurant" from the mark and deletes the apostrophe in the word "mamacita's." Previous UDRP panels have found, and this Panel so finds, that the omission of words and punctuation, such as apostrophes, from a mark do not render a disputed domain name distinct from an established mark. Moreover, the addition of the generic top-level domain ".net" to the disputed domain name is of no consequence to the Policy ¶4(a)(i) analysis, as a top-level domain is required of all domain names. Thus, the Panel concludes that the <mamacitas.net> domain name is confusingly similar to Complainant's MAMACITA'S MEXICAN RESTAURANT mark pursuant to Policy ¶4(a)(i). *See Asprey & Garrard Ltd v. Canlan Computing*, D2000-1262 (WIPO Nov. 14, 2000) (finding that the domain name <asprey.com> is confusingly similar to the complainant's ASPREY & GARRARD and MISS ASPREY marks); *see also LOreal USA Creative Inc v. Syncopate.com – Smart Names for Startups*, FA 203944 (Nat. Arb. Forum Dec. 8, 2003) (finding that the omission of an apostrophe did not significantly distinguish the domain name from the mark); *see also Rollerblade, Inc. v. McCrady*, D2000-0429 (WIPO June 25, 2000) (finding that the top level of the domain name such as ".net" or ".com" does not affect the domain name for the purpose of determining whether it is identical or confusingly similar); *see also Gardline Surveys Ltd. v. Domain Fin. Ltd.*, FA 153545 (Nat. Arb. Forum May 27, 2003) ("The addition of a top-level domain is irrelevant when establishing whether or not a mark is identical or confusingly similar, because top-level domains are a required element of every domain name.").

The Panel concludes Policy ¶4(a)(i) is satisfied.

Rights or Legitimate Interests

Under Policy ¶4(a)(ii), Complainant has the initial burden of showing Respondent lacks rights and legitimate interests in the <mamacitas.net> domain name. Once Complainant makes a *prima facie* case on this issue, however, the burden shifts to Respondent to show that it does have rights or legitimate interests in the disputed domain name. In the instant

case, the Panel finds Complainant has established a *prima facie* case under the Policy. *See Do The Hustle, LLC v. Tropic Web*, D2000-0624 (WIPO Aug. 21, 2000) (holding that, where the complainant has asserted that the respondent has no rights or legitimate interests with respect to the domain name, it is incumbent on the respondent to come forward with concrete evidence rebutting this assertion because this information is “uniquely within the knowledge and control of the respondent”); *see also Clerical Med. Inv. Group Ltd. v. Clericalmedical.com*, D2000-1228 (WIPO Nov. 28, 2000) (finding that, under certain circumstances, the mere assertion by the complainant that the respondent has no right or legitimate interest is sufficient to shift the burden of proof to the respondent to demonstrate that such a right or legitimate interest does exist).

Respondent’s failure to answer the Complaint raises the presumption that Respondent lacks rights and legitimate interests in the <**mamacitas.net**> domain name. *See Am. Express Co. v. Fang Suhendro*, FA 129120 (Nat. Arb. Forum Dec. 30, 2002) (“[B]ased on Respondent's failure to respond, it is presumed that Respondent lacks all rights and legitimate interests in the disputed domain name.”); *see also Charles Jourdan Holding AG v. AAIM*, D2000-0403 (WIPO June 27, 2000) (finding it appropriate for the panel to draw adverse inferences from the respondent’s failure to reply to the complaint). However, the Panel will still examine the record to determine if Respondent has rights or legitimate interests under Policy ¶4(c).

Complainant asserts Respondent is not commonly known by the <**mamacitas.net**> domain name, which indicates a lack of rights and legitimate interests under Policy ¶4(c)(ii). Respondent’s WHOIS information indicates that Respondent is “DNS Market,” and there is no other evidence in the record to suggest that Respondent is known by the <**mamacitas.net**> domain name. Furthermore, Complainant has not authorized or licensed Respondent to use its MAMACITA’S MEXICAN RESTAURANT mark or any derivation thereof. Therefore, the Panel finds Respondent lacks rights and legitimate interests in the disputed domain name pursuant to Policy ¶4(c)(ii). *See Tercent Inc. v. Lee Yi*, FA 139720 (Nat. Arb. Forum Feb. 10, 2003) (stating “nothing in Respondent’s WHOIS information implies that Respondent is ‘commonly known by’ the disputed domain name” as one factor in determining that Policy ¶4(c)(ii) does not apply); *see also Compagnie de Saint Gobain v. Com-Union Corp.*, D2000-0020 (WIPO Mar. 14, 2000) (finding no rights or legitimate interest where the respondent was not commonly known by the mark and never applied for a license or permission from the complainant to use the trademarked name).

Respondent’s <**mamacitas.net**> domain name resolves to a website featuring links to various unrelated third-party websites, and the Panel presumes Respondent earns click-through fees when Internet users click on these links. The Panel concludes that such use constitutes neither a *bona fide* offering of goods or services under Policy ¶4(c)(i) or a legitimate noncommercial or fair use under Policy ¶4(c)(iii), and further indicates Respondent’s lack of rights and legitimate interests under Policy ¶4(a)(ii). *See Bank of Am. Corp. v. Nw. Free Cmty. Access*, FA 180704 (Nat. Arb. Forum Sept. 30, 2003) (“Respondent's demonstrated intent to divert Internet users seeking Complainant's

website to a website of Respondent and for Respondent's benefit is not a bona fide offering of goods or services under Policy ¶4(c)(i) and it is not a legitimate noncommercial or fair use under Policy ¶4(c)(iii)."); *see also WeddingChannel.com Inc. v. Vasiliev*, FA 156716 (Nat. Arb. Forum June 12, 2003) (finding that the respondent's use of the disputed domain name to redirect Internet users to websites unrelated to the complainant's mark, websites where the respondent presumably receives a referral fee for each misdirected Internet user, was not a *bona fide* offering of goods or services as contemplated by the Policy).

The Panel concludes Policy ¶4(a)(ii) is satisfied.

Registration and Use in Bad Faith

Finally, Complainant contends Respondent registered and is using the <**mamacitas.net**> domain name in bad faith. As mentioned above, the Panel presumes Respondent benefits commercially when Internet users click on the links contained on the website that resolves from the disputed domain name. Respondent is thus taking advantage of the likelihood that Internet users, presumably seeking Complainant's business, will be confused as to Complainant's affiliation with the disputed domain name. Under Policy ¶4(b)(iv), the Panel finds this is evidence that Respondent registered and is using the <**mamacitas.net**> domain name in bad faith. *See Am. Univ. v. Cook*, FA 208629 (Nat. Arb. Forum Dec. 22, 2003) ("Registration and use of a domain name that incorporates another's mark with the intent to deceive Internet users in regard to the source or affiliation of the domain name is evidence of bad faith."); *see also Kmart v. Khan*, FA 127708 (Nat. Arb. Forum Nov. 22, 2002) (finding that if the respondent profits from its diversionary use of the complainant's mark when the domain name resolves to commercial websites and the respondent fails to contest the complaint, it may be concluded that the respondent is using the domain name in bad faith pursuant to Policy ¶4(b)(iv)).

The Panel concludes Policy ¶4(a)(iii) is satisfied.

DECISION

Having established all three elements required under the ICANN Policy, the Panel concludes that relief shall be **GRANTED**.

Accordingly, it is Ordered that the <**mamacitas.net**> domain name be **TRANSFERRED** from Respondent to Complainant.


Houston Putnam Lowry, Esq.
Arbitrator

Houston Putnam Lowry, Chartered Arbitrator, Panelist
Dated: December 10, 2007

[Click Here](#) to return to the main Domain Decisions Page.

[Click Here](#) to return to our Home Page

NATIONAL ARBITRATION FORUM