

## **ADMINISTRATIVE PANEL DECISION**

Xtralife Natural Products, Inc. v. Xtralife Colombia S.A.S. / Santiago Chaparro Arias / Maria Eugenia Arias Rivera  
Case No. D2022-4048

### **1. The Parties**

The Complainant is Xtralife Natural Products, Inc., United States of America (“United States”), represented by Sanchelima & Associates, P.A., United States.

The Respondents are Xtralife Colombia S.A.S., Colombia / Santiago Chaparro Arias, Colombia / Maria Eugenia Arias Rivera, Colombia, represented by Triana, Uribe & Michelsen, Colombia.

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

The disputed domain name <xtralifeusa.com> is registered with Hosting Concepts B.V. d/b/a Openprovider (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 27, 2022. On October 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 31, 2022, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 November 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 23, 2022. The Response was filed with the Center on November 23, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on November 30, 2022. 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.

The Panel has not received any requests from the Complainant or the Respondents regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

The language of the proceeding is English, being the language of the Registration Agreement, as per paragraph 11(a) of the Rules.

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

The Complainant is Xtralife Natural Products, Inc., a United States company operating in the field of nutritional supplements, and owning the following United States trademark registrations for XTRALIFE NATURAL PRODUCTS:

- United States Trademark Registration No. 2,666,134 for XTRALIFE NATURAL PRODUCTS, registered on December 24, 2002;
- United States Trademark Registration No. 5,669,359 for XTRALIFE NATURAL PRODUCTS, registered on February 5, 2019.

The Complainant also operates on the Internet, owning the domain name <xtralifemiami.com>.

The Complainant provided evidence in support of the above.

The Respondents (hereinafter referred to as “the Respondent”) are Xtralife Colombia S.A.S., a Colombian company operating in the field of pharmaceutical products, and the two owners of the company, namely Santiago Chaparro Arias and Maria Eugenia Arias Rivera. The Respondent owns the following Colombian trademark registration for XTRALIFE, registered in the name of Maria Eugenia Arias Rivera about ten years before the company Xtralife Colombia S.A.S. was incorporated:

- Colombian Trademark Registration No. 577465 for XTRALIFE and design, registered on February 20, 2008.

The Respondent provided evidence in support of the above.

The disputed domain name was registered on December 25, 2015, according to the Whois records, and it currently redirects to a parking page. However, the Complainant was able to provide evidence that prior to the Complaint the website at the disputed domain name was referring to the Complainant by reproducing the Complainant’s trademark and logo and offering for sale the same products as the Complainant, supposedly counterfeited.

#### **5. Parties’ Contentions**

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

The Complainant states that the disputed domain name is confusing similar to its trademark XTRALIFE NATURAL PRODUCTS, as it fully incorporates the dominant portion of its trademark, namely XTRALIFE.

Moreover, the Complainant asserts that the Respondent was formerly a distributor and licensee of the Complainant from 2004 to 2020 and at no point, neither during the license or after its termination, did the Complainant authorize the Respondent to use, register, or operate the disputed domain name. The

Complainant asserts that the Respondent does not have any legitimate interests in respect of the disputed domain name and that, on the website at disputed domain name, counterfeit versions of the Complainant's nutritional supplements were offered for sale.

The Complainant submits that the Respondent has registered the disputed domain name in bad faith, since the Complainant's trademark XTRALIFE NATURAL PRODUCTS is distinctive and the Respondent was formerly a distributor of the Complainant in Colombia. In 2020, following the termination of the license, the Respondent began using the website at the disputed domain intentionally attempting to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's trademark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website and products.

## **B. Respondent**

The Respondent states that the products in respect of which it registered its trademark XTRALIFE are not the same as the Complainant, as they are pharmaceutical products instead of antiaging compositions, and that the trademark XTRALIFE is weak because it is descriptive of the goods covered, therefore coexisting with several other identical trademarks XTRALIFE belonging to different companies in different fields.

The Respondent asserts to have rights in respect of the disputed domain name, based on its Colombian trademark registration as well as on its company name.

The Respondent finally submits that there is no bad faith in registering and using the disputed domain name, since the latter was registered in 2015 and not in 2020, and because the disputed domain name is used based on the Respondent's acquisition of trademark rights in XTRALIFE in 2008.

## **6. Substantive Issues**

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed 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 disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

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

The Panel finds that the Complainant is the owner of the trademark XTRALIFE NATURAL PRODUCTS and that the disputed domain name is confusingly similar to such trademark.

Regarding the addition of the country abbreviation "usa", the Panel notes that it is now well established that where the trademark at issue is recognizable the addition of other (descriptive or geographical or otherwise) terms to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark (see, e.g., *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. [D2005-0037](#); *Red Bull GmbH v. Chai Larbthanasub*, WIPO Case No. [D2003-0709](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)). The addition of the term "usa" does not therefore prevent the disputed domain name from being found to be confusingly similar to the Complainant's trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8.

It is also well accepted that a generic Top Level Domain, in this case ".com", is typically ignored when assessing the similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.1.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain name is confusingly similar to the Complainant's trademark, pursuant to the Policy, paragraph 4(a)(i).

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

Paragraph 4(a)(ii) of the Policy requires the Complainant to prove that the Respondent has no rights or legitimate interests in the disputed domain name.

The Respondent may establish a right or legitimate interest in the disputed domain name by demonstrating in accordance with paragraph 4(c) of the Policy any of the following circumstances, in particular but without limitation:

“(i) before any notice to you of the dispute, your 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) you (as an individual, business, or other organization) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or

(iii) you are 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.”

According to paragraph 4(a) of the Policy, the Complainant has the burden of proving the three elements of the Policy. However, satisfying the burden of proving a lack of the Respondent's rights or legitimate interests in respect of the disputed domain name according to paragraph 4(a)(ii) of the Policy is potentially quite difficult, since proving a negative circumstance is more complicated than establishing a positive one.

As such, it is well accepted that it is sufficient for the Complainant to make a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain name in order to shift the burden of production on the Respondent. If the Respondent fails to demonstrate rights or legitimate interests in the disputed domain name in accordance with paragraph 4(c) of the Policy or on any other basis, the Complainant is deemed to have satisfied paragraph 4(a)(ii) of the Policy.

The Complainant, as set out above, asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain name since it has not been authorized by the Complainant to register the disputed domain name or to use its trademark within the disputed domain name, nor is making either a *bona fide* offering of goods or services or a legitimate noncommercial or fair use of the disputed domain name. The Complainant submits that the Respondent, a former distributor and licensee of the Complainant from 2004 to 2020, is using the disputed domain name in relation to a website in which counterfeit versions of the Complainant's nutritional supplements are offered for sale.

The Respondent, on the other hand, claims to have rights in respect of the disputed domain name, based on its Colombian trademark registration dating back to 2008, as well as on the name of its company, incorporated in 2018, and provided evidence of both those registrations. Prior UDRP panels have recognized that a respondent's registration of a trademark which corresponds to a domain name may support a finding of rights or legitimate interests in that domain name if it is clear that the respondent's trademark was not obtained primarily to circumvent the application of the UDRP or otherwise prevent the Complainant's exercise of its rights. See [WIPO Overview 3.0](#), section 2.12. Here, given that the Respondent was a former distributor of the Complainant's products – and noting the claims made by the Complainant about the content on the Respondent's website, it is not clear whether this standard is met on the part of the Respondent.

In any event, in light of the the Panel's findings below it is not necessary to make a determination on the matter.

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

Even though the circumstances under the second element present a *prima facie* case to be rebutted, , the Panel deems that the Complainant has not met its burden of proof on this third element for the following reasons.

Regarding the registration in bad faith of the disputed domain name, being the parties collaborating from 2004 to 2020 as stated by the Complainant and not denied by the Respondent, the Panel finds that the Respondent knew of the Complainant and deliberately registered the disputed domain name. However, it is not clear in this case whether the Respondent registered the disputed domain name in bad faith when by all appearances the parties were still collaborating.

As regards to the use of the disputed domain name, when it pointed to a website in which the same products as the Complainant (or counterfeit versions, as alleged) were offered for sale, to the extent the Parties were no longer collaborating, this would seem to raise a question as to the Respondent's motivations at that time which are better suited to discovery and cross-examination.

Similarly, while the registration by the Respondent of its trademark in 2008 when the Parties seemed to be still operating on a cooperative basis raises a question, this is matter that would fall to a court where greater discovery and examination are possible.

The Policy does not apply to all types of trademark infringement *per se*, it applies to the bad faith registration and use of a domain name which is confusingly similar to a party's trademark and in which the domain name registrant has no rights or legitimate interests. The fact that the Respondent here may currently be infringing on the Complainant's trademark does not by itself result in a determination of the disputed domain name being registered in bad faith – as is noted above, for a considerable period the Parties seemed to be on cooperative working terms.

The proceeding under the Policy does not prevent the Complainant from submitting the dispute to a court of competent jurisdiction for independent resolution after this proceeding is concluded, and the Complainant is free to seek other more suitable remedies which may be available in the competent jurisdiction.

In light of the above, the Panel finds that the Complainant has failed to prove that the Respondent has registered the disputed domain name in bad faith, in accordance with paragraph 4(a)(iii) of the Policy.

### **7. Decision**

For the foregoing reasons, the Complaint is denied.

*/Edoardo Fano/*

**Edoardo Fano**

Sole Panelist

Date: December 6, 2022