

## **ADMINISTRATIVE PANEL DECISION**

Real Madrid Club de Futbol v. Whois Agent (346986033), Whois Privacy Protection Service, Inc. / M. Gonzalez, Castellana Holding Inc.  
Case No. D2022-1542

### **1. The Parties**

The Complainant is Real Madrid Club de Futbol, Spain, represented by Neudomains Digital, Spain.

The Respondent is Whois Agent (346986033), Whois Privacy Protection Service, Inc., United States of America (“United States”) / M. Gonzalez, Castellana Holding Inc., Spain, represented by HYAIP, Spain.

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

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

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 28, 2022. On April 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 29, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on May 2, 2022, 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 May 4, 2022.

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 May 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 29, 2022. The Response was filed with the Center on May 29, 2022.

The Center appointed Manuel Moreno-Torres as the sole panelist in this matter on June 13, 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.

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

The Complainant is a professional football club based in Madrid, Spain. The Complainant is the most successful club in Spanish football in terms of international and overall trophies.

The Complainant owns a number of trademark registrations, such as European Union trademark registration number 2342681 for MADRIDISTAS plus logo, registered on July 6, 2003 and European trademark registration number 8359366 for MADRIDISTA plus logo, registered on January 21, 2010.

The Complainant owns a portfolio of domain names comprising its trademarks, for example, <madridistas.net>, <madridistas.org>, and <madridistas.online>.

The disputed domain name was registered on July 29, 2005 and currently is inactive. According to a screen capture included in the Complaint, the disputed domain name has been linked to a parked website including pay-per-click ("PPC") links related to competitor parties' websites. According to a screen capture included in the Response, the disputed domain name displayed a list of most valuable REAL MADRID players in 2008 and 2009.

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

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

The Complainant contends that the disputed domain name differs from MADRIDISTAS trademark only in the addition of the generic Top-Level Domain ("gTLD") ".com" and the trademark is the most prominent part of the disputed domain name. Therefore, the inclusion of the gTLD to the trademark does not make the disputed domain name different to its registered marks but rather increases the risk of confusion; thus, the disputed domain name is identical or confusingly similar to the Complainant's trademark rights.

Moreover, the Complainant highlights how the MADRIDISTAS trademark enjoys substantial goodwill and reputation in services offered and delivered by means of the Internet based on an extensive use, promotion and advertising of the MADRIDISTAS business.

The disputed domain name was chosen by the Respondent to make Internet users believe that any website to which the domain name might resolve is associated with the Complainant. However, the Complainant has not authorized or licensed the use of its marks in the disputed domain name and only due to MADRIDISTAS trademark well-known recognition, the registration of the disputed domain name took place.

The Complainant holds that the Respondent is not commonly known by the disputed domain name nor does the Respondent has any registered trademarks or trade names corresponding to the disputed domain name. Likewise, the Complainant denies any *bona fide* offering in the use of the disputed domain name.

With regards to the third requirement, the Complainant affirms that the term "MADRIDISTAS" is not a common word in the Spanish language. Given the well-known character of MADRIDISTAS, the Respondent could not have been unaware of it. Thus, the Respondent deliberately used the Complainant's trademark when registering the disputed domain name. The Complainant supports its argument of bad faith registration and use through paragraph 4(b)(ii) of the Policy.

Furthermore, the Complainant contends that the registration of a domain name incorporating a distinctive trademark when there is no relationship between the parties, may be sufficient evidence of bad faith. The Respondent relied on the brand recognition for MADRIDISTAS to take advantage of the Complainant and its

trademarks to build the false impression that the disputed domain name is somehow associated with the Complainant. In addition, the Complainant notes that the use of the disputed domain name to advertise PPC links related with football has no imaginable good faith use.

Finally, the Complainant alleges that by incorporating a well-known trademark as it is MADRIDISTAS in the disputed domain name, the Respondent has registered the disputed domain name to prevent the Complainant from reflecting its trademark in a domain name.

## **B. Respondent**

The Respondent contends that "madridistas" is a term widely used and it describes an individual belonging to the Real Madrid Football Club fandom. Therefore, it is claimed that "madridistas" is in essence a dictionary word which describes somebody supporting or working with the Complainant.

The Respondent claims that "madridistas" is a generic term not used in connection with the Complainant's trademarks. Further, according to the Respondent there is a lack of use of MADRIDISTA trademark between 2000 and 2005. The Respondent further states there are a number of websites using the term "madridistas" for their blogs or social media profile, which are not owned or affiliated to the Complainant. In fact, the term "madridistas" is in use in connection with different products for sale, with no connection with the Complainant. Therefore, according to the Respondent registering a disputed domain name with said term does not necessarily imply a use of the Complainant's trademark.

The Respondent claims that the Complainant has not provided any evidence of the alleged well-known character of MADRIDISTAS trademark at the time of the registration of the disputed domain name, back in 2005.

The Respondent alleges to have been registering a number of domain names containing generic or dictionary terms, such as <escorial.com>, <donquixote.com>, or <madridguide.com> and many others. In addition, the Respondent points out to be a REAL MADRID fan and an old member of Club. He denies any infringement of the Complainant's trademarks rights.

Respondent's intent of use was for a web page hosting and DNS type MX for email hosting. In 2006 the disputed domain name was admitted as a Beta tester by Google. The Respondent insists he registered the disputed domain name with the intention of developing a blog about REAL MADRID footballers' first team. However, the Respondent admits that the blog has not been working for a while due to different reasons, including Covid and his workload.

The Respondent produces a number of Panel decisions to support his claim that he did take advantage of a generic term rather than the Complainant's trademarks.

With regards to the third element, the Respondent alleges that he has never had the intention of selling the disputed domain name. He did receive one offer, but he did not even answer to the proposal. The Respondent also states the disputed domain name was not registered in order to prevent the Complainant from reflecting the mark in a domain name.

While the registration of the domain name was based on a hobby practice, the Respondent asserts, he has never disrupted the Complainant's business.

Finally, the Respondent denies that the use of the disputed domain name matches with paragraph 4(b)(iv) of the Policy. The Respondent claims that his use aims to profit from the claimed generic value of the word "madridistas" without intending to take advantage of a complainant's rights in the word.

## 6. Discussion and Findings

Under paragraph 4(a) of the Policy, to succeed the Complainant must satisfy the Panel that:

- (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 was registered and is being used in bad faith.

### A. Identical or Confusingly Similar

As noted above, the Complainant has established trademarks rights for the purposes of the UDRP. Therefore, the assessment focus on the comparison between the disputed domain name <madridistas.com> and the MADRIDISTAS trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") section 1.7. In this case, where the disputed domain incorporates the entirety of the textual components of the trademark, the identity is indisputable.

The Panel also notes that gTLDs are generally irrelevant to the consideration of identity or confusing similarity between a trademark and a domain name. See *Crocs, Inc. v. Client Care, Web Commerce Communications Limited*, WIPO Case No. [D2022-0029](#).

Accordingly, the first requirement is met under paragraph 4(a)(i) of the Policy

### B. Rights or Legitimate Interests

A complainant has to make out a *prima facie* case, unrebutted, to fulfill the requirements of paragraph 4(a)(ii) of the Policy. Thus, the onus proving rests on the complainant. However, it is well established that once the complainant makes out a *prima facie* case the burden of production shifts to the respondent.

The Panel finds that the Complainant has made out a *prima facie* case. Indeed, the Panel accepts that the Complainant has never authorized the use of its MADRIDISTAS trademarks, no evidence shows that the Respondent is commonly known by the disputed domain name, and the disputed domain name (an exact match to the mark) suggests affiliation or association with the Complainant. Further the use of the disputed domain name temporarily to redirect to PPC competitors' links is not to be considered a use in connection to a *bona fide* offering. Moreover, the Complainant states that the Respondent does not have any registered trademark rights corresponding with the disputed domain name.

Thus, there is a *prima facie* case against the Respondent and therefore, the burden shifts to the Respondent to produce evidence demonstrating rights or legitimate interests with regard to the disputed domain name.

Paragraph 4(c) of the Policy determines several illustrative circumstances for the Respondent that may demonstrate rights or legitimate interests in the disputed domain name: "Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate your rights or legitimate interests to the domain name for purposes of paragraph 4(a)(ii): (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."

The Respondent asserts to have registered the disputed domain name as part of a hobby and for a mail hosting service. However, no evidence has been produced, except for a Google invitation email to become a beta tester in May 2006. Be it as it may, this is not a use of a generic term as alleged.

Besides, the Respondent refers to a screen capture where the disputed domain name displayed a list of most valuable REAL MADRID players in 2008 and 2009. Had the disputed domain name not been identical to the famous Complainant's mark, this could potentially support a claim to a legitimate interest, but the Panel notes moreover that (*i.e.*, even if the disputed domain name was not identical to the relevant mark) there was no disclaimer in the corresponding site. See "[WIPO Overview 3.0](#)" section 3.7: "the presence of a clear and sufficiently prominent disclaimer can support a finding that the respondent has undertaken reasonable steps to avoid unfairly passing itself off as related to the complainant, or to otherwise confuse users".

Further, the Complainant has produced a screenshot which evidences the use of a PPC service to links related to competitors parties' websites. This is not a legitimate interest since such links only have value insofar as they trade off Complainant's rights. See *Billy Bob's Texas IP Holding LLC v. Domain Administrator, Name Administration Inc. (BVI)* WIPO Case No. [D2016-1221](#): "Running a PPC page does not *per se* confer a right or legitimate interest on the Respondent; rather, it can support a right or legitimate interest if the links on the page are [not] related to ...its trademark value".

The Panel takes note of <archive.org> snapshots taken since the registration of the disputed domain name by the Respondent to reach the conclusion that inaction is being the most regular status of the disputed domain name for the time being. Between 2005 and 2007, the disputed domain name was inactive. Then, in 2008 it was connected to a PPC site. Then, between 2009 and 2015, the site to which the disputed domain name directed displayed the same ranking of the Madrid football players with very limited updates or changes except in the first year period. Finally, the <archive.org> shows either inaction or no content site at all. Whether the Respondent has been busy or, the Covid pandemic has postponed the use of the disputed domain name in a corresponding *bona fide* offering, does not seem to be supported by the fact that the content appeared in 2008 and 2009 long before this situation.

Under these circumstances, the Panel is of the opinion that the Respondent has not provided any persuasive evidence under paragraph 4(c) of the Policy. In particular, the Panel cannot find a *bona fide* offering or noncommercial or fair use of the disputed domain name without intent for commercial gain to misleadingly divert consumers since the disputed domain name involves a risk of affiliation, and the Respondent has attempted for some time to divert consumers to competitors of the Complainant by using PPC links where, allegedly, the Respondent is obtaining revenues.

The Panel finally takes note of the Respondent's claim that the MADRIDISTAS mark is or has somehow become a generic term. While the Panel acknowledges that the mark seems to be in widespread common use, given the extraordinary popularity of the Complainant's football club and the fact that it remains a registered trademark, such widespread public use would not by itself equate to a mark losing its protected status as a mark. (Indeed, just as the popular search engine Google is sometimes commonly used as a verb, it has been recognized (by a court) as retaining its protected status as a trademark. The Panel is moreover not aware of any action being commenced by the Respondent seeking to cancel the Complainant's trademark.) Overall, the Panel finds that the evidence supports a finding that the disputed domain name was registered because of its renown as a mark, owing to the reputation and goodwill built up by the Complainant, and not because of any claimed generic meaning (which the Panel does not anyway agree is an accurate assessment).

For the above, the Panel finds that the Complainant has succeeded the second requirement to the satisfaction of the Policy, paragraph 4(a)(ii).

### C. Registered and Used in Bad Faith

“[WIPO Overview 3.0](#)”, section 3.1 explains: “Bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”. For such, the Panel’s assessment will normally be made on the basis of the evidence presented in the complaint and the response.

The Complainant alleges that MADRIDISTAS is a well-known trademark, but no particular evidence has been provided to support such claim. In general terms, it can be said that whether a trademark is well-known is based on the market share held by the mark, the intensity, the geographical extension and the duration of its use, as well as the importance of the investments made by the company to promote it, and its general recognition by consumers.

Besides, the Respondent has acknowledged to be a fan of the Complainant and is moreover by his own admission a club member and therefore, it is hard to escape the conclusion that he was aware of the Complainant’s rights.

On balance, these circumstances leads the Panel to conclude that the selection of the disputed domain name was certainly not a random choice. Rather, the Respondent knew or at the very least should have known about MADRIDISTAS as a trademark at the time of the registration.

The Panel looks back to the second requirement. It was concluded that the disputed domain name – being an identical match to the relevant mark – involves a risk of affiliation. At one moment the Respondent has attempted to divert consumers to competitors of the Complainant by using PPC links where, allegedly, the Respondent is obtaining revenues. Such use and purportedly affiliation fits with the circumstances listed in Paragraph 4(b)(iv) of the Policy as evidence of the registration and use of a domain name in bad faith: “by using the domain name, you have intentionally attempted to attract, for commercial gain, internet users to your website or other on-line 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”. See *Banca Akros S.P.A v. Privacy Service Provided by Withheld for Privacy ehf / bancaakros bancaakros*, WIPO Case No. [D2022-0898](#). At another moment the site hosted content about players on the Complainant’s team. And in other moments, and predominately, it has not hosted content. Whatever use the disputed domain name has been put to, the Panel cannot escape that the Respondent (an admitted fan and club member) registered it in the full knowledge of the Complainant and its rights, and would have been aware that doing so would interfere with the same.

Accordingly, the Panel finds that the Complainant has satisfied the requirements of paragraph 4(a)(iii) of the Policy.

### 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, <madridistas.com>, be transferred to the Complainant.

*/Manuel Moreno-Torres/*

**Manuel Moreno-Torres**

Sole Panelist

Date: June 27, 2022