

## **ADMINISTRATIVE PANEL DECISION**

Newcastle United Football Company Limited v. Egzy Gomez Jr  
Case No. D2022-3587

### **1. The Parties**

The Complainant is Newcastle United Football Company Limited, United Kingdom (“UK”), represented by Gateley Legal, UK.

The Respondent is Egzy Gomez Jr, United Kingdom.

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

The disputed domain name <newcastleunitedacademy.com> (the “Disputed Domain Name”) is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 28, 2022. On September 28, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On September 28, 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 (Privacy service provided by Withheld for Privacy ehf, Iceland) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 18, 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 amended Complaint on October 18, 2022.

The Center verified that the Complaint together with the amended 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 October 25, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 14, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 16, 2022.

The Center appointed Michael D. Cover as the sole panelist in this matter on November 24, 2022. The Panel finds that it was properly constituted. The Panel has submitted its 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 company organized and existing under the laws of the UK. Established in 1892, the Complainant is a football club in the Premier League in England. The Complainant's trading name is "Newcastle United". Details of the Complainant's honours and records are attached in Annex 4 to the Complaint. These include achieving 12th place in the UK Premier League in 2021 and 13th place in 2020.

The Complainant had a turnover of between £140 million and £150 million in 2020 and 2021, as set out in a copy of the most recent set of accounts filed at Companies House in the UK, which is annexed to the Complaint as Annex 4a.

To help identify and develop future talent, the Complainant operates a football training and development facility for boys and girls called "Newcastle United Academy". The Newcastle United Academy aims to make a positive contribution to the personal, social, academic and technical development of all boys and girls and scholarship players in the Complainant's youth programme. By providing a safe, professional learning environment, individuals are given the opportunity to maximise their potential. In pursuit of this goal, the Complainant's Newcastle United Academy staff help each player to "be the best that they can be". The objective is to produce talented young men and women, who may go on to represent the Complainant's men's and women's first teams.

The Complainant is the owner of an international portfolio of trademarks, including registrations for its trademark NEWCASTLE UNITED in the UK, for a range of goods and services typical of a professional football club.

Examples are set out below and details of each are attached as Annexes 5, 6 and 7 to the Complaint and include United Kingdom registered trademarks Nos 1,528,410 (filed on March 3, 1993, and registered on June 10, 1994), 2,149,605 (filed on October 1997, and registered on June 5, 1998) and 2,573,017 (filed on February 22, 2011, and registered on June 3, 2011), the earliest of which dates back to March 3, 1993.

The Disputed Domain Name was registered on May 12, 2022. The Disputed Domain Name does not resolve to an active website, but it has been used in connection with emails to parents of children, seeking payments to third parties, and was the subject of email correspondence between the Complainant and the Registrar's Legal and Abuse team in June 2022, which led to the suspension of the service by the Registrar. This is set out at Annexes 8, 9, 10 and 11 to the Complaint.

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

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

###### Identical or Confusingly Similar

The Complainant submits that the Disputed Domain Name contains the Complainant's trademark NEWCASTLE UNITED, followed by the word "academy", exactly matching the name of the Complainant's training and development facility for talented boys and girls.

###### Rights or Legitimate Interests

The Complainant submits that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name since, until the Respondent was stopped by a complaint being made to the Registrar, as set out in Annex 8 to the Complaint, and reported to the police, the Respondent had been attempting to use the Disputed Domain Name for fraud by falsely representing himself as a senior member of the Complainant's Newcastle United Academy.

The Complaint submits that, by appearing to offer children the opportunity of a non-existent football trial in return for payment of GBP 500 to a fictitious third party "agent" called "[...]" by using an email address using the Disputed Domain Name impersonating a real person at the Newcastle United Academy, referring the Panel to Annexes 9, 10 and 11 to the Complaint. The Complainant further demonstrates that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

The Complainant notes that the Respondent is not commonly known by the Disputed Domain Name and the Respondent was neither making a legitimate noncommercial nor fair use of the Disputed Domain Name.

#### Registered and Used in Bad Faith

The Complainant submits that the Respondent has registered and used the Disputed Domain Name in bad faith, since it is beyond doubt that the Respondent was aware of the Complainant when he registered the Disputed Domain Name, as he attempted to use the Disputed Domain Name for fraud by falsely representing himself as a senior member of the Complainant's Newcastle United Academy, appearing to offer non-existent football trials to children in return for payment to a fictitious "agent", breaching the Policy, paragraphs 4(b)(iii) and (iv).

The Complainant states that, following the filing of the Complaint on September 28, 2022, the Center provided the Complainant's representative with the Whois registration details for the Disputed Domain Name. The Complainant notes that a search of UDRP domain name decisions revealed that a person using the same name was the respondent in *The Liverpool Football Club and Athletics Grounds Limited v. Privacy service provided by Withheld for Privacy ehf / Egzy Gomez Jr*, WIPO Case No. [D2022-1145](#). In that case, the Complainant submits that an individual using the same name as in this case registered the domain name <liverpoolfootballclubacademy.com> without Liverpool Football Club's consent and used that domain name to impersonate Liverpool Football Club "in bad faith, in connection with email correspondence under the '@liverpoolfootballclubacademy.com' extension, with a United States of America University". In that case, continues the Complainant, the panel had "no difficulty in finding that the disputed domain name is being used in bad faith", finding that the email correspondence "using the disputed domain name, is a clear example of use of a domain name in bad faith".

The Complainant respectfully requests that this Panel makes the same finding.

#### Remedy

The Complainant requests that the Disputed Domain Name be transferred to the Complainant.

#### **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

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

The Complainant must establish on the balance of probabilities that the Disputed Domain Name is identical or confusingly similar to a trademark in which the Complainant has rights; that the Respondent has no rights or legitimate interests in the Disputed Domain Name; and that 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 has established registered rights in its trademark NEWCASTLE UNITED and that this trademark has become well known, through very extensive use. The first registration of the Complainant's registered trademark NEWCASTLE UNITED goes back nearly 30 years before the registration of the Disputed Domain Name.

The Panel also finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark NEWCASTLE UNITED, in which the Complainant has rights. The Disputed Domain Name incorporates the Complainant's NEWCASTLE UNITED trademark, in which the Complainant has rights, in full. In assessing confusing similarity, it is well established that the addition of other terms, such as the descriptive term "academy", does not prevent a finding of confusing similarity. It is also well established that the generic Top-Level Domain ("gTLD") ".com" is viewed as a standard registration requirement and, as such, is disregarded under the first element of the Policy.

Accordingly, the Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's trademark NEWCASTLE UNITED, in which the Complainant has registered rights, and that the provisions of the Policy, paragraph 4(a)(i) have been met.

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

The Panel accepts and finds that the Respondent has no rights or legitimate interests in the Disputed Domain Name and finds that the provisions of paragraph 4(a)(ii) of the Policy have been met. The Panel accepts and finds that the Respondent has not been authorized, licensed or otherwise permitted by the Complainant to register or use the Complainant's registered trademark NEWCASTLE UNITED as part of the Disputed Domain Name or otherwise.

The Complainant has established a case, to which no response has been filed, that the Respondent has no rights or legitimate interests in the Disputed Domain Name. The Respondent has not, before any notice to the Respondent of the dispute, made use or demonstrable preparations to use the Disputed Domain Name or a name corresponding to it in connection with a *bona fide* offering of goods or services nor has the Respondent been commonly known by the Disputed Domain Name nor has the Respondent made noncommercial or fair use of the Disputed Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue. Such use as has in fact taken place of the Disputed Domain Name involves the Disputed Domain Name being used in connection with the emails for fraudulent purposes, which does not constitute a *bona fide* offering of goods or services and which could tarnish the Complainant's NEWCASTLE UNITED trademark.

The Panel accepts that, by appearing to offer children the opportunity of a non-existent football trial in return for payment of GBP 500 to a fictitious third party "agent" called "[...]" by using an email address using the Disputed Domain Name impersonating a real person at the Newcastle United Academy, the Complainant further demonstrates that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name.

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

The Panel accepts and finds that the Disputed Domain Name has been registered and is being used in bad faith. It is a reasonable inference that the Respondent knew of the Complainant's trademark NEWCASTLE UNITED trademark, which, the Panel accepts, is well known, at the time of registration of the Disputed Domain Name and finds that the Respondent could have had no reason to register the Disputed Domain Name, if not for the significance of the dominant "newcastle united" element of the Disputed Domain Name as the trademark of the Complainant. The Panel's finding has been reinforced by the fact that the Disputed Domain Name has been used to impersonate the Complainant for fraudulent purposes.

With regard to the use of the Disputed Domain Name, this has been in association with the provision of an email service, which, the Panel accepts, has been used fraudulently to impersonate the Complainant and to seek payment from parents whose children may be interested in joining the Complainant's Newcastle United Academy. In addition, the Respondent has failed to avail himself of the opportunity to file a Response to the Complaint and, in particular, to file any evidence of any good-faith use and has sought to conceal his identity.

The Panel accordingly finds that the Respondent has registered and is using the Disputed Domain Name in bad faith and that the provisions of the Policy, paragraph 4(a)(iii) have been met.

## **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 <newcastleunitedacademy.com> be transferred to the Complainant.

*/Michael D. Cover/*

**Michael D. Cover**

Sole Panelist

Date: December 5, 2022