



WIPO Arbitration and Mediation Center

ADMINISTRATIVE PANEL DECISION

Fall Nummer: D2003-0598

Entscheidung vom 8. Oktober 2003

1. The Parties

The Complainant is MADRID 2012, S.A., Madrid, Spain, ...(the "Complainant").

The Respondent is S. Mart.. - MadridMan Websites, ... United States of America (the "Respondent").

2. The Domain Names and Registrar

The disputed domain names , , and <madrid2012.com> (the "domain names") are registered with Register.com.

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 30, 2003. On July 31, 2003, the Center transmitted by email to Register.com a request for registrar verification in connection with the domain names at issue. On August 6, 2003, Register.com transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details for the administrative, billing, and technical contact. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy"), 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(a) and 4(a), the Center formally notified the Respondent of the Complaint on August 6, 2003. After a communication by the Respondent dated August 6, 2003, the language of the proceeding was changed into English. On August 12, 2003, the Center received an English version of the Complaint.

The Center formally re-notified the Respondent of the Complaint, and the proceedings commenced on August 25, 2003. In accordance with the Rules, paragraph 5(a), the due date for Response was September 14, 2003. The Response was filed with the Center on September 6, 2003.

The Center appointed Brigitte Joppich as the Sole Panelist in this matter on September 24, 2003. 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 Spanish company incorporated on July 15, 1999, under the name Fundacion Madrid Nuevo Siglo and renamed MADRID 2012, S.A. on May 18, 2001, with the aim of promoting and drawing attention to the candidature of the Spanish capital, Madrid, for the 2012 Olympic Games. The company was entrusted by the Madrid city council under a collaboration agreement on November 22, 2000, with such candidature project. MADRID 2012, S.A. is the owner of numerous registered trademarks including MADRID2012, MADRID2012 & device, 2M12 & device and M2012 & device in Spain, covering several international classes, namely

Mark

Country

Registration No.

Priority

MADRID 2012

Spain

2373896

January 29, 2001

MADRID 2012 & device

Spain

2380850, 51, 52, 53, 54, 55, 56, 57, 58, 59, 60

February 23, 2001

MADRID 2012 & device

Spain

2391863

April 5, 2001

2M12 & device

Spain

2391864, 65, 66, 67, 68, 69, 70, 71, 72

April 5, 2001

2M12 & device

Spain

2408372, 73, 74, 75, 76, 77, 78, 79, 80, 81, 82, 83

June 15, 2001

M 2012 & device

Spain

2354318, 19

October 30, 2001

The Complainant has registered inter alia the domain names <madrid2012.info>, <madrid2012.biz> and <madrid2012.net> for its online-presence.

S.A. is the Spanish abbreviation of "sociedad anÃ³nima," the equivalent of a public limited company.

The Respondent is an individual living in the United States. He is owner of the domain name <madridman.com> and provides information about Madrid and Spain under this address. He also operates a message board under this domain name which has been, according to the Respondent, the busiest English-language, Spain-dedicated message board on the Internet since its creation in May 2000 and has more than 3,800 registered members.

The Respondent has registered the domain names on the following dates:

Domain Name:

Date of registration:

madrid2012.com

January 27, 2001

2m12.org

April 11, 2001

2m12.com

April 21, 2001

2m12.info

October 5, 2001

The domain names <madrid2012.com>, and are redirected to the website under <madridman.com>. The domain name contains no content.

5. Parties' Contentions

A. Complainant

The Complainant contends that each of the three elements specified in the Policy, paragraph 4(a), are given in the present case, i.e.

(i) the domain names are identical or confusingly similar to the trademarks in which the Complainant has rights:

- The domain names are identical to the Complainant's registered trademarks, MADRID2012 and 2M12 which are all predominated by the word elements and not the device.

- The disputed domain name <madrid2012.com> is identical to the "de-facto"-trademark MADRID2012. Since March 30, 2000, when the Mayor of Madrid presented the city's bid for the 2012 Olympic Games to the IOC, this term has become a well-known symbol of Madrid's bid and was communicated in the press numerous times. These circumstances and the fact, that the Olympic Games have always been identified by the name of the elected host city followed by the year of the games, such as Seoul 88, Barcelona 92, Atlanta 96, Sydney 2000, Athens 2004 or Beijing 2008, makes the term a "de-facto" trademark in which the

Complainant has rights. As the Policy is not limited to the protection of registered trademarks, "de-facto" trademarks are protected against abusive registration of corresponding domain names.

- The domain names are confusingly similar to the M2012 & device trademarks of the Complainant. As the term "2m12" alludes to different meanings of the "m" (being an abbreviation of Madrid as well as an abbreviation of "mil," which is Spanish for "thousand"), the domain names are confusingly similar to the registered M2012 trademarks. Moreover, <madrid2012.com> is confusingly similar to the M2012 trademarks, again based on the fact, that the "m" is understood as an abbreviation of Madrid.

- The disputed domain name <madrid2012.com> is identical to the business name of the Complainant, MADRID 2012, S.A.

(ii) the Respondent has no rights to or legitimate interests in respect of the domain names:

- The Respondent does not own the registered trademarks MADRID2012 and 2M12 and therefore does not have any right or legitimate interest to use MADRID2012 or 2M12 to identify himself.

- The Respondent is not known in the market as MADRID2012 or 2M12. A Google site search with the query "MADRID 2012" produced no hit related to the Respondent.

- The Respondent does not carry out any activity related to the Olympic Games or organization in the field of sports which could be interested in the use of these trademarks or names nor does he offer any products or services identified by these names on his websites.

(iii) the domain names were registered and are being used by the Respondent in bad faith:

- As the Respondent operates a website with information on Madrid and Spain he must have been aware of the nomination of Madrid as a candidate to stage the 2012 Olympic Games. Therefore, he knew about the Complainant's rights in MADRID 2012 and 2M12 at the date of the registration of the domain names and registered them in bad faith. Furthermore, the registration of a well-known trademark as a domain name is in itself a clear indication of bad faith.

- The Respondent is using the domain names <madrid2012.com>, and to attract users to his website by creating a likelihood of confusion with the Complainant's marks, and this is made for commercial gain, as Respondent's website under "www.madridman.com" offers of videos against remuneration, featuring the Respondent's trips to Spain.

- The Respondent has also used the domain name in bad faith. In fact the domain name contains no content. This was found to be bad faith use by previous panels, i.e. in RAIMAT, S.A. v. Antonio Casals, WIPO Case No. D2000-0143.

B. Respondent

The Respondent contends that none of the three elements specified in the Policy, paragraph 4(a), are given in the present case, i.e.

(i) the domain names are not identical or confusingly similar to the trademarks in which the Complainant has rights:

- As to the 2M12 trademarks, they all contain graphics that are not reflected in the domain names (cf. Asociaci n de Usuarios de Internet v. WorldWide Media Inc. WIPO Case No. DBIZ2002-00204). Moreover, none of the trademarks has been registered worldwide in Class 38, which would have protected those trademarks against unauthorized use by third parties on websites and for domain name registrations.

- All MADRID2012 trademarks (except one) contain graphics, too, and therefore the Complaint should be dismissed with regard to these trademarks. All MADRID2012 trademarks were registered after the Respondent had registered the domain name <madrid2012.com>.

(ii) the Respondent has rights or legitimate interests in respect of the domain names:

- The Respondent is planning to develop informational and non-commercial websites relating to the 2012 Olympic Games including discussion board, chat room, human interests stories about the Spanish athletes, and information on tickets, lodging and things to do in Madrid during the time of and the years leading up to the 2012 Olympics, when Madrid might be the Olympic host city. It would be absurd to develop such a website two years prior to the choice of the host city.

- Respondent is known under the domain names as his name is published in the WhoIs directory (which is available to the public).

- The domain names <madrid2012.com>, and have been actively used since their registration for redirection purposes. This indicates their legitimate non-commercial and fair use as <madridman.com> is not a

commercial website but clearly a personal one. The "redirect" function is only temporary until Madrid is - if at all - chosen in 2005 to host the 2012 Olympic games. If people are interested in Madrid's hopes for hosting the 2012 Olympics they are therefore, by association, also interested in the city of Madrid itself. <madridman.com> provides a bona fide offering of non-commercial services, namely information and discussion.

(iii) the domain names were not registered and are not used by the Respondent in bad faith:

- The Respondent was unaware of the Complainant and its trademarks at the time of registration of the domain names. As to the business name of the Complainant, MADRID 2012, S.A., this company was renamed on May 18, 2001, i.e. only after the Respondent had registered the domain names <madrid2012.com>, and was not well-known at the point of registration of . Therefore the domain names were not registered in bad faith.

- The domain names were not used in bad faith because the actual usage is only temporary. Until the Olympic host city will be chosen in 2005, Respondent's usage of the domain names is good faith usage as he is offering first-person, personal information about the city of Madrid to those who seek it. The temporary "redirect" function was not intended to attract Internet users for commercial gain in any form but to "actively use" three of the four domain names. As to the domain name the registration for future usage does not in itself constitute bad faith.

The Respondent has requested the Panel to make a finding of reverse domain name hijacking based on the evidence presented in the Response.

6. Discussion and Findings

Under the Policy, paragraph 4(a) the Complainant must prove that each of the following three elements are present:

(i) the domain names are identical or confusingly similar to the trademarks in which the Complainant has rights;

(ii) the Respondent has no rights or legitimate interests in respect of the domain names; and

(iii) the domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

<madrid2012.com>

The Complainant has rights in numerous trademarks including the element MADRID2012, inter alia a wordmark registered with the OEPM (Spanish Patent and Trademark Office) on January 29, 2001. As the suffix ".com" only indicates that the domain name is registered under this gTLD and is not distinctive, the Panel finds Respondent's domain name <madrid2012.com> to be identical with Complainant's trademarks.

These trademarks are sufficient for the purposes of the Policy, paragraph 4(a)(i), although it is noteworthy that they are quite recent and do not appear to predate the registration of the domain name in question.

Furthermore, as S.A. is the Spanish abbreviation of "sociedad anónima" and not distinctive either, the domain name <madrid2012.com> is also identical to the business name of the Complainant.

Regarding the domain name <madrid2012.com> the Complainant has therefore satisfied the requirements of the Policy, paragraph 4(a)(i).

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The Complainant has rights in numerous trademarks including the element 2M12. The suffixes ".com," ".org" and ".info" only indicate that the domain names are registered under these gTLD and are not distinctive. The elements to be compared are therefore the trademarks 2M12 and devices and the second level domain names 2m12.

The Respondent argues that there can be no similarity between a domain name and a graphical trademark as graphics can never be reflected in a domain name, citing Asociación de Usuarios de Internet v. WorldWide Media Inc. WIPO Case No. DBIZ2002-00204. However, such decision was based on the BIZ-STOP-Procedure, which, under STOP paragraph 4(a), requires that the domain name is identical to a trademark or service mark in which the complainant has rights (confusing similarity is not sufficient under the STOP Policy but under the UDRP). Furthermore, trademarks including a design will be molded by a word or a

sequence of letters or figures if the graphics are not formative. The Panel finds that the graphical parts of Complainant's 2M12 trademarks are not distinctive and must therefore be disregarded with a view to the decision about confusing similarity. As only an identical sequence of figures and one letter remain, Respondent's domain names are found to be confusingly similar to Complainant's trademarks.

Regarding the domain names , and the Complainant has therefore also satisfied the requirements of the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Policy, paragraph 4(c) sets out three illustrative circumstances as examples, which, if proved by the Respondent, shall demonstrate his rights to or legitimate interests in the domain names for purposes under the Policy, paragraph 4(a)(ii).

(i) before any notice to the Respondent of the dispute, the use by the Respondent of, or demonstrable preparations to use, the domain names or names corresponding to the domain names in connection with a bona fide offering of goods or services; or

(ii) the Respondent (as an individual, business or other organization) has been commonly known by the domain names, even if the Respondent has acquired no trademark or service mark rights; or

(iii) the Respondent is making a legitimate noncommercial or fair use of the domain names, without intent for commercial gain to misleadingly divert customers or to tarnish the trademark or service marks at issue.

The Respondent states that he registered the domain names to develop informational and non-commercial websites to the 2012 Olympic Games in Madrid. While the Panel agrees that exhaustive preparations would be inefficient two years prior to the choice of the host city for the 2012 Olympic Games, the Respondent should have used the domain names not only to redirect to his website under "www.madridman.com" but to give an indication of the future use (e.g. a note describing his business and his intentions regarding informational and non-commercial content once Madrid is chosen as host city for the 2012 Olympic Games). The mere allegation of such future use without any evidence of demonstrable preparations is not sufficient under Policy, paragraph 4(c)(i).

The Respondent is furthermore not commonly known by the domain names. The mere presence in the Whois-database is not sufficient in this regard as otherwise every registrant of a domain name could establish a legitimate interest under the Policy, paragraph 4(c)(ii) by using this argument.

Finally, the Respondent is not making a legitimate noncommercial or fair use of the domain names. Even if the services offered under "www.madridman.com" were noncommercial and fair, the mere redirection of the domain names <madrid2012.com>, and to this site would not establish a noncommercial or fair use of these domain names. Otherwise, again, every registrant of a domain name could easily establish a legitimate interest under Policy, paragraph 4(c)(iii), by simply redirecting his domain name to a website providing noncommercial or fair content. Respondent's use of the domain name does therefore not establish rights under Policy, paragraph 4(c)(iii) either.

C. Registered and Used in Bad Faith

The Policy, paragraph 4(b) sets out four illustrative circumstances, which for purposes of the Policy, paragraph 4(a)(iii) shall be evidence of the registration and use of the domain names in bad faith, including

(i) the Respondent has registered the domain names in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that he has engaged in a pattern of such conduct; and

(ii) by using the domain names, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other on-line location, by creating a likelihood of confusion with the Complainant's marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's website or location or of a product or service on its website or location.

<madrid2012.com>

The Respondent registered the domain name <madrid2012.com> two days before the Complainant filed the first application for MADRID2012 and before the company was renamed MADRID 2012, S.A. He therefore probably did not know about the imminent filing. However, as Madrid's bid for the 2012 Olympic Games had been published months before and as the Respondent provides information about Madrid under his website "www.madridman.com," he can be deemed to have been aware of this fact. The Respondent was, to the Panel's belief, also aware of the fact, that the Olympic Games have always been identified by the name of the host city followed by the year of the games, such as Sydney 2000, Athens 2004 or Beijing 2008.

These circumstances lead to the assumption that the Respondent registered the domain name <madrid2012.com> to hinder the people in charge of Madrid's bid for the 2012 Olympic Games from registering it. The Complainant certainly has no right to monopolize all domain names related to the 2012 Olympic Games in Madrid. However, the Respondent must have been aware that a second level domain name such as <madrid2012.com> is the most obvious domain name to represent Madrid's bid for the 2012 Olympic Games and, if Madrid should be elected for host city, to represent the 2012 Olympic Games themselves. Bearing in mind these facts, the Respondent can be deemed to have registered the domain name for blocking purposes. The Panel finds that this was a bad faith registration under the Policy, paragraph

4(a)(iii).

The Respondent's use of the domain name <madrid2012.com> also occurred in bad faith under Policy, paragraph 4(b)(iv). The Respondent is selling self-made videos from his website "www.madridman.com" for an amount exceeding the costs of copying and packing them, thus for profit. In addition, the websites under "madridman.com" contain a category "MadridMan's ALL SPAIN Market" under which books, music and videos can be ordered directly at <amazon.com>. Furthermore, the Respondent states on his websites under "www.madridman.com":

"Do you shop Amazon.com, but don't want Spain-stuff?"

Please use the search box at left and on all MadridMan.com pages for your next Amazon.com purchase to help support MadridMan's Yankee Home Page. Thank you!"

Therefore the Panel assumes, that the Respondent is active in a paid partner program with <amazon.com>. In addition the Respondent has placed advertising banners on his websites under "www.madridman.com" which is normally done against remuneration only.

The Panel finds that, by using the domain name <madrid2012.com>, the Respondent has intentionally attempted to attract Internet users to his websites under "www.madridman.com" by creating a likelihood of confusion with Complainant's trademarks. This was done for commercial gain and therefore in bad faith under Policy, paragraph 4(b)(iv).

and

When the Respondent registered the first disputed domain name containing "2m12," i.e. , on April 11, 2001, the Complainant had already applied for registration of his 2M12 trademarks with the OEPM (Spanish Patent and Trademark Office). The Respondent asserts that he had no knowledge about Complainant's 2m12 trademarks and did not register the domain names in bad faith as it never occurred to him that the "M" could stand for Madrid in 2M12.

The Panel finds the term "2M12" to be a very imaginative creation. This view is supported by the fact, that comparable domain names such as 2A04 (Athens 2004) or 2B08 (Beijing 2008) do not seem to exist. It is extremely unlikely that two persons have the same idea at the same time and create the same sequence of letters in a period of just 6 days aiming at a similar purpose (use in connection with the city of Madrid and its bid). As the Respondent has redirected two of his 2m12 domain names to a Madrid-related website, the Panel assumes, that the Respondent did indeed associate the letter "M" in the domain names with Madrid. As a result, the Panel assumes that the Respondent somehow knew about the Complainant's trademarks when

registering the 2m12 domain names and therefore registered them in bad faith.

The Respondent's use of the domain names and corresponds to the use of domain name <madrid2012.com> and is therefore in bad faith under Policy, paragraph 4(b)(iv) as well.

Regarding the domain name the Respondent has made no active use so far. Prior Panels have already discussed the passive holding of a domain name and found that this can constitute bad faith use, inter alia *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003. In the current case the Respondent has registered, by and by, three domain names which all include Complainant's 2m12 trademarks. was registered by the Respondent on October 5, 2001, six months after he registered his first 2m12 domain name. As outlined above, the Respondent has acted in bad faith again and again by registering these domain names and therefore engaged in a pattern of such conduct. The Panel finds that this is evidence of bad faith registration and usage of the domain name under Policy, paragraph 4(b)(ii).

D. Reverse Domain Name Hijacking

The Respondent has requested a finding of reverse domain name hijacking according to Rules, paragraph 15(e). Rules, paragraph 1 define reverse domain name hijacking as "using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name."

As the Complainant has succeeded in this dispute with regard to all of the domain names, this cannot be a case of reverse domain name hijacking.

7. Decision

For all the foregoing reasons, in accordance with Policy, paragraphs 4(i) and Rules, paragraph 15, the Panel orders that the domain names <madrid2012.com>, , and be transferred to the Complainant.

...

Sole Panelist

