

ADMINISTRATIVE PANEL DECISION

Revista Emprendedores S.L. v. Privacy Service Provided by Withheld for Privacy ehf / Rafel Mayol, Emprendedores Online LLC
Case No. D2022-2488

1. The Parties

The Complainant is Revista Emprendedores S.L., Spain, represented by ECIJA, Spain.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Rafel Mayol, Emprendedores Online LLC, United States of America (“United States”), represented by Law.es, Spain.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 8, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on July 8, 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 July 15, 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 July 20, 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, in English and Spanish, and the proceedings commenced on July 26, 2022. In accordance with the Rules, paragraph 5, the due date for Response was August 15, 2022. Upon request from the Complainant, the Response due date was extended until August 19, 2022. The Response was filed with the Center August 19, 2022.

On August 25, 2022, the Complainant filed a Supplemental Filing.

The Center appointed Luca Barbero, Enrique Ochoa, and Georges Nahitchevansky as panelists in this matter on September 7, 2022. The Panel finds that it was properly constituted. Each member of 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.

On September 8, 2022, the Respondent filed a Supplemental Filing.

On September 23, 2022, the decision due date is was extended to October 3, 2022.

4. Factual Background

The Complainant is a Spanish magazine and newspaper publisher also specialized in training in the entrepreneurship start-up and business sectors.

The magazine “Emprendedores” was initially launched in October 1997 by the multinational group Hachette Filipacchi, led by its director Alejandro Vesga. In 2011, the magazine was acquired by the international publishing group Hearst (holder of “Elle” or “Cosmopolitan”) and in 2020, by the Complainant, a company including as shareholders the investment fund Black Pearl and Onza Partners. Currently, 95 per cent of the Complainant is owned by Alejandro Vesga.

In 1998, the Complainant reached an average circulation of 88,019 monthly copies and according to a recent General Media Study, reaching almost 150,000 copies per year, with a monthly audience of 148,000 readers in 2021, ranking the Complainant as a leader in its sector.

The Complainant is the owner of several trademark registrations for EMPRENDEDORES, including the following:

- European Union trademark registration No. 005188248 for EMPRENDEDORES (word mark), filed on July 10, 2006 and registered on July 20, 2007, in classes 16 and 38;
- Spain trademark registration No. M2721357 for EMPRENDEDORES (word mark), filed on July 7, 2006 and registered on January 12, 2007, in class 16; and
- Spain trademark registration No. M2880862 for EMPRENDEDORES (word mark), filed on June 18, 2009 and registered on January 8, 2010, in classes 38 and 41 (including editing and publication services).

The Complainant is also the owner of the domain name <emprendedores.es>, registered on November 4, 2002 and used by the Complainant to promote its products and services under the trademark EMPRENDEDORES.

The disputed domain name was registered on October 23, 1997, but is claimed to have been purchased by the Respondent in 2019. The disputed domain name is currently registered in the name of Rafel Mayol, Emprendedores Online LLC, and is currently pointed to a website in Spanish promoting online courses to build successful online businesses. Unless otherwise specified, both Rafael Mayol and the company Emprendedores Online LLC, will be collectively referred to as “the Respondent”.

According to the records, Rafel Mayol is originally from Spain and immigrated to the United States in or about 2012. The Respondent started using the domain name <emprendedoresonline.com> to promote his services in 2018 and, in spring 2019, claims to have purchased the disputed domain name for USD 45,000 when it was put up for sale by its former owner. The Respondent started to use the disputed domain name for its online course website, in 2019.

The Respondent is the owner of the European Union trademark application No. 018274554 for EMPRENDEDORES.COM, filed on July 17, 2020 and registered on December 2, 2020, for the following services in class 41: "Business training; Business training in the field of executive coaching and entrepreneurship; Educational services, namely, conducting seminars and providing online non-downloadable videos in the field of entrepreneurship and distribution of educational materials in connection therewith". The Respondent's United States trademark application for EMPRENDEDORES.COM was rejected as non-distinctive and the Respondent obtained a trademark registration EMPRENDEDORES.COM on the Supplemental Register under No. 6115352 on July 28, 2020, for services in class 41.

5. Parties' Contentions

A. Complainant

The Complainant contends that disputed domain name is identical to the trademark EMPRENDEDORES in which the Complainant has rights.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant contends that the Respondent did not appear to have any rights in the trademark EMPRENDEDORES in 1996, and that the Respondent was in no way authorized to register or use the disputed domain name, was never granted any license, and is not in any way affiliated with the Complainant.

The Complainant further submits that, considering the similarities between the Complainant's website and the one displayed at the disputed domain name, the Respondent could not have been unaware of the Complainant at the time of registering the disputed domain name and purposely registered the disputed domain name with the intent of targeting the Complainant allegedly to conduct presumably fraudulent activity and to cause potential damage to the Complainant's reputation.

Moreover, the Complainant asserts that, considering the use that the Respondent makes of the disputed domain name, namely to offer courses "to be rich and happy" and in no way related to entrepreneurial topics, the disputed domain name does not appear to be used for a *bona fide* offering of goods or services, but simply to take advantage of the efforts and reputation of a brand that it clearly denigrates. The Complainant further emphasizes that the Respondent's online courses have been the subject of harsh criticism by the media as they offer buyers/students courses with the promise of becoming rich easily.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent purposely used a figurative mark on its website that closely resembled the Complainant's trademark, with the intent of creating an association with the Complainant and confuse users to hinder the Complainant's activity. The Complainant contends that, in doing so, also considering that the trademark EMPRENDEDORES is well known, the Respondent undoubtedly acted in bad faith.

The Complainant further submits that the Respondent's filing of trademark applications for trademarks encompassing the word "emprendedores" in 2020 and 2021, amounts to bad faith, and asserts that such trademarks will be subject to applications for invalidation by the Complainant before the respective trademark offices. The Complainant submits that the Respondent was taking advantage of and trying to usurp the renowned character of the prior trademarks of the Complainant, when registering or acquiring the domain name in dispute and when requesting the registration of new trademarks.

Moreover, the Complainant contends that the website at the disputed domain name offers content very similar to that included in its corporate website, both in its graphic elements or the so-called look and feel (including its general design with white letters on a black background, format, color scheme, etc.), as well as in its content and use of similar titles in its sections. The Complainant also states that, while the Respondent offers and sells courses on how to get "rich and happy" for his own benefit, it is using the Complainant's brand and reputation by confusing users and potential buyers.

In addition, the Complainant highlights that, although a legal notice on the website indicates that Emprendedores Online LLC is located in Wyoming, United States, and the footer mentions that its offices are in Utah, the content of the website is available only in Spanish, and the website is thus addressed to the Spanish-speaking public, specifically from Spain, where the Complainant has increased awareness and reputation for being generally recognized by the Spanish public.

The Complainant also states that, considering the Respondent's videos and content on social networks, Rafel Mayol seems to operate or work mainly in Spain. Likewise, the Respondent's website mentions only Spanish newspapers and media, the videos uploaded on the web in the "Testimonials" section are all Castilian speakers (Spain), the type of currency to subscribe to the courses is indicated in Euro and, in the section to indicate the phone number, there is the flag of Spain.

B. Respondent

The Respondent rebuts the Complainant's contentions and points out that the disputed domain name is owned by Emprendedores Online, LLC, a Utah limited liability company, whilst Mr. Rafel Mayol is the ultimate beneficial owner of such company and acts as its managing director.

With reference to the language used in the Respondent's website and social network accounts, the Respondent highlights that Spanish is not only related to Spain but that it is the official language in over 21 countries with a combined population of 650 million people.

The Respondent further underlines that Mr. Mayol is a native Spanish speaker who resides in the United States.

With reference to the company Emprendedores Online, LLC, the Respondent highlights that it was formed in 2018 as a Wyoming limited liability. In or about 2020 it was re-domiciled to Utah. The Respondent claims that, although not all references in the website content were properly updated, corrections are being made, at all relevant times the Respondent remains the owner of both domain names <emprendedoresonline.com> and <emprendedores.com>.

The Respondent submits that it earned over USD 7,258,298.49 in revenues since 2018, employs over 20 people and its customers are not limited to Spain.

The Respondent explains that the website at the disputed domain name is not Mr. Mayol's only online business directed to Spanish speaking consumers, as he operated various other websites promoting similar businesses, including the website at "www.emprendedoresonline.com" as of 2018. Since in the spring of 2019, Mr. Mayol was contacted by a domain name broker which told him that he represented a Spanish resident who wanted to sell the disputed domain name and in view of the inherent value of the disputed domain name, the Respondent thus purchased the disputed domain name. The Respondent claims that, before purchasing the disputed domain name, Mr. Mayol consulted a trademark attorney, who excluded any conflict with other trademarks, and indicated that in his opinion the term could be registered under class 41 specifically for business training. The attorney's only caution was that the registration may be refused for descriptiveness. The Respondent thus filed a trademark application for EMPRENDEDORES.COM in European Union, obtaining a valid trademark registration in class 41.

With regards to the Complainant's activity, the Respondent claims the Complainant is a small publisher of a physical magazine and website, both apparently published monthly and highlights that a review of the evidence shows that the Complainant does not appear to have any substantial earnings or expenditures.

The Respondent further highlights that the Complaint does not provide evidence of actual expenditures, that copies of magazine covers are provided as exhibits to the Complaint without indication of dates and that no copies of the magazine have been provided covering the period 2017-2019.

The Respondent submits that, whilst the Complainant alleges it provides online training, it has not provided evidence of such activities and, according to the Respondent's verifications, the Complainant first started providing training services in 2022.

The Respondent contends that all of the above, supports a conclusion that the Complainant was not well known when the Respondent acquired the disputed domain name and began its business venture selling online business training.

The Respondent stresses that that the word "emprendedores" is not unique to the Complainant, being an extremely common moniker with millions of Internet references and used globally by newspapers, websites, and other publications as well as a term encompassed in several third-party trademark registrations.

The Respondent also highlights that it always used the disputed domain name consistently with its European Union trademark registration, *i.e.*, for online courses in class 41, whereas the Complainant first sold online courses in February 2022.

The Respondent also informs the Panel that it sent a cease-and-desist letter to the Complainant demanding that the Complainant cease its infringing activities. No reply from the Complainant was received. With regards to the Complainant's trademark registrations, the Respondent specifically notes that the Complainant registered its trademarks in classes 16, 38, and 41, but points out that none of the registrations cover education and training services. The Respondent further contends that the Complainant's trademark is not renowned, since the Complainant has not provided evidence that its trademark is well-known or evidence that it is known at all to the Spanish-speaking public outside of Spain.

With regards to the website's look and feel", the Respondent submits that the Complainant's figurative trademark has changed over the years to ultimately look very similar to the Respondent's trademark, contrary to what the Complainant states. Indeed, a review of the Complainant's published magazines and website pages shows that its original look and feel was using the color red and a different layout. It was only after the Respondent launched its website that Complainant changed its look and feel to copy that of the Respondent.

The Respondent emphasizes that it has not disrupted the Complainant's business since the Complainant did not provide online courses or training until February 2022, by which time the Respondent had been providing online courses under the "Emprendedores" brand and trademark for almost 4 years, had generated millions in revenues, and invested substantial amounts in marketing.

Lastly, the Respondent highlights that it has never offered for sale the disputed domain name as it was acquired solely for the Respondent's own use.

With reference to the circumstances evidencing bad faith, the Complainant indicates that the Respondent did not register the disputed domain name with the intent of precluding the Complainant from doing so and did not register or use the disputed domain name to create confusion.

The Respondent also submits that this UDRP case was brought as the Complainant's "plan B" and that the Complainant has attempted to mislead the Panel by presenting false evidence to support its arguments. Specifically, the Complainant claims to have provided (using the past tense) educational/training services, whilst the Complainant only began such services in 2022. The Respondent further notes that, whilst the Complainant claims that the Respondent copied the Complainant's logo and the look and feel of its website and social media handles, the evidence uncovered by the Respondent shows that it was the Complainant who copied the Respondent. The Respondent also asserts that the Complainant should have appreciated that its claim could not succeed without the falsified claims.

The Respondent concludes inviting the Panel to consider a finding of Reverse Domain Name Hijacking.

C. Complainant's Supplemental Filing

The Complainant states that the Respondent's statement that "In or about 2020 it [Emprendedores Online LLC] was re-domiciled to Utah" is false, since in 2020 the company Emprendedores Online LLC was in a state of dissolution and the Respondent filed a reactivation request of such company only after the filing of the Complaint.

As further circumstances that would demonstrate the Respondent's bad faith, the Complainant notes that the Respondent was offering courses and handling users' personal data when its company was dissolved and that the documentation provided by the Respondent, *i.e.*, the rental contract of an apartment in California as of December 6, 2018 for 15 months does not demonstrate that D. Rafel Mayol actually resides in the United States.

The Complainant contends that the Respondent has not complied with the applicable regulations on commercial law, tax law, data protection, and consumer protection, among others.

The Complainant highlights that the Respondent did not provide documents to substantiate its statement that it acquired the disputed domain name for USD 45,000 in 2019. On the other hand, the Complainant notes that the Respondent's asserted acquisition was performed after the Complainant registered and started using the trademark EMPRENDEDORES and concludes that the Respondent was thus aware of the Complainant's trademark.

The Complainant further mentions that the Respondent attempted to purchase the Complainant's magazine and its trademark EMPRENDEDORES via an intermediary and, therefore, it was clearly aware of the Complainant's trademark.

D. Respondent's Supplemental Filing

The Respondent submits that the Complainant has not proven that the Respondent lacks a legitimate interest or that the Respondent acquired and used the disputed domain name to target the Complainant or its trademarks or sought to use the disputed domain name to compete with, pass itself off as, or disparage the Complainant.

With reference to the Complainant's assertion that the Respondent's company was dissolved in 2020, the Respondent asserts that, according to the applicable laws of the States of Wyoming and Utah, the retroactive correction of administrative deficiencies such as the failure to pay minimal LLC taxes is allowed, and the correct procedure was undertaken by the Respondent to correct any defect relating to the Respondent.

The Respondent underlines that it never acted fraudulently, that it complied with all relevant regulations regarding its sales and other activities and that it does not sell courses via its website and does not use the website to collect personal identification data. In order to further demonstrate that Mr. Mayol is and has been a resident of the United States, the Respondent provides copies of Mr. Mayol's current Green Card and other historical visas showing permanent US residency as well as a supplemental declaration of Mr. Mayol.

The Respondent further states that the USD 45,000 price paid by the Respondent for the disputed domain name was reasonable and in fact likely well below market value considering that 1-word Spanish language .com domain names have an inherent value absent any relationship to a trademark.

The Respondent also indicates that, while the Complainant claims that the Respondent targeted its trademark, it provides little or no proof and does not dispute that (i) the Complainant did not publish its magazine during the period from 2017 to 2020, (ii) the Complainant did not provide educational services until February 2022, and that (iii) it was the Complainant who copied the Respondent's logo design and social media appearance.

As to the Respondent's offer to purchase the Complainant's magazine and website, the Respondent states that such offer cannot evidence bad faith registration of the disputed domain name because it occurred in December 2021, well after the Respondent had acquired the disputed domain name and had made its substantial investments to build its business.

6. Discussion and Findings

According to paragraph 15(a) of the Rules: "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable." Paragraph 4(a) of the Policy directs that the Complainant must prove each of the following:

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

6.1. First preliminary procedural issue: language of the proceeding

Pursuant to paragraph 11(a) of the Rules, "unless otherwise agreed by the Parties, or specified otherwise in the Registration Agreement, the language of the administrative proceeding shall be the language of the Registration Agreement, subject to the authority of the Panel to determine otherwise, having regard to the circumstances of the administrative proceeding".

In the case at hand, the language of the Registration Agreement of the disputed domain name is English. The Complaint, the Amended Complaint and the Complainant's Supplemental Filing were filed in Spanish.

The Complainant submitted a request for Spanish to be the language of the proceeding based on the following grounds:

- (i) the Complainant is a Spanish entity;
- ii) the Complainant's trademark EMPRENDEDORES is known in Spain and has been registered as a Spanish trademark as well as European Union trademark, with the trademark application filed in Spanish;
- (iii) the disputed domain name encompasses the Spanish word "emprendedores"; and
- iv) the website to which the disputed domain name resolves contain contents in Spanish; and
- v) Mr. Rafel Mayol, whose name is indicated as registrant name for the disputed domain name according to the Whois records, is a Spanish citizen.

The Respondent filed the Response and its Supplemental Filing in English and requested not to admit the Complainants' submissions in Spanish highlighting that:

- i) the Registration Agreement of the disputed domain name is in English and no agreement as to the language of the proceeding has been reached by the parties;
- ii) the Complainant has not shown it would be disadvantaged by having to proceed in English, as there is no evidence or argument that neither the Complainant nor its counsel is unable to sufficiently speak, read or write English;

iii) the Complainant is likely fluent in English, as it purchased the EMPRENDEDORES magazine from a United States entity, Hearst Publications, and submitted legal documents in English concerning the purchase;

iv) the Complainant's attorney has had no apparent difficulty in reviewing the Response or various documents presented by the Respondent in English, including real estate leases and documents filed with the States of Wyoming and Utah; and

v) the Respondent's attorney is not sufficiently versed in Spanish as to represent the Respondent in these proceedings without substantially disadvantaging the Respondent.

In view of the circumstances of the case, exercising its powers under paragraphs 10 and 11 of the Rules, the Panel deems appropriate to conduct the proceeding in both English and Spanish. Indeed, the Complainant has filed the Complaint and its subsequent submissions in Spanish, but does not seem to be hampered in proceeding in English, *i.e.*, the language of the Registration Agreement. On the other hand, the Respondent has filed the Response and its Supplemental Filing in English and does not appear to be prejudiced by the Complainant's use of Spanish. Requiring one of the parties to translate the Complaint and the documents submitted as annexes to the Complaint would cause harm and generate expenses to one of the Parties.

In accordance with the practice adopted in many prior proceedings where language changes were requested and parties were allowed to file in either language and considering that the Panel is fluent in both English and Spanish, the Panel thus accepts the Complainant and the Respondent's submissions, in Spanish and English respectively. Bearing in mind the need to ensure that the proceeding takes place with due expedition, the Panel will proceed to issue the Decision only in English.

6.2. Second preliminary procedural issue: Supplemental Filings

Before entering into the merits of the case, the Panel addresses the issue of the unsolicited supplemental filings submitted by the Parties to the Center.

No provision concerning supplemental filings are made in the Rules or Supplemental Rules, except at the request of the panel according to paragraph 12 of the Rules, which states the panel, in its sole discretion, may request any further statements or documents from the parties it may deem necessary to decide the case.

According to paragraph 10 of the Rules, the Panel has the authority to determine the admissibility, relevance, materiality and weight of the evidence, and also to conduct the proceedings with due expedition, ensuring that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), unsolicited supplemental filings are generally discouraged – unless specifically requested by the panel – and the party submitting an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response.

Accordingly, UDRP panels generally accept supplemental filings only when they provide material new evidence or a fair opportunity to respond to arguments that could not reasonably have been anticipated. See, along these lines, *Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*, WIPO Case No. [D2017-0481](#).

In order to ensure that both Parties are given a fair opportunity to present their case and respond to arguments that could not reasonably have been anticipated, the Panel has decided to accept the Parties' Supplemental Filings, the content of which is summarized in the sections 5.C and 5.D above. However, the Panel notes that, should the Panel not have admitted the Parties' Supplemental Filings, the outcome of the case would have been the same.

6.3 Substantive issues

A. Identical or Confusingly Similar

The Complainant has provided evidence of ownership of trademark registrations consisting in the word EMPRENDEDORES.

As highlighted in section 1.7 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), the first element functions primarily as a standing requirement, and the threshold test for confusing similarity typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name.

In the case at hand, the Complainant's trademark EMPRENDEDORES is entirely reproduced in the disputed domain name, with the mere addition of the Top-Level Domain ".com", which is commonly disregarded under the first element confusing similarity test (section 1.11 of the [WIPO Overview 3.0](#)).

Therefore, the Panel finds that the Complainant has proven that the disputed domain name is identical to a trademark in which the Complainant has established rights according to paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

The Complainant must show that the Respondent has no rights or legitimate interests in respect of 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:

"(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 non-commercial 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."

It is well established that the burden of proof lies on the complainant. However, satisfying the burden of proving a lack of the respondent's rights or legitimate interests in respect of the domain name according to paragraph 4(a)(ii) of the Policy is potentially onerous, since proving a negative can be difficult considering such information is often primarily within the knowledge or control of the respondent.

Accordingly, in line with previous UDRP decisions, it is sufficient that the complainant show a *prima facie* case that the respondent lacks 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 (see, *i.e.*, *Croatia Airlines d.d. v. Modern Empire Internet Ltd.*, WIPO Case No. [D2003-0455](#); *Banco Itau S.A. v. Laercio Teixeira*, WIPO Case No. [D2007-0912](#); *Accor v. Eren Atesmen*, WIPO Case No. [D2009-0701](#)).

In the case at hand, the Panel finds that the Complainant has not discharged its burden of proving that the Respondent lacks rights or legitimate interests for the following reasons.

The term encompassed in the disputed domain name "emprededores" is a common dictionary term in Spanish for "entrepreneurs", used also by many third parties as a title, name, and trademark.

As stated in section 2.10.1 of the [WIPO Overview 3.0](#), “Panels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent; panels have held that mere arguments that a domain name corresponds to a dictionary term/phrase will not necessarily suffice. In order to find rights or legitimate interests in a domain name based on its dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for such use, in connection with the relied-upon dictionary meaning and not to trade off third-party trademark rights. [...] Panels also tend to look at factors such as the status and fame of the relevant mark and whether the respondent has registered and legitimately used other domain names containing dictionary words or phrases in connection with the respective dictionary meaning”.

In the case at hand, there is no evidence that the disputed domain name, which currently points to a website in Spanish promoting online courses providing strategies to create profitable online businesses, might have been used by the Respondent with the intention of trading-off the Complainant’s trademark rights.

Moreover, the Respondent has rights in a trademark corresponding to the disputed domain name as it filed trademark applications for EMPRENDEDORES.COM in 2019 and obtained a European Union trademark registration, in December 2020, covering online courses in class 41. Notably, the Complainant, or its predecessor, which owned Spanish trademark registrations for EMPRENDEDORES in classes 16 and 38, also in the European Union, did not oppose the Respondent’s trademark applications. Furthermore, the Complainant appears to have started providing online courses, *i.e.*, the services for which the Respondent’s trademark is registered, only in February 2022.

The Panel notes that the Complainant’s entire case rests on the notion that the online course website of the Respondent published at the disputed domain name infringes the rights of the Complainant in its publication and its online courses. The Complainant attempted to show that the Respondent specifically targeted the Complainant when it adopted the sign EMPRENDEDORES for its online course website. The evidence submitted, though, is seriously deficient. Indeed, while the Complainant argues that its EMPRENDEDORES magazine has enjoyed a large circulation, the Complainant submitted evidence limited to 1997, 2020, and 2021, without demonstrating circulation of the magazine in any other years (and in particular in 2018 or 2019 before the Respondent acquired the disputed domain name).

Further, there is nothing in the record showing what the fame of the Complainant’s EMPRENDEDORES magazine might have been in 2019, when the Respondent acquired the disputed domain name and started using for the promotion of its online course website. Indeed, it is a basic principle in trademark law that, while a complainant has rights for a given product or services, those rights do not necessarily extend to other classes of interest unless some reputation in the trademark is shown. In the present case, nothing in the record indicates that the trademark EMPRENDEDORES might have been well-known or unique to the Complainant for Spanish-speaking users in Spain or countries outside of Spain at the time the Respondent acquired the disputed domain name.

Therefore, the Panel finds that the Complainant has not demonstrated that the Respondent lacks rights or legitimate interests in the disputed domain name according to paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy requires that the Complainant prove that the disputed domain name was registered and is being used by the Respondent in bad faith.

The Panel finds that the Complainant has failed to demonstrate that the Respondent registered and used the disputed domain name in bad faith for the following reasons.

Despite the fact that the disputed domain name was acquired by the Respondent in 2019, after the registration of the Complainant’s trademark, the Complainant has failed to demonstrate that the Respondent registered the disputed domain name to target the Complainant’s trademark.

Indeed, as mentioned above, the disputed domain name consists of a common dictionary word in Spanish and the Complainant has failed to demonstrate that its trademark EMPRENDEDORES was well-known or enjoyed any broad reputation in Spain or, in particular, with the Spanish speaking population located outside Spain, in 2019, when the disputed domain name was acquired by the Respondent.

Moreover, the amount claimed to have been paid by the Respondent for the acquisition is not insignificant and if true would tend to demonstrate a lack of bad faith since the amount of USD 45,000 would be a very high price to pay to engage in cybersquatting, and arguably indeed seems to be more or less in line with the likely or potential market value of common word domain names.

Furthermore, there is no evidence that the disputed domain name might have been offered for sale by the Respondent to the Complainant. On the contrary, the evidence in the record – including the Respondent's attempt to purchase the Complainant's trademark in 2021 – induce the Panel to believe that, on the balance of the probabilities, the Respondent actually acquired the disputed domain name and registered the corresponding trademark to use them in connection with the Respondent's *bona fide* business in the field of online courses – in which the Complainant only entered recently – without trading off the Complainant's rights.

D. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if “after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”.

The Rules 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.”

The Panel also bears in mind that the Complainant in this case is represented by counsel and, therefore, should be held to a higher standard (see section 4.16 of the [WIPO Overview 3.0](#)).

The Panel concludes that the Complainant's actions constitute Reverse Domain Name Hijacking for the following reasons:

- i) the Complainant, which is represented by counsel, should have appreciated the weakness of its case and the fact that the term “emprendedores” encompassed in the disputed domain name cannot be exclusively referable to the Complainant;
- ii) the Complainant attempted to claim some notoriety of its trademark EMPRENDEDORES by simply providing some 1997 circulation numbers and mostly its 2020 and 2021 circulation numbers, whilst it did not even attempt to prove – even in its Supplemental Filing – any kind of notoriety as of 2019, when the disputed domain name was acquired by the Respondent;
- iii) the Complainant made claims that the Respondent is copying its website colors and stylizations based on current uses, while the evidence submitted by the Respondent shows differences in 2019. Moreover, the Complainant failed to mention that its online courses only began recently in 2022, thereby attempting to suggest to the Panel that such courses have been around for a while and before the Respondent started its use of the disputed domain name for its online courses; and
- iv) in view of the circumstances of the case and considering the Respondent's existing trademark registrations for EMPRENDEDORES, the Complainant's attorneys should have appreciated that the present matter is a trademark dispute which cannot be decided under the Policy, since the annulment of trademark registrations is a competence of National and Regional Administrative and / or Judiciary bodies.

7. Decision

For the foregoing reasons, the Complaint is denied. The Panel also makes a finding of Reverse Domain Name Hijacking.

/Luca Barbero/

Luca Barbero

Presiding Panelist

/Enrique Ochoa/

Enrique Ochoa

Panelist

/Georges Nahitchevansky/

Georges Nahitchevansky

Panelist

Date: October 3, 2022