

ADMINISTRATIVE PANEL DECISION

Francisco Javier Riquelme Duque, Corporación Maratón de Santiago v.
Budy Corbuzier
Case No. D2022-3925

1. The Parties

The Complainants are Francisco Javier Riquelme Duque, Chile (“First Complainant”) and Corporación Maratón de Santiago (“Second Complainant”), represented by Alessandri & Compañía Abogados, Chile.

The Respondent is Budy Corbuzier, Indonesia, self-represented.

2. The Domain Name and Registrar

The disputed domain name <maratondesantiago.com> is registered with Wild West Domains, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed in Spanish with the WIPO Arbitration and Mediation Center (the “Center”) on October 19, 2022. On the following day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 21, 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 (Wild West Domains, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainants on October 25, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainants to submit an amendment to the Complaint. The Complainants filed an amended Complaint in Spanish on the same day.

The Center also sent an email communication in English and Spanish to the parties on October 25, 2022 regarding the language of the proceeding. The Complainants requested that Spanish be the language of the proceeding on the same day. On October 28, 2022, the Respondent sent two email communications in English to the Center: the first concerned the substance of the dispute while in the second communication he objected to the Complainants’ language request.

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, in English and in Spanish, of the Complaint, and the proceedings commenced on November 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 23, 2022. The Respondent did not submit any response beyond its informal email communications of October 28, 2022. Accordingly, the Center notified the Commencement of Panel Appointment Process on November 24, 2022.

The Center appointed Matthew Kennedy as the sole panelist in this matter on November 30, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The “Maratón de Santiago” (meaning the “Santiago Marathon”) is a running race with categories of 10, 21, and 42 kilometres that takes place annually in the city of Santiago, Chile. The event was first held in 1990 as the “Maratón Internacional de Santiago” (meaning the “Santiago International Marathon”) and assumed its current name in 2007, which is combined with the name of its principal sponsor from time to time.

The First Complainant is the general manager of Prokart SpA, an event production company that organized the marathon from 2007. The First Complainant registered the disputed domain name on July 4, 2008. According to the Complaint, the Second Complainant is a non-profit entity that has organized the marathon since 2014, while Prokart SpA is now responsible for production of the event. The race has been affiliated since 2008 with the Association of International Marathons and Distance Races (AIMS) and has been included in the World Athletics (formerly IAAF) bronze label road races calendar. The latest edition of the race attracted more than 30,000 participants.

The Complainants used the disputed domain name in connection with an official website for the event titled “Maratón de Santiago” alongside the logo of the current sponsor. They used the website to publicize and organize the event, including providing participant registration services. Registration of the disputed domain name was renewed for the last time on July 11, 2017 for five years. No explanation was given for the failure to renew the registration in 2022.

The Second Complainant is the registrant of multiple Chilean trademark registrations, including the following:

- No821262 for MDS-MARATON DE SANTIAGO (meaning “MDS – Santiago Marathon”), registered on July 4, 2008, specifying services in classes 35 and 41; and
- No 890244 and No 890245, both for a semi-figurative mark including the textual elements MDS-MARATON DE SANTIAGO, both registered on July 13, 2010, and specifying goods in classes 16 and 25 and services in classes 35 and 41, respectively.

The above trademark registrations are currently valid. The Second Complainant’s other registered marks include MIS-MARATON INTERNACIONAL DE SANTIAGO (meaning “MIS-International Santiago Marathon”); MDS- MEDIO MARATON DE SANTIAGO (meaning “MDS-Santiago Half Marathon”); MDS; and MDS-MARATON DE SANTIAGO LA FIESTA DEPORTIVA MAS GRANDE DE CHILE (meaning “MDS-Santiago Marathon the Largest Sports Festival in Chile”).

The Second Complainant has registered various other domain names, including <maratondesantiago.cl>, registered on May 24, 2013, which the Complainants use in connection with the official website titled “Maratón de Santiago”, where they continue to publicize and organize that event.

According to the information provided to the Registrar for the registration of the disputed domain name, the Respondent is an individual resident in Indonesia. His email user name is “Dewa Cuki”.

The disputed domain name was acquired by the Respondent in or about August 2022 at an auction conducted by the Registrar after the expiry of the First Complainant's registration. The disputed domain name now resolves to a webpage mostly in Indonesian and partially in English that displays an advertisement for a gaming website operated by 3DBet.

5. Parties' Contentions

A. Complainants

The Second Complainant is the proprietor of various Chilean marks that include the expression MARATON DE SANTIAGO, MDS, or similar. The disputed domain name is hugely similar to these marks. It contains the three words in the Second Complainant's trademark MDS-MARATON DE SANTIAGO and its current domain name <maratondesantiago.cl>, and is practically identical to its corporate name "Corporación Maratón de Santiago", with no additional element to distinguish it from the marks for MARATON DE SANTIAGO, which corresponds to a highly distinctive sign, created by the Complainant and associated with a product or service from a particular business origin.

The Respondent has no rights or legitimate interests with respect to the disputed domain name. The Second Complainant has not authorized, licensed, permitted or consented to the use of its marks in the disputed domain name. The Second Complainant has no relationship with the Respondent or his representatives. The Respondent is attempting to attract Internet users to his online gambling site. The use of the mark MDS-MARATON DE SANTIAGO will only confuse Internet users and mislead them into believing that the disputed domain name is associated with or has the same origin as the Second Complainant's websites. The Respondent is not commonly known by the disputed domain name. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name.

The disputed domain name has been registered and is being used in bad faith. The Respondent is using the name and mark of the Second Respondent to promote an online gambling website, with the intention of attracting unsuspecting consumers seeking information about the Second Complainant.

B. Respondent

The Respondent submits that the disputed domain name belongs to him. He won the auction legally conducted by the Registrar and he has paid for the disputed domain name. The disputed domain name is listed under his account, and he provides screenshots of relevant pages from his account with the Registrar.

6. Discussion and Findings

6.1 Procedural Issues

A. Consolidation: Multiple Complainants

The Complaint was filed by two complainants against a single respondent. The Second Complainant, a corporation, organizes the Santiago Marathon and holds relevant trademark rights. The First Complainant is an individual who works for another corporation that produces the Santiago Marathon and uses the Second Complainant's trademarks. The First Complainant was the original registrant of the disputed domain name, which the Second Complainant used in connection with its official website. The Panel finds that the Complainants have a common grievance against the Respondent and that it is efficient to permit the consolidation of their complaints. Therefore, the Panel decides to consolidate their disputes and refers to them below jointly and separately as "the Complainant", except as otherwise indicated.

B. Language of the Proceeding

Paragraph 11(a) of the Rules provides that “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”. The Registrar confirmed that the Registration Agreement for the disputed domain name is in English.

The Complainant requests that the language of the proceeding be Spanish. Its principal arguments are that the disputed domain name is written in Spanish and refers to an athletic event that takes place in Chile, which is a Spanish-speaking country. The disputed domain name itself indicates that it is directed to an audience chiefly located in Chile.

The Respondent strongly objects to the request that the language of the proceeding be Spanish. He submits that he does not understand Spanish and can only communicate in English.

Paragraph 10(b) and (c) of the Rules require the Panel to ensure that the Parties are treated with equality, that each Party is given a fair opportunity to present its case and that the administrative proceeding take place with due expedition. Prior UDRP panels have decided that the choice of language of the proceeding should not create an undue burden for the parties. See, for example, *Solvay S.A. v. Hyun-Jun Shin*, WIPO Case No. [D2006-0593](#); *Whirlpool Corporation, Whirlpool Properties, Inc. v. Hui'erpu (HK) electrical appliance co. Ltd.*, WIPO Case No. [D2008-0293](#).

The Panel observes that the Complaint and amended Complaint in this proceeding were filed in Spanish and that the Respondent's informal email communications are in English. Given that the disputed domain name is in Spanish, it is reasonable to infer that the Respondent has some knowledge of that language. In any case, he has taken the opportunity to present his case, albeit briefly. Therefore, the Panel considers that requiring the Complainant to translate the Complaint into English would create an undue burden and delay whereas accepting all submissions as filed in their original language does not cause prejudice to either Party.

Having considered all the circumstances above, the Panel determines under paragraph 11(a) of the Rules that the language of this proceeding is English. However, the Panel will accept the Complaint and amended Complaint as filed in Spanish, without a translation.

6.2 Analysis and Findings

Paragraph 4(a) of the Policy provides that the Complainant must prove all of the following elements:

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

The burden of proof of each element is borne by the Complainant. Failure to prove any one element will lead to denial of the Complaint.

A. Identical or Confusingly Similar

Based on the undisputed evidence presented, the Panel finds that the Complainant has registered rights in the MDS-MARATON DE SANTIAGO mark, among others. Given the findings below, it is unnecessary to compare these marks with the disputed domain name for the purposes of the first element of paragraph 4(a) of the Policy.

The Panel notes that trademark-like protection is available for unregistered marks under certain national legal doctrines, such as unfair competition and passing off, and is mindful of considerations of parity between complainants from different jurisdictions. Accordingly, the Panel considers that any unregistered rights of the Complainant may also support standing for the limited purposes of the UDRP, even if not under national law in a civil law jurisdiction such as Chile where the Complainant is located. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ([“WIPO Overview 3.0”](#)), section 1.3. In the present case, the name “Maratón de Santiago” has been used in connection with the publicity and organization of the Complainant’s sporting event since 2007, and it has been intrinsically linked to the Second Complainant which was created to organize that event from 2014. The Santiago Marathon is the largest sporting event in Chile and some race participants come from outside that country. The event is referred to as “Maratón de Santiago” by international athletic bodies such as AIMS and World Athletics (IAAF), including in combination with the name of the event’s principal sponsor from time to time. The top results of a Google search for “Maratón de Santiago” all refer to the Complainant’s event and show that it has a large number of followers on various social media platforms. Although the event name is composed of two Spanish words and a place name, the combination of those three elements does not itself correspond to a common or dictionary phrase. Based on this evidence, the Panel is satisfied that MARATON DE SANTIAGO has become a distinctive identifier that consumers associate with the Complainant’s sporting event publicity and organizational services since a point in time some years prior to the filing of the Complaint.

The disputed domain name incorporates the entirety of the MARATON DE SANTIAGO mark. Its only additional element is a generic Top-Level Domain (“gTLD”) extension (“.com”). As a standard requirement of domain name registration, this element may be disregarded in the comparison between the disputed domain name and the Complainant’s trademark for the purposes of the first element of paragraph 4(a) of the Policy. See [WIPO Overview 3.0](#), section 1.11.

The Complainant also alleges similarity with respect to its domain name. However, that circumstance is insufficient in itself to satisfy the first element of paragraph 4(a) of the UDRP, which requires identity or similarity with a trademark or service mark.

Therefore, the Panel finds that the disputed domain name is identical to the Complainant’s MARATON DE SANTIAGO mark. The Complainant has satisfied the first element in paragraph 4(a) of the Policy.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the following circumstances which, without limitation, if found by the panel, shall demonstrate that the respondent has rights to, or legitimate interests in, a disputed domain name, for the purposes of paragraph 4(a)(ii) of the Policy:

- (i) before any notice to [the respondent] of the dispute, [the respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name 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 [disputed] domain name, 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 [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

As regards the first circumstance set out above, the Respondent uses the disputed domain name in connection with a webpage that displays an advertisement for a gambling website. Although the disputed domain name is composed of two Spanish words and a place name, that combination has no apparent meaning other than as a reference to the Complainant’s event, mark, and corporation. The disputed domain name is identical to the Complainant’s MARATON DE SANTIAGO mark, which creates a high risk of implied affiliation. The Complainant submits that it has not authorized, licensed, permitted, or consented to the use

of its marks in the disputed domain name and that it has no relationship with the Respondent or his representatives. Nothing on the Respondent's webpage has any apparent connection to the disputed domain name. These circumstances indicate that the Respondent is not using the disputed domain name in connection with a *bona fide* offering of goods or services related to its meaning.

As regards the second circumstance set out above, the Respondent's name is listed in the Registrar's Whois database as "Budy Corbuzier", while his email user name is "Dewa Cuki" and his advertisement is for a website operated by "3DBet", not "Maratón de Santiago". Nothing indicates that the Respondent has been commonly known by the disputed domain name.

As regards the third circumstance set out above, the Respondent uses the disputed domain name in connection with a webpage that displays advertising for a commercial website. That use is either for the Respondent's own commercial gain, if he is paid to display the advertisement, or for the commercial gain of the operator of the gambling site, or both. In each scenario, such a use is not a legitimate noncommercial or fair use of the disputed domain name.

In summary, the Panel considers that the Complainant has made a *prima facie* case that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Turning to the Respondent's arguments, he submits that the disputed domain name belongs to him, that he won the auction legally conducted by the Registrar and that he has paid for the disputed domain name. However, the Panel considers that the mere registration of a domain name does not create rights or legitimate interests for the purposes of the second element of the Policy, otherwise no complaint could ever succeed, which would be an illogical result. See *Pharmacia & Upjohn Company v. Moreonline*, WIPO Case No. [D2000-0134](#). Nothing on the Respondent's webpage or elsewhere on the record indicates that he holds any rights or legitimate interests in respect of the disputed domain name for the purposes of the Policy. Accordingly, the Panel finds that the Respondent has not successfully rebutted the Complainant's *prima facie* case.

Therefore, based on the record of this proceeding, the Panel finds that the Complainant has satisfied the second element in paragraph 4(a) of the Policy

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that certain circumstances, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith, but these circumstances are not exhaustive. The fourth circumstance is as follows:

(iv) by using the [disputed] domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent's] website or other online location, by creating a likelihood of confusion with the complainant's mark as to the source, sponsorship, affiliation, or endorsement of [the respondent's] website or location or of a product or service on [the respondent's] website or location.

With respect to registration, the disputed domain name was registered by the Respondent in 2022, after the Complainant acquired rights in the MARATON DE SANTIAGO mark. Although the Complainant's mark refers to an event that takes place in Chile, while the Respondent is located in Indonesia, the disputed domain name is intrinsically associated with the Complainant's event, mark and corporation, and it has no other apparent meaning. Further, although nothing indicates that the Respondent is a dealer who offers domains for resale, the evidence shows that he is an experienced domain name registrant with over 100 domain names listed in his account with the Registrar. As such, the Panel considers that the Respondent would be expected to make some good faith effort to avoid registering and using a domain name identical or confusingly similar to a third party mark, in particular where it would be easy to ascertain the prior owner and use. A simple Google search would have revealed the connection between the phrase of which the disputed domain name is comprised and the Complainant, including on the Complainant's official website, which

remains live in the “.cl” country code Top-Level Domain. In view of these circumstances, the Panel finds that the Respondent was aware, or should have been aware, of the Complainant’s event and mark at the time that he registered the disputed domain name.

With respect to use, the Respondent uses the disputed domain name, which is identical to the Complainant’s MARATON DE SANTIAGO mark, in connection with a webpage displaying an advertisement for an unrelated business. This use is for the commercial gain of the Respondent or the operator of the advertised business, or both. In view of the findings in Section 6.2B above, the Panel finds that by using the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to his webpage, by creating a likelihood of confusion with the Complainant’s mark as to the source, sponsorship, affiliation, or endorsement of that webpage within the terms of paragraph 4(b)(iv) of the Policy.

Further, the advertisement displayed on the Respondent’s webpage is for a gambling business, which has the clear potential to damage the reputation of the Complainant’s mark, particularly given that the Complainant formerly owned the disputed domain name.

For the above reasons, the Panel finds that the disputed domain was registered and is being used in bad faith. The Complainant has satisfied the third element in paragraph 4(a) 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 <maratondesantiago.com> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: January 10, 2022