

ADMINISTRATIVE PANEL DECISION

La Plaza S.A. v. Reserved for Customers, MustNeed.com
Case No. D2024-1256

1. The Parties

The Complainant is La Plaza S.A., Chile, represented by Gonzalo Sánchez Serrano, Chile.

The Respondent is Reserved for Customers, MustNeed.com, China, represented by Irene Wang, China.

2. The Domain Name and Registrar

The disputed domain name <elmostrador.com> is registered with Dynadot Inc (the “Registrar”).

3. Procedural History

The Complaint was filed in Spanish with the WIPO Arbitration and Mediation Center (the “Center”) on March 22, 2024. On March 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the following day, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name that differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 2, 2024, 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 in Spanish on April 6, 2024.

On April 2, 2024, the Center informed the parties in English and Spanish that the language of the registration agreement for the disputed domain name is English. On April 6, 2024, the Complainant sent an email communication in Spanish in which it confirmed its request that Spanish be the language of the proceeding. On the same day, the Respondent sent an email communication in English in which it objected to the Complainant’s 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 Spanish of the Complaint, and the proceedings commenced on April 10, 2024. In accordance with the

Rules, paragraph 5, the due date for Response was April 30, 2024. The Respondent sent email communications to the Center in English on April 10, 2024 and April 11, 2024, regarding the language of the proceeding.

The Center appointed Matthew Kennedy as the sole panelist in this matter on May 6, 2024. 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 the publisher of an online newspaper from Chile titled “El Mostrador” launched on March 1, 2000. The Complainant has registered the following Chilean trademarks:

- Number 572871 for EL MOSTRADOR, registered from July 28, 2000, renewed under number 898596 and currently in force, specifying services in class 38;
- Number 572872 for EL MOSTRADOR, registered from July 28, 2000, renewed under number 898597 and currently in force, specifying goods in class 16; and
- Number 1264680, for a semi-figurative ELMOSTRADOR mark, registered from November 30, 2017 and currently in force, specifying goods in class 16.

The Complainant also registered the domain name <elmostrador.cl> on March 1, 2005 that it uses in connection with a website where it publishes its newspaper. Subsequently, the Complainant registered the domain names <diarioelmostrador.cl>, <elmostradormercados.cl>, <elmostradorsemanal.cl>, <grupoelmostrador.cl>, <landingelmostrador.cl>, <mostrador.cl>, and <mostradormercados.cl>. The Complainant operates social media accounts under the name “El Mostrador” and makes available podcasts online under that name as well. According to evidence provided by the Complainant, the top results of Google searches for “El Mostrador” and the disputed domain name relate to the Complainant.

The Respondent is an entity based in China.

The disputed domain name was created on October 14, 2002. According to archived screenshots presented by the Complainant, as at June 8, 2022, it resolved to a landing page displaying the disputed domain name against a background image of moai (the famous stone statues on Rapa Nui (Easter Island) in Chile). Below this, the landing page displayed Pay-Per-Click (“PPC”) links that were all in Spanish and mostly related to real estate, as well as Chile news, used cars in Chile, and houses for sale in Puerto Montt (a town in Chile). Many of the links directed to websites related to Chile, including digital newspapers in that country. As at February 21, 2024, the landing page displayed a banner in English reading “This domain name might be for sale!!! Contact to check it out!” with no image. Below this, the landing page displayed PPC links in Spanish related to Chile news, used cars in Chile, and houses for sale in Puerto Montt.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that the disputed domain name is identical to its EL MOSTRADOR trademark.

The Respondent has no rights or legitimate interests in respect of the disputed domain name. The Respondent has not been licensed or authorized in any way by the Complainant to use its EL MOSTRADOR mark. The Respondent is perfectly aware of the Complainant, which is one of the most relevant and prestigious media outlets in Chile. It is as if a third party registered <TheEconomist.com> (or <NeueZürcherZeitung.com>) and claimed that it was identical to a publication title by mere coincidence, when the content of the associated site only made sense to American (or Swiss) readers. The site associated with the disputed domain name contains news, which is the very type of service that the Complainant provides, and it displays content related to Chile, which reveals complete awareness that the disputed domain name corresponds to a famous and well-known expression in Chile.

The disputed domain name was registered and is being used in bad faith within the terms of paragraph 4(b)(iii) and (iv) of the Policy. The Complainant holds prior trademark and domain name registrations of EL MOSTRADOR, which is sufficient to demonstrate prima facie that the Respondent knew of its existence, especially considering that the Respondent uses the same name to publish news and advertising regarding Chile, where the Complainant operates. EL MOSTRADOR is a famous mark in Chile and abroad.

B. Respondent

The Respondent objected repeatedly to the language in which the Complaint was filed and did not otherwise reply to the Complainant's contentions.

6. Discussion and Findings

6.1. Procedural Issue: Language of the Proceeding

The language of the Registration Agreement for the disputed domain name is English. Pursuant to the Rules, paragraph 11(a), in the absence of an agreement between the parties, or unless specified otherwise in the registration agreement, the language of the administrative proceeding shall be the language of the registration agreement.

The Complaint and amended Complaint were filed in Spanish. The Complainant requested that the language of the proceeding be Spanish for several reasons, including the fact that the disputed domain name is in Spanish, the Complainant is Spanish-speaking, and the webpage associated with the disputed domain name is in Spanish.

The Respondent requested that the language of the proceeding be English, referring to the language of the Registration Agreement, the language of the "[P]arties' historical communication", the Respondent's lack of fluency in Spanish, and arguing that the conduct of the proceeding in Spanish would prejudice its ability to participate effectively. The Respondent later submitted, twice, that it could not understand the Complaint in Spanish attached to the Center's emails and it requested that all communications be provided in English or Chinese.

In exercising its discretion to use a language other than that of the registration agreement, the Panel has to exercise such discretion judicially in the spirit of fairness and justice to both parties, taking into account all relevant circumstances of the case, including matters such as the parties' ability to understand and use the proposed language, time and costs. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.5.1.

Having considered the circumstances of this case, the Panel determines that the language of this proceeding is English, but that it will accept the Complaint and amended Complaint as filed in Spanish without translation. Given the Panel's findings on the merits, this determination does not cause unfairness to either Party.

6.2 Substantive Issues

Paragraph 4(a) of the Policy provides that a complainant must prove each 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. The Respondent's failure to respond to the Complainant's contentions does not by itself mean that the Complainant is deemed to have prevailed. See [WIPO Overview 3.0](#), section 4.3.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. See [WIPO Overview 3.0](#), section 1.7.

The Complainant has shown registered rights in respect of the EL MOSTRADOR mark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the EL MOSTRADOR mark is reproduced within the disputed domain name, except for the space between the words for technical reasons. The only additional element is a generic Top-Level Domain ("gTLD") extension (".com") which, as a standard requirement of domain name registration, may be disregarded in the assessment of identity or confusing similarity. Accordingly, the disputed domain name is identical to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7 and 1.11.

Therefore, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Given the Panel's findings on bad faith below, it is unnecessary to consider the second element of paragraph 4(a) of the Policy.

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy contains two conjunctive requirements. A complainant must show both that the disputed domain name was registered in bad faith, and that the disputed domain name is being used in bad faith. As regards registration in bad faith, the Complainant must demonstrate that the Respondent's aim in registering the disputed domain name was to profit from or exploit the Complainant's trademark.

In the present case, the disputed domain name was registered in 2002, after the original registration of the Complainant's EL MOSTRADOR mark in 2000. Although the disputed domain name is identical to the mark, the Panel notes that the mark consists of an ordinary Spanish dictionary word meaning "counter" (as in a shop counter)¹ preceded by the definite article. It is not difficult to imagine potential commercial uses for that name. The question arises as to whether the Respondent registered the disputed domain name with the

¹ Bearing in mind that the Panel may undertake limited factual research into matters of public record if it considers such information useful in assessing the merits of the case and reaching a decision, the Panel has consulted the dictionary of the Real Academia Española (Spanish Royal Academy) at https://apps.rae.es/DA_DATOS/TOMO_IV_HTML/MOSTRADOR_010970.html. See [WIPO Overview 3.0](#), section 4.8.

Complainant and its trademark in mind, or based on its dictionary meaning. The Panel does not consider that the Respondent should be deemed to have constructive notice of the contents of the Chilean trademark register. The Complainant asserts that its online newspaper was launched in 2000 but, according to its evidence, it registered the domain name associated with its online newspaper in 2005, three years after the registration of the disputed domain name, and it registered its other mostrador-formative domain names later still. While the Complainant may be “one of the most relevant and prestigious media outlets in Chile” today, nothing on the record indicates that this was true at the time when the disputed domain name was registered and, even if it were, that alone would not give rise to the inference that the Respondent, which is based in China, was aware of the Complainant because there is a plausible alternative explanation for the registration of the disputed domain name (i.e., its dictionary meaning). While the Complainant shows that the landing page associated with the disputed domain name formerly displayed a Chilean-themed image, and that it continues to display PPC links related to Chile (including Chile news), this evidence dates from 2022 and 2024 and does not shed light on the Respondent’s aim when it registered the disputed domain name. Nor is there any evidence of the Respondent’s registration or use of other domain names that might establish a pattern of bad faith.

Accordingly, the evidence presented does not indicate that it is more likely than not that the Respondent’s aim in registering the disputed domain name was to profit from or exploit the Complainant’s trademark. Given that the Panel has not found that the disputed domain name was registered in bad faith, it is unnecessary to consider whether it is being used in bad faith.

Therefore, the Panel finds the third element of the Policy has not been established.

7. Decision

For the foregoing reasons, the Complaint is denied.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: May 16, 2024