

ADMINISTRATIVE PANEL DECISION

Sevilla Fútbol Club Sociedad Deportiva, SAD v. Matthew Carpenter
Case No. D2024-3904

1. The Parties

The Complainant is Sevilla Fútbol Club Sociedad Deportiva, SAD, Spain, represented by CASAS ASIN, Spain.

The Respondent is Matthew Carpenter, United States of America (“United States”).

2. The Domain Name and Registrar

The disputed domain name <sevillafcusa.com> is registered with Squarespace Domains LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 24, 2024. On September 25, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same 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 (HF Management USA, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on September 27, 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 amendment to the Complaint on October 7, 2024.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 9, 2024. In accordance with the Rules, paragraph 5, the due date for Response was October 29, 2024. The Respondent sent an email communication to the Center on October 11, 2024. The Complainant sent an email communication on October 17, 2024.

The Center appointed Matthew Kennedy as the sole panelist in this matter on November 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.

The Respondent sent an email communication to the Center on November 6, 2024.

4. Factual Background

The Complainant is a football club in the city of Sevilla, Spain. The club was founded in 1890 and constituted as a sporting and cultural association in 1905. It holds multiple trademark registrations, including the following:

- Spanish trademark registration number 214203 for SEVILLA FUTBOL CLUB SAD, registered on May 20, 1998, specifying services in classes 35 and 41;
- International trademark registration number 1412377 for SEVILLA FC SOCCER ACADEMY and shield device, registered on January 30, 2018, designating jurisdictions including the United States, specifying goods and services in classes 25, 41, and 45; and
- International trademark registration number 1586480 for SEVILLA FC and shield device, registered on October 22, 2020, designating jurisdictions including the United States, and specifying goods and services in multiple classes, including training in the field of playing soccer.

The above trademark registrations are current. The Complainant has also registered multiple domain names, including <sevillafc.es>, registered on June 6, 2021, that it uses in connection with a website where it provides information about itself and its activities and sells merchandise.

The Complainant entered into a license agreement on July 1, 2017, with HF Management USA, LLC (“HF Management”), to create and manage football academies in the United States under the brand name “Sevilla FC Soccer Academy”. Clause 3.4 of this agreement provided that, as a general matter, any use or application of Sevilla FC trademarks or logos must have the express authorization of the Complainant. Clause 3.7 set out HF Management’s rights of commercial exploitation, subject to the condition that nothing in the agreement, except as expressly set forth therein, conferred upon HF Management any right or benefit with respect to the industrial property or intellectual property in the Complainant’s marks and/or training methodology. Clause 4 provided that the agreement had a term of 5 years from the date of signature. Clause 9 provided that the agreement would expire when it reached the end of its term unless the parties expressly agreed to an extension, and it also provided for termination by mutual agreement or for non-compliance. The Complainant alleges that it sent a cease-and-desist letter to HF Management on February 7, 2020, for failure to pay royalties. The Complainant initiated legal proceedings against HF Management in the Mercantile Court of Granada, Spain, on July 2, 2020.

The Respondent is a website developer.

The disputed domain name was registered on July 18, 2022. It resolves to a website for the Sevilla FC Soccer Academy USA that invites Internet users to register for soccer camps. Prices are displayed in USD. The website prominently displays the SEVILLA FC SOCCER ACADEMY and shield device trademark.

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 confusingly similar to its trademarks. The Respondent has no rights or legitimate interests in respect of the disputed domain name. The disputed domain name was registered and is being used in bad faith. The Respondent, aware of the success of the Complainant and its lack of authorization, proceeded to register the disputed domain name after the Complainant had alleged infringement of its intellectual property rights and terminated the license agreement between them. The Respondent has registered and renewed the disputed domain name in bad faith, to disturb the commercial activities of the Complainant, create consumer confusion and take advantage unlawfully from the popularity, effort, work, and investment made by the Complainant in recent years.

B. Respondent

The Respondent alleges that he has no control or ownership rights over the disputed domain name, that he is not affiliated with it in any registrant capacity, and that his involvement with the disputed domain name was limited to designing the website on behalf of a client, a representative of HF Management, whom the Respondent understands to be the rightful owner. The Respondent further alleges that he contacted the Registrar to transfer the disputed domain name to the correct owner but the disputed domain name was locked. Accordingly, the Respondent requests that his name be removed as a respondent in this matter.

6. Discussion and Findings

6.1 Identity of the Respondent and Request for Redaction

The Respondent denies that he is the owner of the disputed domain name and requests that his name be removed as a respondent in this matter.

As regards the identity of the Respondent, the Panel notes that the Registrar has verified that the holder of the disputed domain name is indeed the Respondent. The Panel also notes the Respondent's allegation that the rightful owner of the disputed domain name is a representative of HF Management. This representative was the person who signed the 2017 license agreement with the Complainant on behalf of HF Management, which presumably operates the website associated with the disputed domain name. For the record, the Panel notes that the Center sent the notification of the Complaint to various email addresses, including the contact email address on the website associated with the disputed domain name, but no reply was received from HF Management or its representative.

As regards the Respondent's request for redaction of his name, the Panel recalls that paragraph 4(j) of the Policy provides that all decisions under the Policy will be published in full over the Internet, except when a panel determines in an exceptional case to redact portions of its decision. See also paragraph 16(b) of the Rules. In the present case, the Panel sees no exceptional circumstances, such as identity theft, that would justify redacting portions of this Decision. Nevertheless, the Panel has ensured that the Respondent's arguments regarding the limited nature of his involvement in this matter are reflected in this Decision. The Panel will also take into account the evidence on the record regarding the involvement of HF Management and its representative.

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;

(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.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, \("WIPO Overview 3.0"\)](#), section 1.7.

The Complainant has shown rights in respect of the SEVILLA FC and shield device trademark for the purposes of the Policy. See [WIPO Overview 3.0](#), section 1.2.1. Given that the figurative elements of that mark cannot be represented in a domain name for technical reasons, the Panel will not take them into account in the assessment of identity or confusing similarity. See [WIPO Overview 3.0](#), section 1.10.

The textual elements of the SEVILLA FC and shield device mark are reproduced within the disputed domain name. Despite the addition of the geographic term "usa", the mark is recognizable within the disputed domain name. The only additional element in the disputed domain name is the generic Top-Level Domain ("gTLD") ".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 confusingly similar to the mark for the purposes of the Policy. See [WIPO Overview 3.0](#), sections 1.7, 1.8, and 1.11.1.

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

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. See [WIPO Overview 3.0](#), section 2.1.

In the present case, the disputed domain name incorporates the textual element of the Complainant's SEVILLA FC and shield device mark and resolves to a website that prominently displays the Complainant's SEVILLA FC SOCCER ACADEMY and shield device trademark. The website is for the Sevilla FC Soccer Academy USA and gives the impression that it is affiliated with, or endorsed by, the Complainant. However, while the Complainant has previously granted a license to create and manage football academies under the brand name "Sevilla FC Soccer Academy" in the United States, that license is no longer in effect. It is not clear from the record whether the Complainant terminated the license agreement for breach but nothing indicates that the license agreement was extended. Accordingly, the license agreement expired on June 30, 2022, two years prior to this proceeding, if it was not already terminated for non-compliance. Therefore, nothing on the record indicates that any party currently has any license from the Complainant to operate a Sevilla FC soccer academy in the United States. Accordingly, the Panel does not consider this to be a use of the disputed domain name in connection with a bona fide offering of goods or services for the purposes of the Policy. The evidence does not show that the Respondent, or HF Management, or its representative, has been commonly known by the disputed domain name. Given that the website associated with the disputed domain name charges for registration in soccer camps, the Panel does not consider this to be a legitimate noncommercial or fair use of the disputed domain name either.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. No party has rebutted the Complainant's prima facie showing or come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

Based on the record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith. The fourth of these 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] web site or location.”

The disputed domain name was registered on July 18, 2022, after the registration of the Complainant's SEVILLA FC and shield device trademark. The disputed domain name incorporates the textual elements of that mark, adding only the geographical term “USA” and a gTLD extension. The website displays the Complainant's SEVILLA FC SOCCER ACADEMY and shield device trademark, including its figurative elements, which is clearly not a coincidence. While the Complainant previously granted a license to use its mark to create and manage soccer academies in the United States, that license expired on June 30, 2022, if it was not already terminated for non-compliance; either way, the license ceased to have effect prior to the registration of the disputed domain name. In view of these circumstances, the Panel finds that the disputed domain name was registered in order to take advantage of the Complainant's mark.

With respect to use, the disputed domain name is used in connection with a website for the Sevilla FC Soccer Academy USA. Given the findings in Section 6.2B above, the Panel finds that the website gives the false impression that it is affiliated with, or endorsed by, the Complainant. Accordingly, the Panel finds that the facts of this case fall within the terms of paragraph 4(b)(iv) of the Policy.

Therefore, the Panel finds that the Complainant has established the third element 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 <sevillafcusa.com> be transferred to the Complainant.

/Matthew Kennedy/

Matthew Kennedy

Sole Panelist

Date: November 11, 2024