
Chile: Domain Name Registration Revoked Based on Prior Trademark Rights

By [Alejandra Camacho Luna](#)

Banmédica S.A. v. Arbitrator, Corte de Apelaciones de Santiago, Chile. Case number C-14654-2019 (decision dated July 1, 2020).

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On July 1, 2020, the Chilean Court of Appeal overturned an arbitrator's decision granting the domain name "multimed.cl" due to Banamerica S.A. ("BSA")'s prior trademark rights. This decision holds that domain names are an extension of trademarks on the Internet and illustrates the limitations of the "first-come, first-serve" principle in domain-name disputes in Chile.

Banamerica S.A. ("BSA") filed a petition to revoke the registration of the domain name "multimed.cl" by Vit Vrba ("VV") before the Network Information Center in Chile, the department that administers the registration of ".cl" domain names (also known as "NIC Chile"). BSA's petition was based on its prior trademark registration for MULTIMED for clinic and medical center services in Class 44.

Any dispute involving a ".cl" domain name is resolved through an arbitration proceeding before NIC Chile. BSA submitted evidence (i) that BSA was the legitimate owner of the trademark registration for MULTIMED, (ii) use of the mark MULTIMED by BSA, and (iii) VV's use of the domain name "multimed.cl" for a medical center. However, the arbitrator rejected BSA's petition on the ground that a prior trademark registration for MULTIMED was not sufficient to prove that BSA had a better right than

VV to the disputed domain name. Under the “first-come, first-serve” principle, VV had the right to use the domain name “multimed.cl” given that it was the first party to register it.

Under the CL Domain Name Dispute Resolution Policy, the arbitrator’s decision is final and non-appealable. However, BSA filed a disciplinary complaint against the arbitrator with the Chilean Court of Appeal, arguing that the arbitrator committed a “serious abuse” by rejecting BSA’s revocation petition.

The Court of Appeal overturned the arbitration decision. The Court explained that domain names are an “extension” of trademarks in the Internet world, given that domain names are used as denominations (word marks), which are associated with goods/services on the Internet. Therefore, there is a link between trademarks and domain names that should be recognized and protected. In this case, the mark (MULTIMED) and domain name (“multimed.cl”) are identical and both used in connection with medical-related services. Furthermore, the Court explained that the principle of “first come, first served” is not absolute. It only applies when both parties are in the same position. In this case, the parties were not in the same position given that BSA had legitimate, prior trademark rights. Another factor that the Court considered was that VV did not participate in the trial.

The full decision in Spanish is available below.

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