

ADMINISTRATIVE PANEL DECISION

Brookfield Office Properties Inc. v. Privacy service provided by Withheld for Privacy ehf / Carolina Rodrigues, Fundacion Comercio Electronico
Case No. D2022-2572

1. The Parties

The Complainant is Brookfield Office Properties Inc., Canada, represented by SafeNames Ltd, United Kingdom.

The Respondent is Privacy service provided by Withheld for Privacy ehf, Iceland / Carolina Rodrigues, Fundacion Comercio Electronico, Panama.

2. The Disputed Domain Name and Registrar

The disputed domain name <brookfieldproperties1.com> (the “Disputed Domain Name”) 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 14, 2022. On July 15, 2022, the Center transmitted to the Registrar, by e-mail, a request for registrar verification in connection with the Disputed Domain Name. On July 15, 2022, the Registrar transmitted, by e-mail, its verification response to the Center disclosing registrant and contact information, for the Disputed Domain Name, which differed from the named Respondent and contact information set forth in the Complaint. The Center sent an e-mail communication to the Complainant on July 18, 2022, providing the registrant and contact information disclosed by the Registrar and inviting the Complainant to submit an amendment to the Complaint to update both the Respondent and its contact information. On July 20, 2022, the Complainant filed an amended Complaint.

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”), 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”). All references hereinafter to the Complaint are to the amended version.

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint and that the proceedings commenced on July 22, 2022. In accordance with the Rules, paragraph 5, the due date for Response was set to August 11, 2022. The Respondent did not submit any Response. Accordingly, on August 15, 2022, the Center notified the parties of the Respondent's default.

On August 29, 2022, the Center appointed Peter L. Michaelson as the sole panelist in this matter. 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

As reflected in the registration record for the Disputed Domain Name in the public Whois database, the Disputed Domain Name was registered on September 29, 2021.

A. The Complainant's BROOKFIELD PROPERTIES Marks

As indicated in the Complaint, the Complainant owns various United States, Canadian, European Union, and Australian trademark registrations collectively for the terms BROOKFIELD and BROOKFIELD PROPERTIES (all referred to herein as the "BROOKFIELD PROPERTIES Marks"). The Complainant has provided, in Annex 9 to the Complaint, copies of its registration certificates for these registrations. Pertinent details of several of these registrations are as follows:

- i. **BROOKFIELD PROPERTIES**
United States Registration No. 4,277,629; filed: July 14, 2009; registered: January 22, 2013.

This service mark is registered for use in connection with: "Commercial real estate leasing and management" in international class 36; and: Commercial real estate development and construction of commercial office properties" in international class 37.

- ii. **BROOKFIELD PROPERTIES**
United States Registration No. 5,283,460; filed October 14, 2015; registered: September 12, 2017.

This service mark is registered for use in connection with: "Leasing and management of residential real estate including multifamily residential properties" in international class 36; and "Development and construction of residential real estate including multifamily residential properties" in international class 37.

- iii. **BROOKFIELD PROPERTIES**
Canadian Registration No.: TMA767439; filed: June 25, 2009; registered: May 19, 2010.

This service mark was registered in conjunction with "Commercial real estate development, construction, leasing and management". The registrant claims that it has used the mark in Canada since at least February 1996.

- iv. **BROOKFIELD**
Canadian Registration No.: TMA472422; filed April 9, 1996; registered: March 12, 1997.

This service mark was registered in conjunction with "Commercial real estate development, construction, leasing and management". The registrant claims that it has used the mark in Canada since at least 1990.

B. The Parties and their activities

The Complainant is a wholly-owned subsidiary of Brookfield Asset Management (“BAM”), the latter is a global alternative asset management company focusing on real estate, renewable power, infrastructure and private equity. BAM, which has various wholly-owned subsidiaries covering corresponding sectors in which it operates, was initially founded in 1899, has over USD 500 billion in assets under management, over 1,000 investment professionals and 150,000 operating employees spread over 100 offices in 30 countries and 5 continents. Annexes 4 and 5 to the Complaint respectively provide a copy of the home page of BAM's website and BAM's corporate structure. The Complainant is a real estate organization, which specializes in real estate investment strategies and focuses on the real estate investment activities of its parent. Through its real estate investments, the Complainant has a significant presence in the commercial real estate market in the United States of America, Germany, and United Kingdom – as shown in a copy of webpage, from BAM's website, provided in Annex 10 to the Complaint.

The Complainant and certain of its sister subsidiary companies, such as Brookfield Property Partners and Brookfield Public Securities Group, are regularly featured in major publications due to their market positions in the global real estate and investment sectors. Annex 7 to the Complaint provides copies of a sample of these articles. The Complainant has also received multiple industry awards for its services, such as, e.g., Global Capital Raise of the Year, Global Retail Investor of the Year and Firm of the Year (Canada). Annex 8 to the Complaint provides a list of some of these awards.

Since 1998, the Complainant and BAM have operated their main websites at the domain names <brookfieldproperties.com> and <brookfield.com>, respectively. The Complainant and BAM also own other domain names which incorporate the trademarks BROOKFIELD and BROOKFIELD PROPERTIES, such as, e.g.: <brookfieldcapital.us>, <brookfieldfunds.us>, and <brookfieldfinancialproperties.com>. Annex 11 of the Complaint provides copies of corresponding Whois records for these names.

The Respondent is using the Disputed Domain Name for a website at which Internet users are presented with a series of rotating home pages for corresponding third-party websites that are totally unrelated to the Complainant. These pages include surveys, forced search engine searches, pay-per-click (“PPC”) pages, and websites of third-party commercial services – some of which appear to attempt to install malware to Internet users' computers. Annex 12 to the Complaint provides a video recording of some of these rotating pages.

On February 16, 2022, the Complainant sent a cease and desist letter (a copy of which appears in Annex 15 to the Complaint) to the Respondent, which also demanded that the Respondent transfer the Disputed Domain Name to the Complainant. Thus far, the Complainant has not received any response.

The Respondent is also offering to sell the Disputed Domain Name, through the website at the domain name <sedo.com>, for no less than USD 899.00. Annex 16 to the Complaint provides a copy of the corresponding webpage on <sedo.com> for this name.

Further, the Disputed Domain Name currently has an associated MX (mail exchange) record (as reflected in a print-out of that record in Annex 17 to the Complaint) through which the Respondent established enabling it to use an e-mail server, addressed by that name, to source outgoing e-mail.

Lastly, the Respondent was involved in more than 500 domain name disputes (Annex 18 to the Complaint contains a list of some of them), each of which resulted in transfer of the domain name(s) at issue to the complaining party. In that regard, the Respondent has been involved in a domain name dispute with the Complainant in 2021, which resulted in transfer of the name there at issue to the Complainant (see, e.g., *Smartmockups s.r.o. v. Registration Private, Domains By Proxy, LLC/ Carolina Rodrigues, Fundacion Comercio Electronico*, WIPO Case No. [D2022-1868](#)).

5. Parties' Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the Disputed Domain Name is confusingly similar to its BROOKFIELD PROPERTIES Marks.

Specifically, the Disputed Domain Name contains this mark to which the number "1" has been appended with the latter being insufficient to prevent a finding of confusing similarity. The Complainant notes that, under standard practice, the generic top-level domain ("gTLD") present in the name, *i.e.*, ".com", is ignored, as a standard registration requirement, in assessing confusingly similarity under the Policy.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that, for various reasons, the Respondent has no rights or legitimate interests in the Disputed Domain Name pursuant to paragraphs 4(a)(ii) and 4(c) of the Policy.

Specifically, the Respondent has no connection or affiliation with the Complainant nor is it licensed or otherwise authorized by the Complainant to use any of its BROOKFIELD PROPERTIES Marks.

Moreover, the Disputed Domain Name resolves to a series of rotating home pages for corresponding third-party websites that are totally unrelated to the Complainant. These pages include surveys, forced search engine searches, PPC pages, and websites of third-party commercial services – some of which appear to attempt to install malware to Internet users' computers.

Use of the Disputed Domain Name particularly as a vehicle for installing malware is egregious as doing so creates a potential for serious and significant harm to unsuspecting Internet users who may be directed to such websites. Moreover, it is quite likely that the Respondent derives revenue in some fashion from directing Internet users to these third-party sites and, by so doing, financially benefits from the user confusion it is causing between its name and the Complainant's BROOKFIELD PROPERTY Marks. Use of the Disputed Domain Name in this illicit fashion does not reflect either legitimate rights in the Disputed Domain Name or a *bona fide* offering of goods or services, nor is it a legitimate noncommercial or fair use of the Disputed Domain Name.

Further, the Respondent has never been commonly known by any name, trade name or domain name that incorporates the BROOKFIELD PROPERTIES Marks, nor could it be given that the Complainant's exclusive trademark rights in its mark BROOKFIELD PROPERTIES began well prior to the September 29, 2021, *i.e.* the date on which the Respondent registered the Disputed Domain Name.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the Disputed Domain Name in bad faith in violation of paragraphs 4(a)(iii) and 4(b) of the Policy.

Specifically, the Respondent registered the Disputed Domain Name on September 29, 2021, *i.e.* some 25 years after the Complainant began using its BROOKFIELD PROPERTIES Marks in Canada and some 13 years after the Complainant first registered that mark in Canada. The Respondent, obviously with full knowledge of the worldwide reputation and recognition which the Complainant acquired through its mark since its first use and registration, intentionally chose the Disputed Domain Name for its ability to cause considerable consumer confusion between the Complainant's BROOKFIELD PROPERTIES Marks and the name. This intent is clearly evident in the Respondent's use of the Disputed Domain Name to direct Internet user's which displays a series of rotating home pages for corresponding third-party websites that are totally unrelated to the Complainant.

Clearly, the Respondent is using the Disputed Domain Name to intentionally target the Complainant by deliberately attracting Internet users by creating a likelihood of confusion with the Complainant's BROOKFIELD PROPERTIES Marks as to the source, sponsorship, affiliation or endorsement of the third-parties' websites. The resulting implication arising in the mind of such an Internet user is that the Respondent is associated in some way with the Complainant. Such a user is therefore invited to do business falsely and deceptively believing that it is doing so with either the Complainant itself or someone authorized on its behalf in relation to its services – when in fact it is not and is dealing with the Respondent.

Bad faith, also predicated on the Respondent's exploitation of Internet user confusion, is further evidenced by the Respondent's having established an MX record for the name through which the Respondent has the capability to source outgoing e-mail messages which carries the disputed domain name in the originating address. Such messages will quite likely mislead its recipients into believing that they originate from the Complainant when, in fact, they do not and are sent by the Respondent which has no connection whatsoever with the Complainant.

Moreover, bad faith is also reflected in the Respondent's action in now offering the Disputed Domain Name for sale at a price (no less than USD 899) which exceeds its out-of-pocket costs of registering the name.

Lastly, the Complainant alleges that the Respondent's actions in not responding to the Complainant's February 16, 2022, cease and desist letter are further evidence of bad faith.

B. Respondent

In view of the lack of any Response, this administrative proceeding continued by way of default. Hence, under paragraphs 5(f), 14(a), and 15(a) of the Rules, the Panel decided this proceeding on the basis of the Complainant's undisputed factual allegations which the Panel finds are not inherently implausible.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the Disputed Domain Name is confusingly similar to the Complainant's BROOKFIELD PROPERTIES Marks.

From a simple comparison of the Disputed Domain Name to the Complainant's BROOKFIELD PROPERTIES Marks, no doubt exists that the the Complainant's BROOKFIELD PROPERTIES Marks are recognizable in the Disputed Domain Name. The Disputed Domain Name consists of this mark to which the numeral "1", and then to which the gTLD ".com" has been appended. The addition of the gTLD is typically irrelevant in assessing confusing similarity under paragraph 4(a)(i) of the Policy and thus may be ignored. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), sections 1.7 and 1.11.

It is now very well-established, that a minor variation to a mark, including a minor addition to it such as a single numeral does not prevent confusing similarity. Here, the Respondent's addition of the number "1" to the Complainant's mark to form the Disputed Domain Name unquestionably constitutes such a minor variation and does not prevent a finding of confusing similarity. See [WIPO Overview 3.0](#), section 1.8, and, e.g., *AUTRY International S.r.l. v. Unknown (Whois Agent) / Kuehp Tgfdeu*, WIPO Case No. [D2022-0879](#); and *Universal Services of America, LP d/b/a Allied Universal v. This Domain May be for Sale at https://www.networksolutions.com, New Ventures Services, Corp.*, WIPO Case No. [D2019-0834](#).

Hence, the Complainant satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the Disputed Domain Name under any of the criteria in paragraph 4(c) of the Policy.

The Complainant has never authorized the Respondent to utilize the Complainant's BROOKFIELD PROPERTIES Marks in either a domain name or any other use and has no relationship, affiliation, or connection whatsoever with the Respondent.

Further, it is clearly evident to the Panel that the Respondent has not used the Disputed Domain Name in connection with a *bona fide* offering of goods or services or made any prior demonstrable preparations to do so. Rather, the Respondent illicitly uses the Disputed Domain Name, which totally incorporates the Complainant's BROOKFIELD PROPERTIES Marks, to dynamically resolve to a rotating series of webpages from third-party sites, none of which is related to the Complainant, with these pages containing surveys, forced search engine searches, PPC pages, and pages for third-party commercial services – some of which apparently attempt to install malware onto users' computers. Using a domain name in a manner such as this fails to qualify as a *bona fide* use generally, but also specifically under UDRP paragraph 4(c)(i). Nor does such a use constitute either a legitimate noncommercial or fair use of the Disputed Domain Name under UDRP paragraph 4(c)(iii).

Given the Complainant's exclusive rights in its BROOKFIELD PROPERTIES Marks, which predate the date on which the Respondent registered the Disputed Domain Name, and the recognition, reputation, and good-will which the Complainant likely developed in its BROOKFIELD PROPERTIES Marks over the prior 25 plus years since the Complainant first starting using its BROOKFIELD PROPERTIES Marks in Canada, the Panel finds it unlikely that the Respondent would have registered the Disputed Domain Name without having the Complainant and its BROOKFIELD PROPERTIES Marks in mind. Moreover, there is no evidence before the Panel that the Respondent has trademark rights or is otherwise commonly known by the Disputed Domain Name. Consequently, the Respondent is not commonly known by the Disputed Domain Name and hence does not qualify under UDRP paragraph 4(c)(ii).

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions with respect to the Disputed Domain Name constitute bad faith registration and use.

It is categorically clear to the Panel, even apart from any inference that could be drawn from the lack of any Response, that the Respondent was well aware of the Complainant and its BROOKFIELD PROPERTIES Marks and the considerable potential for the Disputed Domain Name to cause confusion with that mark. Yet, in spite of that knowledge, the Respondent intentionally and purposely registered the name for its substantial potential to likely confuse Internet users and, as a consequence, commercially benefit therefrom.

The Respondent's bad faith registration and use become patently obvious from several principal aspects present here, any one of which suffices. While other aspects exist, they are simply cumulative and need not be addressed in detail.

First, the Respondent is opportunistically exploiting the inevitable user confusion that will result from its use of the Disputed Domain Name to redirect Internet users to a series of websites, in a rotating scheme, that have absolutely nothing to do with the Complainant but from which the Complainant very likely derives some form of pecuniary benefit. These sites include surveys, forced search engine searches, and PPC pages. This conduct constitutes bad faith registration and use under paragraph 4(b)(iv) of the Policy.

Second, in the absence of any Response, the Panel accepts the Complainant's accusation as undisputed that some of these third-party webpages are apparently able, once processed through an Internet user's browser, to install malware on the Internet user's computer. The Complainant does not specify the specific exploit injected by that page nor its installation modality. Owing to very serious risk of substantial injury to the Internet user community through the intentional injection of malware onto an Internet user's computer, the Panel views the Respondents' action in doing so as not only particularly pernicious but also extremely egregious which, under no circumstance, can be tolerated, let alone justified. This conduct constitutes bad faith use under paragraph 4(b)(iii) of the Policy.

Third, bad faith registration and use is also reflected in the Respondent's action in offering the Disputed Domain Name for sale at a price, which exceeds its out-of-pocket costs of registration. Given the Complainant's exclusive rights in its BROOKFIELD PROPERTIES Marks, the Respondent likely believes, in offering the Disputed Domain Name for sale at the price it does, that ultimately the Complainant, to alleviate Internet user confusion and continued injury to its reputation that would otherwise occur, will either purchase the name directly from the Respondent or from an intervening third-party purchaser. This conduct reflects bad faith use and registration under paragraph 4(b)(i) of the Policy.

Fourth, the Respondent has engaged in a pattern of cybersquatting through which it was involved in multiple UDRP proceedings, all of which resulted in transfers to the corresponding complainant, even including a prior UDRP proceeding involving the present Complainant. From this perspective and even apart from the other aspects of the Respondent's conduct reflective of bad faith, the Respondent, in exhibiting a pattern of illicit registrations, very likely deliberately registered the Disputed Domain Name to prevent the Complainant from registering a domain name reflecting its BROOKFIELD PROPERTIES Marks. This conduct reflects bad faith use and registration under paragraph 4(b)(ii) of the Policy.

Consequently, the Respondent's conduct constitutes bad faith registration and use under paragraph 4(a)(iii) 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, <brookfieldproperties1.com>, be transferred to the Complainant.

/Peter L. Michaelson/

Peter L. Michaelson

Sole Panelist

Date: September 12, 2022