

ADMINISTRATIVE PANEL DECISION

Majid Al Futtaim Properties LLC v. Luc Pierre Lescault, Arabian Centres
Case No. D2022-3550

1. The Parties

Complainant is Majid Al Futtaim Properties LLC, United Arab Emirates, represented by Talal Abu Ghazaleh Legal, Egypt.

Respondent is Luc Pierre Lescault, Arabian Centres, Saudi Arabia.

2. The Domain Name and Registrar

The disputed domain name <mallofsaudi.net> (the “Domain Name”) is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 26, 2022. On September 26, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On September 27, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the Domain Name, which differed from the named Respondent (“Registration Private, Domains by Proxy, LLC”) and contact information in the Complaint. The Center sent an email communication to Complainant on September 28, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting Complainant to submit an amendment to the Complaint. Complainant filed an amended Complaint on October 2, 2022.

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 Respondent of the Complaint, and the proceedings commenced on October 3, 2022. In accordance with the Rules, paragraph 5, the due date for Response was October 23, 2022. Respondent did not submit any response. Accordingly, the Center notified Respondent’s default on October 24, 2022.

The Center appointed Christopher S. Gibson as the sole panelist in this matter on October 31, 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

Complainant was established in 1994 as a subsidiary of Majid Al Futtaim Holding LLC, an Emirati holding company founded in 1992 and based in Dubai, which owns and operates shopping malls, retail and leisure establishments in the Middle East, Africa and Asia, with operations in 15 countries: UAE, Egypt, Saudi Arabia, Oman, Lebanon, Bahrain, Kuwait, Qatar, Jordan, Iraq, Kazakhstan, Pakistan, Kenya, Armenia, and Georgia. Complainant employs more than 40,000 people. Majid Al Futtaim Holding LLC manages three major operating subsidiaries, including Complainant, Majid Al Futtaim Retail, and Majid Al Futtaim Ventures.

Complainant is a developer of shopping malls together with hotels and mixed-use community projects in the Middle East and North Africa, as it owns and operates 29 shopping malls, 13 hotels and five mixed-use communities, with further developments underway. The shopping malls portfolio includes Mall of the Emirates, Mall of Egypt, City Centre malls, My City Centre neighborhood centers, and five community malls, which are operated in a joint venture with the Government of Sharjah.

The "MALL OF" brand is Complainant's flagship super regional mall offering, which brings unique experiences to customers, including snow parks and ski slopes, sought after brands from luxury to lifestyle, and a mix of food and beverage, and other innovative retail concepts.

Complainant commenced use for its MALL OF brand in connection with the operation of "Mall of the Emirates" in Dubai, the region's first shopping resort and flagship luxury destination, which opened its doors in 2005. Complainant has spread to other nations and regions in the Middle East by opening shopping mall services under the MALL OF brand. Complainant opened "Mall of Egypt" in Cairo, Egypt in 2017, as a sister brand to Mall of the Emirates. It is a super-regional mall of 165,000 square meters serving the western half of the greater Cairo metropolis. Complainant opened the Mall of Oman in 2021.

Complainant owns a number of trademark registrations for its MALL OF brand in various countries, including:

- MALL OF THE EMIRATES – in English and Arabic letters, registered in UAE and Bahrain under registration UAE Trademark No. 202933 in class 35 (Application date: Dec. 19, 2013); UAE Trademark No. 202936 in class 43 (Application date: Dec. 19, 2013); Bahaini Trademark No. 101352 in class 35 (Application date: Dec. 24, 2013); and Bahaini Trademark No. 101359 in class 43 (Application date: Dec. 24, 2013).

- MALL OF EGYPT – in English and Arabic letters, registered in Egypt under No. 196979 in class 35 (Application date: Feb. 27, 2007); No. 196980 in class 36 (Application date: Feb. 27, 2007); No. 196981 in class 35 (Application date: Feb 27, 2007); No. 196982 in class 36 (Application date: Feb. 27, 2007); No. 242875 in class 35 (Application date: Mar. 11, 2010); No. 345474 in class 35 (Application date: Jan. 5, 2017); No. 345475 in class 36 (Application date: Jan. 5, 2017); and No. 345476 in class 37 (Application date: Jan. 5, 2017).

- MALL OF OMAN – in English and Arabic letters, registered in Oman under No. 43575 in class 35 (Application date: Feb. 10, 2007); and No. 43576 in class 36 (Application date: Feb. 10, 2007).

- MALL OF TUNIS and MALL OF TUNISIA – in English and Arabic letters, registered in Tunis under No. TN/E/2011/000575 in classes 35 and 36 (Application date: Apr. 6, 2011); TN/E/2011/000571 in classes 35 and 36 (Application date: Apr. 4, 2011); TN/E/2011/000570 in classes 35 and 36 (Application date: Apr. 4, 2011); and TN/E/2015/000265 in classes 35 and 36 (Application date: Mar. 30, 2015).

- MALL OF THE KINGDOM, registered in Jordan under no. 150292 in class 16 (Application date: Nov. 29, 2016); No. 150293 in class 35 (Application date: Nov. 29, 2016); and No. 150294 in class 36 (Application date: Nov. 29, 2016).

Complainant maintains websites for its Mall of the Emirates and Mall of Egypt shopping malls. These sites provide information about each mall, while promoting the shopping and services available. Complainant maintains its website for the “Mall of the Emirates” mall at “www.malloftheemirates.com”, with the domain name <malloftheemirates.com> registered July 6, 2003. The site can also be accessed through the Majid Al Futtaim website at “www.majidalfuttaim.com”, with the domain name <majidalfuttaim.com> registered February 9, 2002. Complainant acquired the domain name <mallofegypt.com> in 2015 by virtue of the UDRP decision in *Majid Al Futtaim Properties LLC v. Medhat Eissa*, WIPO Case No. [D2015-1151](#).

On February 8, 2016, Complainant announced plans to develop two new landmark shopping malls in Riyadh, which will offer a series of luxury international fashion brands, as well as unique entertainment and leisure experiences, to the Kingdom for the first time at the “Mall of Saudi” and the “City Centre Ishbiliyah”. The two new developments will bring the total number of Complainant owned and operated malls to more than 20 across the region. Mall of Saudi will be the Kingdom’s flagship destination for retail, leisure and entertainment, offering prestigious stores and new brands making their debut in the market. Designed as a lifestyle venue, the mall will contain recognizable brands in retail from fashion and home styling to electronics, and including snow park and ski slopes and other entertainment and dining options. Complainant’s estimated investment in the Mall of Saudi project is approximately GBP 1.58bn (SAR8.3bn). Complainant is set to open the Mall of Saudi by the first quarter of 2025. A Mall of Saudi brochure can be found at: “https://www.mallofsaudi.com/-/media/mall_mos/about/522020_mos-brochure.pdf?la=en.”

Complainant’s promotion and advertising for Mall of Saudi shopping mall includes street banner advertising, press releases, news, articles, and online advertisement through YouTube videos. Complainant has submitted evidence of its advertising. Complainant owns the <mallofsaudi.com> domain name since 2018 by virtue of the favorable decision in *Majid Al Futtaim Properties LLC v. Scitecs and Arabian Centres Company Limited*, WIPO Case No. [D2018-1776](#). This domain name is connected to a website incorporating Complainant’s MALL OF SAUDI trademark and providing information about the mall, as well as promoting the shopping and services that will be available at the property. Complainant through its subsidiary, Majid Al Futtaim Shopping Malls KSA LLC, owns the <Mallofsaudi.sa> domain name since 2018.

The Domain Name was registered on February 10, 2016 and does not resolve to an active webpage.

5. Parties’ Contentions

A. Complainant

(i) Identical or confusingly similar

Complainant’s claims extensive and continuous use of its MALL OF family of trademarks. According to Complainant, the fact that it has made significant investments over the years to promote and protect these trademarks and Complainant’s business on the Internet, demonstrate that Complainant enjoys a substantial degree of public recognition in the MALL OF brand and has seen this mark become uniquely and distinctly associated with Complainant.

Complainant states that it has also acquired common law rights in its MALL OF SAUDI trademark, by virtue of the extensive commercial use of this trademark in the shopping mall industry through widespread advertisement regarding developments for the Mall of Saudi, which will be the Kingdom’s largest shopping mall, and by the long-term investment of time, effort, and resources to promote the MALL OF SAUDI trademark and the services that will be offered. Complainant states it has spent huge amounts of money on advertising and promotion of its MALL OF SAUDI trademark and has submitted evidence in support of its claim. Complainant states its extensive promotion of the mark, and the fact that Complainant has made

significant investments over the years to promote and protect this mark and Complainant's business across the Internet, demonstrate that Complainant enjoys a substantial degree of public recognition in MALL OF SAUDI and has seen this mark become uniquely and distinctly associated with Complainant. Therefore, Complainant contends it has established common law trademark rights in its MALL OF SAUDI trademark, and that such rights are accorded to Complainant by virtue of national laws and international agreements. Complainant also submits that it has provided evidence to show that its MALL OF brand and MALL OF SAUDI trademark enjoy worldwide reputation.

Further, Complainant submits the Domain Name is identical to Complainant's MALL OF SAUDI trademark and confusingly similar to Complainant's MALL OF THE EMIRATES, MALL OF EGYPT, MALL OF OMAN, MALL OF TUNIS, MALL OF TUNISIA, and MALL OF THE KINGDOM trademarks, among others, as it incorporates the dominant element of these marks in its entirety. The Domain Name comprises the descriptive words "Mall of" qualified by the geographical location "Saudi". In combination, these words effectively read identically to Complainant's distinctive and specific trademark MALL OF SAUDI.

(ii) Rights or legitimate interests

Complainant states there is no evidence that Respondent owns any trademark or service mark rights or registrations that are identical, similar, or in any way related to the Domain Name. Complainant has never authorized or licensed Respondent to use its MALL OF brand or MALL OF SAUDI trademark, nor authorized Respondent to seek the registration of any domain name incorporating the trademark. Complainant contends that Respondent does not have any rights or legitimate interests in the Domain Name for the following reasons:

1. Respondent is not affiliated with Complainant in any way;
2. Complainant has not authorized Respondent to use its trademark or to seek registration of any domain name incorporating the trademark;
3. Respondent has no prior rights or legitimate interests in the Domain Name, since Complainant's operation of the MALL OF brand goes back to 2005 through operation of the Mall of the Emirates and its announcement of March 26, 2012, in which Complainant announced that "it is also considering land in Riyadh, Saudi Arabia, to build a mall". Therefore, there is no evidence of prior rights or legitimate interests for Respondent in the Domain Name before the date of Complainant's usage of the MALL OF brand and its announcement of the development of Mall of Saudi shopping mall in Riyadh; and
4. Respondent registered the Domain Name anonymously and hence, cannot claim to have been commonly known by the Domain Name.

Furthermore, the Domain Name does not resolve to an active website and currently is not being used. By passively holding the Domain Name, Respondent is not making any genuine or legitimate use of it. Hence, failure to make active use of the Domain Name, which is identical to Complainant's mark, means Respondent cannot claim a *bona fide* offering of goods or services pursuant to Paragraph 4(c)(i) of the Policy, nor a legitimate noncommercial or fair use pursuant to Paragraph 4(c)(iii) of the Policy. This confirms Respondent's lack of rights or legitimate interests in the Domain Name.

Complainant claims its fame and massive reputation under the MALL OF brand through its operations of shopping malls in the Middle East countries makes it clear that Respondent knew of Complainant and its brand and trademark. There is no believable or realistic reason for registration or use of the Domain Name other than to take advantage of Complainant rights.

Complainant submits that, given the global fame of Complainant's MALL OF brands in various jurisdictions in the Middle East and the MALL OF SAUDI trademark, there is no conceivable use to which the Domain Name could be put now, or in the future, that would confer any legitimate interest upon Respondent, given the confusing similarity of the Domain Name to Complainant's trademark.

Complainant argues that by registering the Domain Name incorporating Complainant's MALL OF SAUDI trademark, which is uniquely associated with Complainant's services and enjoys public recognition, Respondent pretends to be related to Complainant and hence, misleads consumers in the false view that Respondent's Domain Name and the page linked to it is related to Complainant. Accordingly, a Domain Name that misleads users does not confer rights or legitimate interests in favor of Respondent.

Complainant also contends that the mere registration of the Domain Name does not itself confer rights or legitimate interests in it. Further, panels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests. In order to find rights or legitimate interests based on dictionary meaning, the domain name should be genuinely used, or at least demonstrably intended for use, in connection with the relied upon dictionary meaning, and not to trade off third-party trademark rights. Here, Complainant urges there can be no question that Respondent was aware of Complainant and its marks when registering the Domain Name. Yet, in spite of that knowledge, Respondent intentionally registered it to misappropriate and exploit the reputation inherent in Complainant's marks to Complainant's detriment. Accordingly, Respondent has no rights or legitimate interests in the Domain Name.

(iii) Registered and used in bad faith

Complainant contends that the Domain Name has been registered in bad faith as it is implausible that Respondent was unaware of Complainant's MALL OF brand when registering the Domain Name, because Complainant has been operating the MALL OF brand since 2005; established its company in 1994; registered the domain name <malloftheemirates.com> since July 6, 2003, and requested to obtain protection for its trademarks MALL OF EGYPT on February 27, 2007, MALL OF OMAN on February 10, 2007, and MALL OF TUNIS on April 4, 2011; and announced plans to develop the Mall of Saudi shopping mall in Riyadh on February 8, 2016.

Complainant contends that the significant popularity of Complainant's shopping malls under the MALL OF brand makes it likely Respondent knew of Complainant's trademark rights at the time of registering the Domain Name, and Respondent's sole purpose was to block Complainant from registering the Domain Name. Hence, the aim of the registration was to take advantage of the confusion between the Domain Name and Complainant's rights. Respondent was undoubtedly aware of Complainant's prominence in the shopping mall industry when the Domain Name was registered. However, notwithstanding Respondent's knowledge of the fame and goodwill associated with the MALL OF brand, Respondent intentionally registered, for commercial gain, the Domain Name comprised of Complainant's trademark. Respondent by using the Domain Name, which is similar and identical to Complainant's MALL OF brands and MALL OF SAUDI trademark, will attract Internet users to Respondent's website by creating a likelihood of confusion with Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's website.

Further, Complainant states that panels have consistently found the mere registration of a domain name that is identical or confusingly similar to a famous or widely-known trademark by an unaffiliated entity can by itself create a presumption of bad faith. Moreover, Respondent registered the Domain Name two days (February 10, 2016) after Complainant's announcement of February 8, 2016, in which Complainant announced as follows:

"Mall of Saudi, the Kingdom's largest shopping mall set to be developed in north Riyadh, which will be home to the country's first snow park, Majid Al Futtaim, the leading shopping mall, retail and leisure pioneer across the Middle East and North Africa (MENA), has today announced plans to develop two new landmark shopping malls in Riyadh, which will see a series of luxury international fashion brands, as well as unique entertainment and leisure experiences come to the Kingdom for the first time at Mall of Saudi and City Centre Ishbiliyah".

Again, the Domain Name registration occurred two days after Complainant's announcement of the development of the Mall of Saudi shopping mall in Riyadh. Therefore, it would be highly unlikely for Respondent to have registered the Domain Name consisting of the two terms "Mall of" and "Saudi" in this

exact combination at that exact time, if not for opportunistic bad faith. Complainant contends it is clear that Respondent would never have registered the Domain Name if not for the fact that Respondent knew that it was in use or about to be used as a trademark by Complainant. The Domain Name does not resolve to any website. This passive holding of the Domain Name can in certain circumstances be evidence of use in bad faith. Since Respondent has made no active use of the Domain Name, it is clear that Respondent's purpose was not only to block Complainant from registering the Domain Name itself, but also to use the Domain Name to disrupt the business of Complainant or use it for commercial gain.

In addition, Respondent's use of privacy service coupled with the registration of the Domain Name containing Complainant's mark in its entirety is evidence of bad faith registration and use of the Domain Name.

In view of the totality of the circumstances, namely, the intentional registration of the Domain Name containing Complainant's common law trademark in its entirety, the use of the Domain Name to cause user confusion and diversion, the continuing inactivity of the site since the date the Domain Name was registered, and the lack of Respondent's own rights to or legitimate interests in the Domain Name, all of this shows that Respondent has registered and used the Domain Name in bad faith under paragraph 4(b) of the Policy.

B. Respondent

Respondent did not reply to Complainant's contentions.

6. Discussion and Findings

In order to succeed on its Complaint, Complainant must demonstrate that the three elements set forth in paragraph 4(a) of the Policy have been satisfied. These elements are that:

- (i) the Domain Name registered by Respondent are identical or confusingly similar to a trademark or service mark in which Complainant has rights;
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) Respondent has registered and is using the Domain Name in bad faith.

A. Identical or Confusingly Similar

Complainant's claims rights in its MALL OF family of trademarks both through registration in various countries in the Middle East region and through extensive and continuous use, with supporting evidence. Complainant also contends that it has acquired common law rights in its MALL OF SAUDI trademark, by virtue of the extensive commercial use of this trademark in the shopping mall industry through widespread advertisement regarding developments for the Mall of Saudi.

The Panel confirms Complainant's trademark rights in its MALL OF family of trademarks by virtue of registration and widespread use. However, as to Complainant's claim of common law rights in its MALL OF SAUDI trademark "by virtue of national laws and international agreements", the Panel declines to make a finding on these alleged common law rights. The Panel observes the lack of recognition of common law trademark rights in Saudi Arabia, where trademark rights are mainly obtained by registration, except in limited circumstances where the trademark is well-known, and also observes Complainant's lack of specifying clearly the territory where these common law rights accrued, if not in Saudi Arabia. Complainant also submits that its MALL OF brand and MALL OF SAUDI trademark enjoy worldwide reputation. While Saudi Arabia recognizes well-known trademarks, the Panel, in light of the discussion immediately below, does not need to make a finding on this point.

The Panel determines that the Domain Name is confusingly similar to Complainant's MALL OF family of trademarks. The Domain Name consists of the words "mall of" in the dominant first position, identical to the placement of these words in Complainant's other MALL OF marks, followed by the geographic and jurisdictional indicator "Saudi", just as Complainant's other MALL OF marks incorporate terms relating to prominent geographic and jurisdictional locations in the Middle East. The Domain Name thus follows the same word pattern as Complainant's other MALL OF marks, while the dominant "mall of" feature in Complainant's marks (relating to shopping malls) is recognizable in the Domain Name. See Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (["WIPO Overview 3.0"](#)), section 1.7.

In addition, the Panel notes Complainant has been operating the MALL OF family of trademarks in connections with shopping malls located in different countries, and that Complainant has been operating a shopping mall in Saudi Arabia, which opening was announced before the registration of the Domain Name. The Panel finds that Respondent's opportunistic targeting of Complainant and the broader case context further support a finding of confusing similarity with the MALL OF family of trademarks.

The Domain Name is therefore confusingly similar to Complainant's MALL OF marks.

Accordingly, the Panel finds that the Domain Name is confusingly similar to a trademark in which Complainant has rights in accordance with paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Regarding the second element of the Policy, section 2.1 of the [WIPO Overview 3.0](#), states, "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. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element".

Here, the Panel determines that Complainant has made out a *prima facie* case, while Respondent has failed to respond to Complainant's contentions. The Panel finds that Complainant has not authorized Respondent to use Complainant's MALL OF marks; that Respondent is not commonly known by the Domain Name; that there is no evidence of prior rights or legitimate interests for Respondent in the Domain Name; that Respondent has not used the Domain Name for a legitimate noncommercial or fair use, nor used it in connection with a *bona fide* offering of goods or services. Instead, the Domain Name has been inactive for 6 years. As indicated in [WIPO Overview 3.0](#), section 2.10.1, "[p]anels have recognized that merely registering a domain name comprised of a dictionary word or phrase does not by itself automatically confer rights or legitimate interests on the respondent".

Further, Complainant claims its significant reputation under the MALL OF brand (through operation of its shopping malls in Middle East countries and promotion of its MALL OF brands) provides a basis for why it is likely that Respondent knew of Complainant and its trademark. Further, Complainant claims that Respondent registered the Domain Name two days after Complainant's announcement of February 8, 2016, in which Complainant announced its plans for the development of the Mall of Saudi. In the face of these contentions, Respondent has failed to provide any response or provide any reason for registration of the Domain Name. Thus, the Panel finds there is no basis in the record to find that Respondent has any right or legitimate interests in the Domain Name.

Accordingly, the Panel finds that Complainant has made a *prima facie* showing of Respondent's lack of rights or legitimate interests in respect of the Domain Name, which has not been rebutted by Respondent. The Panel therefore finds that Complainant has established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires that Complainant demonstrate that Respondent registered and is using the Domain Name in bad faith. [WIPO Overview 3.0](#), section 3.1, states, “bad faith under the UDRP is broadly understood to occur where a respondent takes unfair advantage of or otherwise abuses a complainant’s mark”.

Complainant has provided evidence of the reputation of its MALL OF trademarks in countries across the Middle East and North Africa dating back to 2005. Complainant has also provided evidence that the Domain Name registration occurred two days after Complainant’s announcement of the development of the Mall of Saudi shopping mall in Riyadh. Complainant has thus alleged that Respondent registered the Domain Name in opportunistic bad faith. See *General Growth Properties, Inc., Provo Mall L.L.C. v. Steven Rasmussen/Provo Towne Centre Online*, WIPO Case No. [D2003-0845](#) (“Respondent has not convincingly explained why he registered the domain name <provotownecentre.com> at the same time that the mall of the same name was announced and construction commenced”). Further, Complainant has alleged that since Respondent has made no active use of the Domain Name, Respondent’s purpose has been to block Complainant from registering the Domain Name and to disrupt Complainant’s business. While the Domain Name does not resolve to a website, Complainant contends this passive holding can in certain circumstances be evidence of use in bad faith, particularly in the absence of any conceivable good faith use.

Against these allegations, Respondent has made no response. Moreover, although Respondent used a privacy service for registration of the Domain Name, Respondent’s identity, as disclosed by the Registrar, indicates that Respondent is located in Saudi Arabia and associated with a property developer named as a respondent in a previous UDRP case, *Arabian Centres*. See *Majid Al Futtaim Properties LLC v. Scitecs and Arabian Centres Company Limited*, WIPO Case No. [D2018-1776](#).

In view of all of the above circumstances, the Panel finds, on the balance of the probabilities, that the Domain Name was registered and used in bad faith. Accordingly, Complainant has satisfied 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 Domain Name, <mallofsaudi.net>, be transferred to Complainant.

/Christopher S. Gibson/

Christopher S. Gibson

Sole Panelist

Date: November 29, 2022