

## **ADMINISTRATIVE PANEL DECISION**

Majid Al Futtaim Properties LLC v. Zakhm Selim Abou Bernadette  
Case No. D2022-3613

### **1. The Parties**

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

The Respondent is Zakhm Selim Abou Bernadette, France.

### **2. The Domain Name and Registrar**

The disputed domain name <malloftheemirates.net> is registered with Key-Systems GmbH (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on September 29, 2022. On September 29, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On September 30, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (On behalf of malloftheemirates.net OWNER, c/o whoisproxy.com) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 20, 2022, 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 on October 24, 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 the Respondent of the Complaint, and the proceedings commenced on November 1, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 21, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 23, 2022. The Center sent an email regarding the notification of the Complaint on November 29, 2022. The Center granted the Respondent until December 1, 2022, to submit a response. The Respondent did not submit any response and accordingly the Center notified the respondent’s default on December 5, 2022.

The Center appointed Tobias Malte Müller as the sole panelist in this matter on December 13, 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.

On December 15, 2022, the Complainant submitted an unsolicited supplemental filing.

#### **4. Factual Background**

The Complainant defines itself as a leading developer of shopping malls. It is part of the Majid Al Futtaim group, founded in 1992, which operates in the field of retail, leisure, and shopping malls in Middle East, Africa, and Asia including the Mall of the Emirates in Dubai, United Arab Emirates.

The Mall of the Emirates opened its doors in 2005 and is the region's first shopping resort and flagship luxury destination with more than 40 million visitors per year. The Mall of the Emirates is available under the website "www.malloftheemirates.com". The Complainant also operates a mobile application for its Mall of the Emirates shopping mall to help and assist customers navigate around the mall, explore dining options, book movies tickets at VOX Cinemas, view offers and events at the mall, participate in mall promotions; it also provides online shopping services through the App.

The Complaint is based, amongst others, on figurative trademark registrations containing the wording MALL OF THE EMIRATES in English and Arabic letters registered for services in Class 35 in Bahrain (No. 101352, filed on December 24, 2013 and registered on December 15, 2016) and in the United Arab Emirates (No. 202933, filed on December 19, 2013 and registered on September 30, 2014).

The disputed domain name was registered on October 6, 2017.

It results from the Complainant's documented allegations that the disputed domain name resolves to a domain trading website inviting the user to get a price or submit a purchase offer for the disputed domain name - "malloftheemirates.net is for sale! It can be yours today. Click here to get your price or make an offer!".

#### **5. Parties' Contentions**

##### **A. Complainant**

Firstly, the Complainant points out that the disputed domain name is identical or confusingly similar to its prior trademarks MALL OF THE EMIRATES, since it incorporates the dominant element of those marks in its entirety. Therefore, the actual use of the disputed domain name visually and phonetically creates a likelihood of confusion with those registered trademarks.

Secondly, the Complainant alleges that the Respondent has no rights or legitimate interests in respect of the disputed domain name. In particular, the Respondent is neither affiliated with the Complainant in any way nor has the Complainant authorized the Respondent to use its registered trademarks MALL OF THE EMIRATES, or to seek the registration of any domain name incorporating the said trademarks. Furthermore, the Respondent is not commonly known in the market by the disputed domain name. In addition, the Complainant notes that the disputed domain name has been registered five years ago and there is no evidence of the Respondent's use or demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

Thirdly, the Complainant contends that the Respondent registered and uses the disputed domain name in bad faith. It is evident to the Complainant that the Respondent must have had the Complainant's trademarks MALL OF THE EMIRATES in mind when registering the disputed domain name since said trademarks are

widely known and associated exclusively to the Complainant. In addition, Panels have consistently found that 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. Furthermore, the Respondent's use of the disputed domain name, which specifically target the Complainant, to resolve to a webpage which sole purpose is to openly and expressly offer the disputed domain name for sale, cannot be considered to be in good faith. Final, the Respondent had been involved in previous domain name disputes because of registering domain names reproducing or incorporating third party trademarks.

## **B. Respondent**

The Respondent did not reply to the Complainant's contentions.

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to "decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable".

Paragraph 4(a) of the Policy requires the Complainant to prove each of the following three elements in order to obtain an order that the disputed domain name should be transferred or cancelled:

- (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.

The Panel is satisfied that the registrant of record for the disputed domain name is the Respondent and will therefore proceed to analyze whether the three elements of paragraph 4(a) of the Policy are satisfied.

### **A. Supplemental Filing**

The Complainant filed a supplemental filing on December 15, 2022. The supplemental filing included previous UDRP decisions transferring domain names including the Complainant's trademark.

Paragraph 12 of the UDRP Rules provides that it is for the panel to request, in its sole discretion, any further statements or documents from the parties that it may consider necessary to decide the case. Thus, unsolicited supplemental filings are generally discouraged by UDRP panelists, and "panels have repeatedly affirmed that the party submitting or requesting to submit an unsolicited supplemental filing should clearly show its relevance to the case and why it was unable to provide the information contained therein in its complaint or response (e.g., owing to some 'exceptional' circumstance)". See section 4.6 of WIPO Overview of Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Here, the Complainant has provided the supplemental filings in support of the recognition of its rights. While the Panel notes that these decisions were rendered following the filing of the Complaint, thus unavailable at the time of the Complainant's submission, the decisions do not impact the outcome of this proceeding and thus the Panel will not consider the Complainant's supplemental filing.

### **B. Identical or Confusingly Similar**

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must establish rights in a trademark or service mark and subsequently establish that the disputed domain name is identical or confusingly similar to said mark.

The Complainant is the registered owner of figurative trademark registrations containing the wording MALL OF THE EMIRATES in English and Arabic letters registered for services in Class 35 in Bahrain (No. 101352, filing date: December 24, 2013; registration date: December 15, 2016) and in the United Arab Emirates (No. 202933, filing date: December 19, 2013; registration date: September 30, 2014).

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.

As explained in the [WIPO Overview 3.0](#), section 1.7, this test typically involves a side-by-side comparison of the domain name and the textual components of the relevant trademark to assess whether the mark is recognizable within the disputed domain name. While each case is judged on its own merits, in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.

In the present case, the Panel notes that the disputed domain name identically reproduces the English verbal elements MALL OF THE EMIRATES contained in said trademarks. The Panel further notes that the design elements and the verbal elements in Arabic language are incapable of representation in the disputed domain name. As noted in the [WIPO Overview 3.0](#), section 1.10, figurative elements are largely disregarded for purposes of assessing identity or confusing similarity under the first element. On this basis, trademark registrations with design elements would *prima facie* satisfy the requirement that the complainant show "rights in a mark" for further assessment as to confusing similarity. In the light of the above, the Panel concludes that the Complainant's marks are readily recognizable within the disputed domain name.

The generic Top-Level Domain ("gTLD") ".net" may be disregarded, as it is viewed as a standard registration requirement (see [WIPO Overview 3.0](#), section 1.11.1).

Hence, this Panel finds that the disputed domain name is identical to the English verbal elements of the Complainant's trademarks pursuant to the Policy, paragraph 4(a)(i).

### **C. Rights or Legitimate Interests**

Pursuant to paragraph 4(a)(ii) of the Policy, the Complainant must secondly establish that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

Paragraph 4(c) of the Policy contains a non-exhaustive list of circumstances which, if found by the Panel to be proved, shall demonstrate the Respondent's rights or legitimate interests in the disputed domain name. In the Panel's view, based on the unrebutted allegations stated above, the Complainant has made a *prima facie* case that none of these circumstances are found in the case at hand and, therefore, that the Respondent lacks rights or legitimate interests in the disputed domain name.

Firstly, the Panel does not dispose of any elements that could lead the Panel to conclude that the Respondent is commonly known by the disputed domain name or that it has acquired trademark rights pursuant to paragraph 4(c)(ii) of the Policy.

It further results from the Complainant's uncontested and documented evidence that the disputed domain name resolves to a domain trading website inviting the user to get a price or submit a purchase offer for the disputed domain name - "malloftheemirates.net is for sale! It can be yours today. Click here to get your price or make an offer!". The Panel considers such use as being clearly commercial, so that a noncommercial use pursuant to paragraph 4(c)(iii) of the Policy is excluded from the outset.

Finally, the Respondent did not submit any evidence of pre-Complaint preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services pursuant to paragraph 4(c)(i) of the Policy. In particular, the Complainant's uncontested allegations demonstrate that it has not authorized the

Respondent's use of its trademarks for registering the disputed domain name, which is identical to the English verbal elements of the Complainant's trademark.

It is acknowledged that once the Panel finds such *prima facie* case is made, the burden of production shifts to the Respondent to come forward with appropriate allegations or evidence demonstrating rights or legitimate interests in the disputed domain name. Since the Respondent in the case at hand failed to come forward with any allegations or evidence in this regard, this Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

The Complainant is therefore deemed to have satisfied paragraph 4(a)(ii) of the Policy.

#### **D. Registered and Used in Bad Faith**

Pursuant to paragraph 4(a)(iii) of the Policy, the Complainant must thirdly establish that the disputed domain name has been registered and is being used in bad faith. The Policy indicates that certain circumstances specified in paragraph 4(b) of the Policy may, "in particular but without limitation", be evidence of the disputed domain name's registration and use in bad faith.

In the case at hand, the Panel finds that the circumstances listed hereinafter and surrounding the registration suggest that the Respondent was aware that it has no rights or legitimate interests in the disputed domain name, and that the disputed domain name has been registered and is being used in bad faith:

- (i) the details disclosed for the Respondent by the Registrar were incomplete, noting the mail courier's inability to deliver the Center's written communications;
- (ii) the Respondent's failure to reply to the Complaint;
- (iii) the Complainant's active attempt to sell the disputed domain name by using it to resolve to a domain trading website inviting the user to get a price or submit a purchase offer for the disputed domain name;
- (iv) the English terms MALL OF THE EMIRATES are identically incorporated in the disputed domain name;
- (v) the distinctiveness of the trademark MALL OF THE EMIRATES which has existed and been used in commerce since many years; and
- (vi) the Respondent being involved as a respondent in two further cases under the .eu Alternative Dispute Resolution Rules<sup>1</sup>, where the Panels confirmed – respectively – the absence of rights or legitimate interests and the presence of bad faith, which, in this Panel's view, indicates a pattern of bad faith conduct (see [WIPO Overview 3.0](#), section 3.1.2).

Due to the above circumstances, which have not been questioned or rebutted by the Respondent, this Panel concludes that the Respondent knew or should have known the trademark MALL OF THE EMIRATES when it registered the disputed domain name, and that, on the balance of the probabilities, there is no plausible legitimate active use that the Respondent could make of the disputed domain name.

In the light of the above the Panel finds that the disputed domain name has been registered and is being used in bad faith. The Complainant is therefore deemed to also have satisfied the third element, paragraph 4(a)(iii) of the Policy.

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<sup>1</sup> See, *Instagram, LLC v. Bernadette Zakhm Selim Abou*, WIPO Case No. [DEU2018-0021](#); and, *VUR Village Trading No.1 Limited t/a Village Hotels v. Bernadette Zakhm Selim Abou*, WIPO Case No. [DEU2019-0002](#).

## 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, <malloftheemirates.net>, be transferred to the Complainant.

*/Tobias Malte Müller/*

**Tobias Malte Müller**

Sole Panelist

Date: December 27, 2022