

ADMINISTRATIVE PANEL DECISION

Majid Al Futtaim Properties Llc v. Domain-It Hostmaster, Domain-it!, Inc.
Case No. D2021-0591

1. The Parties

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

The Respondent is Domain-It Hostmaster, Domain-it!, Inc., United States of America (“United States”), represented by John Berryhill, Ph.d., Esq., United States.

2. The Domain Name and Registrar

The disputed domain name <citycentre.com> is registered with Domain-It!, Inc. dba Domain-It! (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on February 25, 2021. On February 25, 2021, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On March 1, 2021, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details.

The Center verified that 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 March 2, 2021. In accordance with the Rules, paragraph 5, the due date for Response was March 22, 2021. On March 18, 2021, the Respondent requested an extension to the Response filing period. On March 19, 2021, pursuant to paragraph 5(b) of the Rules, the Response due date was extended until March 26, 2021. The Response was filed with the Center March 26, 2021. On April 7, 2021, the Complainant sent a supplemental filing in response to the Respondent’s response.

The Center appointed Luca Barbero, Nick J. Gardner, and Richard G. Lyon as panelists in this matter on April 15, 2021. The Panel finds that it was properly constituted. Each member of 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

The Complainant, Majid Al Futtaim Properties LLC, was incorporated in 1994 and is a subsidiary of Majid Al Futtaim Holding LLC, an Emirati holding company founded in Dubai in 1992.

The Complainant owns and operates shopping malls, retail, and leisure establishments in the Middle East, Africa, and Asia, with operations in 15 countries (United Arab Emirates, Egypt, Saudi Arabia, Oman, Lebanon, Bahrain, Kuwait, Qatar, Jordan, Iraq, Kazakhstan, Pakistan, Kenya, Armenia, and Georgia), employing more than 40,000 people.

The Complainant has provided evidence of ownership of numerous trademark registrations comprising or including the words CITY CENTRE, including the following:

- Kingdom of Bahrain trademark registration No. 121618 for BAHRAIN CITY CENTRE (figurative mark), filed on January 17, 2018, and registered on June 12, 2018, in international class 36;
- Republic of Lebanon trademark registration No. 151152, for BEIRUT CITY CENTRE (figurative mark), registered on November 21, 1998, and renewed on July 11, 2013, in international class 36;
- Sultanate of Oman trademark registration No. 102294 for SOHAR CITY CENTRE (figurative mark), filed on December 11, 2016, and registered on April 30, 2017, in international class 16;
- Algeria trademark registration No. 86570 for ALGERIA CITY CENTRE (figurative mark), filed on April 13, 2011, and registered on September 30, 2014, in international classes 35 and 26;
- Saudi Arabia trademark registration No. 1435021716 for MY CITYCENTRE (& Arabic) (figurative mark), registered on March 26, 2015, in international class 16;
- United Arab Emirates trademark registration No. 191167 for CITY CENTRE (figurative mark), filed on May 2, 2013, and registered on August 18, 2014, in international class 36.

The Complainant is also the owner of several domain names for each of its City Centre Shopping mall, which can also be accessed via its main website at “www.majidalfuttaim.com”, registered on February 9, 2002, through which the Complainant promotes its shopping mall services in the Middle East.

Amongst these domain names, the Complainant owns domain names incorporating its CITY CENTRE mark, including <citycentredeira.com>, registered on May 20, 2014, <citycentrealmaza.com> registered on September 22, 2014, and <citycentreaajman.com> registered on May 20, 2014.

The disputed domain name <citycentre.com> was registered on September 26, 1998, and is pointed to a parking page with commercial links.

5. Parties' Contentions

A. Complainant

The Complainant contends that disputed domain name <citycentre.com> is identical to its trademark CITY CENTRE and confusingly similar to all its other trademarks containing the term CITY CENTRE in which the Complainant has rights, as it reproduces the trademark in its entirety with the mere addition of the generic Top Level Domain “.com”.

The Complainant highlights that its numerous trademark registrations as well as its claimed common law trademark rights in all its CITY CENTRE trademarks, grant it exclusive rights of use to the trademark CITY CENTRE in the shopping industry.

With reference to rights or legitimate interests in respect of the disputed domain name, the Complainant states that the Respondent was in no way authorized nor licensed to use its trademark CITY CENTRE or to seek registration of any disputed domain name incorporating said trademark.

The Complainant contends that the Respondent is not affiliated with the Complainant in any way and that, considering that the use of the trademark CITY CENTRE dates back to 1995, three years before the registration of the disputed domain name, the Complainant should be seen as being the rightful proprietor and legitimate owner of said trademark.

The Complainant further underlines that the Respondent is also not commonly known by the disputed domain name and that since the disputed domain name points to a parking page with commercial links to third party websites from which it presumably derives pay-per-click revenue, the Respondent has also failed to use the disputed domain name in connection with a *bona fide* offering of goods and services.

The Complainant highlights that the Respondent has also offered the disputed domain name <citycentre.com> for sale and thus asserts that the Respondent appears to have registered or acquired the domain name primarily for the purpose of selling, renting or otherwise transferring the disputed domain name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of its documented out-of-pocket costs.

With reference to the circumstances evidencing bad faith, the Complainant asserts that, considering its world renown, the Respondent most likely registered the disputed domain name with the Complainant's trademark in mind as the trademark CITY CENTRE is widely known and associated exclusively to the Complainant.

The Complainant contends that the Respondent acted in opportunistic bad faith when registering the disputed domain name, since such trademark would be so obviously connected with the Complainant's trademark, that the very selection by the Respondent, who has no connection to the Complainant, suggests that the disputed domain name has been registered with a deliberate intent to create an impression of an association with the Complainant.

The Complainant also emphasizes that, considering the disputed domain name is also being passively held and that the Respondent is not making an active use of the disputed domain name, it is clear that the Respondent's purpose was not only to prevent the Complainant from reflecting its trademark in a corresponding domain name, but also to use the disputed domain name to either purposely disrupt the Complainant's business or for commercial gain; all factors which do not prevent a finding of bad faith registration.

Moreover, the Complainant asserts that, since the disputed domain name is also being offered for sale, the Respondent clearly did not intend to use the disputed domain name in connection with a *bona fide* offering of goods or services.

B. Respondent

The Respondent replied to the Complainant's contentions, denying all the Complainant's allegations and highlighting that the expression "city centre" is in fact a common English expression that generally defines the central part of a city and that, considering the Complainant does not own a single trademark registration comprising exclusively the words "city centre", there should be no reason to believe that the Complainant has exclusive rights to use such expression.

Moreover, the Respondent contends that the earliest trademark registration found in the Complaint, refers to the trademark BEIRUT CITY CENTRE, which corresponds to the only registration presented which predates the acquisition of the disputed domain name by the Respondent in 2001.

The Respondent underlines that the Complainant's trademark registrations all comprise a textual component which narrows considerably the localities of each shopping mall, but asserts that nobody in the English-speaking world, would associate the common expression "city centre" to belong exclusively to a chain of shopping malls in the Middle East.

The Respondent further contends that the Complainant did not supply any proof to substantiate its allegations concerning its reputation in 2001, when it claimed common law rights beyond the immediate area of operations of three shopping centres in the United Arab Emirates, nor did it register a single domain name containing the words "city centre" on their own until 2014 at the earliest, which is more than ten years after the Respondent registered the disputed domain name.

The Respondent also emphasizes that the Respondent is an ICANN-accredited registrar that has been providing domain and IT services before ICANN even existed and over the years has maintained a portfolio of useful generic words and phrases which could find application in its future projects. In 2001, the founder and CEO of the Respondent negotiated the purchase of a domain name reference site and news aggregator, <iGoldrush.com>. The former owner of the domain name had included various generic word and phrase domain names in the purchase as an apology for moving slow with the deal, thus offering the disputed domain name to the Respondent at no charge.

The Respondent thus underlines that the disputed domain name was offered and included by the seller of <iGoldrush.com> as a generous gesture and has since remained in the Respondent's inventory since and has been monetized in connection with real estate and other subjects related to a "city centre" as a common English phrase.

The Respondent highlights that even a database trademark search shows that there are several trademarks worldwide containing the words "City Centre" which are not owned by the Complainant and are generally related to real estate development and leasing of commercial spaces.

The Respondent thus rebuts that, if it had sought to capitalize on the only existing trademark of the Complainant in 2001, the Respondent would have registered <BeirutCityCentre.com> as it would have corresponded to the only trademark registration of the Complainant at the time. However, the Respondent, who has lived in the United Kingdom and the United States, does not speak Arabic and was completely unaware of the Complainant's chain of shopping centres in the United Arab Emirates, so it would have had no reason to register the disputed domain name for such purpose.

The Respondent further denies all allegations concerning the concealed identity of the Respondent in the Whois database and points out that the Respondent has always been identified in the public registration data ever since acquiring the disputed domain name in 2001.

With regards to bad faith registration, the Respondent indicates that considering the Complainant had no Internet presence in relation to any CITY CENTRE domain names in 2001, there is no basis for believing that the Respondent acquired the disputed domain name for any purpose to do with the Complainant, especially considering that it never knew of the existence of the Complainant until shortly before the Complaint was filed. Accordingly, the Respondent submits that the Complainant has failed to substantiate its allegations that the Respondent registered the disputed domain name in 2001 out of any motivation involving the Complainant's then largely non-existent rights or reputation which at the time comprised only a small number of shopping centres the Respondent would have had no reason to know existed.

The Respondent thus declares unfounded all the Complainant's allegations.

6. Discussion and Findings

6.1. Preliminary procedural issue: Complainant's Supplemental Filing.

Before entering into the merits of the case, the Panel addresses the issue of the unsolicited supplemental filings submitted by the Complainant to the Center.

No provision concerning supplemental filings is made in the Rules or Supplemental Rules, except at the request of the panel according to paragraph 12 of the Rules, which states the panel, in its sole discretion, may request any further statements or documents from the parties it may deem necessary to decide the case.

According to paragraph 10 of the Rules, the Panel has the authority to determine the admissibility, relevance, materiality, and weight of the evidence, and also to conduct the proceedings with due expedition, ensuring that the Parties are treated with equality and that each Party is given a fair opportunity to present its case.

As stated in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("WIPO Overview 3.0"), section 4.6, unsolicited supplemental filings are generally discouraged – unless specifically requested by the panel – and the party submitting 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.

Accordingly, UDRP panels generally accept supplemental filings only when they provide material new evidence or a fair opportunity to respond to arguments that could not reasonably have been anticipated. See, along these lines, *Welcomemat Services, Inc. v. Michael Plummer Jr., MLP Enterprises Inc.*, WIPO Case No. D2017-0481.

The Panel notes that none of the Respondent's arguments in the Response was unforeseeable and finds that the Complainant's supplemental submissions is not grounded on evidence that was not available to the Complainant when the Complaint was filed.

In view of the above and since the Complainant has not demonstrated the presence of any exceptional circumstance required for admitting a supplemental filing, the Panel has decided not to consider the Complainant's comments in this additional filing. Nevertheless, the Panel notes that, should the Panel have admitted the Complainant's supplemental filing, the outcome of the case would have been the same.

6.2. Substantive Issues

According to paragraph 15(a) of the Rules: "A Panel shall 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 directs that the Complainant must prove each of the following:

- (i) that the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) that the disputed domain name has been registered and is being used in bad faith.

These requirements are conjunctive; failure to prove any one of them results in a denial of the Complaint. As the Complainant here has not convincingly alleged, nor proven, registration or use in bad faith for the reasons discussed below, this Complaint fails.

A. Identical or Confusingly Similar

The Complainant has proven ownership of the registered trademarks referred to in Section 4 above. Disregarding the generic Top-Level Domain (“gTLD”) “.com”, the disputed domain name is identical to the textual components of the Complainant’s CITY CENTRE trademark (No. 151152). See section 1.10 of the WIPO Overview 3.0.

Accordingly, the Complainant has established the first element for purposes of proceeding to look at the other two elements.

B. Rights or Legitimate Interests

In light of the Panel’s findings on the question of bad faith below, the Panel does not consider it necessary to determine whether or not the Respondent has rights or legitimate interests in respect of the disputed domain name.

C. Registered and used in Bad Faith

The Complainant’s core argument on bad faith is that the Respondent registered the disputed domain name with the primary purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant or to a competitor of the Complainant, though the Complainant has supplied no proof to substantiate such allegations.

Moreover, the Complainant has also not demonstrated that the Respondent, which acquired the disputed domain name in 2001, when the Complainant apparently only had a single trademark registration in Lebanon (for BEIRUT CITY CENTER), was, or ought to have been aware of the Complainant and its trademarks at the time of registering the disputed domain name.

Indeed, there is no evidence in the record that the Complainant’s trademark might have been used outside the Middle East regions and the Complainant’s websites target consumers located in various Middle Eastern locations. In addition, a Google search for “city centre” shows many results unrelated to the Complainant and its mark.

Furthermore, there is also no proof that the Respondent registered the disputed domain name appreciating that it might be confusingly similar to the Complainant’s trademark and also the use of the disputed domain name does not show an intention to target the Complainant or its competitors, as the links displayed on the website published at the disputed domain name are mainly related to real estate, development and leasing of commercial spaces, and not to the Complainant’s trademark and products.

On the contrary, the Respondent has satisfied the Panel that it registered the disputed domain name for its inherent value as a domain name incorporating a common descriptive term, as part of its business as an investor in such domain names.

The Panel also finds that, in view of the circumstances of the case, in particular the common and descriptive nature of the term incorporated in the disputed domain name, the Respondent’s offer for sale of the disputed domain name does not demonstrate that it registered and is using the disputed domain name in bad faith, *i.e.*, with a view to selling it to the Complainant.

Therefore, the Panel finds that the Complainant has failed to demonstrate that the Respondent registered and used the disputed domain name in bad faith.

6.3. Reverse Domain Name Hijacking

Paragraph 15(e) of the Rules provides that, if “after considering the submissions the Panel finds that the complaint was brought in bad faith, for example in an attempt at Reverse Domain Name Hijacking or was

brought primarily to harass the domain-name holder, the Panel shall declare in its decision that the complaint was brought in bad faith and constitutes an abuse of the administrative proceeding”.

The Rules define Reverse Domain Name Hijacking as “using the Policy in bad faith to attempt to deprive a registered domain-name holder of a domain name”. The Panel also bears in mind that the Complainant in this case is represented by counsel and, therefore, it should be held to a higher standard (see section 4.16 of the WIPO Overview 3.0).

The Panel concludes that the Complainant’s actions constitute Reverse Domain Name Hijacking for the following reasons:

i) the Complainant, which is represented by counsel and already lost a prior case with similar circumstances (*Majid Al Futtaim Properties LLC v. Solidere*, WIPO Case No. D2018-0004, concerning <beirutcitycenter.com>), should have appreciated the difficulties in its case and the fact that the term “city centre” encompassed in the disputed domain name cannot be exclusively referable to the Complainant, as claimed in the Complaint, without any supporting evidence;

ii) the Complainant’s case is based on the argument that using a common/descriptive domain name in connection with a pay-per-click website and offering it for sale to the highest bidder, independently of any awareness of the Complainant, is of itself evidence of bad faith. The Panel finds that the Complainant should have known that it could not succeed with such an argument. Indeed, the Complainant appears to unreasonably ignore Policy precedents, not to mention the panel’s holding in *Majid Al Futtaim Properties LLC v. Solidere, supra*, that “The expression ‘city centre’ is plainly a descriptive term which can have an extremely wide range of references that have nothing to do with the Complainant”.

7. Decision

For the foregoing reasons, the Complaint is denied and the Panel declares that the Complaint was brought in bad faith in an attempt at Reverse Domain Name Hijacking.

Luca Barbero
Presiding Panelist

Richard G. Lyon
Panelist

Nick J. Gardner
Panelist
Date: April 30, 2021