

## **ADMINISTRATIVE PANEL DECISION**

McD Asia Pacific LLC v. Jacob Backman  
Case No. DAU2025-0001

### **1. The Parties**

The Complainant is McD Asia Pacific LLC, United States of America, represented by Spruson & Ferguson Lawyers, Australia.

The Respondent is Jacob Backman, Australia.

### **2. The Domain Name(s) and Registrar(s)**

The disputed domain name <mcdonaldsparties.com.au> is registered with GoDaddy.com, LLC.

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on January 8, 2025. On January 8, 2025, the Center transmitted by email to GoDaddy.com, LLC, a request for registrar verification in connection with the disputed domain name. On January 8, 2025, GoDaddy.com, LLC, transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Complainant filed an amendment to the Complaint on January 17, 2025.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the .au Dispute Resolution Policy (the “Policy” or “.auDRP”), the Rules for .au Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for .au Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on January 21, 2025. In accordance with the Rules, paragraph 5(a), the due date for Response was February 10, 2025. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on February 12, 2025.

The Center appointed Andrew F. Christie as the sole panelist in this matter on February 18, 2025. 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**

The Complainant is the owner of various Australian trade mark registrations for or incorporating the word “McDonald’s”, including Australian Trade Mark No. 305956 (registered from March 31, 1997) for the word trade mark MCDONALD’S, Australian Trade Mark No. 218291 (registered from April 5, 1968) for the word trade mark MCDONALD’S GOLDEN ARCHES, and Australian Trade Mark No. 305948 (registered from March 31, 1977) for the figurative trade mark consisting of two arches forming a stylized letter “M” and the word “McDonald’s” independent of color (the “Arches figurative trade mark”). The Complainant’s trade marks are used in Australia by its related entity and authorized user, McDonald’s Australia Limited.

The Complainant has provided evidence that disputed domain name was held by McDonald’s Australia Limited from March 23, 2009, to March 23, 2022, after which it inadvertently expired. During the time the disputed domain name was held by McDonald’s Australia Limited, it was used for customers of McDonald’s restaurants in Australia to book parties, including birthday parties, at McDonald’s restaurants.

The Complainant says the disputed domain name was registered by the Respondent on or about April 2022, and the Registrar confirmed the Respondent has been the registrant of the disputed domain name since at least November 29, 2023. The Complainant provided a screenshot, said to be taken on March 6, 2024, showing that disputed domain name resolved to a webpage containing the Complainant’s Arches figurative trade mark in gold and the words “Something is coming soon, and Hungry Jack’s will be taking over.” As at the date of this Decision, the disputed domain name resolves to a webpage containing the words “chinken nunget mmm yummy”.

On March 6, 2024, the Complainant’s Australian lawyers sent a cease and desist letter to the Respondent.

#### **5. Parties’ Contentions**

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

The Complainant contends that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights on the following grounds, among others. The disputed domain name incorporates the entirety of the Complainant’s registered word trade mark MCDONALD’S. The inclusion of the country code Top-Level Domain (“ccTLD”) “.au” and the second-level domain (“2LD”) “.com”, does not distinguish the disputed domain name from the Complainant’s trade mark. Further, the addition of the descriptive word “parties” does not serve to distinguish the disputed domain name from the Complainant’s trade mark.

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name on the following grounds, among others. The disputed domain name appears to have been registered by the Respondent well after the Complainant’s MCDONALD’S trade mark was first registered in Australia. The Respondent does not have any rights nor legitimate interests in the disputed domain name. Nothing in the WhoIs information of the Respondent demonstrates that the Respondent is commonly known by the disputed domain name. The Respondent cannot be commonly known by the disputed domain name because the Complainant has not authorized the Respondent to use its MCDONALD’S trade mark with respect to the disputed domain name. The Respondent is not licensed or authorized to use the Complainant’s MCDONALD’S trade mark in relation to the disputed domain name or otherwise. The Respondent did not have any registered business name, company name, or Australian trade mark application or registration for MCDONALD’S PARTIES to meet the eligibility requirements for the disputed domain name. The Respondent is not making a legitimate noncommercial or fair use of the disputed domain name. Instead, the Respondent has published on the landing page of the disputed domain name a reproduction of the Complainant’s famous Arches figurative trade mark with a taunting message, namely a competitor restaurant “[...] Hungry Jack’s will be taking over.”

The Complainant contends that the Respondent registered or has used the disputed domain name in bad faith on the following grounds, among others. The Respondent is not an authorized user of the

Complainant's MCDONALD'S trade mark and the Complainant has not authorized the registration and/or use of the disputed domain name. The Respondent's continued holding of the disputed domain name after the cease and desist letter, and its refusal to comply with the Complainant's express request for transfer of the disputed domain name, is evidence of bad faith conduct. The deliberate reference to a competing restaurant brand on the webpage to which the disputed domain name resolved also clearly demonstrates registration and/or use in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

### **A. Identical or Confusingly Similar**

Once the 2LD and the ccTLD are ignored (which is appropriate in this case), the disputed domain name consists of the Complainant's registered word trade mark MCDONALD'S (minus the apostrophe) followed by the word "parties". The Complainant's trade mark is clearly recognizable in the disputed domain name. The addition of the word "parties" does not prevent a finding of confusing similarity of the disputed domain name with the Complainant's trade mark.

Accordingly, the Panel finds that the disputed domain name is confusingly similar to a trade mark in which the Complainant has rights.

### **B. Rights or Legitimate Interests**

The Respondent is not a licensee of the Complainant, is not otherwise affiliated with the Complainant, and has not been authorized by the Complainant to use its MCDONALD'S trade mark. The Respondent has not provided any evidence that it has been commonly known by, or has made a bona fide use of, the disputed domain name, or that it has, for any other reason, rights or legitimate interests in the disputed domain name. The evidence provided by the Complainant shows that the disputed domain name has been used to resolve to a webpage that contains a reproduction of the Complainant's Arches figurative trade mark and a message referring to a competitor of the Complainant. Given the confusing similarity of the disputed domain name to the Complainant's trade mark, the absence of any relationship between the Respondent and the Complainant, and the risk of implied false affiliation with the Complainant, the Respondent's use of the disputed domain name is neither a bona fide use nor a legitimate noncommercial or fair use.

The Complainant has put forward a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name, and the Respondent has not rebutted this. Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name.

### **C. Registered or Subsequently Used in Bad Faith**

The disputed domain name was registered many decades after the Complainant registered its MCDONALD'S word trade mark. It is inconceivable that the Respondent registered the disputed domain ignorant of the existence of the Complainant's trade mark, given the fame of the Complainant's trade mark, the use of the Complainant's figurative mark on the website resolving from the disputed domain name, and that the disputed domain name consists of the Complainant's trade mark with the addition of the word "parties", an activity associated with the Complainant. Given the Respondent's lack of rights or legitimate interests in the disputed domain name and the confusing similarity of the disputed domain name to the Complainant's trade mark, any use of the disputed domain name by the Respondent almost certainly implies an affiliation with the Complainant that does not exist. The Respondent's registration of the disputed domain name in these circumstances is a bad faith registration.

Furthermore, the evidence on the record provided by the Complainant indicates that the Respondent has used the disputed domain name in an attempt to attract Internet users to a webpage at which a confusing reference is made to a competitor of the Complainant. The Respondent's use of the disputed domain name in this manner is a bad faith use.

Accordingly, the Panel finds that the disputed domain name has been registered and is being used in bad faith.

## **7. Decision**

For all the foregoing reasons, in accordance with Paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the domain name <mcdonaldsparties.com.au> be transferred to the Complainant.

*/Andrew F. Christie/*

**Andrew F. Christie**

Sole Panelist

Date: March 4, 2025