

ADMINISTRATIVE PANEL DECISION

Majid Al Futtaim Properties LLC v. Ayman Bajnaid
Case No. D2022-4130

1. The Parties

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

The Respondent is Ayman Bajnaid, South Africa.

2. The Domain Name and Registrar

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

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 2, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. Also on November 2, 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 and contact information in the Complaint.

The Center sent an email communication to the Complainant on November 4, 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 November 8, 2022.

The Center verified that the Complaint and 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 9, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 29, 2022. The Response was filed with the Center on November 12, 2022.

The Center appointed John Swinson as the sole panelist in this matter on November 17, 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

The Complainant is a company registered in Dubai. The Complainant was established in 1994. The Complainant is a subsidiary of Majid Al Futtaim Holding LLC that owns and operates shopping malls, retail, and leisure establishments in the Middle East, Africa and Asia.

According to the Complaint, the Complainant is a developer of shopping malls together with hotels and mixed-use community projects in the Middle East and North Africa, and that it owns and operates 29 shopping malls, 13 hotels and five mixed-use communities, with further developments underway in the region. The shopping malls portfolio includes Mall of the Emirates, Mall of Egypt, Mall of Oman, City Centre malls, My City Centre neighborhood centers, “and five community malls (Matajer), which are in joint venture with the Government of Sharjah”.

The Complainant commenced use of its MATAJER brand in connection with the operation of the Complainant’s “Matajer Al Quoz” mall which opened in October 2011, followed by Matajer Al Juraina, Matajer Al Khan and Matajer Al Mirgab in 2012 in residential and academic areas of Sharjah. The Complainant has a website located at “www.matajersharjah.com” for the Complainant’s Matajer shopping malls. The Complainant registered <matajersharjah.com> in 2016.

The Complainant and its joint venture “Sharjah Holding Co. PJSC” own trademark registrations which the Complainant describes as MATAJER AL RAHMANIVA – in English and Arabic letters and MATAKER AL MUSALLA - in English and Arabic letters. Sharjah Holding Co. PJSC also owns trademark registrations for a device that includes many colourful interlocking rectangles and the word “Matajer” and a word in Arabic. An example is a United Arab Emirates trademark MATAJER, registration number 158961 filed on June 23, 2011 and registered on January 3, 2012.

The Respondent is an individual who is a resident of South Africa.

The disputed domain name was registered on January 5, 2006.

The disputed domain name does not resolve to an active website.

5. Parties’ Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The Complainant commenced use of “Matajer” in 2011 in connection with a shopping mall.

The Complainant claimed: “Since the first Matajer opened in 2011, the focus has been on providing convenience and premium shopping experiences to surrounding residents.”

The Complainant’s extensive and continuous use of the MATAJER trademarks, and the fact that the Complainant has made significant investments over the years to promote and protect these trademarks and the Complainant’s business across the Internet, demonstrate that the Complainant enjoys a substantial degree of public recognition in MATAJER” brand and has seen this trademark become uniquely and distinctly associated with the Complainant.

The Complainant has a substantial social media presence.

The Complainant has common law trademark rights in MATAJER.

The disputed domain name is identical to the Complainant's common law MATAJER trademark and confusingly similar to the Complainant's registered MATAJER AL RAHMANIVA and MATAJER AL MUSALLA trademarks, as it incorporates the dominant element of such trademarks in its entirety.

There is no evidence that the Respondent owns any trademark rights or registrations that are identical, similar, or in any way related to the disputed domain name. The Complainant has never authorized or licensed the Respondent to use its trademark MATAJER. The Respondent is not affiliated with the Complainant in any way. The Respondent has no prior rights or legitimate interests in the disputed domain name. The disputed domain name does not resolve to an active website and accordingly there is no *bona fide* use of the disputed domain name. The Respondent is not commonly known in the market by the disputed domain name.

The Complainant's brand MATAJER gained protection almost 9 years preceding the Respondent's renewal of the disputed domain name at issue coupled with masking the Respondent's identity on November 22, 2020.

There is no believable or realistic reason for registration or use of the disputed domain name other than to take advantage of the Complainant rights.

Given the global fame of the Complainant's MATAJER brands, there is no conceivable use to which the disputed domain name could be put now, or in the future, that would confer any legitimate interest upon the Respondent, given the confusing similarity of the disputed domain name to the Complainant's trademark.

Registering the disputed domain name incorporating the Complainant's trademark was merely to create a connection to the Complainant and to take unfair advantage of the Complainant's MATAJER trademark, and hence, mislead users of the disputed domain name.

There can simply be no question that the Respondent was well aware of the Complainant, its trademark and the Complainant's exclusive rights in that trademark, and the reputation of that trademark when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally registered the disputed domain name to misappropriate and exploit the reputation inherent in the Complainant's trademark to the Complainant's detriment through deliberately causing confusion with that trademark and by doing so diverting Internet users.

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.

Whois records suggest that the ownership of the disputed domain name has been acquired by the Respondent on October 27, 2008.

The Respondent concealed his identity using a privacy service on December 11, 2020. Employing a privacy or proxy service by the Respondent after the Complainant has gained protection for its MATAJER trademark in 2011 confirms the Respondent's bad faith registration of the disputed domain name.

The Respondent's renewal of the disputed domain name accompanied with masking his identity supports the Respondent's bad faith registration of the disputed domain name.

The Respondent has not used the disputed domain name. Such passive holding amounts to bad faith registration and use, as there is no evidence of actual or contemplated good faith use of the disputed domain name and, in light of the Complainant's trademark rights and business activities, any use of the disputed domain name will inevitably cause consumer confusion and infringement of the Complainant's trademark.

The fact that the disputed domain name does not resolve to a website and is being passively held does not obviate a finding of bad faith.

Since the Respondent has made no active use of the disputed domain name, the Respondent's purpose was not only to block the Complainant from registering the disputed domain name itself but also, to use the disputed domain name to disrupt the business of the Complainant.

The Complainant's MATAJER trademarks are well known throughout the world and in the Middle East where the Respondent has its address. The disputed domain name incorporates the entirety in the Complainant's MATAJER trademarks, which demonstrates that the Respondent must have been aware of the existence of the Complainant's brand MATAJER.

The Respondent's registration of the disputed domain name was solely done to lure and mislead people, using a well-known trademark for the Respondent's commercial benefit by diverting internet users to its website. It is obvious that the Respondent acted in bad faith.

Bad faith can also be inferred based on the fame of the Complainant's MATAJER trademark, such that the Respondent was aware or should have been aware of the Complainant's mark and claims of rights thereto.

B. Respondent

In summary, the Respondent makes the following submissions:

Matajer refers to the Arabic word "ماتجر" which means "shops" in Arabic. This word can be written in different ways in English such as matajer, matajir or matager. Matajer is a generic abbreviation, therefore, the Complainant cannot claim exclusivity in this term.

The disputed domain name was registered long before the registration of the Complainant's trademarks. The Complainant admitted that the disputed domain name was registered in 2006 and that the Complainant has been using its trademarks since 2011. It is well-settled that the Complainant is required to show bad faith registration and use. The Complainant has failed to demonstrate that the domain was registered in bad faith.

The Respondent is an original registrant of the disputed domain since January 2006 and has owned the disputed domain name for 16 years.

The Respondent did not have knowledge of the Complainant prior to the Complainant contacting the Registrar and demanding the transfer of the disputed domain name.

The Respondent did not register the disputed domain name for the purpose of preventing "the owner of the trademark or service mark from reflecting the mark in a corresponding domain name", because the Respondent believed that the word "Matajer" is generic, and no one has exclusive right to this word.

If the Complainant truly believed that the disputed domain name was being used in conflict with its trademark rights, the Complainant would have acted long ago. Therefore, the Panel may consider the doctrine of laches as an additional factor in favour of the Respondent.

The Complainant had no *bona fide* basis for commencing this proceeding under the UDRP, and is culpable for reverse domain name hijacking.

The Complainant must have known prior to the filing the Complaint that its registered trademarks would provide no rights to a domain name that has been used by the Respondent in connection with a *bona fide* offering of services. Moreover, the Complainant had to be aware that the generic word would not have protection under UDRP.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (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 *onus* of proving each of these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the 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.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

The Complainant has provided evidence of registered trademark rights in MATAJER AL RAHMANIVA – in English and Arabic letters, and MATAJER AL MUSALLA - in English and Arabic letters. The Complainant has also provided evidence of common law use of “Matajer”, although in many cases this common law use cited by the Complainant was of “Matajer” in combination with another term, such as “Matajer Shahjar”. The Complainant provided registration certificates for trademark registrations owned by Sharjah Holding Co. PJSC, a joint venture in which the Complaint is a member, but does not appear to rely upon such registrations in the Complainant’s arguments. All such trademark registrations were filed in 2011 or in the years after.

In relation to common law rights, the Complainant referred to a Wikipedia entry for “Matajer Malls” which states in part:

“Matajer, meaning ‘shops’ in Arabic, is a neighborhood shopping centre concept located in Sharjah, United Arab Emirates, developed by Sharjah Holding through a strategic partnership between the Government of Sharjah and Majid Al Futtaim Properties. The first Matajer mall, Matajer Al Quoz, opened in October 2011 followed by three other branches, Al Juraina, Al Khan and Al Mirgab in 2012. Matajer malls recorded an annual footfall of over ten million across the four centres in 2012. Each Matajer location has a Gross Leasable Area (GLA) of between approximately 20,000 and 80,000 square feet.”

Questions arise. The first is whether the disputed domain name is confusingly similar to “Matajer Al Rahmaniya” (and other similar registered trademarks owned by the Complainant). The second is whether the Complainant has common law trademark rights in respect of “Matajer” alone (as asserted by the Complainant) or whether such common law rights are in terms such as “Matajer Shahjar” (in if so, whether the disputed domain name is confusingly similar to “Matajer Shahjar”).

In view of the Panel’s decision in respect of the third element of the Policy, the Panel does not need to decide these issues.

B. Rights or Legitimate Interests

In view of the Panel’s decision in respect of the third element of the Policy, the Panel does not need to decide whether the Complainant succeeds on the second element of the Policy.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent registered and subsequently used the disputed domain name in bad faith.

The fundamental problem confronting the Complainant is that the Respondent registered the disputed domain name more than 3 years before (on the best case for the Complainant) the Complainant began using or had any rights in the Complainant's trademarks. At the time of registration of the disputed domain name, the Respondent simply could not have known about the Complainant let alone been targeting it. *Candy Cloud IP LLC v. Mike Morgan*, WIPO Case No. [D2022-3368](#).

The Complainant attempts to overcome this difficulty by asserting that the Respondent renewed the disputed domain name after the Complainant obtained trademark rights. However, the time to look at whether the disputed domain name was registered in bad faith is when the Respondent registered or acquired the disputed domain name, not at the time of a subsequent renewal of the disputed domain name.

The Complainant also asserts that the Respondent started using a privacy service in 2020. This is irrelevant to the issue of whether the Respondent registered the disputed domain name in bad faith in 2006.

The Complainant cannot show that the Respondent was aware of the Complainant or its trademark in 2006 and registered the disputed domain name in 2006 with the intent to take advantage of the trademark value or significance of the Complainant's trademark. The Complainant had no trademark rights in respect of "Matajer" in 2006.

The Respondent could not have selected "Matajer" in 2006 to target the Complainant because there is no evidence that the Complainant had trademark rights in "Matajer" until years later. *Inversiones MCN S.A.S. v. Domains By Proxy, LLC DomainsByProxy.com / Tamarak Marketing, Tamarak Capital*, WIPO Case No. [D2022-3219](#).

Further, there is evidence to support the Respondent's good faith. As the Complainant's evidence shows, "Matajer" is a term which means "shops" in Arabic. The Respondent asserts, and the Panel believes, that the Respondent registered the disputed domain name (not knowing of the Complainant) because the disputed domain name is a term that means "shops" in Arabic and thus has intrinsic value as a domain name.

The Complainant clearly fails on the third element of the Policy because the Complainant cannot show that the Respondent registered the disputed domain name in bad faith.

The Complainant also fails to demonstrate that the Respondent used the disputed domain name in bad faith. The Respondent is not using, and there is no evidence that the Respondent has ever used, the disputed domain name. In an attempt to overcome this difficulty, the Complainant relies on the passive holding doctrine that was established in *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

In the *Nuclear Marshmallows* case, the complainant's trademark was one of the most famous in Australia, the complainant provided substantial evidence of its reputation in Australia, the respondent had an Australian address and was likely aware of the complainant, and the respondent used a fake name to conceal his or her identity.

The Complainant in the present case has not provided evidence to establish that the Respondent registered the disputed domain name because of the Complainant, the term "Matajer" is not famous but a term in Arabic meaning "shops", the Respondent is located in South Africa (where the Complainant does not have shopping malls), and there is no evidence that the Respondent is likely aware of the Complainant. Thus, there is not passive holding under the test set out in the *Telstra* case sufficient to establish bad faith use. See, for example, *Kelin S.r.l. v. Privacy Service provided by Withheld for Privacy ehf / Vincent Cammarata*,

WIPO Case No. [D2022-0746](#); and *Cheyne Capital Holdings Limited v. Sheri Kempe, cheynegroup*, WIPO Case No. [D2022-2070](#).

The Complainant fails on the third element of the Policy.

D. Reverse Domain Name Hijacking (RDNH)

The Respondent has sought a finding of Reverse Domain Name Hijacking.

Paragraph 15(e) of the Rules provides, in part:

“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.”

Paragraph 1 of the Rules defines “Reverse Domain Name Hijacking” to be “using the Policy in bad faith to attempt to deprive a registered domain name holder of a domain name”.

The fact that a complaint has failed is not in itself sufficient to warrant a finding of reverse domain name hijacking.

In the present case, however, the disputed domain name was registered by the Respondent years before the Complainant’s rights accrued. The Complainant has attempted to circumvent that fundamental problem with feeble arguments regarding events that took place more than 10 years after the date of registration and that have no bearing on whether registration was in bad faith.

The Complaint was always doomed to fail.

Additionally, the Complainant seriously overstates its case in many respects. For example, the Complaint states:

“There can simply be no question that the Respondent was well aware of the Complainant, its Mark and the Complainant’s exclusive rights in that mark, and the reputation of that Mark when the Respondent registered the disputed domain name. Yet, in spite of that knowledge, the Respondent intentionally registered the disputed domain name to misappropriate and exploit the reputation inherent in the Complainant’s Mark to the Complainant’s detriment through deliberately causing confusion with that mark and by doing so diverting Internet users to this site.”

This statement is completely false and is not supported by and is contrary to all the evidence. Further, this paragraph argues that the Respondent attempted to cause confusion by diverting the disputed domain name to the Respondent’s website. However, the disputed domain name does not divert to any website, as the Complaint later acknowledges.

The Complainant is represented by trademark and domain name specialist lawyers who ignored well-known and relevant UDRP decisions and filed a Complaint that should never have been filed.

It is wrong and an abuse of process that the Respondent be forced to spend time and effort preparing his Response to this Complaint.

In these circumstances, the Panel considers that a finding of reverse domain name hijacking is entirely appropriate and declares that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding.

7. Decision

For the foregoing reasons, the Complaint is denied.

/John Swinson/

John Swinson

Sole Panelist

Date: December 1, 2022

Addendum to Administrative Panel Decision

This is an Addendum to the Administrative Panel Decision (“Decision”) dated December 1, 2022, with regard to the disputed domain name <matajer.net>.

In light of the panel’s decision in *Majid Al Futtaim Properties LLC v. Ayman Bajnaid*, WIPO Case No. [D2022-4129](#), involving the same Parties and concerning the domain name <matajer.com>, it has come to the Panel’s attention that the Respondent’s country was incorrectly identified in its decision in *Majid Al Futtaim Properties LLC v. Ayman Bajnaid*, WIPO Case No. [D2022-4130](#), wherein the Respondent country was identified as “South Africa”.

Accordingly, the Panel hereby amends its above-referenced decision to reflect the Respondent country as, “Saudi Arabia”.

Further to the Panel’s analysis on page 6 of its decision, reflecting that “the term ‘Matajer’ is not famous but a term in Arabic meaning ‘shops’, the Respondent is located in South Africa (where the Complainant does not have shopping malls), and there is no evidence that the Respondent is likely aware of the Complainant”, the Panel hereby amends the language to reflect, “the term ‘Matajer’ is not famous but a term in Arabic meaning ‘shops’, the Respondent is located in Saudi Arabia (where there is no evidence that the Complainant was operating shopping malls at the time of the registration of the disputed domain name), and there is no evidence that the Respondent is likely aware of the Complainant”.

The Panel takes note that the panel in *Majid Al Futtaim Properties LLC v. Ayman Bajnaid*, WIPO Case No. [D2022-4129](#), has similarly upheld the Respondent’s lack of awareness and targeting of the Complainant, given the lack of the Complainant’s rights at the time of the registration of the disputed domain name. Therefore, the Panel reaffirms its Decision, in particular its order that the Complaint be denied.

/John Swinson/

John Swinson

Sole Panelist

Date: January 5, 2023