

SINGAPORE DOMAIN NAME DISPUTE RESOLUTION SERVICE

Administrative Panel Decision

Case No. SDRP-2008/0003(F)

McDonald's Corporation v Website Development

1. The Parties

- 1.1 The Complainant, McDonald's Corporation, is a corporation duly organised under the laws of the State of Delaware, USA, whose principal place of business is at One McDonald's Plaza, Oak Brook, Illinois 60523, USA.
- 1.2 The Respondent, Website Development (Reg. No. 53059380K), is a sole proprietorship of Yeo Zhiguang, registered in Singapore, whose registered address is at 457 Clementi Avenue 3, #09-580, Singapore 120457.

2. The Domain Name and Registrar

- 2.1 The domain names in issue are "macdonalds.com.sg" ("Domain Name 1"), "macdonald.com.sg" ("Domain Name 2") and "mcdonald.com.sg" ("Domain Name 3") (collectively, the "Domain Names").
- 2.2 The Registrar of the Domain Names is Vooju Pte Ltd of 14 Robinson Road, #11-02B, Far East Finance Building, Singapore 048545, an accredited registrar authorised by Singapore Network Information Centre (SGNIC) Pte Ltd ("SGNIC") of 8 Temasek Boulevard, #14-00 Suntec Tower Three, Singapore 038988.

3. Procedural History

- 3.1 The Complainant submitted its complaint ("the Complaint") pursuant to the Singapore Domain Name Dispute Resolution Policy ("the Policy"), the Rules of the Singapore Domain Name Dispute Resolution Policy ("the Rules") and the Supplemental Rules of the Singapore Domain Name Dispute Resolution Policy ("the Supplemental Rules").
- 3.2 The Secretariat for the Singapore Domain Name Dispute Resolution Service ("the Secretariat") received the Complaint dated 11 August 2008 in hard copy on 11 August 2008 and by e-mail on 12 August 2008. After checking the Complaint for compliance with formalities requirements, the Secretariat forwarded the Complaint, together with the prescribed Complaint Notification Instructions to the Respondent in hard copy on 14 August 2008.
- 3.3 On 12 September 2008, the Secretariat notified both the Complainant and the Respondent (collectively "the Parties") of the appointment of Mr. Jim Lim as the sole panellist on the Administrative Panel ("the Panel") to decide the dispute between the Parties over the Domain Names, after the said Mr. Jim Lim had signed the Statement of Acceptance and Declaration of Impartiality and Independence. The Panel received a hard copy of the Complaint on 11 September 2008 and copies of the Complaint and the Response from the Secretariat by email on 12 September 2008.

4. Factual Background

4.1 The Complainant states that:

- 4.1.1 It is the owner of the registration rights and goodwill in the marks "McDonald's", "Ronald McDonald", "McDonaldLand" and "McDonald's & Corporate Logo", as well as other marks incorporating the word "McDonald's" (collectively the "McDonald's Marks") in respect of a wide range of goods and services in Singapore and throughout the world, including, but not limited to,

prepared foods such as hamburgers, cheeseburgers, fish sandwiches and french fries, and restaurant services.

4.1.2 It is well known throughout the world and has used the McDonald's marks continuously and extensively on a wide range of goods and services. The Complainant has registered the McDonald's marks in, for instance, USA, Brazil, UK, France, Saudi Arabia, Australia, Japan, India, Thailand, Malaysia and Indonesia and also owns other international registrations.

4.1.3 It is also the registrant and owner of the domain name "mcdonalds.com", the same which was registered on 12 July 1994. The Complainant has also registered the domain name "mcdonalds" in many other jurisdictions besides the United States of America, for instance "mcdonalds.it" in Italy.

4.1.4 It owns the goodwill in Singapore and is the rightful proprietor of the McDonald's marks for a wide range of goods and services. The Complainant owns the registration of the McDonald's marks (both in English and in Chinese characters) in Singapore registered in classes 14, 16, 25, 28, 29, 30, 31, 32, 36 and 42 at the Registry of Trade Marks, Singapore. The Complainant commenced use of the McDonald's marks in Singapore in or around the year 1979. Details of the McDonald's marks and the good and/ or services for which they are registered and copies of the registration were furnished with the Complaint.

4.1.5 It is also the registrant and owner of the domain name "mcdonalds.com.sg" in Singapore. The Complainant was awarded the domain name "mcdonalds.com.sg" in an administrative action under the Policy. See *McDonald's Corporation v Naturerise, Inc* (Case Number SDRP-2005/0001(F)) decided on 25 February 2005. With the Complainant's consent, the Complainant's subsidiary in Singapore, McDonald's Restaurants Pte Ltd ("McDonald's Singapore") became the registrant of the domain name "mcdonalds.com.sg" and that domain name has been used by McDonald's Singapore for its corporate website since 1 April 2005. The Complainant furnished a copy of a WHOIS search of "mcdonalds.com.sg".

4.1.6 Through numerous applications and registrations, extensive usage and advertisements worldwide, including in Singapore, the McDonald's marks have become distinctive of and are identified with the Complainant, in respect of goods and services originating from the Complainant, and no other. The Complainant has over the years built up substantial and valuable goodwill and reputation in the McDonald's marks.

4.1.7 Sample net sales of goods and services bearing the McDonald's marks by the Complainant, its affiliated companies and franchisees, both worldwide and in Singapore, are approximately as set out below:

Year	Worldwide (US\$'000)	Singapore (S\$'000)
2000	29,714,000	263,021
2001	29,590,000	259,364
2002	30,022,000	244,645
2003	33,129,000	238,269
2004	37,052,000	246,653
2005	38,913,000	254,111
2006	41,380,000	279,194
2007	46,943,000	310,220

4.1.8 Sample advertising and marketing expenses incurred in promoting and advertising the McDonald's marks by the Complainant and its affiliated companies, both worldwide and in Singapore, are approximately as set out below:

Year	Worldwide (US\$'000)	Singapore (S\$'000)
2000	595,300	13,102
2001	521,500	12,899
2002	532,300	10,602
2003	596,700	13,646
2004	610,200	11,713
2005	611,200	12,850
2006	669,800	12,406
2007	718,300	12,909

4.1.9 As a result of significant sales and advertisement carried out by the Complainant and its affiliated companies worldwide and in Singapore, the McDonald's marks are well-recognised global brands. As a result of the foregoing, the Complainant has very much enjoyed and still continues to enjoy considerable goodwill and reputation throughout the world including Singapore in connection with the McDonald's marks prior to and notwithstanding the registration by the Respondent of the domain name "macdonalds.com.sg" on 21 February 2007, the domain name "macdonald.com.sg" earlier on 6 January 2006, and "mcdonald.com.sg" also on 6 January 2006 (collectively, the "Domain Names"). The Complainant also has common law rights in the McDonald's marks in Singapore.

4.2 The Complainant states in respect of Domain Name 1:

4.2.1 On 16 May 2008, McDonald's Singapore became aware that Domain Name 1 was in use and this fact was brought to the attention of the Complainant on the same date. The Complainant was concerned as Domain Name 1 resolved to a website ("Website 1") that contained materials indicating a false connection or association to, or suggesting a false sponsorship or endorsement by, the Complainant.

4.2.2 Given the almost identical names of Domain Name 1, "macdonalds.com.sg", and McDonald's Singapore's official website, "mcdonalds.com.sg", an innate likelihood existed (which The Complainant submitted the Respondent would have been aware of) that users of Website 1 would be confused into believing that Website 1 was connected to or associated with the Complainant and/or McDonald's Singapore. It is notable that the Respondent did not take any step to differentiate Website 1 to prevent any unintended association and connection of Website 1 with the Complainant or McDonald's Singapore. Instead, as elaborated in paragraphs 4.2.3 to 4.2.4, below, the Respondent introduced features in Website 1 that actively encouraged such false association and connection.

4.2.3 The Complainant furnished copies of screen shots of the home page, the various web pages linked to the home page and selected pages of third party websites with hyperlinks to the web pages of Website 1, which the Complainant reviewed on 15 July 2008. From the screen shot of the home page of Website 1, it can be seen that:

- (a) The first sponsored listing reads "Ronald Mcdonald Find Deals, Read Reviews from Real People. Get the Truth. Then Go [emphasis added]". "Ronald McDonald" needs no introduction – it is the well-loved character and well-known trade mark belonging to the Complainant. The Respondent's objective is to suggest that Website 1 is sponsored by or associated with the Complainant.
- (b) Next, the 2nd and 3rd sponsored listings describe food and beverage-related listings. Together with the 5th listing (mentioned below), it seems clear that the choice of words for these listings is deliberate – i.e. to suggest a connection or association with the Complainant, who is of course a leading global F&B business entity.
- (c) The 5th sponsored listing reads "Fast Food Manufacturers Alibaba B2B online marketplace. Forbes Magazine Best of the Web [emphasis added]". The descriptive words

“Fast Food Manufacturers” appears once again to be an attempt to suggest a connection or association with the Complainant, a leading global fast food vendor.

- (d) The penultimate listing reads “McDonald’s Franchise Looking for McDonald’s Franchise? Visit Top Franchise Sites Here [emphasis added]”. The Complainant is of course the owner, operator and franchiser of the well-known fast food restaurant system known as “McDonald’s System”. The choice of words for this listing is clearly for the purpose of suggesting a connection or association with the Complainant.

4.2.4 On the right-hand side of the home page, there is an icon “Macdonalds” under the heading “Related Searches”. When clicked, the furnished screen shot shows a webpage containing, inter alia, the following listings:

- (a) “McDonald’s Franchise” – the content is as described above. Note the use of “McDonald’s” rather than “Macdonald’s”.
- (b) “Ronald McDonald” – the content is as described above. Again, note the use of “McDonald” rather than “Macdonald”.
- (c) “McDonald’s Corporation NYTimes.com presents news and a financial overview of this company [emphasis added]”. This is an undeniable reference to the Complainant. Why should the Complainant alone be featured and not some other top multi-national corporation? The answer must be to create an illusion that Website 1 is sponsored or connected to the Complainant.
- (d) “Food & Drink Industry” – the content is as described above.
- (e) “ “Hamburgers in Charlotte” Hamburger Restaurants Charlotte NC... [emphasis added]”. The Complainant is internationally known for their hamburger products. The question, why list “hamburgers” and not some other product, is a question susceptible to a simple answer – to create an illusion that the Website is related to or endorsed by the Complainant.
- (f) “Food Industry Recruiting” – the content is as described above.

It is noted that the word “McDonald” or “McDonald’s” is used repeatedly in this webpage. The reference to “McDonald’s Corporation” taken together with the references to the food and drink industry, to hamburgers and to “McDonald’s Franchising”, cannot be coincidental. The Complainant submitted that the whole flavour of the page is intended to suggest a connection between Website 1 and the Complainant and/or McDonald’s Singapore or a sponsorship or endorsement of Website 1 by the Complainant and/or McDonald’s Singapore.

4.2.5 Some contents on Website 1, by reason of the association of Website 1 with the Complainant, are harmful to the extremely valuable intellectual property rights which the Complainant has in the McDonalds marks. For instance, Website 1 contains listing for a multitude of subject matters which have nothing to do with the Complainant, such as shopping websites, hotel reservation websites, job recruitment websites and airline ticketing websites. The Complainant objects to Website 1’s association of all these diverse activities with the Complainant. Such associations can only dilute and damage the goodwill that the Complainant has in its name and in the McDonald’s marks.

4.2.6 The Complainant furnished a copy of a WHOIS search report for a search conducted on Domain Name 1 on 16 May 2008.

4.2.7 Upon enquiries being made by the Complainant’s solicitors, M/s Mallal & Namazie (“M&N”), with SGNIC by email dated 25 June 2008, the name of an individual “Yeo Zhiguang” was provided by the registrar Vooju Pte Ltd in an email dated 30 June 2008.

- 4.2.8 M&N conducted a BizFile search on the Respondent which disclosed that the Respondent is a sole proprietorship owned by one “Yeo Zhiguang”. The principal activity of the Respondent as listed on the BizFile search is “Development of E-Commerce Applications”. The place of business of the Respondent, 457 Clementi Avenue 3 #09-580 Singapore 120457, appears to be the address of an HDB residential unit.
- 4.3 The Complainant states in respect of Domain Name 2 and Domain Name 3:
- 4.3.1 On 28 July 2008, McDonald’s Singapore became aware that Domain Name 2 and Domain Name 3 were in use and this fact was brought to the attention of the Complainant on 31 July 2008. Domain Name 2 resolved to an active website (“Website 2”). The Complainant furnished screen shots of the home page and the various web pages linked to the home page of Website 2, which the Complainant reviewed on 5 August 2008. It can be seen that Website 2 contains a listing of shopping, hotel, air-ticketing, travel and employment websites, including several referring to the name “Macdonald”.
- 4.3.2 Domain Name 3 also resolved to an active website (“Website 3”). The Complainant furnished screen shots of the home page and the various web pages linked to the home page of Website 3, which the Complainant reviewed also on 5 August 2008. It can be seen that Website 3 contains a listing of consumer-related websites relating to job searches, music downloads, classifieds, food delivery, movie downloads, ringtone downloads, etc, most of which concern entities apparently based in the United States.
- 4.3.3 The Complainant notes that Website 3 contains a webpage entitled “Win Money” which connects to a list of internet gambling sites. The Complainant espouses traditional family values and does not wish to be associated with gambling, whether internet or otherwise. The hyperlinks have caused and are causing reputational damage to the Complainant.
- 4.3.4 Further, the Complainant objects to Websites 2 and 3’s association of all the diverse activities featured therein with the Complainant’s name. Such associations can only damage and/or dilute the goodwill that the Complainant has in its name and in the McDonald’s marks.
- 4.3.5 The Complainant furnished copies of WHOIS search reports for searches conducted on Domain Names 2 and 3 conducted on 30 July 2008.

5. The Parties’ Contentions

5.1 The Complainant

Paragraph 4(a)(i), Policy

- 5.1.1 The Complainant contends that the Domain Names are identical or confusingly similar to the McDonald’s marks in which the Complainant has rights (as indicated above at paragraphs 4.1.1 to 4.1.9, above). The third level domain name “mcdonald”, as used in Domain Name 3, is identical with “McDonald’s” as used by the Complainant in its name and in its marks. The third level domain names “macdonalds” and “macdonald”, as used in Domain Names 1 and 2 respectively, are identical with “McDonald’s” as used by the Complainant in its name and in its marks, save for the inclusion of the alphabet “a” in the prefix “mac” in the cases of Domain Names 1 and 2. Phonetically, there is no difference in the pronunciation of “macdonalds”, “macdonald” and “mcdonald” on the one hand and “McDonald’s” on the other. Linguistically, the word “McDonald” is a Scottish surname meaning “son of Donald” and “MacDonald” is an alternative surname spelling for “McDonald”. The Complainant furnished the surname search conducted on the website “www.about.com”. For all intents and purposes, the words “macdonalds”, “macdonald” and “mcdonald” on the one hand and “McDonald’s” on the other hand, are identical. They are, in any event, confusingly similar.

- 5.1.2 The word mark “McDonald’s” has been protected as a registered trade mark in Singapore since 2 July 1969: The Complainant furnished Certificates of Registration of various trade marks of the Complainant. The third level domain names “macdonalds”, “macdonald” and “mcdonald”, as used in the Domain Names, are virtually identical and/or confusingly similar with the word mark “McDonald’s”, which the Complainant has registered in Classes 14, 16, 25, 28, 29, 30, 31, 32, 36 and 42 in Singapore. Some instances are as follows: They are confusingly similar to the word mark “McDonald’s” which the Complainant has registered in Classes 14, 28, 29, 30, 32 and 42 in Singapore. They are confusingly similar to the “McDonald’s and Corporate Logo” mark, which the Complainant has registered in Classes 14, 16, 25, 28, 29, 30, 31, 32, 42 in Singapore. They are confusingly similar to the word mark “McDonaldland” which the Complainant has registered in Classes 28 and 42 in Singapore. They are confusingly similar to the word mark “Ronald McDonald” which the Complainant has registered in Class 14 in Singapore. They are also confusingly similar to the “Ronald McDonald and Clown Figure” mark which the Complainant has registered in Classes 16, 25, 28, 29, 30 and 42 in Singapore.
- 5.1.3 It is also worth noting that as the McDonald’s marks are so well-known in Singapore, any consumer coming across the Domain Names will naturally assume it is owned by or affiliated to the Complainant. The Complainant furnished details of the registrations and specification of goods and/or services of the above marks.
- 5.1.4 Each of the Domain Names “macdonalds.com.sg”, “macdonald.com.sg” and “mcdonald.com.sg” also bears such a close resemblance to McDonald’s Singapore’s official website “mcdonalds.com.sg” that users of Websites 1, 2 and 3 (collectively, the “Websites”) (who are familiar with McDonald’s Singapore’s official website) are likely to mistakenly assume the Websites are connected to mcdonalds.com.sg and/or is affiliated to or sponsored or endorsed by McDonald’s Singapore or the Complainant. McDonald’s Singapore gets an average of 5 million hits per month on “mcdonalds.com.sg”. It is therefore a well-utilised website in Singapore.

5.2 *The Respondent*

- 5.2.1 The Respondent has on record acknowledged receipt of the Complaint but did not submit a response.

Paragraph 4(a)(ii), Policy

- 5.3 The Complainant contends that the Respondent has no right or legitimate interest in respect of the Domain Names as:
- (a) The Respondent is not authorised or licensed to use the Complainant’s name or the McDonald’s marks by the Complainant.
 - (b) The Respondent as an individual or business has never been known by the third level domain names “macdonalds”, “macdonald” or “mcdonald”.
 - (c) Given the undoubtedly well-known reputation of the Complainant and McDonald’s marks in Singapore, the Respondent must have registered the Domain Names when he had actual or constructive knowledge of the Complainant’s rights to the trade name “McDonald’s” and in the McDonald’s marks. The Complainant submitted that any use of the Domain Names by the Respondent can only be with knowledge of the Complainant’s prior rights to the trade name “McDonald’s” and in the McDonald’s marks.
 - (d) The Respondent can have no trademark or service mark rights or any common law rights over the Domain Names as any such right would be inconsistent with the prior rights the Complainant undoubtedly has in the McDonald’s marks.
 - (e) The Respondent is not using the Domain Names in connection with a bona fide offering of goods or services and/or not making a legitimate non-commercial or fair use of the

Domain Names. The Complainant submitted that the Respondent is making use of the Websites for commercial gain. And for the reasons stated in paragraphs 5.4, below, the Complainant submitted that the Respondent is not making a bona fide offering of goods or services or a legitimate or fair use in respect of the Websites.

Paragraph 4(a)(iii), Policy

5.4 The Complainant contends that the Domain Names have been registered and are being used by the Respondent in bad faith for the following reasons:

- (a) Given the undoubtedly well-known reputation of the Complainant's name and McDonald's marks in Singapore, which the Respondent is taken to be aware of, the Respondent's choice of the Domain Names, being identical or confusingly similar to the well-known name and mark of the Complainant is evidence of bad faith on the Respondent's part.
- (b) The Respondent's choice of the Domain Names is in breach of paragraph 9.1 of SGNIC's Registration Policies, Procedures and Guidelines ("RPPG") (to which the Respondent is bound) by which the Respondent represents and warrants that each of the Domain Names "*(a) does not infringe any registered trade mark nor will it give rise to an action in passing off ... (b) is not identical or confusingly similar with either a registered trademark, company or business name in Singapore*". It was held in *McDonald's Corporation v Naturerise, Inc* (Case No. SDRP-2005/0001(F)) that such a choice of a domain name which breaches the warranty/representation in the RPPG is evidence of bad faith on the part of the respondent.
- (c) The Respondent is making a bad-faith use of Domain Name 1. In paragraph 4.2 , above, the Complainant has set forth in detail the features of Website 1 which the Respondent has carefully crafted to create a false connection or association between Website 1 and the Complainant, or sponsorship or endorsement of Website 1 by the Complainant. The Complainant repeats those assertions here.
- (d) The Respondent is using the Websites to advertise a listing of goods and service providers. Such a business requires a strong brand name for the Websites to boost the number of hits on thereon. The Respondent has no reason to choose the third level domain names "macdonalds", "macdonald" and "mcdonald" for his websites, save to capitalise on their similarity to the name of the Complainant, the name of the Complainant's website "mcdonalds.com" and/or the name of McDonald's Singapore's website "mcdonalds.com.sg", so as to increase the internet traffic to his websites.

5.4.1 Regarding paragraphs 5.3.1(a)-(b), the McDonald's marks and the Complainant's name are undoubtedly well known in Singapore and the Respondent must have had actual or constructive knowledge of the same. Each of the third level domain names "macdonalds", "macdonald" and "mcdonald", as used in the Domain Names, is virtually identical and/or confusingly similar with the Complainant's third level domain name "mcdonalds". It is an accepted principle that where the disputed domain name is distinctive, an administrative panel would generally be more prepared to find that the registrant of the domain name has acted in bad faith in registering, accepting a transfer or using the domain name. Further, where the domain name is obviously connected with well-known and distinctive trademarks, use or registration by anyone other than the rights holder suggests opportunistic bad faith: see *Samsung Electronics Co Ltd v Funexpress.com.sg Pte Ltd* (Case No. SDRP-2002-0004(F)). The Complainant submits that this principle applies in the instant case. The Complainant contends that the Respondent's registration and use of the Domain Names are tainted by opportunistic bad faith.

5.4.2 Regarding paragraphs 5.31(c)-(d), the Complainant contends the Respondent is using Domain Name 1 in a manner which would mislead visitors to Website 1 into thinking that Website 1 is sponsored or endorsed by, or in some other way affiliated or connected to the Complainant. The

Complainant contends that the Respondent is using the third level domain name “macdonalds” to ride on the undoubted extensive goodwill which the Complainant has in the name “mcdonalds”. The Complainant submits the Respondent’s use of Website 1 indicates an intentional attempt to attract businesses to advertise on Website 1 for commercial gain, by creating a likelihood of confusion with the Complainant’s name and marks as to the source, sponsorship, affiliation or endorsement of Website 1. The Complainant submitted that the Respondent’s actions come within paragraph 4(b)(iv) of the Policy.

5.4.3 Initially, when the Complainant became aware of the existence of Website 1, the Complainant felt that the Respondent was behaving as a “typosquatter” of sorts. The Respondent appeared to be riding on the well-known reputation and goodwill established by the Complainant in its name “McDonald’s” to attract users who misspell or mistype the Complainant’s name when entering the URL which includes the Complainant’s name. Such a user may conceivably type “macdonalds” instead of “mcdonalds” when attempting to locate the Complainant’s website or McDonald’s Singapore’s website. The Respondent will then benefit from the inadvertent hits on and page views of Website 1 by using the elevated traffic flow to Website 1 to entice goods and service providers to list on Website 1 for a substantial fee. There is clear recognition that this type of conduct constitutes bad faith registration and use for the purposes of paragraph 4(b)(iv) of the Policy. See *Yahoo! Inc v Data Art Corp* (WIPO Case No D2000-0587).

5.4.4 With the discovery of Websites 2 and 3, The Complainant submitted that the Complainant’s theory that the Respondent is a “typosquatter” is confirmed. There can be no good faith reason for the Respondent to additionally register third level domains for “macdonald” and “mcdonald”, save to capitalise on internet users who wrongly type in the Complainant’s third level domain name “mcdonalds” when searching for McDonald’s Singapore’s website. Domain Names 2 and 3 basically captures other ways one can mis-type the Complainant’s third level domain name “mcdonalds”. By covering a wide spectrum of possible typographical errors, the Respondent hopes to capture more of the mis-hits of internet users and utilise same for commercial profit – the Respondent is undoubtedly trading on the distinctiveness and reputation of the Complainant’s name and the McDonald’s marks and in the Complainant’s third level domain name “mcdonalds”.

5.4.5 The Respondent’s registration and use of Domain Names 2 and 3, when taken with his registration and use of Domain Name 1, clearly demonstrate that the Respondent is a typosquatter and the registration and use of each of the Domain Names is tainted by bad faith.

6. Discussion and Findings

6.1 Under paragraph 4a of the Policy, the Complainant must establish the following three conditions to be entitled to the remedy under paragraph 4i of the Policy of a transfer of a domain name:

6.1.1 the registrant’s domain name is identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights;

6.1.2 the registrant has no rights or legitimate interests in respect of the domain name; and

6.1.3 the registrant’s domain name has been registered or is being used in bad faith.

6.2 *Identical/Similar to Name/Mark in Which Complainant Has Rights*

6.2.1 With respect to the first condition to be met under paragraph 4a(i) of the Policy, the Complainant must establish both of the following, namely, that:

(1) the Complainant has rights in the name or mark “McDonald’s”; and

(2) the Domain Names are identical or confusingly similar to the name or mark “McDonald’s”.

6.2.2 *Complainant's Rights*

- (1) The Complainant has registered the name or mark “McDonald’s” in Singapore either as a word mark on its own or together with other elements, together forming the collection of McDonald’s Marks owned by the Complainant, as stated at paragraphs 4.1.1 and 4.1.4 above. Under Section 26 of the Trade Marks Act (Cap. 332) (“the Act”), trade mark registration in Singapore confers upon the proprietor the exclusive right to use and authorise other persons to use the registered trade mark, in relation to the goods or services in respect of which the trade mark is registered.
- (2) In addition, as a result of the numerous applications and registrations, extensive usage and advertisements worldwide of the McDonald’s Marks and the significant sales generated by such use coupled with the substantial advertising and promotion as disclosed by the Complainant and set out in paragraph 4.1.7 and 4.1.8 above, the “McDonald’s” name has become distinctive of and are identified with the Complainant, in respect of goods and services originating from the Complainant, as well as being a recognised global brand in Singapore and elsewhere. The Complainant has over the years built up substantial and valuable goodwill and reputation in the McDonald’s marks. Such reputation and goodwill constitute a basis on which the common law action of passing off may be founded in the appropriate circumstances.
- (3) With registration of the McDonald’s Marks dating back to as early as 1969 and use of the McDonald’s Marks having commenced in Singapore since 1979, long before both the registration of the Domain Names, the Panel finds that the Complainant has, at the commencement of this Administrative Proceeding, rights in the name or mark “McDonald’s”.

6.2.3 *Identical or Confusingly Similar*

- (1) Turning now to whether the Domain Names are identical or confusingly similar to such “McDonald’s” name (over which the Complainant has rights), the Panel agrees that it is generally accepted that the addition of the portion “.com” is to be ignored and the comparison is to be with the characterising part of the domain name (see *VAT Holding AG v VAT.com* (WIPO Case No. D2000-0607) and *Croatia Airlines d.d. v Modern Empire Internet Ltd.* (WIPO Case No. D2003-0455) referred to in *McDonald’s Corporation v Naturerise, Inc* (Case Number SDRP-2005/0001(F)) decided on 25 February 2005.).
- (2) Accordingly, when the “.com.sg” portion of the Domain Names are discounted, the Panel finds that the Domain Names are identical and/or confusingly similar to the “McDonald’s” name or mark over which the Complainant has established rights.

6.2.4 This Panel is therefore of the view that the Complainant has satisfied the requirements of paragraph 4a(i) of the Policy that the Domain Names are identical or confusingly similar to a name, trade mark or service mark in which the Complainant has rights.

6.3 *Rights or Legitimate Interests of Respondent*

6.3.1 On the second condition under paragraph 4a(ii) of the Policy, the Complainant is required to prove that the Respondent has no rights or legitimate interests in respect of the Domain Names. Pursuant to paragraph 4c of the Policy, the following in particular but without limitation, which if proved, shall demonstrate the Respondent’s rights to or legitimate interests in the Domain Names for purposes of this second condition:

- (1) before any notice to the Respondent of the dispute, the Respondent’s use of, or demonstrable preparations to use, the Domain Name or a name corresponding to the Domain Name in connection with a *bona fide* offering of goods or services;

- (2) the Respondent has been commonly known by the Domain Name, even if it has acquired no trade mark or service mark rights; or
- (3) the Respondent is making a legitimate non-commercial or fair use of the Domain Name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue.

6.3.2 *Bona Fide Offering of Goods and Services*

- (1) The question therefore is: Has the Respondent used or made demonstrable preparations to use the Domain Names in connection with a *bona fide* offering of goods or services? The evidence in this regard is as follows:
 - (a) The Respondent is not using the Domain Names in connection with a bona fide offering of goods or services and/or not making a legitimate non-commercial or fair use of the Domain Names. The Respondent is making use of the Websites for commercial gain. And for the reasons stated in paragraph 5.4, above, the Panel finds that the Respondent is not making any bona fide offering of goods or services or a legitimate or fair use in respect of the Websites.
 - (b) The Respondent's failure to respond to this Complaint does not assist the Panel. In the absence of a response, the Panel can only rely on the submissions of the Complainant in that the Respondent is a "typosquatter" as elaborated below.
- (2) The SGNIC RPPG provide under:
 - (a) paragraph 9.2 that "*the registrant also represents and warrants ... that the domain name ... is for its own organisational use*"; and
 - (b) paragraph 13.1 that "*The registrant has the right to use the domain name but not the right to own it. As such, the registrant does not have the right to sell or transfer the domain name to any party whether for profit or otherwise*".

6.3.3 *Commonly Known by Domain Name*

The Respondent's name is Website Development which bears no resemblance whatsoever to the Domain Names. In the absence of the Respondent's response, the Panel can only conclude on the face of the Respondent's name that the Respondent cannot claim to be commonly known by any of the Domain Names.

6.3.4 *Non-Commercial or Fair Use*

Is the Respondent making a legitimate non-commercial or fair use of the Domain Names, without intent for commercial gain to misleadingly divert consumers or to tarnish the trade mark or service mark at issue? The evidence discussed at paragraph 6.3.2 above (in the examination of whether the Respondent has used or is preparing to use the Domain Names in connection with a *bona fide* offering of goods or services) most certainly points to an answer in the negative.

- 6.3.5 The Panel accordingly finds that the condition under paragraph 4a(ii) of the Policy is also satisfied as the Respondent does not have any legitimate right or interest in the Domain Names, taking into account the above considerations discussed in this paragraph 6.3 and in the absence of any other submission made or evidence provided by the Respondent on such right or interest in the Domain Names.

6.4 *Registration/Use of Domain Name in Bad Faith*

6.4.1 The third and final condition to be met under paragraph 4a(iii) of the Policy requires the Complainant to prove that the Domain Names have been registered or is being used in bad faith. The Policy clarifies at paragraph 4b that the following circumstances in particular but without limitation, if found to be present, shall be evidence of the registration and use of a domain name in bad faith:

- (1) circumstances indicating that the registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant, who bears the name or is the owner of the trade mark or service mark, or to a competitor of that complainant, for valuable consideration in excess of the registrant's out-of-pocket costs directly related to the domain name;
- (2) the registrant has registered the domain name in order to prevent the owner of the trade mark or service mark from reflecting the mark in a corresponding domain name, provided that the registrant has engaged in a pattern of such conduct;
- (3) the registrant has registered the domain name primarily for the purpose of disrupting the business of a competitor; or
- (4) by using the domain name, the registrant has intentionally attempted to attract, for commercial gain, internet users to the registrant's website or other on-line location, by creating a likelihood of confusion with the complainant's name or mark as to source, sponsorship, affiliation, or endorsement of the registrant's website or location or of a product or service on the registrant's website or location.

6.4.5 *Conduct of the Respondent*

- (1) In the absence of a response from the Respondent, the Panel relies and places significance on the following submission of the Complainant on this issue of bad faith:
 - (a) When the Complainant became aware of the existence of Website 1, the Complainant felt that the Respondent was behaving as a "typosquatter" of sorts. The Respondent appeared to be riding on the well-known reputation and goodwill established by the Complainant in its name "McDonald's" to attract users who misspell or mistype the Complainant's name when entering the URL which includes the Complainant's name. Such a user may conceivably type "macdonalds" instead of "mcdonalds" when attempting to locate the Complainant's website or McDonald's Singapore's website. The Respondent will then benefit from the inadvertent hits on and page views of Website 1 by using the elevated traffic flow to Website 1 to entice goods and service providers to list on Website 1 for a substantial fee. There is clear recognition that this type of conduct constitutes bad faith registration and use for the purposes of paragraph 4(b)(iv) of the Policy. See *Yahoo! Inc v Data Art Corp* (WIPO Case No D2000-0587).
 - (b) With the discovery of Websites 2 and 3, The Complainant submitted that the Complainant's theory that the Respondent is a "typosquatter" is confirmed. There can be no good faith reason for the Respondent to additionally register third level domains for "macdonald" and "mcdonald", save to capitalise on internet users who wrongly type in the Complainant's third level domain name "mcdonalds" when searching for McDonald's Singapore's website. Domain Names 2 and 3 basically captures other ways one can mis-type the Complainant's third level domain name "mcdonalds". By covering a wide spectrum of possible typographical errors, the Respondent hopes to capture more of the mis-hits of internet users and utilise same for commercial profit – the Respondent is undoubtedly trading on the distinctiveness and reputation of the Complainant's name and the McDonald's marks and in the Complainant's third level domain name "mcdonalds".

- (c) The Respondent's registration and use of Domain Names 2 and 3, when taken with his registration and use of Domain Name 1, clearly demonstrate that the Respondent is a typosquatter and the registration and use of each of the Domain Names is tainted by bad faith.
- (d) The Respondent's choice of the Domain Names, bearing and being identical or confusingly similar to the well-known name and mark of the Complainant, is evidence of bad faith as it is contrary to and in breach of the SGNIC RPPG provisions (to which it is bound) under:
 - paragraph 9.1 whereby it represents and warrants that the Domain Name "*(a) does not infringe any registered trade mark nor will it give rise to a cause of action in passing off ... (b) is not identical or confusingly similar with either a registered trade mark, company or business name in Singapore ...*" (which is similarly provided at paragraph 8.1 of the Registrant Agreement to which the Respondent is also bound).
 - paragraph 13.1 that "*The registrant has the right to use the domain name but not the right to own it. As such, the registrant does not have the right to sell or transfer the domain name to any party whether for profit or otherwise*";
- (e) The administrative panels in *J. Crew International, Inc. v crew.com* (WIPO Case No. D2000-0054) and *Government of Canada v David Bedford a.k.a. DomainBaron.com* (WIPO Case No. D2001-0470) also held that the registration of domain names which are identical or confusingly similar to the trade marks of others may be taken to be evidence of bad faith for the purposes of the Policy.
- (f) The failure to respond to a complainant has been held in past decisions to indicate bad faith (*Samsung Electronics Co., Ltd v Funexpress.com.sg Pte Ltd* (SDRP-2002-0004 (F)) and *Google, Inc. v Googles Entertainment* (SDRP-2002-0003 (F))).

6.4.6 For the reasons stated at paragraph 6.4.5 above, the Panel finds that the Domain Names have been registered or are being used in bad faith by the Respondent and that accordingly the condition under paragraph 4a(iii) of the Policy has also been satisfied.

7. Conclusion

In the premises, the Panel finds that the Complainant has established the three elements under paragraph 4a of the Policy and is therefore entitled to the remedy of a transfer of the Domain Names as provided under paragraph 4i of the Policy.

Jim Lim
Sole Panellist
26 September 2008