

## DISPUTE RESOLUTION SERVICE

D00008634

### Decision of Appeal Panel

Emirates

and

Michael Toth

#### 1. The Parties:

Complainant: Emirates  
Group Legal Department  
P.O BOX 686  
Dubai  
United Arab Emirates

Respondent: Michael Toth  
35 Cowpasture Road  
Ilkley  
West Yorkshire  
LS29 8SY  
United Kingdom

#### 2. The Domain Name:

emirates.co.uk (the "Domain Name")

#### 3. Procedural History:

The decision under appeal was issued by the appointed expert ("the Expert") and issued to the parties by Nominet on 24 September 2010. On 27 October 2010 Nominet received the Appeal Notice from the Complainant together with the full Appeal fee. The Respondent responded to the Appeal Notice on 11 November 2010.

On 18 November 2010 Ian Lowe, Claire Milne and David King were appointed to the Appeal Panel (the "Panel"). Each of the members of the Panel have confirmed to the Nominet Dispute Resolution Service that:

*"I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties."*

This is an Appeal against a **Decision** at first instance in favour of the Respondent. The Panel was appointed to provide a decision on or before 7 January 2011. This process is governed by version 3 of the *Procedure for the conduct of proceedings under the Dispute Resolution Service* ("the Procedure") and the **Decision** is made in accordance with version 3 of the *Dispute Resolution Service Policy* ("the Policy"). Both of these documents are available for inspection on the Nominet website (<http://www.nominet.org.uk/disputes/drs>).

#### 4. The Nature of This Appeal

The Policy §10a provides that: *"the appeal panel will consider appeals on the basis of a full review of the matter and may review procedural matters"*.

The Panel concludes that insofar as an appeal involves matters that are not purely procedural the appeal should proceed as a re-determination on the merits. Accordingly, the Panel does not propose to undertake a detailed analysis of the Expert's decision and will only refer to the Expert's decision where the Panel feels it would be helpful to do so.

In addition to the **decision under appeal**, the Panel has read the Complaint dated 19 May 2010, the Response dated 17 June 2010 and the Reply dated 29 June 2010, as well as three Non-Standard Submissions by the parties as noted in the section below. The Panel has also considered the Appeal Notice submitted to Nominet on 27 October 2010, and the Appeal Response submitted on 11 November 2010.

#### 5. Formal and Procedural Issues

##### Reply

As the Expert noted, paragraph 6b of the Procedure provides as follows:

*"b. Any reply by the Complainant must be restricted solely to matters which are newly raised in the Respondent's response and were not raised in the Complainant's complaint as originally submitted to us. If an Expert is appointed and the reply extends to other matters, the Expert may declare it inadmissible to the extent that it deals with matters going beyond those newly raised in the Respondent's response..."*

The Expert considered that parts of the Complainant's Reply did not comply with this provision. He disregarded those parts of the Reply that comprised what he considered to be a substantial body of new evidence as to the extent of the Complainant's reputation in 2002. This was relevant to the Respondent's alleged knowledge of the Complainant at the time of the registration of the Domain Name.

The Panel fully endorses the view that the Nominet DRS should be an efficient, cost-effective alternative dispute resolution policy to handle domain name disputes in the '.uk' domain. Prolivity of submissions is discouraged. The Procedure gives the Complainant the opportunity to respond to the Respondent's case and paragraph 6b is intended to avoid the Complainant's raising new matters in the Reply that the Respondent had no chance to deal with in his Response. Paragraph 6b goes on to provide that if the Expert does decide to admit new matters in the Reply then the Respondent would normally be given the opportunity to deal with them in a further submission.

In his Response, the Respondent asserted that he did not believe he was aware of the Complainant in 2002 and that he did not have the Complainant in mind when he registered the Domain Name. In the view of the Panel, this did justify a reply from the Complainant, addressing these assertions with further evidence as to its reputation as at 2002. The additional material on this point was justifiable and on balance did not go beyond matters newly raised in the Response. The Panel has accordingly taken account of the further evidence in the Reply.

The Respondent has already commented at length on the extent of the Complainant's reputation at the time he registered the Domain Name and his knowledge of the Complainant at that time, particularly in his First Non-Standard Submission ("NSS") of 23 August 2010. This was a response to the Reply and the Panel does not therefore consider it necessary to give the Respondent a further opportunity to comment on the Reply.

### **Non-Standard Submissions**

The Expert also took account of a Second NSS by the Respondent (of 21 September 2010) and of the first NSS by the Complainant of 3 September 2010. The Panel has similarly had regard to these additional submissions, but not a Second NSS by the Complainant not considered by the Expert.

In addition, at the time of submitting a response to the Appeal notice and then again some days later, the Respondent sought to submit a total of three further NSS. The Panel has considered the explanatory paragraphs seeking to justify these additional submissions. The first sought to introduce a photograph evidencing a point made by the Respondent in his Appeal Response. The others concerned recent UDRP or DRS decisions and commentary on one of them. The Panel concluded from the explanatory paragraphs submitted by the Respondent in accordance with paragraph 13b of the Procedure that there was no exceptional need to consider these further submissions and declined to ask for them.

## **6. The Facts**

The Complainant, Emirates, is a Dubai corporation established by a 1985 decree of the Government of Dubai. It is the official international airline of the United Arab Emirates.

The Complainant is the proprietor of a number of registered trade marks including:

- a) UK trade mark number 2023709 registered as of June 1995, Community trade mark number 22137 registered as of April 1996 and US trade mark number 2254666 dated August 1996, all in Class 39 for the stylised word "Emirates" together with Arabic characters in a design said to be a transliteration of "Al-Imarat" meaning "the Emirates";

b) UK trade mark number 2023708 registered as of June 1995 in Classes 39 and 42 and UK trade mark number 2399015 registered as of August 1995 in Classes 39 and 43 for the stylised words "Emirates Holidays" together with the Arabic characters described above; and

c) US trade mark number 2495959 in Class 39 for the word mark EMIRATES dated June 2000.

The Respondent is an individual who on 14 May 2010 owned 2,665 ".co.uk" and ".org.uk" domain names including the Domain Name which was registered on 4 April 2002. At the date of the Complaint the Domain Name resolved to a website (the "Website"). The home page was headed "The United Arab Emirates Resource Guide". It was divided into small sections variously headed "Hotels in Dubai", "Car Hire", "Emirates Holidays", "Flights to the Emirates" amongst others.

The Complainant's solicitors wrote to the Respondent on 16 April 2008 requesting transfer of the Domain Name. There was further correspondence between the parties but no transfer of the Domain Name has taken place.

## **7. The Parties' Contentions**

The parties' contentions at first instance are set out in detail in the Expert's decision. In summary they are as follows:

### **Complaint**

The Complainant is the official international airline of the United Arab Emirates and was established by Government decree in 1985. It is one of the world's fastest growing airlines and flies to over 90 destinations in 59 countries. As well as operating passenger air services, the Complainant's business activities include freight services, logistics and aircraft engineering. It also carries on business as a tour operator under the name Emirates Holidays.

The Complainant owns a significant trade mark portfolio including those trade marks listed above. It has operated its main website at [www.emirates.com](http://www.emirates.com) since 1998, and launched another website at [www.emirates-holidays.com](http://www.emirates-holidays.com) in 1999. It has an extensive portfolio of other domain name registrations including the word "Emirates".

In its comparatively short history, the Complainant has received numerous awards for excellence including in the UK.

The Complainant has spent considerable time and money promoting its business from its head office in Dubai and through its offices and agents located in numerous cities around the world including London, Manchester and Birmingham as well as through [www.emirates.com](http://www.emirates.com). Internationally, the Complainant has entered into high profile sponsorship deals including with Arsenal Football Club (the Emirates stadium and the team shirts), FIFA World Cup 2006, AC Milan and the Rugby World Cup 2007 as well as other major sporting events.

As a result, the Complainant is the owner of a significant international reputation and goodwill in the EMIRATES name and marks that have become synonymous with aviation, travel and leisure services.

The Domain Name is identical and/or similar to the Complainant's trade marks.

The essence of the Complainant's allegations on abusive registration is that the Respondent must have been aware of the Complainant and its brand, trade marks and business when it registered and used the Domain Name. The Respondent would not have chosen the Complainant's world famous mark unless it was seeking to create an impression of an association with the Complainant.

The Complainant contends that the Respondent is using the Domain Name in a way likely to confuse people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. The Respondent's use of an ineffective disclaimer suggests that he appreciates that the public will be confused into thinking that there is a connection between the Domain Name and the Complainant's businesses. As a result the Respondent's business is unfairly advantaged or the Complainant's business is unfairly disadvantaged.

The Complainant does not believe that the Respondent can demonstrate any circumstances that would evidence that the registration was not abusive for the purpose of the Policy. The Respondent's use of the Domain Name is not legitimate non-commercial or fair use. In particular, the word Emirates has acquired a secondary significance and connotes the Complainant more than it does the region known as the United Arab Emirates. There is a high degree of international renown attaching to the Complainant's marks. As the panellist found in the complaint concerning <emirates.eu> (Case No. 05405, *Emirates v Stichting Roos Beheer* – where the Respondent was held to be the beneficial owner of the domain name),

*“...the name EMIRATES, standing alone, is too powerful, too universally recognised, and too well protected by trademark, to enable any indulgent view that it is merely a generic word in innocent usage.”*

The Complainant makes other allegations as to the Respondent's motives on registering the Domain Name (specifically, that this was a blocking registration and intended to disrupt the Complainant's business) and that the Respondent is engaged in a pattern of registrations corresponding to well-known marks in which he has no rights. The Complainant also refers to the Respondent's publicly stated views when standing as a candidate in Nominet elections. The Panel's thinking has not been influenced by any of these considerations, so they are not set out here in detail.

## **Response**

The Respondent asserts that there has been unconscionable delay in bringing the Complaint. The Domain Name was registered over eight years ago and the website was operational from at least 2004, if not earlier. Much is said to turn on the Respondent's choice of the Domain Name, its plain dictionary meaning and the Complainant's alleged acquired secondary meaning. The extreme delay in bringing the claim makes it harder to gather evidence and unfairly prejudices the Respondent's ability to respond to it.

The Respondent admits the Complainant's registered trade marks but states that none are identical to the Domain Name since they include either additional words that qualify them or an Arabic design.

The Respondent submits that when considering abusive registration the Panel should limit its assessment to the Complainant's proven reputation and goodwill in 2002. He asserts that the Complainant provides no evidence of the scale of its operations in the UK in 2002 when the Domain Name was registered.

Due to the passage of time, the Respondent cannot be sure but does not believe that he was aware of the Complainant in 2002. He states with certainty, however, that he did not have the Complainant in mind when he registered the Domain Name. His motive for registering it was simply that it is descriptive of a place name and in particular that it is commonly used in the vernacular for the United Arab Emirates.

He registered it because it was a generic English word. The word "emirate" is a descriptive word that means a country or territory ruled by or under the control of an emir. The United Arab Emirates ("UAE") is a middle-eastern federation of seven emirates and there are several independent emirates that are not in the UAE. There is a large number of other "emirates" related websites that are not owned or controlled by the Complainant as well as registered UK and EU trademarks. The Respondent points in particular to the Community trade mark THE NATIONAL AIRLINE OF THE UNITED ARAB EMIRATES registered by Etihad Airways.

The Respondent relies on the views of the appeal panel in DRS 4331 *verbatim.co.uk* in relation to knowledge and intent on the part of a registrant of a domain name. He also points to the limits suggested by the expert's decision in DRS 292 *chivasbrothers.co.uk* as to when abusive registration may be inferred if a domain name is identical to a name exclusively referable to the complainant. He refers to the appeal panel decision in DRS 4884 *maestro.co.uk* that when the trade mark in question is a dictionary word there has to be something more than knowledge of the trade mark to justify a finding of abusive registration. Where the ordinary dictionary meaning has not been displaced by an overwhelming secondary meaning then the evidence of abuse will have to be very persuasive.

The Respondent maintains that the website at the domain is a genuine and *bona fide* offering of information about the United Arab Emirates. It also includes advertising links to suppliers of relevant goods and services but this is a perfectly legitimate and descriptive use of the domain.

The disclaimer was inserted by the Respondent on the website when he became aware of the Complainant's increasing profile, and is evidence of his bona fides. The disclaimer includes a link to the Complainant's website that does not generate revenue. There is no evidence of any confusion on the part of visitors to his website despite the years of co-existence of the Domain Name and the Complainant's website at [www.emirates.com](http://www.emirates.com).

As well as denying that he is engaged in a pattern of registrations corresponding to well-known marks in which he has no rights, the Respondent states that the registration of the Domain Name was in fact part of a pattern of his registering a large number of country and place names that he says have an intrinsic value. As evidence of this pattern he lists over 200 .uk domain names that he has registered (10 of them at about the same time as the disputed registration) corresponding to country and territory names, and produces details of his purchase of <china.co.uk>.

## Reply

The Complainant does not accept that a delay in bringing a complaint is a reason for it not to succeed. There is nothing in the Policy or any authorities submitted by the Respondent that state that delay is a factor that the Expert should consider relevant. In any case, the Respondent is not prejudiced by any delay. The majority of the Respondent's website has not changed at all in the past five years. The "Local News" section appears to date from September 2005 and the "Live Weather" link was last updated in April 2007.

The Complainant points out that it is simply wrong of the Respondent to claim that no evidence has been submitted in respect of the Complainant's goodwill in 2002. It points in particular to the list of awards won by the Complainant in the period 1988-2007, which was provided as an annex to the complaint.

The Complainant submits further evidence (not taken into account by the Expert) as to the extent of its goodwill in 2002. This includes examples of press coverage as well as extracts from its Annual Reports for the years 1997 to 2002. The financial statements show UK revenue for the Complainant in 2001 of £143,356,392 and in 2002 of £147,149,272. In addition, the Complainant points out that in October 1998 Emirates signed a code-sharing deal with British Airways and in 2000 a frequent flyer participation agreement. The Complainant's website became operational in 1998 and in that year it became one of the first airlines to be completely Internet based.

The Complainant disputes the Respondent's interpretation of the decision of the Appeal Panel in *verbatim.co.uk*. It in fact stated that "*the Complainant must satisfy the Panel... that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at the commencement of an objectionable use of the Domain Name.*" The Respondent makes specific reference to the Complainant on the website. If the Respondent had not heard of the Complainant when he registered the Domain Name (which the Complainant considers inconceivable) it is even more doubtful that this was the case when the website became operational, presumably in 2004.

As the Complainant comments, the only evidence that the Respondent's website was operational in 2004 is the copyright notice on the website. The Respondent has blocked access to viewing details and dates of historic pages of the *emirates.co.uk* website at the Internet archive website.

The Complainant does not accept that the registration of the Domain Name is part of a pattern of registering country and place names since "Emirates" is not a common geographic term in the same way as many country or even regional terms. People may say that they are travelling to Argentina, but no-one says that they are travelling to "Emirates". This is because "Emirates" is not primarily geographically descriptive – it can refer to several places. It in fact connotes the Complainant more than it does the UAE.

The Complainant considers that there is an obvious risk that visitors to the Respondent's website will be confused into believing that it is connected with the Complainant. A click on the sidebar of the Website brings up a page entitled "Emirates Flights". Furthermore, the "Contact Us" section includes comments such as "Please do not contact us regarding your flight" and "Do not press send if you need to contact Emirates Airline". The implication is that the Respondent has received queries from customers confusing the Website with the Complainant.

### **Respondent's First Non-Standard Submission**

The Respondent relies on the decision in DRS 8347 *Salive.co.uk* to support his submissions on delay, as well as two recent UDRP decisions and commentary by UDRP panellist Neil Brown QC. He claims to have suffered unfair prejudice as a result of the delay through the time and money spent developing the Website from 2004 and in purchasing the domain name <theemirates.co.uk> in 2007. He was entitled to rely on the Complainant's silence over his registration of the Domain Name when deciding to purchase <theemirates.co.uk>. He notes that the Complainant has given no explanation for its delay in bringing the Complaint.

The Respondent states that the server hosting the website failed in 2008 causing major technical problems. Certain links were broken on the site leading to problems such as out of date weather and other feed information which appeared and has not been remedied. This should not detract, however, from the fact that this is a proper website with unique content. It has a Google page rank of 4 which would not be possible for a mere parking page or a site without useful and relevant content.

The Respondent accepts that the Complainant had sufficient goodwill in respect of EMIRATES in 2002 to amount to Rights for the purposes of the Policy, but he disputes how strong its rights are in the name.

He notes that the recently launched country code top level domain extension for United Arab Emirates comprises characters in Arabic script that have a meaning equivalent to "Emirates" in English.

#### **Complainant's First Non-Standard Submission**

The Complainant points out that notwithstanding the decisions relied upon by the Respondent, it remains clear that the prevailing view of both UDRP panellists and Nominet experts is that delay is not a ground for refusing a domain name complaint. The Respondent cannot have been in any doubt as to the Complainant's objections to his use of the EMIRATES mark for a domain name. The solicitors' correspondence took place in 2008 and the Complainant then made its (successful) complaint in respect of <emirates.eu>. The Respondent has not suffered any unfair prejudice as a result of any delay. He cannot have spent anything significant on the development of the Website and he paid only a modest sum for <theemirates.co.uk>.

The Respondent's claim that the website was not updated because of a server failure in 2008 is implausible. He has not explained how links broken in 2008 have resulted in links dating back to 2005 remaining on the website. If the website really was a "proper website with unique content" the problems would not have remained unremedied in 2010.

#### **Respondent's Second Non-Standard Submission**

The Respondent was not aware of the problem with the weather links. He has no in-house technical support and has over a hundred websites in operation, with more being developed. He had not noticed the problem with these links after old backup data was uploaded for this and other sites following the server failure.

#### **Appeal Notice**

The Complainant submits that the Expert significantly underestimated the likelihood of confusion; that is the likelihood that people or businesses would be confused "into believing that the Domain Name was registered to, operated or authorised by, or otherwise connected with the Complainant". It also considers that the Expert made



incorrect findings about the evidence as to the Complainant's rights and as to the Respondent's pattern of registrations.

In particular, the Complainant relies on the finding of the Panel in its domain name complaint concerning <emirates.eu> which resolved to the Website as in this case. As the decision stated:

*“Mr Toth’s revenue model depends entirely on the attraction of visitors who then follow links. The Complainant’s registered trademark is the name of a major international airline. The disputed domain name is identical. It is reasonable to expect that many, perhaps a majority, of Internet users who search for the name EMIRATES expect to find the authentic website of the Complainant. By the nature of search engine technology they are likely to be led to Mr Toth’s website, as are those who make the same entirely sensible but wrong guess of the URL of the Complainant’s European website. The word EMIRATES would have functioned in a trademark sense. The Panel finds it likely that visitors may initially be confused into believing that the website has the endorsement of the Complainant, and thus Mr Toth would have attracted visitors through the fame of the Complainant’s trademark. All of the requirements are met for the Panel to find bad faith registration and use.”*

The Complainant submits in particular that it was inaccurate for the Expert to state that “The Complainant exhibits a limited amount of evidence relevant to the Complainant’s reputation in 2002.” Evidence relevant to 2002 was exhibited at annexes 1,2,3,4,5 and 6 to the original Complaint and was not limited. The Complainant distinguishes the appeal decision in <verbatim.co.uk> and maintains that all the evidence points to the Respondent having been fully aware of the Complainant and its rights not only in 2002 but certainly by 2004.

## Appeal Response

The Respondent submits in his response to the Appeal Notice some new evidence about the use made by the Complainant of the term Emirates in its in-flight information system. This apparently includes the sentence “Dubai, one of the seven Emirates that make up the United Arab Emirates”. The Respondent relies on the evidence of widespread descriptive/generic use of Emirates.

The Respondent otherwise reinforces points made by him in his Response and Non-Standard Submissions.

## 8. Discussion and Findings

### General

In order for the Complainant to succeed it must (pursuant to Paragraph 2 of the Policy) prove to the Panel, on the balance of probabilities, **both** that:

*it has Rights in respect of a name or mark which is identical or similar to the Domain Name; **and***

*the Domain Name, in the hands of the Respondent, is an Abusive Registration as defined in Paragraph 1 of the Policy.*

The meaning of 'Rights' is clarified and defined in the Policy in the following terms:

**Rights** means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.

If the Complainant satisfies the Panel that it has relevant rights, the Panel must address itself to whether the registration by the Respondent of the Domain Name is abusive. An Abusive Registration is defined in the Policy as follows:

**Abusive Registration** means a Domain Name which either:

*was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights; OR*

*has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights;*

### **The Issues before the Panel**

#### **Rights**

As the Expert found, there is no dispute between the parties as to the Complainant's Rights in the name EMIRATES as at the date of the Complaint. These comprise both unregistered rights arising from the Complainant's extensive trading activities in the UK and elsewhere and its rights deriving from its registered UK and Community trade marks consisting of the prominent stylised word "Emirates" and Arab characters.

The Panel agrees that the Complainant has Rights in a name or mark that is similar to the Domain Name.

#### **Abusive Registration**

Accordingly, the Panel has to consider whether the Domain Name is an Abusive Registration in the hands of the Respondent, but also whether the Complainant should be denied relief under the Policy because of delay on the part of the Complainant in bringing this Complaint. The Panel considers that it would be appropriate initially to look at the question of Abusive Registration.

As the Policy provides, a domain name may be an Abusive Registration because it was registered with abusive intent or because it has been used in an abusive manner.

At the heart of the Respondent's case is his submission that his use of the Domain Name is entirely legitimate because:

- a) he is using it for a genuine business; and
- b) the primary meaning of "Emirates" is the geographic term referring to either the United Arab Emirates or emirates generally – that is territories ruled by an emir.

#### **The Website**

The Respondent's use of the Domain Name for the website at [www.emirates.co.uk](http://www.emirates.co.uk) has significantly influenced the Panel's view of this case. The Respondent explains that he registered the Domain Name as part of his collection of geographical names, and goes on to say:

"My intentions when registering these geographic domains was to use them for a cluster of country related resource guides. I have developed some of the geographic domain – e.g. [China.co.uk](http://China.co.uk); [Maldives.co.uk](http://Maldives.co.uk); [Canada.co.uk](http://Canada.co.uk). One of my most popular websites is [UnitedKingdom.co.uk](http://UnitedKingdom.co.uk). (Annex 12)."

Annex 12 includes a screenshot from each of the four websites mentioned in this passage. The Panel notes a close resemblance between the home pages of [www.china.co.uk](http://www.china.co.uk) and [www.emirates.co.uk](http://www.emirates.co.uk). In fact, the former appears to be derived from the latter by replacing "Emirates" with "China" throughout (resulting in occurrences of "the China", and photographs of uncertain provenance). This, the Panel notes, indicates the Respondent's idea of a developed "country related resource guide".

While the website at [www.emirates.co.uk](http://www.emirates.co.uk) relates more closely to the United Arab Emirates than the website at [www.china.co.uk](http://www.china.co.uk) does to China, in the Panel's view it has little value as a source of current, accurate information about the area in question. The Panel has difficulty in seeing it as a "genuine offering of goods or services" in the sense of paragraph 4aiA of the Policy. Rather, its use comes across as a vehicle for click-through traffic and a place holder for a valuable domain name.

The Panel cannot draw any useful conclusions from the Respondent's claim that the Website has a Google Page Rank of 4. The PageRank link analysis algorithm is complex and a website's PageRank is open to a number of interpretations.

As paragraphs 4d and 4e of the Policy state, trading in domain names for profit is in itself a lawful activity and earning click-per-view revenue is not of itself objectionable. However, if these activities rely on taking unfair advantage of the Complainant's Rights then they will amount to abusive use of the Domain Name.

The Respondent relies on what he says is a pattern of registering geographic domain names to meet the Complainant's case that he has engaged in a pattern of registrations corresponding with well-known names in which he has no rights. The Panel accepts that this registration is part of a pattern of registering geographic domain names, but is not persuaded that this helps the Respondent, since the position would depend on whether rights existed in relation to any particular geographic name.

The Panel has considered the Complainant's allegation that the Respondent has a pattern of registering well-known names in which he has no rights, but finds that the few names cited in the Complaint in support of this allegation do not clearly constitute such a pattern.

### **"Emirates"**

The Panel of course accepts that "emirate" has an ordinary, generic meaning. It is a territory ruled by an emir. Furthermore, "Emirates" is part of the name of the United Arab Emirates, a federation of seven States (or emirates). In the Panel's view, the meaning of the word Emirates will vary depending on the context in which it is used. Accordingly, the fact that the Complainant or its solicitors or anyone else uses the word with this ordinary meaning is neither surprising nor conclusive.

The Panel agrees with the Complainant's submission that it would not be natural for someone to say that "we are going to Emirates for our holiday" in the same way that they might say "we are going to Argentina for a holiday". They are far more likely to refer to Dubai, for example. The shorthand for United Arab Emirates would normally be "UAE" but would invariably be "the Emirates" rather than "Emirates" alone.

The key issue is whether, following the Complainant's very extensive trading under the name Emirates since it was formed in 1988, and its marketing and advertising over the relevant period, the word Emirates has acquired a determinative secondary meaning.

### **Secondary meaning**

The Panel disagrees with the Expert's view on the strength of the secondary meaning of the name. The Panel has little doubt that as a result of the Complainant's very extensive successful trading over many years and its widespread marketing and advertising in the UK, as well as elsewhere in Europe and globally, Emirates has acquired a secondary meaning which is synonymous with the Complainant, when the context permits. Except where it was clear from the context that the word was being used in its generic sense, a relatively uncommon occurrence, Emirates would be taken to be a reference to the Complainant, particularly in relation to travel and holidays.

The Expert recorded that the Appeal Panel in DRS 4884 *maestro.co.uk* had stated that:

*"Where a domain name is a single ordinary English word, the meaning of which has not been displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive if it is to be held to be an Abusive Registration under the DRS Policy."*

Here, however, the Panel does not consider that the Domain Name fulfils the conditions in the first part of this test. As noted earlier, "emirate" is an English word, and "the Emirates" is used as an abbreviation for the United Arab Emirates (or, of course, the Arsenal football ground sponsored by the Complainant). But, it is the view of the Panel that there is a significant distinction between "Emirates", "emirate" and "the Emirates". The Panel finds that "Emirates" has acquired a very strong secondary meaning and, given the nature of the Website and the business of the Respondent, finds that the evidence of abuse is persuasive.

### **Timing**

So far as timing issues are concerned, the Respondent accepts that at the date of registration of the Domain Name in 2002 the Complainant did have sufficient reputation in the mark EMIRATES to found Rights under the Policy. The Panel also finds that the Complainant had relevant registered trade mark rights as at that date. The dominant feature of its various UK, Community and US registered trade marks dating back to 1995 and 1996, cited above, was the slightly stylised word EMIRATES. This is not therefore a case like those cited in the Overview involving domain name registrations pre-dating the Complainant's rights – namely DRS 02223 (*itunes.co.uk*), the decision and Appeal decision in DRS 04962 (*myspace.co.uk*), the decision and Appeal decision in DRS 05856 (*t-home.co.uk*) and the decision and Appeal decision in DRS 06365 (*oasis.co.uk*).

The Appeal Panel in DRS 04331 *verbatim.co.uk* determined that, for the complaint to succeed, "the Complainant must satisfy the Panel, as an opener, that the Respondent was aware of the existence of the Complainant or its brand at the date of registration of the Domain Name or at commencement of an objectionable use of the Domain Name." It

had, however, also noted that “...when a Respondent denies all knowledge of the Complainant and/or its Rights at the relevant time, that denial is not necessarily the end of the matter. The credibility of that denial will be scrutinised carefully in order to discern whether, on the balance of probabilities, the relevant degree of knowledge or awareness was present.”

The Panel has some sympathy with the Complainant's comment that the Expert was unduly dismissive of the Complainant's original evidence as to the extent of its goodwill as at 2002 (when the Domain Name was registered) and 2004 (the earliest likely use of the Domain Name). Annex 6 to the Complaint, for example, included a long list of travel awards made to the Complainant over the years 1988 to 2007. There are more than 170 awards over the years 1988 to 2002, the majority with a UK connection, including:

Best Airline to the Middle East –Travel Weekly – UK (12 years running to 2002)

Airline of the Year Best Airline Based in the Middle East/Indian Sub-continent – Official Airline Guide (OAG) – UK (14 years running to 2002)

Best Economy Class – Business Traveller UK (2002)

Best Airline of the Year – Skytrax research – UK (2001)

Best Airline to the Middle East – Selling Long Haul – UK (2000)

Best Airline to the Middle East – Travel Bulletin – UK (4 years running to 1999)

Best International Airline – Daily Telegraph UK (1999).

There are around a further 24 similar awards in 2003/2004.

In its Reply, the Complainant also adduced further evidence including details of its UK based turnover - £143,356,392 in 2001 and £147,149,272 in 2002.

The Panel would have expected this level of activity to have come to the notice of the Respondent, given his interest in the travel sector.

The Panel notes that the Respondent claims no clear recollection of his awareness or otherwise of the Complainant and its Rights at the time of registration of the Domain Name in 2002. The Panel has considered the evidence of the Complainant's growing renown, its reputation amongst consumers and the travel industry, and the substance of its UK based business as reflected in the turnover figures. The Panel believes that it is on balance very likely that the Respondent was indeed aware of the Complainant during 2002, and at all times thereafter.

A natural inference is that the Respondent very probably designed his use of the Domain Name in the light of that awareness. We note in this connection that no records are available of early use of the Domain Name which prevents the Panel from drawing firm conclusions on this matter. As the Complainant points out, historic pages of the Website are no longer available from the Internet Archive Wayback Machine at [www.archive.org](http://www.archive.org) (although the Respondent provided evidence that they were available on 18 June 2010 for five dates in October 2004).

We do know from the Respondent's original Annex 9 that for a period of unknown length ending in August 2007, the Website was linked directly to the Complainant's website.

During this period the Respondent presumably benefited directly from traffic attracted to the Website and then from the Website as a result of the Complainant's Rights. He was evidently aware of the undesirability of this situation, as he took steps to block the outgoing traffic. Even were we to disregard this period of specific benefit, all subsequent use has evidently been with the Respondent's full knowledge of the Complainant's Rights, and of the increasing public recognition of the Complainant. The Panel assumes that the Respondent has continued this use because he derives some benefit from it, and in these circumstances the Panel sees this benefit as unfair.

### **Initial interest confusion**

As the panellist found in the complaint regarding <emirates.eu>, the Respondent's business model depends on attracting Internet users to his website who then generate revenue by click-throughs. Visitors drawn to the site following an Internet search are far more likely to have been looking for the Complainant's website than a general resource on the United Arab Emirates, and are likely to have assumed that the site they were visiting was associated with or authorised by the Complainant. Similarly those accessing the Website directly are very likely to have been users guessing (incorrectly) at the URL of the Complainant's UK website.

As paragraph 3.3 of the Nominet DRS Expert Overview (the "Overview") records, "the overwhelming majority of Experts" view "initial interest confusion" as a possible basis for a finding of Abusive Registration,

*"...the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name."*

The Panel also notes that in a recent decision of the English High Court in *Och-Ziff Management Europe Limited v OCH Capital LLP* ([2010] EWHC 2599 (Ch)) Mr Justice Arnold held that "initial interest confusion" was actionable under Article 9 of the Community Trademark Regulation. The concept cannot be said to be well-founded only under US law as suggested by the Respondent in his Second NSS of 21 September.

Accordingly, the Panel would find that the Domain Name was probably registered and has certainly been used in a manner that takes unfair advantage of the Complainant's Rights in the name EMIRATES. It is therefore necessary for the Panel to consider whether the Complaint should be denied because of delay on the part of the Complainant in bringing the Complaint.

### **Delay**

The DRS is founded in the Registration Agreement between registrants and Nominet by which those registering domain names with Nominet agree to be bound by the Policy and Procedure (amongst other terms). The Policy does not expressly deal with the issue of delay on the part of the Complainant in bringing a Complaint under the Policy or whether the common law principles of laches or acquiescence should apply.

The generally held view amongst Nominet experts (and UDRP panellists) is that delay alone is not a ground on which a Complaint may be denied. Recent decisions under both

systems have suggested that there may be scope for such a defence (whilst acknowledging the prevailing view).

The Panel makes no finding as to whether a limitation point arises in respect of the Complaint because, for example, the Domain Name was registered more than six years before the Complaint was submitted. The Respondent's Abusive Registration in respect of his use of the Domain Name continued up to the date of the Complaint (and still continues).

In DRS 8347 *5alive.co.uk* the main reason the Expert rejected the complaint was the complainant's delay in making its complaint coupled with a poorly argued case. The Expert said that "*...in situations like this, where there has been such a long delay between the registration of the Domain Name and the initiation of the complaint, there has to be evidence beyond mere assertion to justify the claim that this is an Abusive Registration.*" In contrast, in this case, the Complaint is far from poorly argued or based only on mere assertion.

As the Panel has found, the Respondent is very likely on balance to have been aware of the Complainant's Rights both when he registered the Domain Name and when he began use of the Domain Name that the Panel has found to be abusive. He was certainly aware of the Complainant's explicit objection to his use of the Domain Name from the time of the solicitors' correspondence in 2008 and its subsequent complaint in respect of <emirates.eu>.

The Panel accepts that there may be a case for delay or acquiescence amounting to a defence to a complaint under the Policy but is not at all satisfied that this is such a case. The delay is not such as to prejudice the proper consideration of the issues. Even if the Respondent could properly claim to have acted on the assumption that the Complainant had no objection to his registration and use of the Domain Name, we do not consider that he has suffered any unfair prejudice as a result of the delay. As we have found, he cannot be said to have developed a proper business under the Domain Name or a "genuine offering of goods or services" in the sense of paragraph 4aiA of the Policy. Rather, its use has been for click-through traffic and as a place holder for a valuable domain name. The Panel finds that the Respondent has not in reality developed a business under the Domain Name in the belief that the Complainant had no objection to his using it or with the encouragement of the Complainant.

The Panel does not therefore accept that the delay on the part of the Complainant in bringing the Complaint should lead to its finding against the Complainant.

## **9. Decision**

The Panel finds that the Complainant has Rights in a name or mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. The Panel allows the Appeal and directs that the Domain Name be transferred to the Complainant.

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Claire Milne

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Ian Lowe

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David King

Dated: 7 January 2011