

DISPUTE RESOLUTION SERVICE

D00008634

Decision of Independent Expert

Emirates

and

Michael Toth

1. The Parties:

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

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

2. The Domain Name(s):

emirates.co.uk (“the Domain Name”)

3. Procedural History:

Reply

Certain parts of the Complainant's reply do not comply with paragraph 6b of the DRS Procedure, which 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 reply includes a substantial body of new evidence as to the extent of the Complainant's reputation in 2002 (ie relevant to the Respondent's alleged knowledge of the Complainant at the date of registration of the Domain Name). This issue was originally raised in the complaint (as one might expect) and was not “newly” raised in the response. Such evidence should have been included in the complaint. I have therefore disregarded those parts of the reply. However, for reasons explained below, the outcome would have been the same even if I had taken this evidence into account.

Non-Standard Submissions

Each party has sought to file two non-standard submissions.

Paragraph 13(b) of the Procedure says that non-standard submissions must contain, as a separate first paragraph, a brief explanation of why there is an exceptional need for the submission and that it is in the Expert's sole discretion whether or not to request the full submission. Paragraph 12(b) provides that the Expert shall determine the admissibility, relevance, materiality and weight of the evidence.

I refer also to paragraph 5.3 of the DRS Expert Overview on Nominet's website which states:

“The Procedure is intended to provide a satisfactory basis for expeditious and cost-effective resolution of domain name disputes within the ambit of the Policy. Unsolicited further statements from the parties tend to run counter to that intention. If one party is permitted to submit a further statement, the Expert will normally, in the interests of justice, permit an answering submission from the other party. The case gets weighed down with paper and delays ensue. Experts will normally require an explanation from the party wishing to submit an additional submission, justifying a departure from the prescribed procedure.”

The separate first paragraph to the Respondent's first submission stated that its purpose was to respond to the new matters raised in the reply and also to submit new evidence that did not exist or that he “did not have” at the time of the

response. It was impossible to assess how much of this submission was likely to be justified by exceptional need and so I asked to see the entire submission. I also gave the Complainant an opportunity to make a further submission in response, which it did. The Respondent then filed a further request seeking to respond to new matters allegedly raised in the Complainant's submission. Again, I asked to see this.

I have now reviewed these three non-standard submissions against the criteria of "exceptional need" and concluded that they are admissible only to the limited extent set out below under "Parties' Contentions".

I considered that, for the most part, there was a lack of exceptional need as these (lengthy) submissions addressed issues which could have been raised in the original pleadings and/or repeated the pleadings and/or responded to those matters raised in the reply which (I have concluded above) are themselves inadmissible and / or covered areas of peripheral relevance to the case or which were unnecessary for me to decide.

I decided not to request the full version of the Complainant's second non-standard submission as it was filed shortly before the decision was due and I considered that its content – as summarised in the explanatory first paragraph - was unlikely to be material to the decision.

4. Factual Background

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 owns, *inter alia*, the following registered trade marks:

- 1 the stylised word "Emirates" together with Arabic characters in a design (stated to be a transliteration of "Al-Imarat" meaning "The Emirates"):
 - a. UK registered trade mark (2023709) in class 39, dated June 1995;
 - b. Community trade mark (22137) in class 39, dated April 1996; and
 - c. US registered trade mark (2254666) in class 39, dated August 1996.
- 2 the words "Emirates Holidays" in stylised form together with the Arabic design referred to above:
 - a. UK registered trade mark (2023708) in classes 39 and 42, dated June 1995; and
 - b. UK registered trade mark (2399015) in classes 39 and 43, dated August 1995; and
- 3 word EMIRATES: US registered trade mark (2495959) in class 39, dated June 2000.

The Complainant has operated its main website at emirates.com since 1998. It launched another website, at emirates-holidays.com, in 1999.

The Respondent registered the Domain Name on 4 April 2002.

As of 14 May 2010, the Domain Name resolved to a website. The home page was branded "Emirates.co.uk" (in stylised form) and bore the heading "The United Arab Emirates Resource Guide". The home page was divided into small sections headed "Hotels in Dubai", "Car Hire", "Emirates Holidays", "Flights to the Emirates", "Property Buying" and "Facts and Figures". Each of these sections linked to more detailed content. At the bottom of the home page, there was a notice stating: "Please note that this site is not affiliated with the Emirates Airline." This disclaimer linked to the Complainant's site.

5. Parties' Contentions

Complaint

Rights

The Complainant is one of the world's fastest growing airlines. It flies to over 90 destinations in 59 countries.

In 2003, the Complainant placed the largest aviation order in history - 71 new aircraft. The Complainant also ordered 42 Boeing 777 aircraft at the 2005 Dubai Airshow in a deal worth US\$9.7 billion and, in November 2007, the Complainant ordered 120 aircraft worth US\$34.9n billion.

In addition to passenger air services, the Complainant's business activities include: freight services (Emirates Sky Cargo); ground logistics and tourism (Arabian Adventures); aircraft engineering and maintenance (Emirates Engineering); and outbound tour operator (Emirates Holidays).

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. Marketing staff in the Complainant's head office in Dubai co-ordinate marketing of the Complainant's services. Sales teams promote the Complainant's services via road shows, seminars and personal visits to members of the travel industry - such as travel agents. The Complainant's services are also promoted to consumers by the staff of the Complainant's offices or agents located in numerous cities around the world including London, Manchester and Birmingham and through emirates.com.

Internationally, the Complainant has entered into high profile sponsorship deals including sponsorship of Arsenal Football Club (the Emirates stadium and the team shirts), the FIFA World Cup 2006, AC Milan and the Rugby World Cup 2007. The Complainant is also a major sponsor of events in golf, tennis, horse-racing, sailing and Australian Rules Football.

For the financial year ending 31 March 2008, the Complainant announced net profits of AED (UAE Dirham) 5 billion (US\$1.3 billion). Total revenue in 2007-2008 was AED 38.8 billion (US\$ 10.56 billion), an increase of 62.14 % over the previous

year. The Complainant's revenue for year ending 31 March 2010 was AED 43.5 billion (US\$11.8 billion) with net profits of AED 3.5 billion (US\$964 million), an increase of 416 % over the 2008/2009 profits.

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

The disputed domain name is conceptually and aurally identical to the Complainant's "Emirates" trade marks. The domain name is identical and/or similar to trade marks in which the Complainant has rights.

Abusive Registration

The Respondent is an individual who currently owns 2665 '.co.uk' and '.org.uk' domain names. Many of these domain names correspond to the trade marks of third parties including conservative-party.co.uk, dylanthomas.co.uk, starwarsbooks.co.uk, banzai.co.uk, banzai.org.uk, borderbook.co.uk, cokemachines.co.uk, eastenders.org.uk.

According to reports on the internet, the Respondent set up a small computer repair and networking company in 1996. He developed a piece of software to catch any domain names which were returned to Nominet and then registered them. He sits on the Policy Advisory Board (PAB) of Nominet. According to web postings, he stood for the PAB "to change things from the inside" and is "involved in trying to make changes to the DRS system, which is now very much in favour of the complainant".

The Respondent has at least two Nominet decisions against him - *bounce.co.uk*, DRS 3316 and *universityoflondon.co.uk*, DRS1740.

The Respondent registered the Domain Name on 4 April 2002. This was:

1. over 11 years after the Complainant was incorporated in Dubai;
2. over four years after the Complainant began operating its website at www.emirates.com;
3. over five years after the Complainant registered "Emirates" as a UK trade mark; and
4. over three years after the Complainant registered "Emirates" as a Community trade mark.

The Respondent's website purports to be a "resource guide" to the United Arab Emirates. However, at the top of the home page there is stylised wording for "Emirates" not dissimilar to the Complainant's wording. In addition, there are various links on the website to services such as hotels, car hire, flights, holidays and travel insurance, which are services which the Complainant provides.

The Complainant's solicitors sent a pre-action letter to the Respondent on 16 April 2008 requesting transfer of the domain name. There has been some further correspondence between the parties, but no transfer of the domain name has taken place.

The Domain Name was registered as a blocking registration against a mark in which the Complainant has a major international reputation. The Complainant's capacity to promote its brand through the Domain Name has been blocked. Accordingly, paragraph 3(a)(i)(B) of the Policy is satisfied.

The Domain Name was registered for the purpose of unfairly disrupting the business of the Complainant (Policy 3(a)(i)(C)), and/or otherwise taking unfair advantage of the Complainant's rights, for the following reasons:

First, the Respondent is in the business of providing online links and search services related to air travel and must have been aware of the Complainant and its brand, trade marks and business when it registered and used the Domain Name.

Second, the Respondent registered the Domain Name after the Complainant registered and used its trade marks for "Emirates". Where a mark is world famous, as in this case, it is "not one traders would legitimately choose unless seeking to create an impression of an association" with the Complainant per the UDRP decision in *Telstra Corp. Ltd v Nuclear Marshmallows (WIPO Case No. D2000-0003)*.

Third, the wording and location of the disclaimer is insufficient to avoid unfairly disrupting the business of the Complainant. It is located right at the bottom of the screen and a visitor to the Website would have to scroll down to see it (if they ever in fact do so).

The Respondent is using the Domain Name in a way likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant in accordance with paragraph 3(a)(ii) of the Policy. The Respondent's use of an ineffective disclaimer suggest that he appreciates that the public will be confused into thinking there is a connection between the Domain Name and the Complainant's businesses.

As a result, the Respondent's business is unfairly advantaged, and/or the Complainant's business is unfairly disadvantaged. Accordingly, paragraph 2(a)(ii) of the Policy is satisfied.

The Respondent is engaged in a pattern of registrations which correspond to well-known names or trade marks in which the Respondent has no apparent rights. The Domain Name is part of this pattern. Specifically, the Respondent has previously registered at least one other Emirates domain name, *emirates.eu*. In 2009, the Czech Arbitration Court ordered the revocation of this domain name and found that it had been registered and was being used in bad faith. *Emirates v Stichting Roos Beheer Case No. 0540*. The Respondent was held to be the beneficial owner of the domain. Accordingly, paragraph 3(a)(iii) of the Policy is satisfied.

The Complainant does not believe that the Respondent can demonstrate any circumstances that would evidence that the registration of the Domain Name was not an abusive registration for the purpose of paragraph 4 of the Policy.

First, since the Respondent must have been aware of the Complainant when it registered the Domain Name, the Respondent was aware of the Complainant's cause for complaint when it registered and used the Domain Name (Policy 4(a)(i)).

Second, the Respondent's use is neither legitimate non-commercial, nor fair, use of the Domain Name; nor is the Domain Name generic or descriptive (Policy 4(a)(ii)). In *Emirates Corporation -v- 2220 Internet Coordinator, WIPO Case No D2005-1311* the WIPO Panel found that the internet domain name emiratescareers.com was confusingly similar to the name "Emirates". The panel accepted that the word EMIRATES has acquired a secondary significance and that it connoted the Complainant more so than it did the region known as the United Arab Emirates. The panel indicated that "there are few ways in which the Respondent could legitimately use the disputed domain name or prove its own right to the name ... any such use would require the utmost bona fide character." Similarly, in *Emirates v. Domain Admin, WIPO Case No. D2007-1674*, the panel recognised that "the Complainant has numerous registered trademarks for EMIRATES and [recognised] the high degree of international renown attaching to these marks". In *Emirates v Stichting Roos Beheer, supra* the panel said that: "In all the circumstances the Panel concludes that 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".

Response

Complainant's Delay

There has been unconscionable delay in bringing this claim. The Domain Name was registered over 8 years ago and the website on it was operational soon afterwards. The Respondent can evidence its use at least by 2004 but believes it was used even earlier.

Much turns on the Respondent's choice of the Domain Name for its plain dictionary meaning; and the Complainant's alleged acquired secondary meaning. The Respondent denies that the Complainant should be allowed to try to monopolise a common English word. The extreme delay in bringing this claim makes it harder to gather evidence and so unfairly prejudices the Respondent's ability to respond to it.

Complainant's Rights

The Complainant's registered trade marks are admitted, although two of them were allowed to lapse in 2005. None are identical to the domain, since they either include additional words that qualify them or an Arabic design.

Abusive Registration

The Complainant provides no evidence of the scale of its operations in the UK in 2002, when the Domain Name was registered. It does however submit a substantial body of evidence that describes how the Complainant has grown in the intervening eight years.

The Complainant's undoubted extreme growth in the intervening years means that it enjoys a considerably greater public awareness now than in 2002. When

considering abusive registration, the Panel should limit its assessment to the Complainant's proven reputation and goodwill in 2002. The complaint admits that the Complainant has a "comparatively short history" and is fast growing. It would be inequitable if the Complainant's unexplained delay in bringing this complaint should benefit it as a consequence of its growth subsequent to registration of the Domain Name more than eight years ago.

Due to the passage of time, the Respondent does not believe that it was aware of the Complainant in 2002. The Respondent can, however, say with certainty that it did not have the Complainant in mind when it registered the Domain Name. His motive for registering the Domain Name 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 is a middle-eastern federation of seven emirates. There are several independent emirates that are not in the UAE. The use of a country name is common for flag carrier airlines, but this does not entitle it to monopolise that country's generic domain name.

A large number of other "emirates" related websites are in use that are not owned or controlled by the complainant.

There are numerous registered UK and EU trade marks including EMIRATES, many of which cover the same classes as those the Complainant's registrations.

The classification of services in the Complainant's trade marks is limited to operating an airline, something that the Respondent does not do and his website does not suggest that he does.

The Complainant's assertions and implications made against the Respondent's character are unfounded. His views were legitimate, as confirmed by a letter from the former Chairman of Nominet's PAB.

It is denied that the website at the Domain Name has a similar get up to the Complainant's website. The Respondent's website relates to the United Arab Emirates. The Complainant's website is an airline website.

The headings are dissimilar. The Respondent's is white, in a distinctive font and has a depiction of a "minaret" in place of the dot on the letter "i". The Complainant's is either red or gold; is a totally different font; has a normal letter "i" and also has the Arabic depiction annexed to it that the Respondent's does not.

The Respondent relies on the decision of the appeal panel in *verbatim.co.uk*, DRS 4331 in particular paragraph 8.13 concerning knowledge / intent.

The Complainant has failed in its duty to establish the "major international reputation" it asserts it had over eight years ago.

The Domain Name was not a blocking registration. There is no evidence to support this. Where the Complainant also has the relevant country code domain, the user is re-directed to emirates.com.

The website on the Domain Name is a genuine and bona fide offering of information (including a page about property development and also a link giving up to date local weather details) about the United Arab Emirates. It also includes advertising links to suppliers of relevant goods and services. This is a perfectly legitimate and descriptive use of the Domain Name. It is not merely a pay per click site, although in any event PPC use of a descriptive domain such as this would be lawful and is expressly permitted under the DRS (paragraph 4(e)).

The website on the Domain Name was first developed and used in or before 2004 as indicated on the copyright notice on the website. Due to the passage of time, the Respondent does not have records of exactly when such use commenced but in any event it was long before the Respondent first received notice of the Complainant's complaint through its solicitors' letter of 2008.

The Complainant's reference to *Telstra Corp. Ltd v Nuclear Marshmallows, supra*, is wholly misconceived. In that case, the mark in question was the unique brand of Telstra. This is a generic and descriptive word, "emirates".

The more appropriate test is the often cited one in *chivasbrothers.co.uk, DRS 292*. The test in that case does not apply as the Domain Name is not exclusively referable to the Complainant; there is an obvious innocent justification for having registered the Domain Name and the Respondent has set out the legitimate explanation for having selected it.

The disclaimer on the website was inserted when the Respondent became aware of the Complainant's increasing profile. Contrary to what is suggested in the complaint, the disclaimer is evidence of the Respondent's bona fides. It shows that he does not want to profit unfairly from the Complainant's goodwill and it also provides a direct link to the Complainant's website. That link does not generate any revenues.

If the Respondent wanted to take unfair advantage of the Complainant's rights, more likely that there would be advertising or paid for links to the Complainant's site, whereas there are none. The Respondent took steps with the advertising provider to prevent adverts for the Complainant's website from appearing.

In contrast, the emirates.com.au website – where the Complainant's auDRP complaint failed – has a disclaimer, and also appears to have adverts that go direct to the Complainant's site, generating revenue for the registrant. Despite this, the use of the emirates.com.au domain was held to be in good faith.

The complaint contains no evidence of actual confusion, despite the co-existence of the Domain Name and emirates.com for over eight years. Given the current scale of their business, the absence of actual confusion after this length of time is compelling evidence that there is also no likelihood of confusion. The Respondent has a successful website that provides information about the UAE to visitors. There

is nothing on the site that suggests a connection to the Complainant and the only reference to it is made in a descriptive context as a provider of flights to the United Arab Emirates.

There are appellate DRS authorities (*myspace.co.uk*, DRS 04962, *oasis.co.uk*, DRS 06365), stating that where a domain is in legitimate use, a change in the status of the Complainant does not give rise to a finding of an abusive registration provided that the Respondent does nothing actively to exploit his position. The Respondent has done the opposite of seeking to actively exploit his position – he has provided a clear statement and a free of charge link to the Complainant’s site.

There are parallels with *oasis.co.uk*. Both are generic and descriptive single words and involving trade mark registrations predating registration of the domain names. However, the facts in *oasis.co.uk* only demonstrated plans to use, whereas the Respondent has demonstrated at least six years of bona fide actual use of the domain; and also here there are no allegations of adverts that refer directly to the Complainant.

The Respondent denies that his domain portfolio shows that he engages in a pattern of abusive registrations. Paragraph 4(d) of the Policy explicitly accepts that owning a large portfolio of domains is of itself a lawful activity. Out of a portfolio of 2665 domains, the Complainant alleges that only a handful are abusive. The Respondent denies that the domains that it refers to are necessarily abusive – e.g. *banzai* is a well known Japanese expression that is well known to English speakers.

The Domain Name is part of a much bigger pattern of country and place names that the Respondent has registered consisting of around 210 country names and around 35 place names.

Around the time that the Respondent registered the Domain Name, the Respondent was registering a large number of generic .uk domains because of their intrinsic value. On the same day, he registered over 30 generic names including *gmv.co.uk*, *celebrate.co.uk*, *pickle.co.uk*, *sheets.co.uk*, *treacle.co.uk*, *witches.co.uk*. The Respondent would look through lists of thousands of domains a day that were due to become available and register a number each day. He did not have time to do more than form a personal opinion about a domain – in essence was it a common English word or phrase that he had heard and/or was it related to other domains that he had already registered and had plans to develop? Country and geographical names followed this plan.

His intention when registering these geographic domains was to use them for a cluster of country-related resource guides.

In *verbatim.co.uk*, *supra* at paragraph 8.16(b), the appeal panel rejected the same allegation against the Respondent’s portfolio on the basis that the domain names featuring the names / trade marks of others were only a very small proportion of the overall portfolio and largely recognisable as being the names / trade marks of others whereas the domain name was an ordinary dictionary word.

No weight can be placed on *bounce.co.uk, supra*, given the warning and Nominet's apology placed on the face of the decision.

The decision in *emirates.eu, supra*, can be distinguished. The panellist erred in finding that the registrant could have bona fide rights to the domain and also registered and used in bad faith. The panellist made incorrect findings concerning dictionary entries. The Respondent refers to the auDRP decision in *emirates.com.au*. In addition, the .eu dispute mechanism allows for a finding against the registrant even where (as was held in that case) only bad faith registration has been found, even where the registrant was held to have rights in the domain. The DRS Policy does not permit such a distinction. The relevant date in the two cases is also very different. The .eu registration was many years after the 2002 registration of the Domain Name.

The UDRP cases cited in the complaint relate to uncontested disputes with domains that often explicitly related to the Complainant. The registrations also significantly post-date the registration in this case.

The Domain Name is being used in connection with a bona fide offering of goods or services – namely the descriptive use made of the Domain Name in respect of the website found at the domain. This use pre-dates the initial letter of complaint from the Complainant's solicitors by at least four years. This use satisfies the requirements of Policy, paragraph 4(a)(i)A.

The Respondent has routinely included reference to his registration of the Domain Name *emirates.co.uk* in his email signature and it was generally known in the domain name industry that he had a website at the Domain Name. Therefore he is legitimately associated with the mark, in accordance with Policy paragraph 4(a)(i)B.

The Domain Name is generic and descriptive and he is making fair use of it in accordance with Policy paragraph 4(a)(ii). The Respondent refers to the appeal panel decision in *maestro.co.uk DRS 4884* 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 and, if not displaced by an overwhelming secondary meaning, the evidence of abuse will have to be very persuasive if it is to be held abusive.

No evidence of any overwhelming secondary meaning, at the time of the Domain Name's registration and first use, has been provided. It is beholden on the Complainant to have proved it in the complaint but it has not done so, beyond making bare assertions about the Complainant's alleged reputation in 2002 and confirming that it has grown rapidly in its short history.

Reply

Delay

It is not accepted that a 'delay' in bringing a complaint is a reason for it not to succeed. There is nothing in Nominet's Policy, nor any authorities submitted by

the Respondent, which state that delay is a factor which the Expert should consider relevant.

In any case, the Respondent is not unfairly prejudiced by that delay. The majority of the content of the website has not changed at all within the past five years. The 'Local News' section dates from September 2005. The 'Live Weather' link was last updated in April 2007.

The Complainant did not respond to the assertions by the Respondent's solicitors in 2008 because it had become clear to the Complainant by then that formal Nominet proceedings would be necessary.

Complainant's reputation in 2002

A great deal of evidence has already been submitted in respect of the Complainant's goodwill in the period up to 2002. For example, the list of awards won by the Complainant.

In any case, the *verbatim.co.uk* appeal decision makes clear that "intention" is not a necessary ingredient for a complaint under 3(a)(ii) of the Policy.

Furthermore the Respondent makes specific reference to the Complainant on the website. Even if the Respondent had not heard of the Complainant when he registered the Domain Name in 2002 (which the Complainant considers inconceivable) it is even more doubtful this was the case when the website became operational, presumably in 2004. The panel in *verbatim.co.uk* states 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 commencement of an objectionable use of the Domain Name".

Assessing goodwill

Use of a domain name, subsequent to its registration, can constitute abusive registration. The relevant date for assessing the Complainant's goodwill can in fact be later than the date the Domain Name was registered.

The Respondent submits that his website was operational in 2004 or possibly in 2003. The only evidence is the copyright notice on the website which is dated 2004. The Respondent has blocked access to viewing details and dates of historic pages of the website at the internet archive website.

The trade mark Emirates

The Respondent has suggested some of the Complainant's trade marks have "lapsed", though it does not specify which. The UK Intellectual Property Office confirmed that each of the UK and Community trade marks referred to in the Complaint are currently registered trade marks. Additionally, there is no evidence that the US trade mark referred to in the Complaint has lapsed.

The Respondent states that none of the trade marks are identical to the Domain Name. The "Holidays" element of "Emirates Holidays" is a descriptive element, and

therefore the mark and the Domain Name are effectively identical. As for the Arabic design, it is not possible to include an Arabic design in a domain name.

The Respondent states that the Domain Name is part of a pattern of country and place names which he has registered as domain names. But 'Emirates' is not a common geographic term in the same way as many country or even regional terms eg people may say they are travelling to Argentina but no-one says they are travelling to "Emirates". This is because "Emirates" is in fact not primarily geographically descriptive; it can refer to several places and, as *Emirates Corporation -v- 2220 Internet Coordinator, supra*, makes clear, it connotes the Complainant more so than it does the UAE.

Confusion

There are prominent references to hotels, holidays and flights on the home page and other pages of the website. For example, a click on the "Flights" link brings up a page entitled "Emirates Flights". There is an obvious risk that consumers will be confused into believing the site is connected with the Complainant.

The implication the "Contact Us" section of the website is that the Respondent has received queries from customers confusing the website with the Complainant. For example: "Please do not contact us regarding your flight" and "Do not press send if you need to contact Emirates Airline".

Other points

The views of a former chair of the Nominet Policy Advisory Board are not relevant to this case.

Respondent's First Non-Standard Submission

As to the broken links referred to in the reply, the server hosting the website suffered a total failure in 2008. The server was hosting a number of the Respondent's main websites and this caused major technical problems. Certain links were broken on this site - e.g. out of date weather and other feed information appeared and has not been remedied. However, this should not detract 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 exhibits to the Response include some of the original templates for the site (taken from the Respondent's web designer's website) and a print out from web archive, confirming that those pages were created in 2004. This is more than adequate evidence of preparation for use, which started in either 2003 or 2004. If the panel finds otherwise, the Respondent points out that it would have been better able to produce further evidence if the complaint had been brought in a timely fashion.

Complainant's First Non-Standard Submission

The Respondent's claim that the reason that the website was not updated was due to a server failure in 2008. This explanation is implausible. It has not properly

explained how links broken on the website in 2008 have therefore resulted in links dating back to 2005 remaining on the website. Notwithstanding that point, it is difficult to accept that, if the website really was a "proper website with unique content", the problems would remain unremedied in 2010.

Respondent's Second Non-Standard Submission

Now that the Respondent is aware of the problem with the weather links, it has fixed them. He has no in-house technical support and has over a hundred websites in operation, with more being developed. He had simply not noticed the problem with these links after the backup data was uploaded for this and other sites, following the server failure. The backup version had older data than that which existed prior to the server failure. He has otherwise not altered the site since the DRS started, in order to avoid any possible claim that he tried to mislead the panel.

6. Discussions and Findings

General

To succeed, the Complainant has to prove in accordance with paragraph 2 of the DRS Policy on the balance of probabilities, first, that it has rights (as defined in paragraph 1 of the DRS Policy) in respect of a name or mark identical or similar to the Domain Name and, second, that the Domain Name, in the hands of the Respondent, is an abusive registration (as defined in paragraph 1 of the DRS Policy).

Delay

The Respondent argues that the complaint should be rejected on the grounds of the Complainant's "unconscionable" delay in bringing the claim. However, I have determined that it is unnecessary for me to make any finding on this aspect given that the complaint has failed for other reasons as set out below.

Complainant's rights

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"

While the extent of the Complainant's goodwill at the time of registration of the Domain Name in 2002 is hotly contested (in connection with abusive registration), it is not in dispute that by the date of the complaint - when rights are assessed - the Complainant had acquired unregistered rights in the name "Emirates" arising from its extensive trading activities in the UK and elsewhere. This mark is identical to the Domain Name.

The Complainant also has rights deriving from its registered UK and Community trade marks consisting of the prominent stylised word "Emirates" plus Arab characters in a design. These marks are similar to the Domain Name.

Abusive registration – introduction

Is the Domain Name an abusive registration in the hands of the Respondent? Paragraph 1 of the DRS Policy defines “abusive registration” as a domain name which either:-

- “i. 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*
- ii. has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”*

The Respondent’s views concerning the DRS

One matter which I should mention at the outset is that the Complainant has drawn attention to the Respondent’s alleged views concerning the DRS, said to have been expressed in connection with his election to Nominet’s Policy Advisory Board. I have disregarded these matters entirely as in my view they are irrelevant to the complaint.

Knowledge / intent

The level of knowledge / intent required for the purposes of abusive registration was set out by the appeal panel in *verbatim.co.uk, DRS 4331* as follows:

“8.13. In this Panel’s view the following should be the approach to the issues of knowledge and intent in relation to the factors listed under paragraph 3 of the Policy:

- (1) First, some knowledge of the Complainant and/or its brand/rights is a pre-requisite for a successful complaint under all heads of the DRS Policy other than paragraph 3(a)(iv) (giving false contact details). The DNS is a first-come-first-served system. The Panel cannot at present conceive of any circumstances under which a domain name registrant, wholly unaware of the Complainant and its Rights, can be said to be taking unfair advantage of or causing unfair detriment to the Complainant’s Rights.*
- (2) Secondly, ‘knowledge’ and ‘intention’ are pre-requisites for a successful complaint under all heads of paragraph 3(a)(i) of the Policy. The wording of that paragraph expressly calls for the relevant intent, which cannot exist without the relevant knowledge.*
- (3) Thirdly, ‘intention’ is not a necessary ingredient for a complaint under paragraph 3(a)(ii) of the DRS Policy. The test is more objective than that. However, some knowledge of the Complainant or its name/brand is a pre-requisite.*
- (4) Fourthly, while some knowledge of the Complainant or its name/brand is a pre-requisite for a successful complaint under the DRS Policy (save for a complaint under paragraph 3(a)(iv)), knowledge is not of itself*

conclusive in favour of the Complainant. The Expert/Appeal Panel will still need to be satisfied that the registration/use takes unfair advantage of or is causing unfair detriment to the Complainant's Rights.

(5) Fifthly, 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.

8.14. Accordingly, in the view of this Panel, for this 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 is clear that in the case of trade marks which are dictionary words, knowledge of the Complainant or its trade mark is not of itself sufficient. For example, the appeal panel in *maestro.co.uk*, DRS 4884 stated:

“... knowledge of the Complainant's trade mark only gets the Complainant part of the way. 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. Were it otherwise, owners of trade marks which are dictionary words would effectively be able to monopolise the use of such words for domain names...

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.”

See also *oasis.co.uk* (DRS 6365), where the appeal panel observed at paragraph 8.10:

*“...absent any evidence that the Respondent was purchasing the Domain Name as part of some sort of deliberate scheme to take advantage of the Complainant's established name and business (and there is no such evidence), even had the Respondent known of the Complainant's business that does not itself make the purchase of a Domain Name, which comprises an ordinary English word, objectionable. This is not a case where the word is a made up word which, if contained within a domain name, inevitably raises at least an inference that it will be associated with the party most commonly associated with the word. In such cases an Expert can infer that the purpose of the purchase was to take advantage of that connection. It would for example be relatively easy to infer (at least absent any credible explanation) that a third party purchasing, say, *kodak.co.uk* intended to take advantage of the name and reputation enjoyed by the well known*

Kodak company. The same is not true where the name comprises a common English word where any number of uses may be perfectly unobjectionable – particularly where, as here, the evidence shows a large number of trade marks for that word co-exist.”

Respondent’s knowledge of the Complainant in 2002

The Complainant says that the Respondent is in the business of providing online links and search services related to air travel and must have been aware of the Complainant and its brand, trade marks and business when it registered and used the Domain Name. The Complainant points out that registration of the Domain Name occurred some 11 years after the Complainant’s incorporation, four years after the Complainant starting using its website at emirates.com and three / five years after registration of the Complainant’s UK and Community trade marks respectively. The Complainant exhibits to the complaint a limited amount of the evidence relevant to the Complainant’s reputation in the UK in 2002. This consists principally of a list of awards won by the Complainant, some of which derive from UK national newspapers and trade publications.

The Respondent says that, due to the passage of time, he cannot say whether or not he was aware of the Complainant in 2002. However, he maintains with certainty that, even if aware of the Complainant, he did not have the Complainant in mind when registering the Domain Name.

For the moment, it is convenient to proceed on the assumption (without having reached a conclusion either way) that the Respondent was indeed aware of the existence of the Complainant or its trade marks at the time of registration of the Domain Name.

Respondent’s purpose in registering the Domain Name

The Respondent says that his motive for registering the Domain Name was simply that “emirates” is commonly used in the vernacular to describe the United Arab Emirates as well as a generic word meaning countries ruled by an emir. He says it forms part of a pattern around 210 country names and around 35 place names registered by the Respondent including the following, all registered in the first four months of 2002:

Countries

Argentina.co.uk 31st January 2002
Canada.co.uk 31st January 2002
Ecuador.co.uk 31st January 2002
Ibiza.co.uk 31st January 2002
Frenchpolynesia.co.uk 23rd April 2002
Herzegovina.co.uk 23rd April 2002
Marshallislands.co.uk 23rd April 2002
saintkitts.co.uk 23rd April 2002
oldengland.co.uk 25th April 2002
aussie.co.uk 23rd April 2002

Towns

Berwick.co.uk 31st January 2002

Guisborough.co.uk 31st January 2002
Peterhead.co.uk 31st January 2002
Atlanta.co.uk 4th February 2002
Penrith.co.uk 16th February 2002

The Complainant claims that “Emirates” is not a common geographic term in the same way as many country or even regional terms because, while for example, people may say they are travelling to Argentina, no-one says they are travelling to “Emirates”. The Complainant says that this is because “Emirates” is not in fact primarily geographically descriptive but it can refer to several places and that the UDRP case of *Emirates Corporation -v- 2220 Internet Coordinator, WIPO Case No D2005-1311* makes clear that it connotes the Complainant more so than it does the United Arab Emirates. The Complainant also invokes the UDRP case *Emirates v. Domain Admin, WIPO Case No. D2007-1674* where the panel recognised that “the Complainant has numerous registered trademarks for EMIRATES and [recognised] the high degree of international renown attaching to these marks”. The Complainant further invokes *Emirates v Stichting Roos Beheer, Case No. 0540* (concerning emirates.eu) where the panel said that: “In all the circumstances the Panel concludes that 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”.

I am, however, satisfied from the extensive evidence exhibited to the response that “emirates” is a generic word meaning both the plural form of “emirate”, a country ruled by an emir, and is also a generic name used widely and colloquially to refer to the United Arab Emirates (a federation of seven independent emirates). There is significant evidence of third party use of the term “Emirates” in a way which denotes a geographic connection with the United Arab Emirates eg “Emirates Racing Authority”, “Emirates Palace Hotel”, “Emirates Scout Association”, “Emirates Shipping Line” and “Emirates NBD Bank”, to name but a few.

Whether or not people say that they “are travelling to ‘Emirates’” (as denied by the Complainant), it is nonetheless clear from the evidence that the term is widely used as shorthand for the United Arab Emirates.

I do not find the two cited UDRP cases or the emirates.eu case to be of assistance here. These were factual conclusions by different panels under different dispute systems and indeed the two UDRP cases were undefended. (See further below as to the emirates.eu decision.) Indeed, the Respondent has drawn attention to an auDRP case *Emirates, Emirates Group v. Bluecom Consulting Group Pty Ltd, WIPO Case No. DAU2008-0004* (emirates.com.au) where yet another panel took a different view and the Complainant’s case failed.

I have to decide this case on the basis of the evidence provided by the parties in this case. My conclusion is that, while there is no doubt that the Complainant has by now acquired a very substantial reputation in the name “Emirates”, the Complainant has not established that its name has now, or at any stage, “displaced” the generic meaning of the term (per *maestro.co.uk, supra*). Accordingly, the evidence of abuse from the Complainant needs to be “very persuasive”.

Whether or not the Respondent was aware of the Complainant on registration of the Domain Name in 2002, I have no reason to disbelieve the Respondent's above explanation of his purpose in registering the Domain Name. While "Emirates" is a colloquial / shorthand rather than the exact name of a territory, nonetheless it seems to me that the Domain Name still fits broadly within the pattern of the Respondent's country / place domain names, fifteen of which were registered within a few months of the Domain Name.

Blocking

The Complainant asserts that the Respondent registered the Domain Name primarily as a blocking registration against a name or mark in which the Complainant has rights, under paragraph 3(a)(i)(B) of the Policy.

The Complainant says that its capacity to promote its brand through the Domain Name has been blocked. However, this is not of itself sufficient. This provision requires "intent" on the Respondent (see *verbatim.co.uk, supra*). As explained above, I do not believe that the Complainant has established such intent on the part of the Respondent as at the date of registration of the Domain Name.

Disruption

The Complainant also argues that the Respondent registered the Domain Name primarily for the purpose of unfairly disrupting the business of the Complainant under paragraph 3(a)(i)(C).

As in the case of blocking, this head also fails for lack of relevant intent on the Respondent's part as of the date of registration.

The Complainant argues, *inter alia*, that its mark is world famous and that the Domain Name is not one a trader would legitimately choose unless seeking to create an impression of an association with the Complainant per the UDRP decision in *Telstra Corp. Ltd v Nuclear Marshmallows (WIPO Case No. D2000-0003)*. But that case was concerned with a trade mark which was a distinctive, coined term – entirely different from the name at issue in this case.

The Complainant also relies on the assertion that "the wording and location of the disclaimer is insufficient to avoid unfairly disrupting the business of the Complainant" due to its location at the bottom of the page. By this the Complainant appears to be implying that the content of the Respondent's website is designed to disrupt the Complainant's business and that the disclaimer is ineffective to prevent this. In any case, the Complainant has not established that the Respondent registered the Domain Name for the primary purpose of disrupting the Complainant. Whether or not the content of the website amounts to abusive use of the Domain Name (ie under the second limb of the abusive registration test) is a separate matter which is covered below.

Pattern

The Complainant invokes paragraph 3a(ii) of the Policy:

“iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trade marks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern”

The Complainant, relies, first on the domain name emirates.eu which it alleges (and the Respondent does not deny) is beneficially owned by the Respondent and which was the subject of a finding of bad faith by the Czech Arbitration Court in *Emirates v Stichting Roos Beheer, supra*.

In my view, emirates.eu does not constitute a pattern under paragraph 3a(ii). Aside from whether a single domain name can constitute a pattern, emirates.eu is (for present purposes) materially the same as the Domain Name whereas the purpose of 3a(ii) as explained in paragraph 3.5 of the DRS Expert Overview is “to simplify matters for a Complainant, where the only available evidence against the registrant is that he is a habitual registrant of domain names featuring the names or marks of others.” Whether or not emirates.eu “correspond[s] to well-known names or trade marks in which the Respondent has no apparent rights” begs similar questions to those at issue in this case and does not of itself indicate a habitual pattern of illicit registrations. My conclusion is not altered by the fact that a panel operating under the different .eu domain arbitration system has reached a conclusion of bad faith based on whatever evidence was provided in that case.

The Complainant also refers to the Respondent’s portfolio of some 2,600 .uk domain names, “many” of which are said correspond to trade marks of third parties. Examples given are conservative-party.co.uk, dylanthomas.co.uk, starwarsbooks.co.uk, banzai.co.uk, banzai.org.uk, www.borderbook.co.uk, cokemachines.co.uk, eastenders.org.uk.

See, however, *maestro.co.uk, supra*, (involving the same Respondent as in this case), where the appeal panel concluded that the disputed domain name was not part of a pattern because:

- a) the other domain names relied upon were well-known trade marks or combinations which are not common expressions whereas the disputed domain name was known as much for its ordinary English meaning as for anything else;
- b) the disputed domain name was registered in a different time period to the other domain names; and
- c) the domain names identified were only a small part of the Respondent’s portfolio.

Similarly, here, the domain names identified by the Complainant are only a very small part of the portfolio, the offending domain names are mostly well-known trade marks and (as I have concluded above) the disputed domain name is known as much for its ordinary English meaning as for anything else. Indeed, as explained, I believe that in fact the Domain Name falls within a separate and genuine pattern of domain names reflecting country / place names.

The Complainant refers to two Nominet decision against the Respondent: - *bounce.co.uk*, DRS 3316 and *universityoflondon.co.uk*, DRS1740. It is not clear whether that is in connection with paragraph 3(a)(ii). In any case, no weight can be placed on *bounce.co.uk* in light of the Nominet apology and caveat placed at the top of that decision. The effect of the other decision is to increase marginally the small list of offending domain names mentioned above but this does not affect my conclusion that the Complainant has failed to establish a pattern under paragraph 3(a)(ii).

Abusive use

The Complainant asserts that the Respondent is using the Domain Name in a way likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant in accordance with paragraph 3(a)(ii) of the Policy.

In respect of this paragraph, the appeal panel in *verbatim, supra* concluded that intention was not necessary. "The test is more objective than that."

The Respondent counters that the Domain Name is generic or descriptive and that the Respondent is making fair use of it per paragraph 4a(ii) of the Policy.

The Respondent has drawn attention to *oasis.co.uk*, DRS 6365 where the appeal panel stated at paragraph 8.29:

*"The Panel has also had regard to the appeal decision in DRS 04962 MySpace, Inc v Total Web Solutions Limited concerning *myspace.co.uk*, given that it also considers abuse arising out of the behaviour of a parking page, and given the extensive consideration of that decision by the Expert in his decision in the current matter. The Panel in the MySpace decision concluded that "However, the registration of domain names is still a first-come-first-served system and the Panel is reluctant to place any duty on a registrant, who has merely had the good fortune (or maybe ill fortune) to register a name in good faith, which subsequently, through no fault of his own, acquires notoriety, **provided that he does nothing actively to exploit his position**". [emphasis added]*

It seems to the Panel in the present case that such reasoning is even more applicable in circumstances where, as here, not only has the Respondent done nothing actively to exploit his position, but in fact it is the Complainant's actions which have caused the behaviour of which complaint is made."

The appeal panel in *myspace.co.uk* had also observed:

"To date experts and Appeal panels have reasonably consistently taken the view that if a registrant acquires a domain name in advance of the coming into existence of the complainant's rights, the registrant is entitled in principle to hold onto the domain name and to use it, notwithstanding that confusion of the 'initial interest' variety may be inevitable."

The facts of this case are different from *myspace.co.uk* (domain name registered before rights existed) and *oasis.co.uk* (respondent unaware of complainant at the time of registration whereas here I am assuming the Respondent was so aware). Nonetheless, in light of my conclusion that the Respondent registered the Domain Name for a genuine descriptive purpose, it seems to me that one is looking here for evidence of some form of active exploitation by the Respondent of its position vis a vis the Complainant which goes beyond normal descriptive use of the Domain Name. And that the likelihood of confusion, of itself, would not suffice.

I am also mindful that, in the circumstances of this case, “persuasive evidence” of abuse is required, as explained above.

The Respondent says that the site was first used in or before 2004. He says that due to the passage of time he no longer has records of the exact start date but he refers to the copyright notice dated 2004 on the current version of his website as well as screenshots of template pages created by the Respondent’s designer plus a Wayback Machine screenshot from an “emirates” section of the designer’s site showing (only) five entries for 2004, which, he says, confirm that those pages were created in 2004. While the Complainant observes that the Respondent has blocked access to the details / dates of the historic pages of the website at the Domain Name itself, nonetheless there is nothing in the evidence which gives me reason to doubt that the Respondent started using the Domain Name for a website in about 2004.

As mentioned under “Factual Background” above, the website at the Domain Name describes itself as a “resource guide” for the United Arab Emirates including sections on hotels, car hire, holidays, flights, property and facts and figures. The website also includes advertising by suppliers of relevant goods and services. It appears from the 2004 template design pages produced by the Respondent that the website has remained in broadly similar format since that time.

I cannot see anything in the evidence which causes me to think that the Respondent at any time had in mind anything other than a descriptive use of the Domain Name as an information site concerning the “United Arab Emirates”, consistent with the purpose for which he registered it.

The Complainant observes that some of the links on the site (particularly weather and local news) have not been updated for some years and is sceptical of the Respondent’s claim that this was due to a server failure. Whatever the exact reason, it is clear that the site has not received close attention from the Respondent. But this fact does not of itself lead me to believe that the site was not genuine or that it was targeted at the Complainant in some way.

The Complainant draws particular attention to the “flights” section of the website. The home page states: “Flights to the Emirates. Charter flights are becoming increasingly popular as tourists head over to enjoy the sunshine. The schedule carriers also offer regular flights and business and first class are available.” There is then a link to a separate page headed “Emirates Flights” which contains general information about flying to “the Emirates” including the following: “Emirates, Qatar Airways, Gulf Air and British Airways all fly to Dubai International ...

Emirates fly daily from Heathrow ...". There are also a number of sponsored links to flight-related websites eg ""Cheap Dubai Flights".

In my view, it is not unreasonable for a site providing information about flights to the United Arab Emirates to mention the Complainant and indeed other airlines are referred to also.

The Complainant does not place particular weight on the fact of the sponsored links on this or the other pages of the sites. In any case, paragraph 4(e) of the Policy makes clear that such advertising is not of itself objectionable. It states that the Expert is to take into account, *inter alia*, the nature of the domain name and of the advertising links. In my view, in light of the nature of the Domain Name, it was not unreasonable for the Respondent to place on its website sponsored links insofar as connected with a genuine descriptive use of the Domain Name.

The Complainant observes that some of the services covered on the website are provided by the Complainant, such as hotels, car hire, flights, holidays and travel insurance. But these are exactly the kinds of services one might expect to see on a country information site such as this. I do not read anything sinister into the inclusion of those topics on the website.

The Complainant asserts that the Respondent's use of a disclaimer (which it describes as ineffective) suggests that it appreciates that the public will be confused into thinking there is a connection between the Domain Name and the Complainant's business. However, I do not think that much turns on the fact of the disclaimer. If anything, it suggests that the Respondent was out to minimise any possible confusion although I agree with the Complainant that it is not in a prominent position and unlikely to have been effective.

I disagree with the Complainant's assertion that the stylised wording for "Emirates" on the Respondent's website is similar to the Complainant's logo. As the Respondent says, its logo is white, in a distinctive font and has a depiction of a "minaret" in place of the dot on the letter "i". The Complainant's is either red or gold, is in a different font, has a normal letter "i" and also has the Arabic depiction annexed to it that the Respondent's does not.

For the reasons explained above, I conclude that the Complainant has failed to establish that the Respondent has used the Domain Name abusively for the purposes of the second limb of the definition of abusive registration.

Abusive registration - conclusion

The Complainant has failed to establish that the Domain Name is an abusive registration under the Policy.

7. Decision

I decide that no action should be taken in respect of the Domain Name.

Signed : AdamTaylor

Dated: 24 September 2010