

# **DISPUTE RESOLUTION SERVICE**

**D00016769**

## **Decision of Independent Expert**

Dubai Aviation Corporation trading as flydubai

and

Global Travel Domains Ltd

**1. The Parties:**

Lead Complainant: Dubai Aviation Corporation trading as flydubai  
flydubai Headquarters Terminal 2  
Dubai International Airport  
PO Box 353  
Dubai  
United Arab Emirates

Respondent: Global Travel Domains Ltd  
14 Athol Street  
Douglas  
IM1 1JA  
Isle Of Man

**2. The Domain Name:**

flydubai.co.uk

**3. Procedural History:**

I can confirm 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 such a nature as to call into question my independence in the eyes of one or both of the parties.

The dispute was received by the Dispute Resolution Service (DRS) on November 13, 2015. The Complaint was validated on November 16, 2015 and notification of the Complaint was sent to the Parties on the same date.

The Response was received on December 3, 2015 and notified to the Parties on December 8, 2015. A Reply to the Response was received on December 15, 2015 and notified to the parties on December 16, 2015. Mediation failed on January 4, 2016 and the Expert decision payment was received on January 15, 2016.

#### **4. Factual Background**

The Complainant is an international airline owned by the Dubai government and trading as “flydubai”. The airline serves the Middle East, North and East Africa, Asia and Europe from Dubai, and is well known in Europe and the United Kingdom (UK). The Complainant trades through the website located at flydubai.com, which has yielded millions of dollars worth of sales emanating from UK Internet addresses. The airline has flown under the FLYDUBAI trademark since June 1, 2009 and has used the domain name flydubai.com since then.

The Complainant has listed six FLYDUBAI or FLYDUBAI.COM trademarks that it states it holds, of which the following are representative:

FLYDUBAI, United Kingdom Intellectual Property Office, registration granted March 13, 2009, registration number 2498374, class 39;

FLYDUBAI.COM, European Community Trademark, registration granted November 11, 2009, registration number 7256365, class 39.

The Respondent is a travel company of 33 years standing catering for business, leisure and tour travel. Global Travel Domains Ltd and the Online Regional Travel Group Ltd (ORTG) are in co-ownership. The Respondent foresaw the role of the Internet as the future way to book travel, developed its strategy accordingly, and now does considerable business through the Internet. The disputed Domain Name, flydubai.co.uk, is one of a number held by the Respondent with names constructed on the theme of “fly” and a place name.

The disputed Domain Name was registered on June 9, 2005.

#### **5. Parties’ Contentions**

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

The Complainant’s contentions include the following.

The Complainant asserts rights in the name or trademark FLYDUBAI. It has continuously used the FLYDUBAI trademark and (itself or through its predecessors) has used the domain name flydubai.com since 2008, a date “half a decade” before the disputed Domain Name directed visitors to a live website. The Complainant also refers to the unregistered trademark value of its name as appearing, for example, painted on its aircraft and in media reports.

The Complainant’s website flydubai.com was accessed by UK Internet users numbering some 1.2 million in the past four years, accounting for over \$13.5 million worth of sales.

The Complainant contends that the Domain Name flydubai.co.uk is identical or similar to the Complainant's name and trademark FLYDUBAI. The Complainant's trading name and registered trademark is the dominant and distinctive element of the Domain Name. The Domain Name is also identical to flydubai.com owned by the Complainant except that the Complainant's domain name (.com) is a gTLD whereas the disputed Domain Name (.co.uk) is ccTLD. The Complainant says this similarity has been implicitly recognised by the Respondent, which has now moved its content to a new domain name, flytodubai.co.uk (to which the Domain Name has redirected), and has removed references to "flydubai".

The Complainant further contends that the Domain Name in the hands of the Respondent is an Abusive Registration under the Policy. The Domain Name was registered by the Respondent on June 9, 2005, but does not appear to have been used until November 2014.

The Complainant says that according to an archived screen capture, the Domain Name was available for sale on November 8, 2012.

The Complainant states that it has not given any permission to the Respondent to register or use a Domain Name incorporating the Complainant's trademarks.

The Complainant says that because of the similarity of the Domain Name to the Complainant's trademarks visually, orally and conceptually, and its use in relation to identical services, there is a likelihood that consumers will be confused misleadingly into associating the Domain Name with the Complainant. The Domain Name continues to receive visitors and redirects them to the Respondent's new website at flytodubai.co.uk.

The Complainant contends that the Domain Name takes unfair advantage of the Complainant's trademarks, is detrimental to the Complainant's business, and is an Abusive Registration. The Respondent could not have been unaware of the Complainant and its trademarks at the time of registration of the Domain Name, at the time of offering it for sale, at the time of creation of its travel website, or when setting up the redirection to flytodubai.co.uk.

Following legal letters from the Complainant, the Respondent refused to transfer the Domain Name to the Complainant, but agreed to cease using the Domain Name and said that it would use the new domain name flytodubai.co.uk instead.

The Complainant requests the transfer of the Domain Name.

## **B. Respondent**

The Respondent denies the Complaint. The Respondent's contentions include the following.

The Respondent outlines the business structure of the relevant entities owned by Brian Kelly, a resident of the Isle of Man. The Respondent describes a comprehensive and successful travel company that has adapted to changing situations including the introduction of Internet booking systems.

The Respondent says that one of its strategies was to create niche destination websites. The Respondent acquired more than 70 domain names, of which it has produced a list, most of them based on "fly" and a place name. The Respondent owned domain names incorporating flydubai, flyabudhabi and flyoman, and decided to focus on the UAE and to launch the corresponding websites in 2015.

The Respondent considered that the Complainant was not operating or marketing in the UK, and the Respondent, because it was not selling flights from Dubai to the Middle East and Asia but was selling holidays to Dubai from the UK, did not think it was in competition with the Complainant.

The Respondent says that it was aware of the airline flydubai, and has produced correspondence with Emirates (the airline) in the UK stating the Respondent's plans. A reply from Emirates raised no objections to the Respondent's use of the disputed Domain Name, and wished the Respondent luck.

The Respondent says that in response to the Complainant's approach, it removed the Domain Name and now uses flytodubai.co.uk instead. It has also now removed a link between flydubai.co.uk and flytodubai.co.uk.

The Respondent says it has operated as a travel business for 33 years, operated as an online travel agency for 10 years prior to the creation of the flydubai airline, and does not have any case to answer with regards to ownership of the Domain Name. In the Respondent's view the disputed Domain Name flydubai.co.uk, and the Complainant's domain name flydubai.com, are not phonetically or conceptually identical. The Respondent suggests that the Complainant's airline may not exist after another five years.

The Respondent denies that its registration of the Domain Name was abusive or opportunistic, and says it reflects a company strategy developed well before the Complainant was created.

### **Reply to the Response**

The Complainant's Reply partially reiterates the Complaint and includes the following points.

As alleged in the Complaint, it is incorrect that the Complainant and the Respondent are not in competition.

It is incorrect that the Complainant was made aware of the Respondent's intentions and did not object to the use of the Domain Name. The Respondent did not contact the Complainant but contacted Emirates in the UK, which was not the owner of the Complainant's trademarks and had no authority to grant permission to use them. The reply received from Emirates was a simple acknowledgement of the Respondent's approach and a request for further information about the Respondent's venture in the future.

The Complainant refutes the suggestion that it may be short-lived and points to having 50 aircraft in operation, with a further 110 aircraft on order from Boeing.

The Respondent has implied that its registration was not abusive on the basis that the original "fly" concept, dating back to 2004-2006, pre-dated the commercial launch of the flydubai brand by the Complainant in 2009. However the Respondent's "fly" concept only progressed within the past 5 years and the Respondent has provided no evidence of business development plans relating to the "fly" concept between 2006 and 2014.

The Complainant says that whilst the Respondent may have originally acquired the Domain Name in good faith, that does not preclude abusive use by the Respondent subsequently.

The Complainant contends that the Respondent was aware of the goodwill embodied in the Complainant's brand prior to the commercial launch of the Respondent's own venture and

refers to the examples in the Complaint of how the Respondent's conduct has been detrimental to the flydubai brand.

The Complainant says that the Respondent has not substantively responded to the Complaint's allegation of trademark infringement, and that such infringement would constitute a breach of condition 7.4 of the Terms and Conditions of Domain Name Registration with Nominet.

## **6. Discussions and Findings**

Paragraph 13(b) of the Procedure reads:

### **"13. Further Statement**

a. In addition to the complaint, the response and if applicable the reply and any appeal, the Expert may request further statements or documents from the Parties. The Expert will not be obliged to consider any statements or documents from the Parties which he or she has not received according to the Policy or this Procedure or which he or she has not requested.

b. Any communication with us intended to be passed to the Expert which is not part of the standard process (e.g. other than a complaint, response, reply, submissions requested by the Expert, appeal notice or appeal notice response) is a 'non-standard submission'. Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission. We will pass this explanation to the Expert, and the remainder will only be passed to the Expert at his or her sole discretion. If there is no explanation, we may not pass on the document or information.

c. On receipt of a non-standard submission we shall copy to the other Party the explanatory first paragraph, but we will only send the remainder to the other Party if and when the Expert requests sight of the remainder."

The Respondent has submitted a request to make a further, non-standard, submission.

The DRS provides for complaints to be resolved expeditiously. The Respondent has had the opportunity to comment on the Complainant's case, and the Complainant has had the opportunity to comment on the Respondent's case. The Expert does not find the need to request any further submission in this instance and is satisfied that sufficient evidence has been produced for a decision to be made. The Respondent's request to make a non-standard submission is declined.

An Expert duly appointed under the DRS is required to determine whether or not the Complainant has proven its case under paragraph 2(a) of the Policy. The Complaint's allegation of trademark infringement falls outside the scope of the Policy; there was no requirement for the Respondent to answer it and it will not be considered further. As the Foreword to Version 2 of the DRS Experts' Overview, November 2013, makes clear, *"Disputes are decided by reference to the terms of the Policy, not the law, so the fact that a domain name registration and/or the registrant's use of it may constitute trade mark infringement, for example, will not necessarily lead to a finding of Abusive Registration under the DRS Policy."*

Paragraph 2(a) of the Policy requires the Complainant to prove, on the balance of probabilities, that:

- i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

### **Complainant’s Rights**

The Complainant has produced a list summarising its FLYDUBAI and FLYDUBAI.COM trademarks that, since these are not contested by the Respondent, the Expert will admit as establishing the Complainant’s rights in them for the purposes of the present proceeding.

### **Identity or Similarity**

The Domain Name contains exclusively the registered trademark FLYDUBAI, apart from the second level and country code suffix .co.uk, and accordingly the Domain Name is found to be effectively identical to the trademark in which the Complainant has rights in the terms of paragraph 2(a)(i) of the Policy. The Domain Name is also found to be confusingly similar to the trademark FLYDUBAI.COM because the replacement of the generic top level directory .com with .co.uk is likely to project an impression of representing the UK branch or office of the Complainant.

### **Abusive Registration**

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.”

Paragraph 3 of the Policy, Evidence of Abusive Registration, reads in part:

“a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
  - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
  - B. as a blocking registration against a name or mark in which the Complainant has Rights; or
  - C. for the purpose of unfairly disrupting the business of the Complainant;

- ii. Circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is 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;

(.....)”

Paragraph 4 of the Policy outlines how the Respondent may demonstrate that the Domain Name is not an Abusive Registration, and reads in part:

“a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

- i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;
- B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name;
- C. made legitimate non-commercial or fair use of the Domain Name; or

(.....)”

The Domain Name was registered by the Respondent on June 9, 2005. The Complainant's claims of ownership and usage of the FLYDUBAI trademarks have a later date. The FLYDUBAI trademark was first granted registration in the UK on March 13, 2009 and the airline's first commercial flight was on June 1, 2009. A claim of Abusive Registration is not automatically countered by proof that the Domain Name was registered before the existence of the relevant trademark or name, for example it might be shown that a registrant had inside knowledge or was reasonably able to foresee the adoption of a name or trademark. Absent any such evidence, it is accepted that the Respondent could not reasonably have foreseen the creation of the Complainant's name and trademark at least 3 years after the Domain Name was registered. The Expert is satisfied that the *registration* of the Domain Name at the time did not constitute an Abusive Registration.

The wording of paragraph 1 of the Policy is in the alternative, i.e., Abusive Registration may be found if the Domain Name was either registered unfairly or used unfairly. By implication the Respondent relies mainly on paragraph 4(a)(i)(A) of the Policy in order to deny unfair use.

The meaning of the phrase “not necessarily the 'complaint' under the DRS” in paragraph 4(a)(i) of the Policy is, in effect, that the Respondent's use or preparations for use of the Domain Name for a genuine offering of goods or services must have pre-dated, not only the Complaint, but the Respondent's first awareness of the Complainant's name or trademark (Version 2 of the DRS Experts' Overview, articles 4.2 and 4.3). Plausibly the Respondent, as an experienced travel agent, was aware of the publicised impending launch on June 1, 2009 of the flydubai airline. In the Respondent's own words, “We were aware very early on that FlyDubai.com was a low cost airline operating out of Dubai...”. It is necessary therefore to look for evidence of at least demonstrable preparations by the Respondent to use the Domain Name for a genuine purpose at a date before the flydubai airline was announced.

Beyond the Respondent's assertions of having a company strategy in 2004-2006 to create "fly" destination websites, no palpable evidence has been advanced. Since its creation on June 9, 2005, the Domain Name appears to have lain dormant for a number of years, through and following the launch of the flydubai airline. On November 8, 2012, according to a screen capture produced by the Complainant, the Domain Name was for sale, resolving to a website marked "Buy this domain". Not until 2015, about 6 years after the launch of the Complainant's flydubai airline, was the Domain Name brought into use as a travel website.

The Respondent has produced email correspondence with Emirates, UK, which the Respondent says raised no objection to its plans for the Domain Name and wished the Respondent luck.

The selection of correspondence reproduced by the Respondent appears to be part of a sequence, addressed to an official at Emirates and copied to three people. On June 4, 2014 the Respondent alluded to how flights and accommodation may be promoted through the Domain Name, mentioned joint marketing opportunities, and offered to keep the addressees informed. The reply from an Emirates official, 2 minutes later, said, "Apologies and thanks for clarifying. Please do get in touch as and when you see fit. All the best with the launch".

It is not clear whether the Respondent's emails to Emirates were intended to obtain clearance to use the Complainant's trademarks in a particular way, or whether the reply "All the best with the launch" was interpreted by the Respondent as permission to do so. Emirates and the Complainant are both effectively owned by interests associated with the Dubai government, but are separate entities. The evidence shows the Complainant to be listed independently at the Dubai Chamber, membership number 159668, trade name "Dubai Aviation Corporation "FLYDUBAI"". The guiding mind of the Respondent has considerable business experience, having operated his own successful travel business for 33 years, and would have understood the autonomous nature of companies within a group structure. Only the Complainant, whose registered address is publicly available, would be in a position to grant a licence for the Respondent's use of the Complainant's trademark in an agreed manner. It may reasonably be anticipated that the grant of a licence to use a trademark would entail considerable enquiry leading to a fully detailed contract, and nothing binding or contractual can possibly be read into the nature of the quick reply from an individual at Emirates, a different company.

The Expert finds that the Respondent has failed to establish the factors required in order to succeed under paragraph 4(a)(i)(A) of the Policy. The Respondent is found not to have been commonly known as flydubai in the terms of paragraph 4(a)(i)(B) of the Policy, and the Domain Name is clearly not in non-commercial or fair use within the meaning of paragraph 4(a)(i)(C) of the Policy.

In the terms of paragraph 3(a)(ii) of the Policy, the evidence is to the effect that the Respondent has used the Domain Name flydubai.co.uk to promote and sell air travel focused on the Middle East. The Domain Name is similar to the Complainant's registered trademarks and in the Expert's judgment is more likely than not to confuse people or businesses into believing, at least initially, that the Domain Name is operated or authorised by the Complainant. Accordingly the Expert finds, on the balance of probabilities, that the use of the Domain Name in the hands of the Respondent constitutes an Abusive Registration.



**7. Decision**

The Expert finds that the Complainant has Rights in respect of the trademarks FLYDUBAI and FLYDUBAI.COM; that the disputed Domain Name flydubai.co.uk is similar to the Complainant's trademarks; and that the disputed Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name flydubai.co.uk is ordered to be transferred to the Complainant.

**Signed** Clive Trotman

**Dated** February 1, 2016