# Panel Decision for dispute CAC-ADREU-005405

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| Case number | CAC-ADREU-005405 |
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| Domain names | emirates.eu |

## Case administrator

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| Name | Josef Herian |

## Complainant

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| Organization / Name | Emirates, (A Dubai Corporation) |

## Respondent

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| Organization / Name | Stichting Roos Beheer |

INSERT INFORMATION ABOUT OTHER LEGAL PROCEEDINGS THE PANEL IS AWARE OF WHICH ARE PENDING OR DECIDED AND WHICH RELATE TO THE DISPUTED DOMAIN NAME

The Panel has not been made aware of other legal proceedings pending or decided in respect of the domain name presently disputed.

FACTUAL BACKGROUND

According to the Complainant, Emirates is the official international airline of the United Arab Emirates. The scale of the Complainant's operations was 17,544,140 passengers and 1,155,894 tonnes of cargo carried in 2006-2007. Emirates is a profitable airline that has received hundreds of awards for excellence.

The Complainant has spent considerable time and money promoting its business world wide. In the 2007 financial year it spent AED 3.55 billion on sales and marketing. It is well known through sponsorship, of for instance the 1999 Cricket World Cup, Arsenal Football Club (Emirates stadium and team shirts), FIFA World Cup 2006, AC Milan, Rugby World Cup 2007, and others.

The Complainant owns UK and CTM trademarks comprising or incorporating the word Emirates. It also operates the website www.emirates.com.

The Respondent is Stichting Roos Beheer of the Netherlands. It appears that Mr Michael Toth of the UK is the beneficial owner and guiding mind of the disputed domain name. According to Mr Toth he has various business interests, including websites that contain information of interest that are funded by advertising revenue or by commissions from referrals to other websites.

The disputed domain name emirates.eu was apparently registered in September 2006.

A. COMPLAINANT

The Complainant's contentions include the following.

The Complainant has rights in a significant portfolio of trademarks internationally incorporating the name EMIRATES including:

EMIRATES, UK trademark 2023709, class (Nice) 39, registered March 1996;
EMIRATES, CTM 22137, class 39, registered August 1998;
EMIRATES HOLIDAYS, CTM 22111, classes 39, 42, registered August 1998
EMIRATES HOLIDAYS, UK trademark 2023708
EMIRATES HOLIDAYS, trademark 2399015

The Complainant contends that the disputed domain name is identical or similar to trademarks in which the Complainant has rights and

which were registered before the disputed domain name.

The United Arab Emirates (UAE) comprises Abu Dhabi, Ajman, Dubai, Fujairah, Ras al-Kahaimah, Sharjah, and Umm al-Quwain. There are independent emirates such as Kuwait and Qatar. Accordingly the word “Emirates” does not connote a specific geographical location or the name of a place but is a description of a territory under the rule of an Emir.

The Complainant submits that the name and trademark EMIRATES is now a household name, exclusively associated with the Complainant by the general public. The term has a stronger significance as a trademark than as a geographical indicator or an abbreviation for United Arab Emirates.

The Complainant further contends that the respondent has acted in bad faith and does not have rights or legitimate interests in the disputed domain name.

The Complainant says that the disputed domain name was initially registered by RoosIT which, in a previous decision (Case No. 02955) was held to be closely related to, and to have the same signatory as, Stichting Roos Beheer. RoosIT made a successful Sunrise application to register the disputed domain name, based on a Maltese trademark for E&M&I&R&A&T&E&S. The Complainant submits that RoosIT did not intend to use that trademark for a bona fide offering of goods or services and that the application was made in bad faith.

The Complainant submits with documentary evidence that RoosIT made 214 similar trademark applications in Malta and 13 in the Benelux, such as F&1, V&I&R&G&I&N and O&2, which it submits were solely intended to allow RoosIT to register domain names such as f1.eu, virgin.eu and O2.eu, for itself or related entities. Furthermore the Maltese trademark registration specifies that “registration gives rights to the exclusive use of the word “emirates”, only when this is used within the “&” symbols as shown in the mark”. RoosIT does not therefore hold any trademark or other rights in the word EMIRATES, only in the term E&M&I&R&A&T&E&S. The Complainant submits that it is inconceivable that there was any bona fide intention to use that trademark except to obtain the related .eu domain name.

The Complainant submits that RoosIT has shown a pattern of conduct in registering trademarks with the addition of “&” (ampersand) symbols and cites previous decisions in support (Case No. 04090 and Case No. 02955). Neither Stichting Roos Beheer, nor RoosIT before them, can demonstrate any rights or legitimate interests in the disputed domain name.

It is submitted that the disputed domain name cannot be used by the Respondent in connection with a bona fide offering of goods or services. It could not have been chosen for any other reason than its association with the Complainant’s trademark, of which RoosIT must have been aware. Where a mark is world famous, other traders would not choose it unless seeking to create an impression of association. Anyone selecting emirates.eu when searching for a website would believe they would be taken to the Complainant’s webpage. Therefore RoosIT’s choice to register the disputed domain name and Stichting Roos Beheer’s subsequent ownership were motivated by the desire to divert users from the Complainant to the Respondent and therefore the Respondent has no rights or legitimate interests.

The Complainant has cited previous domain name decisions that it would like to be treated as precedent.

The Complainant requests the transfer to it of the disputed domain name.

B. RESPONDENT

The Respondent denies the Complaint and makes contentions, with documentation submitted in support, that include the following.

The beneficial owner of the disputed domain name is Michael Toth of the United Kingdom. In the contentions that follow, Mr Toth speaks for the Respondent which he describes as a registrar or registration agency through which he registered the disputed domain name. Prior to the date of this Complaint Mr Toth was not aware that the disputed domain name remained in the name of Stichting Roos Beheer, instructions having been given for its transfer to Mr Toth (documentary evidence submitted). He says there is no evidence of a connection between Stichting Roos Beheer and RoosIT.

It is common ground that the word emirates can be a descriptive generic term. The Respondent denies the Complainant’s assertion that the word does not connote a specific geographic location or place name. The Respondent draws comparisons with the website of emirates.org and invites perusal of the decision in WIPO Case No. DAU2008-0004 (emirates.com.au), which was decided against the Complainant, and by contrast, WIPO Case No. D2005-1311.

The Respondent submits that the Complainant’s relevant trademarks apply to its passenger air services under the name Emirates Airlines. The Complainant’s freight service is operated as Emirates Sky Cargo, its tourism service is operated as Arabian Adventures, or

as Emirates Holidays, and its aircraft engineering and maintenance service is operated as Emirates Engineering. Mr Toth does not seek to associate his business with any such services.

Trademarks to which the Complainant refers consist of the word EMIRATES in combination with added matter. The Respondent submits registration documents of trademarks containing the word EMIRATES that do not belong to the Complainant and therefore show the Complainant not to have exclusive rights. An example is CTM 6549919 for THE NATIONAL AIRLINE OF THE UNITED ARAB EMIRATES owned by Etihad Airways, which the Complainant has not opposed.

Mr Toth contends that he has not acted in bad faith and does have a legitimate interest in the disputed domain name. His websites contain information of interest and are funded by advertising revenue or commissions, which is an accepted method of business.

The Respondent says that the Complainant has acknowledged that the word emirates is a geographic description. Mr Toth says he is also the registrant of the domain name emirates.co.uk which, together with the disputed domain name and according to the evidence, points to an information portal website entitled “The United Arab Emirates Resource Guide” that contains useful information. It is submitted that the care and skill in the construction of that home page compare very favourably with www.emirates.org.

Mr Toth says his website is carefully constructed and not the usual “parking” page. It includes a car hire search engine and his business receives a commission for each booking. Mr Toth thereby claims a legitimate interest within the meaning of Art. 21(1)(a) and Art. 21(2)(a) of Regulation EC 874/2004. The disputed domain name points to an information portal about the UAE from which Mr Toth generates legitimate income in a manner that does not impinge upon any rights the Complainant may have in the word emirates. Mr Toth says he uses the same short form of United Arab Emirates as does the official web site of the UAE, namely the simple word emirates as part of the disputed domain name.

If the Complainant seeks to suggest that Mr Toth should have used either unitedarabemirates.eu or unitedarabemirates.co.uk for his business, in fact neither is available, and in any case, Mr Toth wants to be inclusive of independent emirates.

Mr Toth submits a list of about 212 domain names owned by him based on country names (including emirates.co.uk and emirates.ltd.uk, but excluding emirates.eu). These have been registered to promote his similar business within the countries concerned.

Mr Toth says that the disputed domain name has been registered since September 2006 and points to a website corresponding to emirates.co.uk, registered in April 2002, which has been live since December 2004. Documents show that a demand from the Complainant in April 2008 for the transfer of emirates.co.uk received a robust reply and the matter did not proceed. As an unsolicited gesture of goodwill Mr Toth added a link to the Complainant’s website.

Mr Toth says that a list of trademark applications (by RoosIT) submitted by the Complainant relates to common descriptive words that would be devoid of distinctive character but for the alternating ampersands. There is no evidence that the registrant of these trademarks attempted to misappropriate the registered trademark of any third party. It cannot be said that seeking trademark registration for a descriptive word, disguised and rendered distinctive with ampersand symbols, constitutes bad faith.

The validity or otherwise of those other trademarks is not open to question in this proceeding. It is not necessary to consider whether the applicant intended to use the trademark concerned, or whether intention to use is required under trademark law of Malta or Benelux. It has been accepted (e.g., Case No. 01867, domain name OXFORD) that a trademark incorporating the “&” symbol constitutes a Prior Right for the purposes of Art. 10(1) of the regulation. In consequence the presently relevant trademark relied upon by its registrant in the Sunrise period is a valid Prior Right. The Complainant could have brought a complaint against EURid at the appropriate time. There is no evidence to show that the Complainant was blocked by the disputed domain name from filing an application under the Sunrise regulations or that the Complainant was in a position to do so. The Complainant’s stance may be equated with reverse domain name hijacking.

The relevance (if any) of Case No. 04090 and Case No. 02955 cited by the Complainant appears to be that the relevant respondent in those cases failed to show a legitimate interest, whereas in the present case Mr Toth does have a legitimate interest.

The Complainant alleges that “anyone typing Emirates.eu when searching for a website would believe that they would be taken to the Complainant’s webpage”. The Respondent says there is no evidence that this is so. Numerous other traders have established trademark rights in the word emirates so there may be many reasons why people search for the word.

## DISCUSSION AND FINDINGS

Given the convoluted contentions in this dispute, the Panel will set out certain findings of fact before analysis of the Rules.

RoosIT, which is not a Party to this dispute, appears to be domiciled in the Netherlands and to have registered over 200 Maltese trademarks, in blocks of consecutive registration numbers. They are of the general form M&A&P&S, that is to say, the word MAPS with ampersands between the letters. The list includes many possibly uncontentious words such as MUSIC, MOVIES, RADIO, TICKETS, BEACH ..., but in each case with ampersands between the letters.

Trademarks such as M&A&P&S might appear to be of limited use but their purpose to RoosIT evidently was to lay claim to related .eu domain names at the opening, on the basis of a prior right in a trademark. Domain names cannot contain ampersands, therefore the domain name MAPS could be claimed to be closely related to the trademark M&A&P&S.

As pointed out by the Complainant, the learned Panelist in Formula One Licensing BV v RoosIT, Marc Roos, Case No. 02955, found reason to refer to the present Respondent in these terms: "... Stichting Roos Beheer, a company which appears to be related and whose signatory appears to be the same Mark [sic] Roos as signed the transfer on behalf of the Respondent". That dispute concerned the Maltese trademark F&1 on the basis of which the relevant Respondent (named as RoosIT, Marc Roos) obtained the domain name f1.eu. The decision referred in its course to RoosIT, Marc Roos, having registered 214 Maltese ampersand-rich trademarks and subsequently a number of related .eu domain names.

The Respondent says there is no evidence to connect Stichting Roos Beheer with RoosIT. Either way, Stichting Roos Beheer is the recorded holder of the presently disputed domain name. ADR Rules A1 defines a Respondent as "the holder of a .eu domain name registration ... in respect of which a Complaint ... is initiated". The Respondent is therefore the registrant Stichting Roos Beheer.

With the evident acquiescence of the Respondent, Mr Michael Toth answers for it in this dispute. According to Mr Toth's evidence he is the beneficial owner of the disputed domain name, he thought it had been transferred to him, and expects that it will be. It is clear that he has control over it. It will be convenient to refer to the Respondent, or Stichting Roos Beheer, or Mr Toth, interchangeably.

Mr Toth expressly states his business model. He operates websites upon the principle known as click-through or pay-per-click. Websites display links to advertisers, and when a viewer follows such a link, the destination site pays a commission to Mr Toth. He may also exhibit paid advertisements. Thus his websites generate income.

In general the click-through business model may be entirely legitimate. Many websites providing information such as news or data as a public service are legitimately subsidized by click-through or paid advertisements. The model is capable of sophistication as the operator may subscribe to a service that targets advertisements and links according to what is known about each visitor and their search, or the operator can incorporate functionality such as an off-the-shelf search engine or car-rental search facility.

The business can be magnified by owning multiple domain names. Mr Toth provides a list of over 200 domain names he owns based on country names (americansamoa.org.uk, andorra.me.uk, anguilla.me.uk ...). It may be that many of these are free to use.

The name EMIRATES requires deeper enquiry. On the one hand it may be partially in the nature of a geographic identifier. These are notoriously difficult to trademark standing alone; see, for example, Her Majesty The Queen, in right of her Government in New Zealand, as Trustee for the Citizens, Organizations and State of New Zealand, acting by and through the Honourable Jim Sutton, the Associate Minister of Foreign Affairs and Trade v Virtual Countries, Inc., WIPO Case No. D2002-0754, which was decided against the relevant Complainant by a Panel of three. Even if a place name is trademarked, the registration may be restricted or placed on a supplementary register as a matter of record but with little or no protection.

On the other hand the word emirate is generic, meaning a nation with an Emir. Generic words standing alone cannot normally be trademarked in the same generic field but may be in another. Thus Apple or Blackberry standing alone can be trademarked in respect of computers or telephones, but not for fruit.

On the balance, the Panel finds the word emirates, standing alone and detached from the immediate context of any particular emirate or the United Arab Emirates, to be more a generic word than a place name. Furthermore, it is outside of its generic field that the word emirates has become the name of a major international airline. In other words, in the present context, reference to EMIRATES standing alone would likely evoke a particular airline and seldom a place or number of places. Inescapably, the name EMIRATES has been accepted for registration as a trademark in the European Community and in the UK. The Complainant owns the trademark and the Respondent does not.

The Panel now turns to the matters that the Complainant is required to prove on the balance of probabilities in accordance with ADR Rules B11(d)(1). The citations indicated by both Parties have been consulted, taking into account differences between the Rules and the

UDRP.

WHETHER THE DOMAIN NAME IS CONFUSINGLY SIMILAR TO A NAME IN WHICH THE COMPLAINANT HAS RIGHTS

The registration of UK trademark 2023709 displays the word EMIRATES below an Arabic character that, according to the document, reads as Al-Imarat, meaning The Emirates. The trademark was registered by the Complainant on March 22, 1996 in Class 39. The equivalent trademark was registered by the Complainant as CTM 22137, Class 39, on August 10, 1998.

Notwithstanding the stylized character of the trademarks, the Panel is satisfied for the purposes of ADR Rules B11(d)(1)(i) that the Complainant is the holder of registered trademarks in the word EMIRATES standing alone in respect of which a right is recognized or established by the national law of a Member State and Community law.

The Complainant must prove that the effective component of the disputed domain name emirates.eu, i.e., EMIRATES, is identical or confusingly similar to the name EMIRATES. Clearly it is identical and the Panel so finds in the terms of ADR Rules B11(d)(1)(i).

WHETHER THE RESPONDENT HAS RIGHTS IN THE DOMAIN NAME

The Complainant has asserted prima facie that the Respondent does not have rights or legitimate interests in the disputed domain name because the Complainant holds the rights in the name and has not authorized the Respondent to use it.

The ADR Rules provide for the Respondent to rebut the Complainant's assertions in any way, and provide illustrative circumstances that, if any is proved based on an evaluation of all evidence presented, shall demonstrate the Respondent's rights or legitimate interests for purposes of ADR Rules B11(d)(1)(ii). These circumstances are specified in ADR Rules B11(e) as follows:

"(1) prior to any notice of the dispute, the Respondent has used the domain name or a name corresponding to the domain name in connection with the offering of goods or services or has made demonstrable preparation to do so;

(2) the Respondent, being an undertaking, organization or natural person, has been commonly known by the domain name, even in the absence of a right recognized or established by national and/or Community law;

(3) the Respondent is making a legitimate and non-commercial or fair use of the domain name, without intent to mislead consumers or harm the reputation of a name in which a right is recognized or established by national law and/or Community law."

The Respondent is found by the Panel not to have rights under ADR Rules B11(e)(3) because the website to which the disputed domain name resolves is overtly commercial, and not to have rights under ADR Rules B11(e)(2) because the Respondent or any associated business cannot realistically claim to be known as Emirates.

In the terms of ADR Rules B11(e)(1), Mr Toth asserts that he is using the disputed domain name for the offering of a service of information about the Emirates with functionality including a car hire search facility. The website of the disputed domain name resolves to, and serves passively to augment the catchment of, emirates.co.uk. Mr Toth invites positive comparison with the website of emirates.org (operated by another) which he insinuates to have "official" or "government" connotations. Having made the visit the Panel would be very surprised indeed if the website at emirates.org had the official endorsement of the United Arab Emirates (see www.government.ae by contrast). As to the content of the website to which the disputed domain name ultimately resolves, the Panel finds it to follow a model common on the Internet, projecting a veneer of token relevance over a revenue-generating click-through operation. It does little more than refer visitors to the goods or services of others, of which Mr Toth need have no knowledge or day to day control.

Nevertheless, the wording of ADR Rules B11(e)(1) is silent on the degree to which use must be demonstrably bona fide. The Panel makes no finding under ADR Rules B11(d)(1)(ii) and will proceed under the heading of bad faith.

WHETHER THE DOMAIN NAME HAS BEEN REGISTERED OR USED IN BAD FAITH

ADR Rules B11(f) defines circumstances, without limitation, that may be evidence of the registration or use of a domain name in bad faith. ADR Rules B11(f)(4) is pertinent:

"the domain name was intentionally used to attract Internet users, for commercial gain to the Respondent's website or other on-line location, by creating a likelihood of confusion with a name on which a right is recognized or established, by national and/or Community

law".

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 within the ambit of ADR Rules B11(f)(4).

The Panel is also mindful of the finding of the learned Panelist in WIPO Case No. D2000-0163, who referred to a name (veuvecliquot.org) "so obviously connected with such a well-known product that its very use by someone with no connection with the product suggests opportunistic bad faith". Whoever precisely registered the present disputed domain name evidently employed some ingenuity to secure a trademark different from that of the Complainant's, but identical when stripped of characters impermissible in a domain name. The Respondent is the holder of a domain name comprising the Complainant's trademark and is responsible for its use. In all the circumstances the Panel concludes that the name EMIRATES, standing alone, is too powerful, too universally recognized, and too well protected by trademark, to enable any indulgent view that it is merely a generic word in innocent usage.

Since Mr Toth has answered for the Respondent, the Panel states for the record its finding that the Respondent is the holder of a disputed domain name that has been registered and is used in bad faith within the meaning of ADR Rules B11(d)(1)(iii).

The Panel notes that the Complainant has identified itself as "Emirates, (A Dubai Corporation)", with an address in Dubai, the United Arab Emirates. The Complainant has not addressed the question of its eligibility to register a .EU domain name in the terms of Article 2(b)(i) or (ii) of Regulation 733/2002. The disputed domain name, which would otherwise have been transferred to the Complainant, is therefore revoked.

DECISION

For all the foregoing reasons, in accordance with ADR Rules B12, the Panel orders that the domain name emirates.eu be revoked.

## PANELISTS

| Name | **Dr. Clive Trotman** |
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DATE OF PANEL DECISION 2009-08-14

## Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

The Complainant is the airline company Emirates (a Dubai Corporation) which is the owner of trademark registrations including: EMIRATES, UK trademark 2023709; and EMIRATES, CTM 22137. The Respondent is the registered holder of and has enabled a person to use the disputed domain name emirates.eu.

The Panel found that the disputed domain name is identical to a name in respect of which a right is recognized or established by the national law of a Member State and Community law; and that the Respondent has acted in bad faith since it may reasonably be concluded that the disputed domain name was intentionally used to attract visitors for commercial gain to the Respondent's website, by creating a likelihood of confusion with the name EMIRATES.

Since the Complainant has not established eligibility to register a .EU domain name, the Panel ordered that the disputed domain name emirates.eu be revoked.