



ABN 69 008 651 232

**LEADR Domain Name Dispute - Administrative Panel Decision (single panellist)  
Regarding domain names: <emirates.net.au> and <emiratesholidays.com.au>**

**Between: Emirates (a Dubai Corporation)  
and**

**Shellball Pty Ltd (in liquidation) ABN 44 055 035 839**

**Matter: auDRP 14/08**

**1. The Parties**

1.1 The Complainant is "Emirates", a Dubai Corporation established by Decree No. 2 of 1985 (as amended), by the Government of Dubai.

Emirate's contact person is Ms. Shannon Peterson.

Emirates is represented by Ms Elisabeth White and Ms Victoria Bell, of Baker & McKenzie (an Australian Law Firm).

1.2 The Respondent is Shellball Pty Ltd (in liquidation).

Shellball's nominated contact person is Dale Robert Lawrence. Mr Lawrence submitted a response to the complaint, in his capacity as Director of Shellball Pty Ltd.

1.3 Liquidators were appointed to the Respondent on 31<sup>st</sup> December 2013, being: Messrs David Ross and Domenic Calabretta. The liquidators did not submit a response to the complaint in their capacity as authorised representatives of the Respondent.

**2. Subject Matter of Complaint**

2.1 Domain Names in Dispute are: <emirates.net.au>, created on 18 August 2006, and <emiratesholidays.com.au>, created on 17<sup>th</sup> September 2008.

2.2 Registrar: Drop.com.au Pty Ltd

2.3 Relevant Names, Trade Marks or Service Marks are: "Emirates" and "Emirates Holidays".

2.4 Authority for Reference: the auDRP Rules; .au Dispute Resolution Policy; and the LEADR Supplemental Rules for .au Domain Name Dispute Resolution Policy (auDRP 2010-5).

### **3. Jurisdiction and Basis of Determination**

3.1 The complaint was submitted for determination by a single panellist under:

- (a) The provisions of Section 3 of Schedule B of the auDRP Rules (the “Rules”);
- (b) The provisions of Paragraph 4(a) of Schedule A of the .au Dispute Resolution Policy (the “auDRP”);
- (c) The LEADR Supplemental Rules for .au Domain Name Dispute Resolution Policy (auDRP 2010-5). LEADR is the Provider.

3.2 Section 4 of Schedule A of the auDRP covers Mandatory Administrative Proceedings.

3.3 Section 4(a) deals with Applicable Disputes and states: *“You are required to submit to a mandatory administrative proceeding in the event that a third party (a “Complainant”) asserts to the applicable provider, in compliance with the Rules of Procedure that:*

- i) Your domain name is identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights; and*
- ii) You have no rights or legitimate interests in respect of the domain name; and*
- iii) Your domain name has been registered or subsequently used in bad faith.*

*In an administrative proceeding, the Complainant bears the onus of proof.”*

### **4. Procedural History**

4.1 On 10/06/2014: LEADR received the Complaint and sent an acknowledgement to the Complainant on the same day.

4.2 On 11/06/2014: a copy of the complaint was submitted, along with a request to confirm the Respondents’ details and to lock the domain name during proceedings, by email, to the Registrar - Drop.com.au Pty Ltd.

4.3 On 12/06/2014: the Registrar confirmed, by email, that the domain name in dispute had been locked and,

LEADR advised auDA of the complaint, by e-mail.

4.4 On 17/06/2014: LEADR sent the Respondent (Shellball Pty Ltd) an email and a written notification of the complaint lodged against them. The Complainant was provided with a copy, by email, of these notifications.

The due date for response to the complaint was given as 7/07/2014.

4.5 On 7/07/2014: the Provider approached the Panellist to request their participation in this matter.

The Panellist confirmed their availability, informed the Provider that they had no issues of conflict with the parties, and accepted the matter on that day.

The case file and relevant correspondence were forwarded to the Panellist.

LEADR notified the parties of the allocation of their dispute to the Panellist.

The Respondent requested an extension of time to provide his response.

The Panellist granted a 2 day extension of time to the Respondent to provide his response – expiring at 5.00pm on 9/07/2014.

4.6 On 09/07/2014: Dale Lawrence, acting in his capacity as Director of the Respondent, Shellball Pty Ltd (in liquidation), submitted a response to the Provider, dated 6<sup>th</sup> July 2014, with copy to the Complainant's legal representatives.

The Provider forwarded a copy of the Response to the Panellist on that day.

4.7 No further submissions were requested or received from either party, other than an administrative correction (noted below).

4.8 The Panellist's decision was published and sent to the Provider on 23/07/2014 (14 days after receipt of Response).

## **5. The Complainant's Case - Factual Background**

5.1 The Complainant is Emirates, a Dubai Corporation. It is wholly owned by the Government of Dubai.

5.2 The Complainant was set up by the Dubai government in 1985. Its main activities are the provision of passenger and freight air services, ground logistics, tourism, aircraft engineering, IT development and maintenance.

5.3 According to the Complainant's website, it:

- i) Is the official international airline of the United Arab Emirates, with a fleet of 220 aircraft flying to 140 destinations in 80 countries. In 2013/2014 it carried 44.5 million passengers and 2.25 million tonnes of cargo.
- ii) Won the Skytrax "Airline of the Year" award in 2013 for being the world's best airline.
- iii) Recently enhanced its level of recognition in Australia by the creation of a "global partnership" with Qantas.

5.4 The Complainant has registered "Emirates" (the word "Emirates" plus an image or device) and "Emirates Holidays" as marks in Australia, and around the world, over a period of many years.

5.5 Relevant Australian registrations include Trade Marks No. 701864 and 701865. Both bear application dates of 6th February, 1996.

5.6 Trade Mark No. 701864, for class 39, covers:

Airline services; air transportation services, aircraft chartering services; courier services for cargo and passengers; cargo handling services; chauffeur and limousine services; delivery of goods by air; customs clearing services; escorting of travellers; forwarding agency services in this class; freight brokerage and freight forwarding services; guarded transport services; travel guide services; air navigation services; air traffic control services; packing and storing of goods; operating and organising tours; booking and reservation agencies for travel; warehousing services; airport handling services; information and advisory services relating to all the aforesaid services

5.7 Trade Mark No. 701865, for class 41, covers:

Education and training services (in relation to the operation of airlines and cargo handling); flight instruction; publication of magazines and books in relation to the airline and tourism industries; production of radio programmes and video films; provision of in flight entertainment services; provision of airline club facilities at airports; arranging and conducting of conferences, seminars and symposiums.

5.8 The Complainant advertises and markets its products and services extensively in Australia, through most forms of mainstream, and relevant specialist media. It is also recognised as a major sponsor of sporting and cultural events in Australia and overseas.

5.9 The Complainant requests the transfer or cancellation of both domain names.

**6. Complainant's Arguments (1): The disputed domain names are identical or confusingly similar to various names, trade marks or service marks in which the Complainant has rights:**

6.1 The disputed domain names are either identical or confusingly similar to the Complainant's corporate name: "Emirates"; and/or to its business name: "Emirates Holidays"; and/or to the "Emirates" and "Emirates Holidays" marks and/or to the domain name: <emirates.com>.

6.2 The disputed domain names were created well after the Complainant had been using, and had registered, its various marks. They thereby infringe its rights in those names and marks.

6.3 For purposes of comparison and effect, domain name extensions should be disregarded to focus on the main words / names only.

6.4 The addition of a single generic term does not necessarily reduce or eliminate the risk of confusion between a "strong" trade mark and a similar sounding domain name.

**7. Complainant's Arguments (2): The Respondent has no rights or legitimate interests in respect of the domain name:**

7.1 The Complainant's exclusive rights in the "Emirates" and "Emirates Holidays" names and trade marks were established before the disputed domain names were registered.

7.2 The Respondent must have known of the "notoriety and reputation" of the names and trade marks at the time of registration.

7.3 The Complainant has never granted any rights to the Respondent to use the relevant trademarks.

7.4 The Respondent does not own or trade under any business or company names that include the word "Emirates", or "Emirates Holidays".

7.5 The use of the disputed domain names is likely to infringe the Complainant's rights under the Trade Marks Act 1995 (as amended) and amount to misleading and deceptive conduct at law. Such infringements would prevent the disputed domain names from being used to legitimately supply goods and services.

7.6 The Respondent has never used the disputed domains, bona fide, to offer goods or services:

i) In respect of <emirates.net.au> the Respondent has only ever possessed a "parking webpage".

ii) In respect of <emiratesholdidays.com.au> the domain re-directs to a website that provides listings of flights and travel services offered by third party providers to destinations around the world, including the UAE. These services compete directly with the Complainant's business. The Respondent receives a pay-per-click commission from these links and is therefore operating a "link farm parking page", which is not a bona fide offering of goods and services.

7.7 In respect of <emiratesholdidays.com.au>, the website currently indicates that the domain name is for sale, which reinforces the assertion that it is not being used, nor is it intended for use, for the bona fide supply of goods or services, by the Respondent.

7.8 The "Emirates" and "Emirates Holidays" names and trade marks are so well known they "have a stronger significance as trade marks than as geographical terms".

7.9 The use of the domains: (a) <emirates.net.au> as a parking page; and (b) <emiratesholdidays.com.au> as a link farm parking page, confirms that neither are being used for legitimate non-commercial, or fair use.

**8. Complainant's Arguments (3): The domain names have been registered, or subsequently used, in bad faith:**

8.1 When the Respondent registered its domains: "Emirates" and "Emirates Holidays" those names and trade marks were already registered and well-known in Australia, and worldwide. The Respondent should have been aware of this.

8.2 The Respondent's "Emiratesholdidays.com.au" website offers flights and tourism products and services that compete with the Complainant's business, through third party providers, from whom it obtains pays-per-click commissions.

8.3 The Respondent's "Emiratesholdidays.com.au" domain is currently being openly offered for sale on the internet through that domain's landing page. The Complainant sent the Respondent an anonymous offer of \$2,000.00, in August 2013, to purchase the domain. The offer was rejected, and \$10,000.00 was requested. The offering of the domain name for sale at a price substantially in excess of its out of pocket expenses supports the argument that it was both registered, and has been operated, in bad faith.

8.4 The Respondent is using the domain <emiratesholdidays.com.au> as a link farm landing page that does not clearly indicate that the website has no connection with the Complainant's business. This indicates that the website is being used to intentionally attract Internet users by creating a likelihood of deception or confusion with the complainant's "Emirates" and "Emirates Holidays" names and trade marks as to the source, sponsorship, affiliation, or endorsement of that web site or location. The Respondent is unduly profiting from this misrepresentation.

8.5 The website <emirates.net.au> directs to a parking web page. It has never been actively used, which creates an inference that it was either being held to obtain benefits by confusing or misleading internet users as to its affiliation with the Complainant's business, or to disrupt the business of the Complainant by preventing it from reflecting its own name or trade marks.

8.6 The fact that the Respondent registered two sites that use the "Emirates" name indicates bad faith.

**9. Remedies Sought**

The Complainant requests that the Respondent be required to transfer the disputed domain names to them, or be required to cancel their registration.

## **10. The Respondent’s Case - Factual Background**

- 10.1 The Respondent has been a travel agent since 1976.
- 10.2 The Respondent provides general geographic and economic information about the UAE and travel relating to that part of the world.
- 10.3 The Respondent’s business went into administration 3 years ago.

## **11. The Respondent’s Case - Arguments**

- 11.1 The Respondent refers to WIPO Arbitration and Media Center and Administrative Panel Decision: Emirates, Emirates Group vs Bluecom Consulting Group Pty Ltd, Case No.DAU2008-0004. The dispute involved the same Complainant as the present case and related to the use of the domain <emirates.com.au>. The complaint was denied.
- 11.2 The Respondent notes that the Complainant, at Paragraphs 2.6 and 7.1 of its Complaint, incorrectly refers to its ownership of the domain <emirates.com.au>. As a result of the incorrect naming of its own website the Respondent contends that the factual information provided by the Complainant about itself is misleading and incorrect and should therefore be dismissed.
- 11.3 The Respondent contends that: “the generic nature of the domains refers to the UAE and not specifically to Emiratesairlines but the UAE regions”. (sic)
- 11.4 The recent parking of the domain <emirates.net.au> was caused by the Respondent’s financial situation - his previous business went into administration 3 years ago.
- 11.5 The Respondent intends to establish a site similar to <emirates.com.au> to provide geographical information on the UAE and to sell packaged holidays to the Emirates, and other locations.
- 11.6 The domains: <emirates.net.au> and <emiratesholdidays.com.au> never have and will never be used in bad faith or passed off as an airline site.

## **12. Decisions, with brief reasons**

- 12.1 I am required to determine whether the Complainant has established that the Respondent’s right to own and operate the disputed domains fails all three tests specified by Section 4(a) of Schedule A of the auDRP.
- 12.2 If I find that the Complaints are justified I am further required to determine whether one or both of the disputed domains should be transferred into the Complainant’s name, or have their registrations cancelled.
- 12.3 The Respondent does not accept that he has done anything wrong and rejects the Complainant’s complaints and demands.

**13. Question 1: Per 4(a) (i) - is the domain name identical or confusingly similar to a name, trademark or service mark in which the Complainant has rights?**

- 13.1 **I find** that the domain name: <emirates.net.au> is “identical or confusingly similar” to “Emirates”, being the same word as the name, trademark or service mark in which the Complainant has established that it has legal rights. The web extension <.net.au> is disregarded in this context.

The “Emirates” name and trademarks have been extensively marketed and are well-known in Australia and around the world. As a result, in the absence of any clear contra-indicator on the face of the relevant web page, an ordinary internet user is likely to be confused into associating the disputed domain with the Complainant’s business.

- 13.2 **I find** that the domain name: <emiratesholdidays.com.au> is also “identical or confusingly similar” to “Emirates Holidays”, being the same words as the name, trademark or service mark in which the Complainant has established that it has legal rights.

The “Emirates Holidays” name and trademarks have been extensively marketed and are well-known in Australia and around the world. As a result, in the absence of any clear contra-indicator on the face of the relevant website, the disputed domain is likely to confuse ordinary internet users into believing that there is a real connection between the disputed domain and the Complainant’s business.

**14. Question 2: Per 4(a) (ii) – has the Complainant established that the Respondent has no rights or legitimate interests in respect of the domain name?**

- 14.1 Section 4(c) of Schedule A to the Policy lists three forms of evidence that may demonstrate a Respondent’s rights and legitimate interests in a disputed domain:

- (i) *before any notice to you of the subject matter of the dispute, your bona fide use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name in connection with an offering of goods or services (not being the offering of domain names that you have acquired for the purpose of selling, renting or*



*otherwise transferring); or*

- (ii) you (as an individual, business, or other organisation) have been commonly known by the domain name, even if you have acquired no trademark or service mark rights; or*
- (iii) you are making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue.*

- 14.2 **I find** that the Respondent has failed to prove that it has rights and legitimate interests in the disputed domain names <emirates.net.au> and <emiratesholdidays.com.au>.
- 14.3 **I find** that the Complainant has positively established that the Respondent lacks rights or legitimate interests in respect of the disputed domain names <emirates.net.au> and <emiratesholdidays.com.au>.
- 14.4 The Respondent has not established that before commencement of the dispute it owned, or traded under any business or company names that included the word “Emirates”, or “Emirates Holidays” - other than in the disputed domain names themselves, which are not sufficient to establish any legal rights.
- 14.5 The Respondent has not established that it was known by either of the disputed domain names before the complaint was raised.
- 14.6 The Respondent’s <emiratesholdidays.com.au> website offers flights and tourism products and services that compete directly with the Complainant’s business. It achieves this through third party providers, from whom it obtains pays-per-click commissions.

This form of use is not sufficient, in itself, to establish legitimate interests in the Respondent in respect of the disputed domain name.

Given the strength of the Complainant’s trademarks and its general recognition in the specific area marketed through the website, the absence of a clearly visible statement to the effect the Respondent’s site has no connection whatever with the Complainant’s business, may constitute an overt breach of the Complainant’s trademark rights.

- 14.7 The domain <emirates.net.au> is a parking web page. The domain <emiratesholdidays.com.au> is a “link farm parking page”. In these capacities, neither satisfies the specifications of 4 (c) (iii), which requires: *“a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the name, trademark or service mark at issue”*.
- 14.8 The Respondent relies, in part, on WIPO Arbitration and Media Center and Administrative Panel decision in : Emirates, Emirates Group vs Bluecom Consulting

Group Pty Ltd, Case No.DAU2008-0004, which referred to a dispute relating to <emirates.com.au>.

That complaint was denied because the Complainant failed to establish that the Respondent did not have legitimate rights in the disputed domain name, for the following reasons:

- (a) The Respondent had expended considerable effort and expense in an attempt to establish a legitimate business with tangible connections to the Emirates region; and
- (b) There are many companies around the world that include the word "Emirates" in their business and domain names as a reference to the geographic region described by the word "Emirates"; and
- (c) The Complainant's acknowledged trade mark rights could not, in themselves, absolutely prevent other businesses from using the word "Emirates", as an accepted name for a geographic region, simply as a result of the rights that attach to its trade and other marks.

14.9 The facts in (a) do not apply in this case, which makes (b) and (c) irrelevant to the matter in hand.

14.10 I further note that the Bluecom website <emirates.com.au> clearly states that it has no connection with Emirates Airline. The following statement appears on its home page: **"Note this site is NOT affiliated with Emirates airline"**.

14.11 The Respondent notes that the Complainant, at Paragraphs 2.6 and 7.1 of its Complaint, incorrectly refers to its ownership of the domain <emirates.com.au>. As a result of the incorrect naming of the website the Respondent contends that the factual information provided by the Complainant about its own business is misleading and incorrect and should therefore be dismissed. The error was subsequently acknowledged as such by the Complainant, who confirmed that they meant to refer to <emirates.com>. In my view, this was a clerical error. The substance of their information is unaffected, with reference to this matter, and the original error has no probative implications or value.

**15. Question 3: Per 4(a) (iii) – has the Respondent registered or subsequently used its domain name in bad faith?**

15.1 Section 4(b) of Schedule A to the Policy lists four forms of evidence of registration and use of a domain in bad faith. In respect of the Respondent:

- (i) *circumstances indicating that you have registered or you have acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to another person for valuable consideration in excess of your documented out-of-pocket costs directly related*

*to the domain name; or*

- (ii) you have registered the domain name in order to prevent the owner of a name, trademark or service mark from reflecting that name or mark in a corresponding domain name; or*
- (iii) you have registered the domain name primarily for the purpose of disrupting the business or activities of another person; or*
- (iv) by using the domain name, you have intentionally attempted to attract, for commercial gain, Internet users to a web site or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of that web site or location or of a product or service on that web site or location.*

15.2 **I find** that the Respondent registered the domain name <emirates.net.au> in bad faith.

15.3 As a travel agent operating since 1976, at the time of registration of the disputed domain <emirates.net.au>, the Respondent would have been aware that said domain name: (a) was identical to “Emirates” and, (b) the Complainant owned “Emirates” trademarks in Australia and, (c) the registration and use of such a name, at least without appropriate disclaimers (which do not appear on the <emiratesholdidays.com.au> website), would be likely to confuse internet users into believing the website had some affiliation with the Complainant’s business.

15.4 The registration of <emirates.net.au> therefore constitutes an action made in bad faith insofar as a reasonable person in possession of that knowledge would have known that it was wrongful to so register the domain.

15.5 **I find** that the Respondent registered the domain name <emiratesholdidays.com.au> in bad faith.

15.6 As a travel agent since 1976, at the time of registration of the disputed domain <emiratesholdidays.com.au>, the Respondent would have been aware that said domain name: (a) was identical to “Emirates Holidays” and, (b) the Complainant owned “Emirates Holidays” trademarks in Australia and, (c) the registration and use of such a name, without appropriate disclaimers (which are not evident on the website), would be likely to confuse internet users into believing the website had some affiliation with the Complainant’s business.

15.7 The original registration of <emiratesholdidays.com.au> therefore constitutes an action made in bad faith insofar as a reasonable person in possession of that knowledge would have known that it was wrongful to so register the domain.

15.8 The subsequent use of <emiratesholdidays.com.au>, as a link farm parking page and pays-per-click website constitutes further evidence that the Respondent

sought to obtain benefits and gains from trading on the name and reputation of the Complainant.

- 15.9 The Respondent refers to the WIPO administrative panel decision in: Emirates, Emirates Group V Bluecom Consulting Group Pty Ltd, Case No. DAU2008-0004, which referred to a dispute relating to <emirates.com.au>. The complaint was denied for reasons explained in 14.8 above. For those reasons I reject the use of that decision to support the Respondent's defence here, and in particular refer to the fact that there is no disclaimer on the <emiratesholdidays.com.au> website alerting visitors: "**Note this site is NOT affiliated with Emirates airline**". I take this as further evidence of the Respondent's bad faith dealings in its use of this website.
- 15.10 **I find** that the Respondent subsequently used the disputed domain name in bad faith, as use of the word "Emiratesholdidays.com.au" in the disputed domain in Australia was likely to confuse ordinary website visitors: *"by using the domain name you have intentionally attempted to attract, for commercial gain, Internet users to a website or other online location, by creating a likelihood of confusion with the complainant's name or mark as to the source, sponsorship, affiliation or endorsement of that website or location or of a product or service on that website or location"* (paragraph 4(b)(iv) of the auDRP).

## **16. Remedies Requested and Determination**

- 16.1 In accordance with Section 6 of the auDRP, the Complainant requests a decision that either cancels the domain name registrations 6.1(a), or transfers them to the Complainant 6.1(b).
- 16.2 **I determine**, for the reasons given above, that the Complainant has succeeded on all three required arguments and accordingly I order the transfer of the disputed domains from the Respondent to the Complainant.

### **Signed as a Determination**



**Jon Kenfield**

Panellist

Melbourne, 23<sup>rd</sup> July 2014