



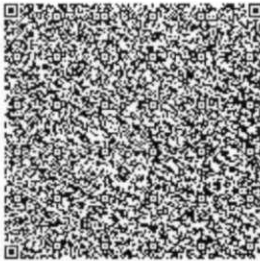
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e-Stamp

Certificate No. : IN-DL48384387133382L
 Certificate Issued Date : 12-Aug-2013 12:11 PM
 Account Reference : SHCIL (FI)/ dl-shcil/ HIGH COURT/ DL-DLH
 Unique Doc. Reference : SUBIN-DLDL-SHCIL95446082607574L
 Purchased by : AMARJIT SINGH ADVOCATE
 Description of Document : Article 12 Award
 Property Description : NA
 Consideration Price (Rs.) : 0
 (Zero)
 First Party : AMARJIT SINGH ADVOCATE
 Second Party : NA
 Stamp Duty Paid By : AMARJIT SINGH ADVOCATE
 Stamp Duty Amount(Rs.) : 100
 (One Hundred only)



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ARBITRATION AWARD

.IN REGISTRY - NATIONAL INTERNET EXCHANGE OF INDIA
 .IN domain Name Dispute Resolution Policy
 INDRP Rules of Procedure

IN THE MATTER OF:
 Emirates

...Complainant

VERSUS

Inshallah Ltd.

.....Respondent

Disputed Domain Name:

<www.emiratesholidayhs.in>

Statutory Alert:

1. The authenticity of this Stamp Certificate should be verified at "www.shcilestamp.com". Any discrepancy in the details on this Certificate and as

ARBITRATION AWARD

.IN REGISTRY – NATIONAL INTERNET EXCHANGE OF INDIA .IN domain Name Dispute Resolution Policy INDRP Rules of Procedure

IN THE MATTER OF:

Emirates
Emirates Group Headquarters,
P.O. Box 686, Dubai
United Arab Emirates.

...Complainant

VERSUS

Inshallah Ltd.
4 Perrin Court, Sheerwater
Surrey, GU21 5NN
GB

.....Respondent

Disputed Domain Name: **<www.emiratesholidays.in>**

1. THE PARTIES:

The Complainant in this arbitration proceeding is Emirates, Emirates Group Headquarters, P.O. Box 686, Dubai, United Arab Emirates.

The Respondent in the arbitration proceedings is Inshallah Ltd., 4 Perrin Court, Sheerwater, Surrey, GU21 5NN, GB

2. THE DOMAIN NAME AND REGISTRAR

The disputed domain name **<www.emiratesholidays.in>** has been registered by the Respondent. The Registrar with whom the disputed domain is registered is Dynadot LLC (R117-AFIN), P.O. Box 345, San Mateo, CA 94401, U.S.A.

3. **PROCEDURAL HISTORY**

The Complaint was filed with the .In Registry, National Internet Exchange of India (NIXI) against Inshallah Ltd., 4 Perrin Court, Sheerwater, Surrey, GU21 5NN, GB. The NIXI verified that the Complaint and the annexures to the Complaint and was satisfied that the formal requirements of the .in Domain Name Dispute Resolution Policy ("The Policy") and the Rules of Procedure ("The Rules") were complied with.

3.1 The Panel submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by NIXI to ensure compliance with the Rules (paragraph-6).

3.2 In accordance with the Rules, Paragraph-2(a) and 4(a), NIXI formally notified the Respondent of the Complaint and appointed me as a Sole Arbitrator for adjudicating upon the dispute in accordance with The Arbitration and Conciliation Act, 1996, Rules framed there under, .In Dispute Resolution Policy and Rules framed there under on **2nd May, 2013**. The Respondent vide his e-mail dated **2nd May, 2013** stated that he has not received any papers by e-mail or otherwise and requested the Panel to supply the paper book in order to file the reply in time.

The Panel by its e-mail dated **3rd May, 2013** directed the Registry to forward the proof of delivery to the Respondent and also directed the Complainant to forward soft copy of the Complaint along with all the Annexures to the Respondent within two days by e-mail.

- 3.3 In accordance with the rules, paragraph 5(c), the Respondent was also notified by me about the commencement of arbitration proceedings on 3rd **May, 2013** and the due date for filing his response.
- 3.4 The Panel did not receive delivery report from the Centre nor the Complainant confirming the delivery of Paper Book by e-mail to the Respondent as per Panel's direction dated **May 3, 2013**. However, the Respondent filed his response to the Complaint filed by the Complainant on 17th **May, 2013**, which satisfied the requirement of delivery / service of the documents to the Respondent.
- 3.5 The Panel considers that according to Paragraph-9 of the Rules, the language of the proceedings should be in English. In the facts and circumstances, in-person hearing was not considered necessary for deciding the Complaint and consequently, on the basis of the statements and documents submitted on record, the present award is passed.

4. **FACTUAL BACKGROUND**

- 4.1 The Complainant in these administrative proceedings is Emirates, Emirates Group Headquarters, P.O. Box 686, Dubai, United Arab Emirates.
- 4.2 The Complainant claims to be the world renowned, award winning international airline of United Arab Emirates and the largest airline in the Middle East. In little more than two decades, the Complainant has experienced extraordinary growth and has become

one of the most trusted transcontinental passenger airlines brand.

- 4.3 The complainant, under the brand EMIRATES, flies to over 132 destinations in 77 countries around the world. Apart from aviation, the Complainant also claim to have spread its wings into every aspect of travel, tourism and leisure to become a leading global corporation, and employs more than 42,000 people around the world.
- 4.4 The Complainant was founded on 25th October 1985. Since then the Complainant has evolved into a globally influential travel and tourism conglomerate known the world over for its commitment to the highest standards of quality in every aspect of its business. That Emirates Holidays is the tour-operating arm of the Complainant and offers a comprehensive range of holiday products for discerning travellers.
- 4.5 The Complainant expended significant resources in promotion and advertisement worldwide, including in India, and has established significant Internet presence over the years. Advertisements pertaining to the Emirates Family of Marks have been featured regularly in print and electronic media which inter alia include magazines, television, and the internet. The Complainant has incurred a significant amount of money in promotional expenses worldwide. As a result of Complainants' efforts, the Emirates Family of Marks enjoys tremendous reputation and goodwill in the minds of the consumers as well as

the members of the trade all over the world, including India. Consequently, the members of the trade and public associate and recognize the Emirates Family of Marks exclusively with the Complainant and none else.

- 4.6 The respondent has obtained registration of Domain name www.emiratesholidays.in, which is the subject matter of the present complaint.

5. PARTIES CONTENTIONS

5A. COMPLAINANT

- 5A(1) The Complainant submits that he has adopted the trade mark EMIRATES as early as the year 1985 with respect to its goods/services and is consequently a prima facie distinctive trade mark. The Complainant is the owner of the mark EMIRATES and various other marks containing the word EMIRATES, including EMIRATES HOLIDAYS. In addition to its use as a trade mark, the word EMIRATES is also the corporate identity and trading style of the Complainant.
- 5A(2) The Complainant further submits that they have been sponsoring many events, seminars, exhibitions, conferences etc., where the Emirates Family of Marks are displayed conspicuously through banners, hoardings, or online displays. The Complainant has been committed to sports sponsorship in both in UAE and around the world, beginning with the first powerboat race held in Dubai, in 1987.
- 5A(3) It is submitted by the complainant that due to the high quality of services being rendered by the

Complainant, it has been conferred with numerous prestigious awards for excellence worldwide.

5A(4) The Complainant submits that they own an extensive portfolio of international trade mark registrations for both the marks EMIRATES and EMIRATES HOLIDAYS. Many of Complainant's EMIRATES HOLIDAYS trade mark registrations were made in the 1990s either for the words EMIRATES HOLIDAYS alone or in conjunction with a logo. In most instances, however, the words "EMIRATES HOLIDAYS" are the predominant feature of the logo registrations. Therefore, the Complainant has a well-established proprietary claim over the trade mark EMIRATES and EMIRATES HOLIDAYS, and people all over the world associate the same exclusively with the Complainant.

5A(5) The profile and popularity of the Complainant under the trade/service name/mark EMIRATES, has been continuously increasing since the date of adoption and use of the mark. At present, the complainant's trade name/mark is a formidable brand and has acquired an enormous goodwill not only in the UAE or India but in many countries across the globe.

5A(6) The Complainant submits their trade/service name/mark an important and an extremely valuable asset and thus in order to protect the same, has obtained trade mark registration for the mark EMIRATES and EMIRATES HOLIDAYS in India.

5A(7) It is submitted by the Complainant that the marks EMIRATES and EMIRATES HOLIDAYS have acquired

unique importance and are associated with the Complainant. A mere mention of the said marks establishes an identity and connection with the Complainant and none else. The Complainant owns all the rights in the said marks which are its "Trade Mark" & "Service Mark". The use of the said marks by a third party either as a mark, name and domain name, or in any other form whatsoever constitutes infringement and passing off and is a violation of the Complainant's rights in the said marks. Further, the use of the disputed domain name by the Respondent amounts to misrepresentation and the Respondent by doing so is indulging in unfair competition.

5A(8) It is further submitted by the Complainant that as the Internet has become an essential medium to conduct business, the Complainant in order to expand its presence obtained the domain name registrations for "emirates.com" and "emirates-holidays.com" on July 25, 1996 and December 9, 1997, respectively. The Complainant has spent a considerable amount of money and skill to develop the marks EMIRATES and EMIRATES HOLIDAYS. The website www.emirates.com and emirates-holidays.com are comprehensive, unique and acclaimed sites of the Complainant.

5A(9) The complainant has also registered/acquired a number of domain names containing the word/words "EMIRATES" and EMIRATES HOLIDAYS in order to prevent others from using variations of its famous marks.

5A(10) The Complainant submits that EMIRATES and EMIRATES HOLIDAYS marks have been used extensively in commerce for a sufficient length of time and submits that the Complainant has also established in these proceedings that it has made enormous investments to promote/advertise the trade mark in India and internationally. The Complainant further submits that he has demonstrated that its EMIRATES and EMIRATES HOLIDAYS trade marks are highly distinctive one, with respect to its goods/services more precisely services related to travel and holidays. Considering the impeccable reputation, goodwill and notoriety enjoyed by the Complainant in its Emirates Family of Marks the world over including in India, its unauthorized usage and thereby infringement by unscrupulous traders in all arrays of business activities has been on a rise. To safeguard its intellectual property rights in the Emirates Family of Marks, the Complainant has been extremely vigilant and, wherever geographically possible, has been taking stringent legal actions against the unscrupulous traders and infringers, including in India.

B. RESPONDENT

5B(1) The Respondent in these proceedings is Inshallah Ltd., 4 Perrin Court, Sheerwater, Surrey, GU21 5NN, GB.

5B(2) The Respondent by its e-mail dated **2nd May, 2013** informed the Panel as well as NIXI that it has not

received any documents pertaining to the disputed Domain Name www.emiratesholidays.in.

The Panel vide e-mail dated 3rd **May, 2013** directed the NIXI to provide proof of delivery of the documents to the Respondent and also directed the Complainant to forward soft copy of the Complaint along with all the Annexures to the Respondent within two days by e-mail. Thereafter, the Respondent filed its response by e-mail dated May 17, 2013.

5B(3) The Respondent denies that the Complainants have shown sufficient evidence to prove all three elements of the Policy that are needed to succeed and prayed that the Complaint should be refused and the domain should remain in the ownership of the Respondent.

5B(4) The Respondent raise the following defences and made references to support its contentions in a nut shell as under:

The Complainant may have a Trade Mark that is valid in India, but

- (a) Such Trade Mark has not been used in India at all or to any extent sufficient to make it a well-known trade mark and it is not commonly known.
- (b) The Trade Mark is NOT a "word only" Trade Mark and includes a logo.

- (c) The Respondent was not at all aware of any such Trade Mark at the time that it registered the domain names now in dispute.
- (d) The 2 words "Emirates" and "Holidays" are both generic words and both words are used widely by many other persons and companies.

5B(5) The Respondent submit that it has not, at all, registered the domain name in bad faith or used it in any way that is in bad faith. The Respondent refers to the purchase by the Complainant of the domain name "EmiratesHolidays.co.uk" on or around the 2nd week in April 2012. This shows that the Complainant considered that the Respondent has rights and therefore had to pay the Respondent for said domain name. it cannot now say the opposite in respect of the .co. in and .in domain names.

5B(6) The Respondent submit that the words "emirates" and "holidays" are both generic words that are widely in use by many different companies and persons throughout the World. The Respondent does not accept that the Complainant has any monopoly on EMIRATES HOLIDAYS as the Complainant has a Trade Mark registered as a Logo. The Respondent therefore avers that the matter now in dispute should be decided strictly on basis of whether the Respondent was seeking to pass off as the Complainant. The Respondent registered the domain name in dispute.

- (a) because of the sale to the Complainant of the domain name "EmiratesHolidays.co.uk"
- (b) because the 2 words are both generic.

5B(7) The Respondent contends that he clearly has a legitimate right to the domain names in dispute viz e viz the words "emiratesholidays" and has NOT registered them in bad faith and has NOT used them in bad faith.

5B(8) The Respondent further submits that to succeed in the Complaint, the Complainant must prove all 3 parts of the Dispute Resolution Procedure (It is NOT for the Respondent to disprove but for Complainant to Prove) and the Respondent strongly contends that the Complaint must fail on the basis that the Complainant has NOT proven all 3 elements as required. It could be argued (I would aver not successfully) that the Complainant has rights, but it cannot possibly be sustainably argued that the Respondent does not have rights or that the Respondent has registered or used the domain names in dispute in any bad faith.

6. **DISCUSSIONS AND FINDINGS**

6.1 The Complainant, while filing the Complaint, submitted to arbitration proceedings in accordance with the .In Dispute Resolution Policy and the Rules framed there under in terms of paragraph (3b) of the Rules and Procedure. The Respondent also submitted to the mandatory arbitration proceedings in terms of paragraph 4 of the Policy, while seeking registration of the disputed domain name.

6.2 Paragraph 12 of the Rules provides that the Panel is to decide the Complaint on the basis of the statements and documents submitted and that there shall be no in-person

hearing (including hearing by teleconference video conference, and web conference) unless, the Arbitrator, in his sole discretion and as an exceptional circumstance, otherwise determines that such a hearing is necessary for deciding the Complaint. I do not think that the present case is of exceptional nature where the determination cannot be made on the basis of material on record and without in-person hearing. Sub-Section 3 of Section 19 of The Arbitration & Conciliation Act also empowers the Arbitral Tribunal to conduct the proceedings in the manner it considers appropriate including the power to determine the admissibility, relevance, materiality and weight of any evidence.

- 6.3 It is therefore, appropriate to examine the issues in the light of statements and documents submitted as evidence as per Policy, Rules and the provisions of the Act.
- 6.4 The onus of proof is on the Complainant. As the proceedings are of a civil nature, the standard of proof is on the balance of probabilities. The material facts pleaded in the Complaint concerning the Complainant's legitimate right, interest and title in the trade mark, trade name and domain name **<www.emiratesholidays.in>** and the reputation accrued thereto have neither been dealt with nor disputed or specifically denied by the Respondent. The Respondent has not also denied the correctness and genuineness of any of the Annexures/Exhibits filed by the Complainant along with the Complaint.
- 6.5 Under the provisions of Order 8 Rule 5 of the Code of Civil Procedure, 1908 the material facts as are not specifically denied are deemed to be admitted.

- 6.6 The decision of Hon'ble Supreme Court of India in the matter of **JahuriSah Vs. Dwarika Prasad** – AIR 1967 SC 109, be referred to. The facts as are admitted expressly or by legal fiction require no formal proof. (See Section 58 of the Indian Evidence Act, 1872).
- 6.7 Paragraph 10 of the Policy provides that the remedies available to the Complainant pursuant to any proceedings before an arbitration panel shall be limited to the cancellation or transfer of domain name registration to the Complainant.
- 6.8 Paragraph 4 of the Policy lists three elements that the Complainant must prove to merit a finding that the domain name of the Respondent to be transferred to the Complainant or cancelled:

A. IDENTICAL OR CONFUSINGLY SIMILAR

- 6A.1 The Complainant contends that the Registrant's Domain Name is identical or confusingly similar to a trade mark in which the Complainant has rights.
- 6A.2 The Respondent registered the Disputed Domain Name on 25th April, 2012.
- 6A.3 The Complainant is a registered proprietor of the Trade Mark (s) 'EMIRATES' & 'EMIRATES HOLIDAYS' vide Registration Nos. 632522 & 1288982 in India respectively. The Complainant also hold registration of the mark 'EMIRATES' in Arabic characters & 'EMIRATES SKY CARGO' in Arabic characters in India. The Trade Marks 'EMIRATES', 'EMIRATES HOLIDAYS' & 'EMIRATES

SKY CARGO' are also subject matter of registration in various countries around the world, the list whereof has been annexed by the Complainant with his Complaint as Annexures 6 & 7.

- 6A.4 The Respondent contents that the Complainant has not made use of the Trade Mark in India. The Respondent also contents that the Trade Mark, subject matter of registration is a Label mark and not a word mark. The Respondent also contends that the words EMIRATES & HOLDAYS are both generic words and both words are used by many other persons and companies.
- 6A.5 The case set up by the Respondent as far as validity and use of the Trade Mark (s) of the Complainant are concerned is not the subject matter of adjudication before this Panel. As stated earlier, the Panel is empowered to give its findings on the material available on record only limited to the cancellation or transfer of the Domain Name in dispute.
- 6A.6 The Respondent is at liberty to approach the appropriate Forum in case of non use of the mark by the Complainant under the provisions of Trade Marks Act, 1999. So long as the trade mark is registered it confer exclusive rights of use on the registered proprietor and right to restrain the use of any identical or deceptively similar mark under Sections 28 and 29 of the Act.
- 6A.7 The Registration Certificates of the Trade Marks 'EMIRATES' & 'EMIRATES HOLIDAYS' in India are prima facie sufficient to establish the right of the

Complainant in the mark. The essential part of the Label subject matter of the registration nos. 632522 in Class 16 & 1288982 in Classes 39 & 42 is 'EMIRATES' & 'EMIRATES HOLIDAYS'.

6A.8 The Complainant has also registered various Domain names incorporating the mark 'EMIRATES HOLIDAYS' under different gTLDs and ccTLDs. Some of the Domain Names are such as www.theemiratesgroup.com, www.emiratesholidays.biz, www.emiratesgroupcareers.com, www.emiratesholddays.info, www.emiratesholddays.co.uk, www.emiratesholddays.us, www.emiratesholidays.asia, www.emiratesholidays.com, www.emirates-holidays.info, www.emirates-holidays.org, www.emirates-holidays.in, www.emirates-holidays.co.uk, www.emirates-holidays.us, www.emirates-holidays.co.in, www.emiratesaviationcollege.com, www.emiratesliveevents.com, www.emiratesairlinefoundation.org, etc.,

6A.9 The words EMIRATES & HOLIDAYS have been alleged to be generic in nature and not distinctive by Respondent.

CL1 In Red Bull GmbH v. Chai Larbthanasub (WIPO Case No. D2003-0709) "The mere addition of a descriptive term to an identical trade mark is not sufficient to avoid confusion between the domain name and the trade mark"

- 6B.3 There has never been any relationship between the Complainant and the Respondent. The Respondent has no proprietary or contractual rights in any registered or common law trade mark corresponding in whole or in part to the disputed domain name. Further, the Respondent is not authorized or licensed by the Complainant to use its trade mark/trade name or to use the disputed domain name.
- 6B.4 The disputed domain name incorporates the whole of the Complainant's trade mark EMIRATES HOLIDAYS and the domain name suggests that it is associated with a website affiliated with, or otherwise connected to, the Complainant. Such a registration cannot be considered bona fide in nature or otherwise performed in good faith.
- 6B.5 The Respondent submits that the Complainant may have right in the Trade Mark, but the Respondent also have right since the Complainant has purchased the domain incorporating the mark EMIRATES HOLIDAYS under .co.uk ccTLD. The Respondent submits that it has legitimate right to the domain name and has not registered the said domain name in bad faith nor has used it in bad faith.
- 6B.6 The dispute before this Panel is with regard to registration of domain name <emiratesholidays.in>. The scope of this Arbitration proceedings is to determine the rights of the Complainant and that of the Respondent in the mark and the disputed domain name.

The Respondent has not been able to show cause his legitimate interest to develop or to provide any goods/services through the disputed domain name. This has rather clarified the Complainant's contention that the disputed domain has been held for the purpose of resale or to sell the same in the secondary market.

6B.7 In the matter of Charles Jourdan Holding AG v. AAIM (WIPO Case No. D2000-0403), it was held that :

"Paragraph 4(a) (ii) of the ICANN Policy asks whether the respondent has any rights or legitimate interests in respect of the domain name.

Paragraph 4(c) provides examples of circumstances that can demonstrate the existence of such rights or legitimate interests:

- (1) use of, or preparations to use, the domain name in connection with a bona fide offering of goods or services;
- (2) the fact that the respondent has commonly been known by the domain name; and
- (3) legitimate noncommercial or fair use of the domain name. The Panel finds that the Respondent has no legitimate rights or interests in that
 - (i) Respondent is not a licensee of Complainant, nor has he received any permission or consent to use the trademark;

- (ii) Complainant has prior in that trademark which precede Respondent's registration of the Domain Name; and
- (iii) Respondent is not (either as an individual, business or other organization) commonly known by the name Charles Jourdan. In this latter respect it is noted that the only use the Respondent has made of the Domain Name since its registration is as the web address for a site offering the Domain Name for sale."

6B.8 Therefore, this panel is satisfied that the respondent has no rights or legitimate interest in respect of the disputed domain name.

C. **Registered and used in Bad Faith**

6C.1 For a Complainant to succeed, the Panel must be satisfied that a domain name has been registered and is being used in bad faith.

6C.2 Paragraph 6 of the Policy states circumstances which, if found shall be evidence of the registration and use of a domain name in bad faith:

6C.3 The bad faith in registering the impugned domain name by the respondent is apparent from the fact that the same has been registered for the sole purpose of sale as discussed in the preceding paragraphs. Non use and passive holding is evidence

of bad faith. The above proposition is held in Bayer Aktiengesellschaft v. Henrik Monssen (WIPO Case No. 2003-0275). Numerous decisions support this proposition are in favour of the complainant.

6C.4 The registration of Domain Name incorporating a well known mark is strong evidence of bad faith. Various INDRP decisions and UDRP decisions support this proposition in favour of the Complainant.

6C.5 It is very unlikely that Respondent was unaware of Complainant's existence or trademark rights before registering the disputed domain name.

It has been held that the registration of a domain name containing a well-known mark is strong evidence of bad faith (Case No. INDRP/018, October 6, 2006, Becarrat SA v. Doreen Jungnickel/Darius Herman Domcreate;; Case No. INDRP/051, November 5, 2007, NBA Properties, Inc. v. Rickson Rodricks – Annex 34).

The Website posted on the disputed domain name clearly shows that the domain name subject matter of the dispute has been registered solely for the purpose to sell either to the Complainant or to any other person giving the demanded price to the Complainant.

The Respondent has also not disputed the said proposition and has rather provided an argument in support of buying and selling of domain name incorporating the trade mark of the Complainant.

6C.6 The Respondent further submits that the words EMIRATES & HOLIDAYS are generic words and cannot be registered by the Complainant.

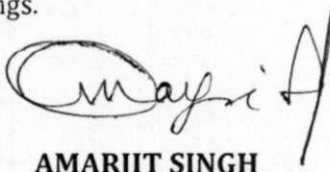
As stated earlier, the Respondent's argument cannot be entertained before this Panel as this Panel is only empowered to decide the dispute on the basis of the rights of the Complainant in the mark and satisfied with the registration of the mark EMIRATES & EMIRATES HOLIDAYS by the Complainant and if the Respondent wish to -challenge the said registration, he can approach the appropriate Forum for the redressal of the same.

6C.7 The Panel accepts the contentions of the Complainant as have been raised by them and holds that the registration of the domain name on the part of the Respondent is in bad faith.

7. **DECISION**

In view of the fact that all the elements of Paragraphs 6 and 7 of the policy have been satisfied and in the facts and circumstances of the case, the panel directs the Transfer of the domain name <www.emiratesholidays.in> to the Complainant.

The Respondent is also directed to pay cost of Indian Rupees 50,000/- (Rupees Fifty thousand only) to compensate the Complainant towards the cost of proceedings.


AMARJIT SINGH
Sole Arbitrator

Dated: August 1, 2013