

தமிழ்நாடு தமில்நாடு TAMILNADU

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8 AUG 2012

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**AK 322955**  
**P.S. SHANMUGA SUNDARAM,**  
STAMP VENDOR,  
L No B4 / 109 / 88  
HIGH COURT CAMPUS,  
CHENNAI-600 104 (TAMIL NADU)

BEFORE THE SOLE ARBITRATOR MR.D.SARAVANAN  
.IN REGISTRY  
(C/o. NATIONAL INTERNET EXCHANGE OF INDIA)

Disputed Domain Name: <[www.emirates.in](http://www.emirates.in)>

Emirates  
Emirates Group Headquarters,  
P.O. Box 686, Dubai, United Arab Emirates,  
Represented by Mr. Tarvinder Singh &  
Anshuman Sharma (Kochhar & Co. Gurgaon)  
([tarvinder.singh@kochhar.com](mailto:tarvinder.singh@kochhar.com))  
([anshuman.sharma@kochhar.com](mailto:anshuman.sharma@kochhar.com))

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Complainant

vs

Chella Goundappan,  
12044 Grewing SQ, #C3,  
Reston, VA 20191, USA,  
([Mail2chells@yahoo.com](mailto:Mail2chells@yahoo.com))

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Respondent

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#### 1.The Parties:

The Complainant is Emirates having their address at Emirates Group Headquarters, P.O.Box 686, Dubai, United Arab Emirates, Rep. by Mr.Tarvinder Singh & Mr.Anshuman Sharma.

The Respondent is Chella Goundappan having his address at 12044 Grewing SQ, #C3, Reston, VA 20191, USA.

#### 2. The Domain Name and Registrar:

The disputed domain name : <www.emirates.in> Created on 11.10.2006

The disputed domain name is registered with .IN REGISTRY, through its registrar GoDaddy.com Inc.

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### 3. Procedural History

- June 12, 2012 : The .IN REGISTRY appointed D.SARAVANAN as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- June 12, 2012 : Consent of the Arbitrator was given to the .IN REGISTRY according to the INDRP Rules of Procedure.
- June 28, 2005 : Complaint was filed by the Complainant in accordance with the Policy for Domain Name Dispute Resolution, adopted by the National Internet Exchange of India[NIXI].
- July 4, 2012 : 1st Notice of Hearing.
- July 13, 2012 : Respondent sent his response through e-mail.
- July 19, 2012 : Arbitrator sent a Notice through e-mail to the Claimant to file their rejoinder.
- July 24, 2012 : Rejoinder was filed by the Claimant through e-mail.

### 4. Factual Background

#### 4.1 The Complainant:

The Complainant is Emirates having their address at Emirates Group Headquarters, P.O.Box 686, Dubai, United Arab Emirates, Rep. by Mr.Tarvinder Singh & Mr. Anshuman Sharma.

#### 4.2 Complainant's Activities:

The Complainant is a large global airline and travel service company. It was incorporated on 25th October, 1985 at Dubai and now it is well established with 173 aircrafts under its Brand name and flies over 123 destinations in 73 countries around the world. Apart from aviation, the company has also 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. With the view to expand its business activities, the Complainant has been extensively advertising and promoting





EMIRATES in various electronic media which inter alia includes magazines, television and the internet.

#### 4.3 Complainant's Trading Name:

The Complainant 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, Emirates is a well-known airways company with the domain <www.emirates.com> that has been registered on July 25, 1996. The Complainant owns all the rights in the said name which is its "Trade Mark" & "Service Mark". The Complainant has been sponsoring many events, seminars, exhibitions, conferences etc., where the name/mark EMIRATES is displayed conspicuously through banners, holdings, or online displays. The complaint has been committed to sports sponsorship in both UAE and around the world. The said mark qualifies all tests for the well-known status of a mark under Section 11(6) of the Trade Marks Act, 1999, which includes considerations like knowledge or recognition among relevant section of public, duration, extent and geographical area of use, promotion and publicity of mark etc. It is further submitted that the mark EMIRATES also falls under the category of a famous mark as provided by Article 6 BIS of the Paris Convention. The Complainant also acquired a series of other domain names containing the word, "emirates" such as the [www.theemiratesgroup.com](http://www.theemiratesgroup.com), [www.emiratesgroupcareers.com](http://www.emiratesgroupcareers.com), [www.emiratesholidays.com](http://www.emiratesholidays.com), [www.emiratesaviationcollege.com](http://www.emiratesaviationcollege.com), [www.emiratesliveevents.com](http://www.emiratesliveevents.com), [www.emiratesairlinefoundation.org](http://www.emiratesairlinefoundation.org), etc, in order to prevent others from using variations of its famous mark.

##### 4.3.1 Respondent's Identity and activities:

The Respondent is Chella Goundappan having his address at 12044 Grewing SQ, #C3, Reston, VA 20191, USA.

##### 4.3.2 Dispute

The dispute arose when the Complainant became aware of the existence of the domain name "[www.emirates.in](http://www.emirates.in)" registered by the Respondent Company. Fearing



*mala fide* intentions of the Respondent and the possible damages so caused the Complainant has raised the dispute for resolution through arbitration.

## 5. Parties contentions:

### A. Complainant:

**(a) The Domain Name is identical to a Trademark or service mark of the Complainant in which the Complainant has rights:**

(i) According to the Complainant, the disputed domain name <emirates.in> includes the word emirates, which is identical and confusingly similar as a whole to the well known trademark <emirates.com> in which the Complainant has a statutory rights. The Complainant points out that not even a single letter differs between the disputed domain name and the corporate trademark of the Complainant. The Complainant further cites cases such as *ReunTERS Ltd. Vs Global Net 2000 inc.* ( WIPO Case No. D2000-0441), *Altavista Company Vs, Grandtotal Finances Ltd.*(WIPO Case No. D2000-0848), *Playboy Enterprises Vs. Movie Name Company* (WIPO Case NO. D2001-1201) where it was held that even the mere omission of one letter of a trade mark has no effect on determination of confusing similarities between a trade mark and a domain name. The present case is on an even greater footing as the Respondent has picked up the mark /name of the Complainants verbatim reproduction without even changing a single letter.

(ii) The Complainant states that they are the owner of trademark registrations with the term 'Emirates' in several jurisdictions and the Complainant is the registered proprietor of the mark 'Emirates' in India under the Trade Marks Act, 1999. The Complainant further states that as the disputed domain name <www.emirates.in> is clearly identical/confusingly similar to the Complainant's trademark in which the Complainant has exclusive rights and legitimate interest, the right of the Complainant is violated.

(iii) The Complainant further cites *Magnum Piering Inc, V. the Mudjackers and Granwood S. Wilson* (WIPO Case No. D2000-1525) and *Rollerblade Inc. V. Chris McCrady* (WIPO CASE No. D2000-0429) where it was established that the specific top level domain name such as ".com", ".org" may be disregarded when determining whether



it is identical or confusingly similar to the trade mark on which the Complainant has rights.

**(b) Respondent has no rights or legitimate interests in respect of the domain name:**

(i) The Complainant states that the Respondent is in the business of holding domain names and selling them, whereas the Complainant is an established business entity doing business under the mark /name "Emirates". This is evidence enough to show that the Respondent has no interest in the disputed domain name and is merely hoarding the same without doing any business from it.

(ii) The Complainant contends that the sole purpose of registering the domain name is to misappropriate the reputation associated with the Complainant's famous trademark "Emirates". The Complainant also points out that the Respondent is not commonly known by the domain name nor has he made any demonstrable preparation to use the disputed domain name in connection a commercial purpose.

(iii) 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/services mark/name or to use the disputed domain name. The Respondent may misuse the domain name by hosting an unauthorized website.

(iv) Explaining the significance of the domain name the Complainant stated that domain name acts as a web address or web mark of the company and is as important as a trade mark or a service mark.

**(c) Respondent has registered and is using the domain name in bad faith:**

1) The Complainant claims that the very fact that the Respondent registered the disputed domain name years after the registration of the Complainant's domain name www.emirates.com is *prima facie evidence* of *mala fide* intentions and bad faith. The Complainant further claims that the Respondents actions bear any or all of the following motives:





- (i) The domain name could be used by the Respondent to extract huge sums of money from the Complainant who has a legitimate interest in the said domain name;
  - (ii) Through the impugned domain name, by activating a website, the Respondent may be able to represent itself as the Complainant or its authorized representative and cause damage to some innocent party by entering into transactions or contracts with them under the garb of being associated with the Complainant;
  - (iii) The Respondent can sell the disputed domain name to some competing interest of the Complainant who may damage the goodwill and reputation of the Complainant by inserting prejudicial material in relation to the Complainant;
  - (iv) The Respondent by using the disputed domain name, may attempt to attract for commercial gain, the internet users to the Respondent's website or other on-line location, by creating a likelihood of confusion with the Complainant's mark/name/domain name as to the source, sponsorship, affiliation, or endorsements of the Respondent's website or location or of product or service on Respondent's website or location.
- 2) The Complainant also contends that the Complainant's emirates mark is a well known and the Respondent is presumed to have knowledge of the Complainant's mark at the time of registration of the confusingly similar domain name. Therefore, the Complainant submits that the domain name has been registered in bad faith for monetary gain.

#### **B. Response by the Respondent:**

The Respondent submitted a reply stating that there are similar domain names that are registered and are functioning with no identical name or trade mark issues. The Respondent further states it is not confusing for the people when they use the following domain names that are registered and functioning which are said to be identical <www.emirates.org> <www.emirates.net> <www.emirates.info> <www.emirates.biz> <www.emirates.co.in>. The Annexures filed by the Respondent



shows the screen shots of those websites respectively. The Respondent states that he has registered the domain name just to provide information to the people around the world regarding "The United Arab Emirates" which is stated to be one of the world's fastest growing tourist destinations. The Respondent states that he registered the said domain name <emirates.in> in a good faith so that he can provide information to the people around the world in the same way that the other above stated websites provide and there is no bad faith or intention in registering the domain name.

### C. Rejoinder by the Complainant:

- (i) The Complainant has provided ample evidence to prove the longstanding use of the domain name. It has been proved beyond reasonable doubt that the Complainant is the owner of the well known trade mark "EMIRATES".
- (ii) The Complainant refers to some decisions passed in its favour where it was noted that the term "Emirates" has acquired a secondary significance and connote the Complainant more so than it does the region known as United Arab Emirates".[ Emirates Corporation V. 2220 Internet Coordinator (WIPO Case No. D2005-1311), Emirates V. Michale Toth (Nominet Dispute Resolution Service Case No, D00008634), EmiratesV. Melanie A, Orchard (WIPO Case No D2008-1837), Emirates Group Headquarters V. Domain Discreet/ Ahmed Bin Subaih (WIPO Case No. D2010-0811)
- (iii) The disputed domain name <emirates.in> includes the word Emirates, which is identical and confusingly similar as a whole to the well known and registered trade mark Emirates in which the Complainant has statutory rights as well as rights in common law, by virtue of a long and continuous use and being its registered proprietor thereof. This makes it very likely that the internet user may confuse the website to be associated with the Complainant.
- (iv) The Complainant states that the Respondent has failed to furnish any evidence to prove its right in the Emirates mark, neither has it





established any bona fide use of the mark in commerce. The Complainant further cites the following cases:- [Vaicom International Inc. V. MTV ALBUMS- Mega Top Video Albums Peter Miadshi (WIPO case No. D2002-0196), Magnum Piering, inc. V. The Mudjakers and Garwood S.wilson, Sr. (WIPO Case No, D2000-1525) and Boehringer Ingelhiem Pharma GmbH & Co.KG V. Philana Dhimkana (WIPO Case NO.2006-1594), INDRP in INDRP/015 regarding SONYERRISION mark and HSBC Holdings plc V. HOoman Esmail Zedeh (INDRP-32) where it was observed that it is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark.

- (v) The Claimant states that the Respondent has failed to comply with the Section 3 of INDRP by infringing upon the Complainant's right.
- (vi) To counter the Respondents' argument about the existence of many other similar websites, the Claimant argues that it is settled law that "an imitation remains an imitation whether it is done by one or by many, it requires no legitimacy. A wrong is not rightened by the following it musters". The Complainant further relies on cases where the courts have expressed that this tendency must be crubed in the interest of trade and consumers.( Tata Iron & Steel Co.Ltd V. Mahavir Steel and Ors (MANU/DE/0525/1992), Kumar Electric Works & Anr. V. Olympia Home Appliances (P) Ltd.
- (vii) It is further submitted that the Respondent's registration and design of domain name <www.emirates.in > has been dormant for the past five years and has failed to demonstrate any use in connection with the bona fide offering of goods and services. The Complainant replied upon the decision of Byar Aktiengesellschaft v. Henrik Monssen (WIPO Case No.2003-0275) , HSBC Holdings plc. v. Hooman Esmail Zedeh (INDRP-32) and Bloomberg Finance L.P. v. Kanhan Vijay V (INDRP-110). Where it was held that non use and passive holding is evidence of bad faith use. The Complainant further discussed Audi



AG v. Hans Wolf (Audi-Lamborghini.com) where the same was discussed in detail.

- (viii) Finally, the Complainant submitted that it is established principle that when a domain name is so obviously connected with the Complainant and its good/services very use by someone with no connection to the Complainant suggests "opportunistic bad faith". The Complainant relied on the following cases in this regard. Tata Sons Limited v. Tata Telecom Inc/Tata-telecom.com, Mr. Singh (Case No. D2009-0671) and America online Inc. v. Chinese ICQ Network (WIPO Case No. D2000-0808)

#### 6. Discussion and Findings:

Under paragraph 4 of the IN Domain Name Dispute Resolution Policy (INDRP), the Complainant must prove each of the following three elements of its case:

- (i) The Respondent's domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) The Respondent has no rights or legitimate interest in respect of the domain name; and
- (iii) The Respondent's domain name has been registered or is being used in bad faith.

#### (a) Identical or confusing similarity:

(i) The registered name of the Complainant is "Emirates" and it has furnished its annual report and the games to which it sponsored in the Annexure 3 and Annexure 4 respectively. The main defense of the Respondent is that other websites such as <www.emirates.org>, <www.emirates.net>, <www.emirates.info>, <www.emirates.biz> and <www.emirates.co.in> has the same identical name as emirates and they are functioning without any legal or trade mark issues. The Respondent's contention to provide information about "The United Arab Emirates" to the people around the world is to be taken as informative but there has been no





activity by the Respondent for the five years and there has been no such activity as stated by the Respondent. And the site <emirates.in> showing "This site is not currently available" may create confusing in the minds of the people.

(ii) Admittedly, the disputed domain name <emirates.in> include the word emirates, which is identical and confusingly similar as a whole to the well known and registered trademark <emirates.com> in which the Complainant has statutory rights as well as rights in common law, by virtue of a long and continuous user and being its registered proprietor thereof. The Respondent's domain name <emirates.in> consists of entirely Complainant's trade mark. Thus, this Arbitral tribunal comes to the irresistible conclusion that the disputed domain name <emirates.in> is confusingly similar or identical to the Complainant's marks. Thus, the disputed domain name is likely to cause confusion, mistake and deception, and hence constitutes infringement of Complainant's domain name and trade mark, as well as constituting unfair competition. As established in the cases presented by the Complainant ".com", ".org", etc, can be disregarded while determining whether the addresses in question are identical.

(iii) The Arbitral tribunal concludes that the Complainant has established paragraph 4(i) of the IN Domain Name Dispute Resolution Policy.

**(b) Respondent's Right or Legitimate Interests :**

Under section 7 of INDRP, the existence of a legitimate interest is determined by considering the existence of following circumstances

1. Use of, or preparation of use of, the domain name in connection with *bona fide* offerings of goods and services;
2. The fact that the Respondent has commonly been known with the domain name; and
3. Legitimate non-commercial or fair use of domain name.

(i) The Respondent has no legitimate interest in the disputed domain name. There is no material exhibited on the part of the Respondent that he is



a prior user of the impugned domain name and also the Respondent is not commonly known by the domain name and in fact it is not the Respondent's case also. The Respondent's domain name will misleadingly divert customers or tarnish the trademark of the Complainant. "Emirates" is a legitimate and commonly understood short-hand for matters connected with United Arab Emirates. The Respondent claims to have plans of providing information about the United Arab Emirates to people around the world through the domain name in dispute. However as stated in prior decisions of UDRP, any such use would require the utmost *bona fide* character. The Respondent has made no use of the domain name for the past five years. It is also to be noted that the Respondent seems to have no intention or purpose to use the disputed domain name for bona fide offering of goods and services in relation to it and that the Respondent is in the business of holding and selling domain names.

(ii) From the materials, the Respondent does not have rights or legitimate interests in the disputed domain name. The Respondent has not been licensed or otherwise authorized the Respondent to use their trademark.

(iii) The Arbitral Tribunal is satisfied that the Respondent has no rights or legitimate interest in respect of the disputed domain name and accordingly paragraph 4(ii) of the policy is satisfied.

**(c) Registration and Use in Bad faith:**

1) The Respondent claims to have plans of providing information about the United Arab Emirates to people around the world through the domain name in dispute. However, he fails to answer critical questions as to why the website was dormant for the past five years. It is settled law that the non use and passive holding is evidence of bad faith use. To further support this claim, the Complainant has cited the following cases Bayer Aktiengesellschaft V. Henrik Monssen (WIPO Case No. 2003-0275), HSBC Holdings plc V. Hooman Esmail Zedeh (INDRP-32) and Bloomberg Finance L.P. V. Kanhan Vijay V (INDRP-110).





2) Section 6 of INDRP states that the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

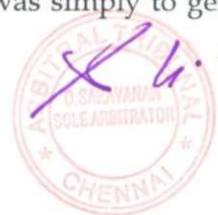
(i) circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or

(ii) the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or

(iii) by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location.

3) The Respondent has made no use of the domain name for the past five years. It is also to be noted that, the Respondent is in the business of holding and selling domain names. Hence, it is reasonable to believe that the Respondent has malafide interest.

4) In view of the submitted evidence and in the specific circumstances of this case, this Arbitral Tribunal draws the legal inference that Respondent's purpose of registering the domain name was in bad faith within the meaning of the Policy. The Respondent has no legitimate rights or interests in the disputed domain name and there was a malafide intent for registering the disputed domain name other than for commercial gains, and that the intention of the Respondent was simply to generate



revenue, either by using the domain name for its own commercial purpose or through the sale of the disputed domain name to a competitor or any other person that has the potential to cause damage to the ability of the Complainant to have peaceful usage of the Complainant's legitimate interest in using their own trade names.

In the light of the above, this Arbitral Tribunal finds that the Complainant has established that the disputed domain name was registered and is being used in bad faith.

#### 7. Decision :

In view of the above facts and circumstances, it is clear that the Complainant has succeeded in his complaint. In the facts and the circumstances of the case it can be legally inferred that the only purpose for the registration of the disputed domain name by the respondent was to capitalize on the fame and reputation of the Complainant and to make monetary benefits.

The Respondent has got registered and used the disputed domain name in bad faith. Hence the .IN Registry of the NIXI is hereby directed to transfer the domain name i.e.<www.emirates.in> to the Complainant in accordance with Paragraph 10 of the INDRP rules.

Dated at Chennai (India) on this 13<sup>th</sup> August, 2012.

  
(D.SARAVANAN)  
Sole Arbitrator