

Al Tamimi wins its own domain name hijack case

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The Scam

The Respondent, Nicole Huisman, registered the disputed domain name 'www.altamimichambers.com'. No website was created for the domain name. Instead the scam involved emails being sent to people by a person who identified himself as Mr. T. K. Badran of the Commercial Bank of Dubai. He would inform the victim that they were the beneficiaries of a deceased estate, and that in order to inherit they needed to provide their bank details and liaise with an attorney called Mr. H. Hourani, the managing partner of Al Tamimi & Company. The contact details provided were the correct details of Al Tamimi & Co.; the only incorrect detail was the email address, given as "[...]@altamimichambers.com" and the phone number.

The Complaint

Al Tamimi & Co. owns the registered trademark 'Al Tamimi & Company', and uses the domain name 'www.tamimi.com', which is a source of information and contact details for clients and potential clients.

On learning of the scam the firm filed a complaint before the World Intellectual Property Organization (WIPO) against Nicole Huisman to stop her using the Al Tamimi trademark. The firm argued that:

1. The disputed domain name was confusingly similar to its own trademark.
2. The Respondent had no rights or legitimate interests in using the disputed domain name, and was in fact using it bad faith.
3. The Respondent has no connection with Al Tamimi & Co. and was not authorized by the law firm to use its name.
4. The Respondent is not known by the name Al Tamimi, nor was the name being used for a non-commercial purpose (which may have provided a defence to the complaint).
5. There was no plausible reason why the Respondent would have chosen to use 'Al Tamimi' as part of the disputed domain name except to misappropriate the goodwill and reputation of Al Tamimi & Co. The Respondent must have known of the 'Al Tamimi' trademark and the credibility it has in the market place. The Respondent had manifestly registered the domain name solely for the purpose of attracting users who rely upon the goodwill and reputation subsisting in the Complainant's name.

WIPO's Findings

The WIPO Panel agreed with Al Tamimi & Co. that the disputed domain name had incorporated its 'Al Tamimi' trademark in its entirety and, crucially, that the addition of the descriptive term 'chambers' had added nothing to distance the domain name from the Complainant.

The WIPO panel also found that the Respondent's use of the disputed domain name could not be characterised as 'use in connection with the bona fide offering of services'. Instead it found that the disputed domain name had been registered and used in bad faith.

The Panel also accepted Al Tamimi & Co.'s argument that the Respondent must have had knowledge of its

trademark and its reputation at the date at which the Respondent registered the disputed domain name. In particular the Panel accepted that Husam Hourani is a well known legal personality in the region who had been named Managing Partner of the Year in 2013 by IFLR, and that this was doubtless why his name and law firm he worked for had been targeted.

Accordingly, the WIPO Panel was satisfied that the Complainant had succeeded in proving its case and ordered that the disputed domain name be transferred to Al Tamimi & Co. (thereby preventing the Respondent from further using the firm's name in its scams).

Comment

A company's business reputation is its fortune. It is important to be vigilant in monitoring any unauthorised usage of your intellectual property in cyberspace and to act swiftly and decisively in rooting out any problems. Using the WIPO Arbitration and Mediation Centre as a means to do so has proven highly effective and quick in resolving domain name disputes.

In this case, the fact that Al Tamimi & Co. has a portfolio of trademarks that it vigilantly enforces supported its argument that any attempt to free ride on its substantial goodwill and reputation was damaging to its brand integrity and likely to cause brand dilution.

Fortifying one's cyber presence has never been more important as an increasing number of users log onto the internet to conduct research and to seek verification of facts and figures as a basis for making commercial decisions.

This significant case represents yet another decisive victory for the ATCO Domain Name Dispute Resolution practice, part of our award winning IP practice which continues to counsel clients in ensuring that their valuable goodwill and reputation is well protected in cyberspace.