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CYBERSQUATTING AND ITS IMPLICATIONS – COMMENTARY ON CASE NO. D2024-4706 INVOLVING THE “PROPERTY FINDER” TRADEMARK.

Property Finder is a household name in the booming UAE real estate market. The trademark “**PROPERTY FINDER**” is well-known in the UAE and the Middle East as most property buyers and sellers as well as lessors and lessees use the Property Finder website and application to list and search for properties. There is no doubt that fame comes at a cost, which in terms of trademarks is usually infringement. Infringers are always at a lookout for famous trademarks to capitalize on their goodwill and to make easy profits. Same is the case with our client Property Finder IP Holding Limited.

Our client, **Property Finder IP Holding Limited**, recently became aware of an infringing domain name <propertyfindersuae.com> registered and used by a third party without their consent. After some research and gathering evidence, we filed a complaint before the WIPO Arbitration and Mediation Center which was registered under **Case No. D2024-4706**, and an Administrative Panel was appointed.

INTRODUCTION

In the case of we argued that the disputed domain name infringed upon our client's registered trademark and intellectual property rights; whereas the Respondent claimed that her domain name was valid, asserting it was

unrelated to the Complainant's business activities.

FACTUAL BACKGROUND

Our client, Property Finder IP Holding Limited (Complainant) is an online real estate advertising platform operating throughout the Middle East region. The Complainant's real estate listings are accessible throughout the world to search for property in the Middle East, including the United Arab Emirates. The domain name “**Propertyfinder.com**” was launched in 1995 and was later acquired by the Complainant. The Complainant's domain name is currently used by thousands of real estate agents and individuals under the Complainant's representation to offer a vast range of properties for sale and/or rent. The Complainant's website is accessed by a significant number of unique visitors every month, which serves as evidence of the well-known status of the **PROPERTY FINDER** / **PROPERTYFINDER** formative trademarks and the goodwill the Complainant holds in the trademark. For several years the Complainant has held a prominent position in the Middle East region and maintains a substantial client portfolio consisting of brokerages, real estate agents, and developers. This is confirmed by media coverage by distinguished broadcasters and several renowned publications over the years.

In order to protect their valuable trademark from infringement and passing off, the Complainant has obtained registration of their various trademarks in a number of countries around the world. The Complainant owns several trademark registrations for “**PROPERTY FINDER**” formative marks, and a number of domain names including www.propertyfinder.com, www.propertyfinderuae.com, www.propertyfinder.ae.

The disputed domain name, <propertyfindersuae.com>, was registered in 2012 and redirected to a website listing homes for sale and rent.

COMPLAINANT'S CLAIMS

We on behalf of the Complainant argued that the disputed domain name is confusingly similar to our client's registered trademarks, as it incorporates the “**PROPERTY FINDER**” trademark with the addition of the letter “s” and the suffix “uae.” We asserted that the Respondent does not have any rights or legitimate interests in the domain name, as the Respondent was not authorized by our client to use the trademark. Furthermore, the domain name was being



used in bad faith to deceive internet users and disrupt the Complainant's business.

RESPONDENT'S DEFENCE

The Respondent argued that the domain name **<propertyfindersuae.com>** was registered in 2012 for a real estate business that has been operational for over 12 years. The Respondent asserted that the domain name was selected based on its alignment with the business's activities and was not intended to infringe on the Complainant's rights. The Respondent claimed that she began using the impugned domain name in 2017, which indicates that the Complainant was aware of the Respondent's domain name but did not raise objections until much later. The Respondent also argued that her business, Property Finders Real Estate, is distinct from the Complainant's online portal, and that she has legitimate rights to use the domain name because it reflects her business name.

FINDINGS

The Panel's findings based upon the submissions made by both the parties were as follows:

Identical or Confusingly Similar

The first element under the **UDRP (Uniform Domain Name Dispute Resolution Policy)** is whether the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights. The Panel found that the disputed domain name is confusingly similar to the Complainant's trademark. Although the domain name adds "s" and "uae" to the Complainant's trademark, these additions do not prevent a finding of confusing similarity. The Complainant's trademark is clearly recognizable within the disputed domain name, and such modifications are unlikely to prevent confusion.

Rights or Legitimate Interests

The second element requires the Respondent to demonstrate rights or legitimate interests in the disputed domain name. In this case, the Complainant successfully established a *prima facie* case that the Respondent lacked such rights or interests. The Respondent's argument that the domain name reflects her business name **Property Finders Real Estate** was rejected by the Panel. The Respondent failed to include the full business name in the domain name (i.e., "Real Estate" was omitted), and the inclusion of "uae" was most likely designed to capitalize on the Complainant's trademark and place of business.

Furthermore, while the Respondent operated a legitimate real estate business, her use of the domain name was deemed likely to confuse users into believing it was affiliated with the Complainant.

Registered and Used in Bad Faith

The third element examines whether the domain name was registered and is being used in bad faith. The Respondent claimed that when she registered the domain name in 2012, she was unaware of the Complainant's business. However, the Panel found it difficult to accept this claim, given the Complainant's well-established presence in the UAE real estate market at that time. Internet archive records show that the Complainant's domain names were in use well before the Respondent's registration of **<propertyfindersuae.com>**.

Moreover, the Panel noted that the Respondent's website used a logo similar to the Complainant's, and the presentation of "Property Finder" on the site mirrored the Complainant's branding. The Respondent's attempt to attract users by creating a likelihood of confusion with the Complainant's trademark supported a finding of bad faith.

DECISION

In light of the above findings, the Panel concluded that the Respondent's registration and use of the disputed domain name constituted bad faith under the UDRP. Consequently, the Panel ordered that the disputed domain name **<propertyfindersuae.com>** be transferred to the Complainant.

CONCLUSION

This case highlights the importance of trademark rights in domain name disputes and the potential for domain names to create confusion in the digital marketplace. The Panel's decision to transfer the domain name underscores the need for businesses to respect intellectual property rights and avoid using domain names that may mislead consumers or capitalize on the reputation of established brands.

If you're facing a similar issue, feel free to reach out to us at global@audirivox.com, and we'll be glad to assist you.

IP UPDATES

SAUDI ARABIA: DESIGNATION OF USPTO AS AN ISA/IPEA UNDER THE PCT



The Saudi Authority for Intellectual Property (SAIP) has formally appointed the United States Patent and Trademark Office (USPTO) as an International Searching Authority (ISA) and International Preliminary

Examining Authority (IPEA) under the Patent Cooperation Treaty (PCT). This update is effective immediately and allows applicants filing international patent applications via SAIP to select the USPTO for international search and preliminary examination processes.

This development signals enhanced cooperation in intellectual property between Saudi Arabia and the United States. The USPTO now joins the list of SAIP-recognized ISAs/IPEAs, which includes:

- Korean Intellectual Property Office (KIPO)
- European Patent Office (EPO)
- Intellectual Property Office of Singapore (IPOS)
- Egyptian Patent Office
- Russian Federal Service for Intellectual Property (ROSPATENT)
- Canadian Intellectual Property Office (CIPO)

IRAN SHIFT TO ELECTRONIC TRADEMARK PUBLICATION



Effective April 12, 2025, under Iran's revised Industrial Property Protection Law (2024), all accepted trademark applications and post-registration changes will be

published exclusively on the Intellectual Property System website: <https://ipm.ssaa.ir/MGZ>.

This change replaces publication in the Official Gazette with the new Electronic Gazette of Intellectual Property. As a result, previous publication fees have been eliminated.

ETHIOPIA: ONLINE PUBLICATION OF TRADEMARKS INITIATED



Starting March 26, 2025, the Ethiopian Intellectual Property Authority (EIPA) has begun publishing accepted trademarks on its official website. This move

supplements the existing method of publication via the Ethiopian Press Agency, which remains valid for the time being.

Currently, no official fees are being charged for online publication, though it is expected that a fee structure may be introduced in the future. Updates regarding such changes will be shared as they become available.

IRAQ IMPLEMENTATION OF THE 11TH EDITION OF THE NICE CLASSIFICATION



From January 2025, the Iraqi Trademarks Office (TMO) has transitioned from its national subclassification system to the globally accepted 11th Edition of

the Nice Classification.

Key Changes and Implications:

- **Mandatory Pre-filing Search:** All trademark applications require compulsory preliminary search. Results are provided in a binary ("YES" or "NO") format without detailed explanations. Applicants have 30 days to file following the search result.
- **Goods/Services Classification:** All new applications must follow the Nice 11th Edition. Existing pending applications can either:
 - Proceed under the old subclass system and reclassify post-opposition before registration; or
 - Reclassify immediately during prosecution by aligning with the Nice 11th Edition. The TMO has discretion to modify classifications as necessary.

This transition aims to harmonize Iraq's trademark system with international norms but may pose temporary challenges for applicants, particularly those with complex applications.

TURKEY INTRODUCTION OF SUBCLASSES IN TRADEMARK APPLICATIONS



As per Communiqué No. 2024/2 issued by the Turkish Patent and Trademark Office (TÜRKPATENT), a new subclassification system for goods and services came into force on December 20, 2024.

Notable Features:

- Trademark classes now include specific subclasses to better define protection scope and reduce ambiguity in disputes.
- A major update affects Class 35, particularly subclass 35.5, which covers services involving the retail and wholesale of a broad range of goods.
- For example, a textile company registering under Class 25 can optionally include subclass 35.5 to cover services like retailing clothing, footwear, and accessories.
- TÜRKPATENT has also introduced additional fees for applications that specify more than two subclasses under 35.5, encouraging precise and justified usage.
- It is important to note that Subclass coding (e.g., 35.5) remains optional but is recommended for strategic clarity.



PATENT CASES



ABBVIE BIOTHERAPEUTICS INC & ANR. (Appellant) vs ASSISTANT CONTROLLER OF PATENT DESIGNS (Respondent)

CASE NO.: C.A.(COMM.IPD-PAT) 44/2023 & I.A. 23895/2023
DECIDED ON: April 16th, 2025



The appellant has filed an appeal against the respondent challenging the rejection of the appellant's patent application on the grounds of section 2(1)(j), 3(i) and 59(1) of the Patent Act. The appellant contended that the amended claims directing 'anti-cMet antibody-drug conjugate (ADC)' are disclosed in the specification and claims therefore the same can be accepted under section 59(1) and also the objections under section 2(1)(j) and 3(i) of the Act should be waived off. The

respondent counter argued that the appellant seeks to convert the original set of method claims into product claims and the amendments made were also beyond the scope under section 59(1). The respondent further stated that the original set of method claims fall under excluded subjected matter under section 3(i) and lack of industrial application under section 2(1)(j).

The Hon'ble Delhi High Court upheld the impugned order passed by the respondent. The Hon'ble Court stated that the amended set of claims removes limitation by amending claims beyond the scope of originally filed specification and claims, thereby affecting the patentability under section 59(1). Also, the original set of claims are excluded under section 3(i) of the Act and also lacks industrial applicability under section 2(1)(j) of the Act. The Hon'ble Court concluded by dismissing the present appeal.

UCB PHARMA GMBH & ANR. (Appellant) vs THE CONTROLLER OF PATENTS AND DESIGNS (Respondent)

CASE NO.: IPDPTA No. 117 of 2023 (OA/1/2020/PT/KOL.)
DECIDED ON: April 08th, 2025



The appellant has filed an appeal against the respondent for rejecting the appellant's patent application on the ground of lack of inventive step under Section 2(1)(j) of the Patents Act. The appellant argued that none of the prior art cited by the respondent provide any kind of suggestion to an artisan compared to the solution offered in the appellant's invention. The appellant further argued that the respondent had cited new prior arts at the time of the hearing, which is not acceptable, and it was also wrongfully justified by the respondent.

The Hon'ble Calcutta High Court analyzed the current matter and stated that the appellant should be priorly intimated before the hearing regarding the new objections or prior arts cited and considered by the respondent. The Hon'ble Court concluded by setting aside the impugned order and remanded the matter back to the different Controller for fresh consideration.

BTS RESEARCH INTERNATIONAL PTY LTD (SR/55/2020/PT/KOL) (Petitioner) vs THE CONTROLLER GENERAL OF PATENTS & DESIGNS, MUMBAI & ORS. (Respondent)

CASE NO.: IPDPTA 56 OF 2023
DECIDED ON: April 03rd, 2025



In the present case, the petitioner had challenged the respondent for rejecting the petitioner's patent application under Section 3(j) and 3(c) of the Patents Act, 1970. The petitioner contended that the subject invention related to tri-hybrid cell is produced by an artificial process using genetic engineering techniques and not by using any biological process for production or propagation of plants and animals. Therefore, the present invention cannot fall within the scope of section 3(j) and section 3(c) of the Patent Act. The respondent countered that the subject invention are stem cells and are capable of developing into organisms, also the applicability of section 3(j) has been adequately reasoned and explained while rejecting the subject invention.

The Hon'ble Calcutta High Court observed the following matter and stated that the subject invention does not deal with artificial process and genetic manipulation is a technical process which falls outside the mischief of section 3(j). The Hon'ble Court also stated that the rejection under section 3(j) is unsubstantiated and fundamentally misinterpreted by the respondent and the respondent has also ignored the technical intervention or human step in the subject invention, and baselessly rejected the subject invention under section 3(c). The Hon'ble Court concluded and directed the patent office to consider the matter afresh, ensuring that the matter is reheard by a different Controller.

KEMIN INDUSTRIES, INC. (Appellant) vs THE CONTROLLER OF PATENTS (Respondent)

CASE NO.: CMA(PT) No.46 of 2024

DECIDED ON: March 18th, 2025



The present appeal has been filed by the appellant against the respondent for rejecting the appellant's patent application on the grounds of Section 2(1)(j), Section 3(i) and Section 3(d).

The appellant argued that the cited prior art fails to disclose the combination of the four main chain degrading enzymes as in the appellant's invention, satisfying all the requirements of section 2(1)(ja). Also, the appellant has employed more than one new reactant, therefore the appellant's invention is patentable under section 3(d). The appellant further contended that the invention do not teach a method of treating animals but rather focuses on a method of supplementing an animal feed, therefore the appellant's invention cannot be excluded under section 3(I).

The respondent counter argued that the cited prior arts discloses the appellant's invention and the appellant's invention also make use of a known process. Further the appellant's invention discloses a process for treating animals to increase their economic value. Therefore, the

claimed invention cannot be patentable under Section 2(1)(j), Section 3(i) and Section 3(d).

The Hon'ble Madras High Court observed that the cited prior arts do not disclose the combination of four enzymes as disclosed in the claimed invention, also the method illustrated in the invention do not aim for treating animals. Further, the claims also deploys more than one reactant. Therefore, the claimed invention constitutes inventive step under Section 2(1)(j) and cannot be excluded under Section 3(i) and Section 3(d). The Hon'ble Court concluded by setting aside the impugned order and ordered the claimed invention to proceed for grant.



TRADEMARK CASES

DIAGEO SCOTLAND LIMITED (Appellant) vs. PRACHI VERMA & ANR. (Respondents)

CASE NO.: C.A. (COMM.IPD-TM) 7/2025

DECIDED ON: 16th April 2025

The present appeal was filed by the appellant challenging the order dated 01.10.2024 passed by the Assistant Registrar of Trade Marks, which dismissed its opposition to the registration of the mark "CAPTAIN BLUE" by respondent no.1.

The appellant is the registered proprietor of the trademarks "CAPTAIN" and "CAPTAIN MORGAN" and has been using these marks extensively in India since 2006. The "CAPTAIN MORGAN" brand reported sales of approximately USD 6.48 million in India in 2023. Respondent no.1 had applied for registration of "CAPTAIN BLUE" on a "proposed to be used" basis for alcoholic beverages.

The Hon'ble Delhi High Court held that the respondent no.1's mark "CAPTAIN BLUE" was deceptively similar to the appellant's registered "CAPTAIN" family of marks and would likely cause confusion among consumers. The Hon'ble Court noted that the appellant had established prior rights and reputation in the "CAPTAIN" marks, while respondent no.1 had failed to demonstrate bona fide adoption or use of the impugned mark.

Hence, the Hon'ble Court set aside the Registrar's order and directed the removal of "CAPTAIN BLUE" from the Register of Trade Marks, upholding the appellant's exclusive rights in its well-known "CAPTAIN" trademarks.

MANKIND PHARMA LIMITED (Petitioner) vs. PREET KAMAL GREWAL AND ANR. (Respondents)

CASE NO.: C.O. (COMM.IPD-TM) 279/2022
DECIDED ON: 2nd April 2025

The present petition has been filed seeking the removal of the impugned trademark '**KINDPAN**' registered in the name of the respondents, arguing that it infringes upon the petitioner's established trademark rights.

The petitioner has been using the trademark '**MANKIND**' since 1986 and holds the trademark '**KIND**' for medicinal and pharmaceutical preparations. The petitioner is recognized as a leading player in the pharmaceutical industry, with significant annual turnover and goodwill.

The Hon'ble High Court found that the respondents failed to appear in the proceedings, leading to the admission of the petitioner's claims. The trademark '**MANKIND**' and the '**KIND**' family of marks are not distinctive, and the registration of '**KINDPAN**' would likely cause confusion and dilute the distinctiveness of the petitioner's marks. A decree was granted in favor of the petitioner, directing the removal of the impugned trademark '**KINDPAN**' from the Trade Marks Registry, affirming the petitioner's rights as the prior adopter and user of the '**KIND**' family of marks.

ADIDAS AG (Plaintiff) vs. SANDEEP VOHRA (Defendant)

CASE NO.: CS Comm. No.828/2024
DECIDED ON: 02nd April 2025

The present suit was filed by **Adidas AG**, seeking a **permanent injunction** restraining the defendant from infringing its registered trademarks "**Adidas**", "**Three Stripes**", and "**Trefoil**" logo, along with reliefs for passing off, copyright violation, damages, and delivery-up of counterfeit goods.

The plaintiff is the registered proprietor of the aforementioned trademarks in India and worldwide. Investigations revealed that the defendant was **manufacturing, stocking, and selling counterfeit Adidas products**, including shoes bearing identical/deceptively similar marks, through his premises in Delhi and an Instagram handle (@epickickx).

The Hon'ble Court held that the defendant had slavishly copied Adidas' registered and well-known trademarks, causing **brand dilution** and **monetary losses**. A **Local Commissioner's** seizure of **1,680 counterfeit shoes** further established the infringement. The Hon'ble Court emphasized the defendant's **blatant infringement** and

upheld Adidas' rights, reinforcing strict action against counterfeiters.

CHANDRA SHEKHAR SABOO & ORS. (Plaintiffs) vs. SHIV CHARAN SHARMA & ORS. (Defendants)

CASE NO.: CS (COMM.)/335/2019
DECIDED ON: 2nd April 2025


The present suit has been filed seeking relief of permanent injunction restraining the defendants from infringing the trademarks and copyright of the plaintiffs, passing off their goods as that of the plaintiffs, along with other ancillary reliefs.

The plaintiffs have been using '**PUKHRAJ**' trademark since 1963 and '**EMERALD**' trademark since 1979. The plaintiff no.2 is the registered proprietor of the trademark '**PUKHRAJ**' and plaintiff no.3 is the registered proprietor of trademark '**EMERALD**' under different classes in India whereas Defendants 1 to 3 were using the impugned trademark '**PANNA PUKHRAJ**'.

The Hon'ble Court held that the defendants have dishonestly adopted the plaintiffs' registered trademarks '**PUKHRAJ**' and '**EMERALD**' (which means '**PANNA**' in Hindi) and the products of the said defendants bearing the impugned marks are being used for identical goods. Hence, a decree of permanent injunction was passed in favour of the plaintiffs as they were successful in establishing a clear case of infringement and passing off.

UNDER ARMOUR INC. (Petitioner) vs. ASHWANI & ANR. (Respondents)

CASE NO.: C.O. (COMM.IPD-TM) 150/2023
DECIDED ON: 6th March 2025

The present rectification petition was filed seeking cancellation of trademark registered in the name of respondent no.1, on grounds of deceptive similarity and bad faith. The impugned mark "AU" 

with an interlocking design was alleged to infringe upon the well-known '**UA**'  and '**UNDER**

ARMOUR' trademarks of the petitioner.

The Petitioner is globally recognized for its sportswear and accessories and holds registered rights to the '**UA**' mark internationally and in India since 2004. The petitioner alleged that the respondent's impugned mark was deceptively similar to its own stylized '**UA**' logo, and that the respondent intended to ride on the goodwill and reputation of the petitioner's brand.



Despite being served and given multiple opportunities, the respondent failed to file a reply or appear before the Hon'ble Court. Upon comparing the marks, the Hon'ble Court observed that the respondent's mark was a deliberate imitation, using the interlocking style to mislead consumers. The Hon'ble Court held that this act amounted to infringement, deception, and passing off, reiterating that deceptive similarity in logos or device marks, especially in overlapping industries, warranted cancellation if it created confusion in the minds of consumers.

LOREAL S.A. (Plaintiff) vs. ASHOK KUMAR AND OTHERS (Defendants)

CASE NO.: CS(COMM) 474/2021, I.A. 12603/2021, I.A. 12608/2021, I.A. 12609/2021 & I.A. 47983/2024
DECIDED ON: 4th March 2025

The present suit has been filed seeking relief of permanent injunction restraining the defendants from infringing the trademark and copyright of the plaintiff, passing off their goods and services as that of the plaintiff, along with other ancillary reliefs.

The plaintiff has been using the trademark 'L'Oreal' and its various stylized marks since 1900. The plaintiff's goods are sold in approximately 130 countries, including India, where they enjoy significant goodwill. The defendants are engaged in fraudulent activities, impersonating the plaintiff's employees and misleading consumers through a rogue website under the domain name www.lorealglobal.in

The Hon'ble Delhi High Court held that the defendants had copied the plaintiff's registered and well-known trademark 'L'Oreal' and other formative marks. The products bearing the impugned marks were used for identical services, leading to confusion among consumers. A decree of permanent injunction was passed in favor of the plaintiff, as they successfully established a clear case of trademark infringement and passing off.



COPYRIGHT CASE

PHONOGRAPHIC PERFORMANCE LIMITED (Plaintiff) vs. AZURE HOSPITALITY PRIVATE LIMITED & ORS. (Defendants)

CASE NO.: CS(COMM) 714/2022

DECIDED ON: 3rd March 2025

The present suit was filed seeking relief of permanent injunction restraining the defendants from infringing the copyright of the plaintiff in sound recordings by publicly performing them without license, along with other ancillary reliefs. The plaintiff is the assignee of public performance rights for over 4 million sound recordings from various music labels. The defendants operate 86 restaurants/bars (including 'Mamagoto' and 'Dhaba') where they were found playing the plaintiff's copyrighted sound recordings without authorization during July-October 2022.

The Hon'ble Delhi High Court held that the defendants' unauthorized use of the plaintiff's copyrighted works constituted infringement under Section 51 of the Copyright Act. The Hon'ble Court rejected the defendants' contention that the plaintiff required copyright society registration under Section 33, affirming its rights as an assignee-owner under Section 30. The Hon'ble court granted an interim injunction restraining the defendants from exploiting the plaintiff's sound recordings pending final suit adjudication.

AUDIRI VOX IS EXHIBITING AT INTA

We are thrilled to announce that Audiri Vox will be participating as an Exhibitor at the 2025 INTA Annual Meeting in San Diego from May 17-21, 2025!

Find us at **Booth No. 1254** – where our team will be ready to connect, collaborate, and discuss the latest in IP and trademark strategies.

Want to schedule a meeting with us?
Reach out at **Global@Audirivox.com**



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