

DISPUTE RESOLUTION SERVICE

D00013645

Decision of Independent Expert

Skyscanner Limited

and

Mr Alan Elias

1. The Parties:

Lead Complainant: Skyscanner Limited
Quartermile One
15 Lauriston Place
Edinburgh
EH3 9EN
United Kingdom

Respondent: Mr Alan Elias
kuipersdijk 157
Enschede
Netherlands
7512 CD
Netherlands

2. The Domain Name:

skyscanner.me.uk

3. Procedural History:

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need to be disclosed as they

might be of such a nature as to call in to question my independence in the eyes of one or both of the parties.

18 December 2013 09:38 Dispute received
18 December 2013 11:08 Complaint validated
18 December 2013 11:14 Notification of Complaint sent to parties
09 January 2014 01:30 Response reminder sent
13 January 2014 09:40 Response received
13 January 2014 09:40 Notification of Response sent to parties
16 January 2014 01:30 Reply reminder sent
16 January 2014 12:06 Reply received
16 January 2014 12:07 Notification of Reply sent to parties
16 January 2014 12:07 Mediator appointed
21 January 2014 14:16 Mediation started
04 February 2014 09:52 Mediation failed
04 February 2014 09:53 Close of mediation documents sent
14 February 2014 01:30 Complainant full fee reminder sent
19 February 2014 08:58 Expert decision payment received

4. Factual Background

The Complainant is a UK registered company incorporated on 16 May 2001. Since 2002, it has traded under the name SKYSCANNER. It is the creator of a travel search and price comparison website hosted at the domain skyscanner.net (and other domains registered by the Complainant using, inter alia, the name SKYSCANNER). The Complainant achieves 60 million visits per month from over 25 million unique visitors around the world and offers travel searches in 30 different languages. It has won numerous awards, including a Queen's Award for Enterprise and the SKYSCANNER website has received significant media coverage.

The Complainant is the proprietor of 29 trade mark registrations in 16 jurisdictions, and a further 109 pending trade mark applications for additional trade marks in 53 jurisdictions, all of which consist of or incorporate the word SKYSCANNER. In each jurisdiction, the trade mark registrations and applications include online travel information and arrangement services, which includes providing flight comparison information online. The Complainant's trade mark registrations include UK registered word mark SKYSCANNER (registered number: 2313916), filed on 23 October 2002 and registered on 30 April 2004, and European Community registered word mark SKYSCANNER (registered number: 1030086), filed on 1 December 2009 and registered on 17 January 2011.

The Respondent registered the domain name in dispute <skyscanner.me.uk> (the Domain Name) on 29 September 2013.

On 15 October 2013, the Complainant sent a letter to the Respondent requesting that he transfer the Domain Name to the Complainant and explaining why he should do so. The Respondent replied by email on 1 November 2013, refusing to transfer the Domain Name, saying that he was

setting up his own travel comparison website and that the *'the only way to make this undone is to receive a personal phone call from the CEO of Skyscanner. Otherwise, you will be hearing from my website as soon as you will see your visitors are being reduced by the day, looking for cheaper tickets elsewhere'*. The Complainant responded by email on 13 November 2013, restating its position (that the Respondent's registration of the Domain Name constituted an 'Abusive Registration') and again requesting that the Respondent transfer the Domain Name to the Complainant. The Complainant also offered to pay the Respondent £250.00 to cover out-of-pocket expenses associated with the transfer. The Respondent replied by email on 24 November 2013, rejecting the Complainant's offer and stating that he had begun work on his own travel comparison site.

5. Parties' Contentions

The Complainants' contentions can be summarised as follows:

- A very substantial amount of time, effort and cost has been invested by the Complainant in order to generate very extensive goodwill in the Complainant's websites and related trade marks, to build up custom and to acquire an established and well-regarded reputation in the travel industry. The extent of the Complainant's reputation and goodwill in the websites and related trade marks is such that they are distinctive of the Complainant and exclusively associated with the Complainant in the minds of the industry and the public throughout the world.
- On or around 11 October 2013, the Complainant became aware of the existence of the Domain Name. The Domain Name is not currently being, and so far as the Complainant is aware has not in the past been used to host an active website.
- There is no business relationship or connection of any kind between the Complainant and the Respondent.
- The Domain Name is identical to the Complainant's SKYSCANNER trade marks and registration of the Domain Name post-dated acquisition by the Complainant of rights in the name SKYSCANNER.
- The Domain Name was registered in a manner which, at the time of registration, took unfair advantage of, or was unfairly detrimental to the Complainant's rights and is therefore an Abusive Registration.
- The Domain Name was registered for the purpose of unfairly disrupting the business of the Complainant and/or as a blocking registration and/or otherwise to take unfair advantage of the Complainant's rights.
- The Respondent was aware of the Complainant's brand and business at the time of registration of the Domain Name. The Respondent selected the Domain Name for its association with the Complainant's SKYSCANNER mark. He is actively in the process of developing a

business which will provide identical services to that of the Complainant's websites as evidenced by the Respondent stating in his email of 1 November 2013, that *'The reason I purchased this domainis to help Skyscanner in becoming the largest, but things have changed now... I am setting up my own Comparison site which involved all big travel search engines....I don't have to explain the effect to you as you know that and you are scared....'*

- The Respondent also made clear in his email of 1 November 2013, that his aim was for his own website to compete directly with the Complainant's websites, stating (as mentioned above) that *'..you will be hearing from my website as soon as you will see your visitors are being reduced by the day, looking for cheaper tickets elsewhere.'* (The Respondent also stated in the same email that he had the requisite skills to achieve his aims).
- The Complainant contends that it is reasonable to believe that the Respondent intends either to host his own rival travel comparison site from the Domain Name, or to host such a site from an alternative domain, while using the Domain Name to divert Internet users searching for the Complainant's websites to the Respondent's rival site. In any event, the logical inference is that the Respondent is determined to unfairly disrupt the business of the Complainant and that registration of the Domain Name represents part of that strategy.
- So far as the Complainant is aware, the Respondent has no registered rights in any trade marks which comprise all or part of the Domain Name.
- The Complainant does not believe that the Respondent can demonstrate any circumstances that would evidence that registration of the Domain Name was not an Abusive Registration: the Respondent was aware of the SKYSCANNER marks (and of the Complainant's cause for complaint) when it registered the Domain Name, and he has not made any legitimate use of the Domain Name to date or advanced any argument that he intends to. The Domain Name is not generic or descriptive (the word 'skyscanner' has no, or at least no obvious meaning other than to identify the Complainant's business and, as a purely invented term, is highly distinctive).
- Finally, the fact that the Respondent will not transfer the Domain Name to the Complainant (even in exchange for the reasonable consideration offered by the Complainant), precludes him from arguing that he is engaged in any lawful practice of trading domain names for profit.

The Respondent's contentions can best be summarised by quoting from his Response:

- The Respondent says that he acquired the Domain Name *'with only good intentions which was helping Skyscanner in becoming on of the*

largest Travel Search Engine site on the planet and by doing that I was hoping to get a fixed job at their office. As you can see in the defend I first received a very threatening letter about the consequences of not giving the domain back. Why? I don't think it's very polite of such a large company to threaten a individual who fairly bought a domain which was available the time I saw it ...

I refused to be treated that way and said "No" to their request of giving it back, so I received an offer by Andrew of I believe 250 Pound while I clearly mentioned that I didn't want any money from them I only requested a phonecall from the CEO to ask him the following question: Can I have a job interview? Nothing more and nothing less ...

I also mentioned that I was now going to support a new concept which was setting up a website to compare travel search engines (see email enclosed by mr. Andrew), so comparing Opodo with Skyscanner, WTC, vliegtickets.nl etc. This is nothing compared to what skyscanner does, because skyscanner is comparing flight prices of airlines and not travel search engines ...

I also indeed stated that skyscanner will see a drop in it's visitors and that would be also the fact if there was a website comparing all the travel search engines. Sometimes the Dutch WTC.nl is more affordable to fly with than skyscanner or Opodo and that is nothing more than a smart decision of someone who is looking for a cheaper ticket.

Having mentioned that I would like to state that in every email I sent out I have never talked about using the domain skyscanner.me.uk to harm Skyscanner in any way. '

- The above represents more or less the entirety of the Response.

The Complainant's Reply to the Response

- At no point during the pre-Complaint correspondence did the Complainant behave in a threatening manner. The Complainant sought to resolve the matter reasonably and without recourse to formal legal procedure and conducted itself in a reasonable and moderate manner despite unreasonable demands from the Respondent, such as to receive a personal call from the Complainant's CEO.
- The Respondent suggests that his intended comparison site is dissimilar to that of the Complainant. That is incorrect. His site would be a direct competitor to the Complainant's business.
- As to the Respondent's comment '*I have never talked about using the domain skyscanner.me.uk to harm Skyscanner in any way*' the Complainant states, first, that this is irrelevant and secondly, if the Respondent's intention in registering the Domain Name was merely to use it to assist him in obtaining a job with the Complainant, he was still

acting in a way that took unfair advantage of or was unfairly detrimental to the Complainant's registered rights. If the Respondent wished to obtain a job with the Complainant, he should have applied in the normal way.

6. Discussions and Findings

Preliminary matter

The Respondent has submitted a request under Paragraph 13(b) of the DRS Procedure that a non-standard submission be allowed. He states *'I have an exceptional need for the Expert to view my further submission because it's technically not possible to upload any further defence against Skyscanner's latest reply on Nominet. In this way Skyscanner is allowed to reply on my latest response, but I on the other hand am not which makes this case already not fair towards me.'*

The Reply of the Complainant deals with matters raised by the Respondent in his Response. Whilst the Response was a brief document, that was of the Respondent's choosing. He has had a full opportunity to express his views on matters addressed in the Complaint. The Expert does not consider this to be a case where there is an exceptional need for the Respondent to be allowed to submit to the Panel a further submission. In fact, the Respondent has not even tried to make out such a case, simply referring to what he perceives to be the inherent unfairness in the Complainant being allowed to respond to his submission, but he not being allowed to respond to the Complainant's (second) submission i.e. the Reply. But those are the rules. Something more therefore needs to be shown before a non-standard submission is to be allowed, and it wasn't.

The Policy

Under the provisions of Nominet's Dispute Resolution Service Policy (the Policy), for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the domain name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's 'Rights'

The meaning of 'Rights' is defined in the Policy as follows: *'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning'*.

The Complainant enjoys long-standing registered rights in the SKYSCANNER mark. It has several trade mark registrations for SKYSCANNER and the mark has been used in its activities over many years.

The Domain Name encapsulates the Complainant's mark SKYSCANNER in its entirety. The suffix '.me.uk', may be disregarded for comparison purposes and thus the Complainant's SKYSCANNER mark is identical to the Domain Name.

Accordingly, the Expert is satisfied that the Complainant has Rights in a name or mark that is identical to the Domain Name.

The Expert must now therefore consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either '*registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights*' or which '*has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights*;'.

A non-exhaustive list of factors which may indicate that a domain name is an Abusive Registration is set out in paragraph 3 of the Policy. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the domain name primarily as a blocking registration against a name or mark in which the Complainant has rights, or for the purpose of unfairly disrupting the business of the Complainant.

Other factors suggesting an Abusive Registration include the Respondent using or threatening to use the domain name in a way which has confused or is likely to confuse people or businesses into believing that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

A non-exhaustive list of countervailing factors (which may indicate that a domain name does not constitute an Abusive Registration) is set out in paragraph 4 of the Policy. This includes, for instance, circumstances indicating that before being aware of the Complainant's cause for complaint, the Respondent has made legitimate non-commercial or fair use of the domain name.

Discussion

The Complainant contends that the Respondent registered the Domain Name for the purposes of unfairly disrupting the business of the Complainant and/or as a blocking registration, pursuant to Paragraph 3 (a)(i)(b) and (c) of the Policy, and/or otherwise taking unfair advantage of the Complainant's rights, and has no answer to the Complaint.

The Domain Name is identical to the SKYSCANNER mark. The Respondent clearly knew of the Complainant at the time of registration, and of its brand. That is abundantly clear from his stated purpose of registration – to impress the Complainant and to thereby secure employment. (His Response states that he registered the Domain Name *‘with only good intentions which was helping Skyscanner in becoming on of the largest Travel Search Engine site on the planet and by doing that I was hoping to get a fixed job at their office’*).

The difficulty with the Complainant’s contention that he registered the Domain Name for the purposes of unfairly disrupting the business of the Complainant and/or as a blocking registration, is that the circumstances set out in Paragraph 3(a)(i) of the Policy envisage the registrant (the Respondent) having the requisite intention (e.g. to disrupt or block), at the time of registration and such intention being the primary aim of registration. But if the Respondent’s case is taken at face value, that may be unlikely. However, Paragraph 3.2 of the Nominet DRS Expert Overview (the “Overview”) deals with this very point and provides:

‘3.2 The circumstances set out in paragraphs 3(a)(i) all concern the registrant’s motives at time of registration of the domain name. Can a subsequent intention (i.e. formed after registration of the domain name) to sell the domain name to the Complainant at a profit or to unfairly disrupt the Complainant’s business constitute an abusive use within the meaning of subparagraph ii of the definition of Abusive Registration in paragraph 1 of the Policy?’

The answer is Yes. The Overview states, in answer to the question posed, *‘Unfair disruption of the Complainant’s business by way of a domain name is very likely to constitute an abusive use of the domain name (DRS 02223 itunes.co.uk). Similarly, a threat to unfairly disrupt the Complainant’s business by such a means is also likely to constitute an abusive use of the domain name (qv. the wording “is using or threatening to use the domain name ...” in paragraph 3(a)(ii) of the Policy)’*.

The Complainant has rights in the SCYSCANNER mark of which the Respondent was aware at the time of registration. The use to which the Respondent has or threatens to put the Domain Name would undoubtedly cause disruption to the business of the Complainant. In these circumstances, the Expert has no doubt that the Complainant has made out a case of Abusive Registration. The Expert must now consider whether the Respondent has an answer to that case.

Such a consideration usually involves a review of Paragraph 4 of the Policy. However, the Respondent has not bothered to refer to it. Instead, the Respondent appears to rely on matters that have no real bearing on the decision the Expert needs to make, such as the perceived lack of courtesy shown to him by the Complainant. The Expert does not consider that the Response gives rise to an answer to the Complaint. Moreover, it appears to a certain extent to be inconsistent with matters previously advanced by the Respondent. In this regard, the Expert refers to the Respondent’s comment

(in his Response) that *'I have never talked about using the domain skyscanner.me.uk to harm Skyscanner in any way.'* That statement appears to be directly at odds with statements made by the Respondent (and referred to earlier) in the pre-Complaint correspondence between the parties e.g. *'I am setting up my own Comparison site which involved all big travel search engines....I don't have to explain the effect to you as you know that and you are scared'*.

In all the circumstances, the Expert is satisfied that in the hands of the Respondent, the Domain Name is an Abusive Registration.

7. Decision

The Expert finds that the Complainant has rights in a name or mark that is identical to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name, <skyscanner.me.uk> be transferred to the Complainant.

Signed: Jon Lang

Dated 12 March 2014