

DISPUTE RESOLUTION SERVICE

D00021656

Decision of Independent Expert

Skyscanner Limited

and

Kalin Karakehayov

1. The Parties:

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

Respondent: Kalin Karakehayov
19 Koziak Sofia
Sofia
1407
Bulgaria

2. The Domain Name:

skyscanneruk.uk

3. Procedural History:

I 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 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.

22 July 2019	15:33	Dispute received
23 July 2019	12:02	Complaint validated
23 July 2019	13:58	Notification of complaint sent to parties
09 August 2019	02:30	Response reminder sent
12 August 2019	10:56	Response received
12 August 2019	10:56	Notification of response sent to parties
15 August 2019	02:30	Reply reminder sent
20 August 2019	09:22	No reply received
23 August 2019	11:40	Mediator appointed
28 August 2019	10:21	Mediation started
28 October 2019	09:24	Mediation failed
28 October 2019	09:24	Close of mediation documents sent
28 October 2019	13:58	Expert decision payment received

4. Factual Background

The Complainant, Skyscanner Limited, is an online travel company founded in 2003 and operating under the brand SKYSCANNER. It is the holder of several trade marks, including UK trade mark number 2313916 SKYSCANNER registered on 30 April 2004.

The Domain Name was registered on 4 July 2019 and currently points to a parking page containing pay-per-click (PPC) links, some of which refer to websites of the Complainant's competitors.

5. Parties' Contentions

5.1 The Complainant's contentions can be summarised as follows:

- the Domain Name is virtually identical to the Complainant's Rights, including the SKYSCANNER word mark mentioned above. The Domain Name simply contains in addition the term 'uk', which merely describes the location of the Complainant's registered office. This is not sufficient to render the Domain Name distinct from the Complainant's Rights in visual or phonetic characteristics.

- the Respondent does not own any trade mark applications or registrations for SKYSCANNER. Further, the Complainant has found no evidence to suggest that the Respondent is commonly known as 'Skyscanner UK'. The Complainant has not given the Respondent consent to use confusingly similar variations of its trade marks within the Domain Name.
- the Respondent lacks any legitimate interest in the Domain Name and is not making fair use of the Domain Name.
- the Respondent must have been aware of the Complainant's reputation in its Rights at the time the Domain Name was registered, as the Complainant already enjoyed an international reputation in the travel industry in relation to its services under its trade marks. The Complainant claims it has 80 million users every month and that its mobile app was downloaded 70 million times. The Complainant also refers to press articles regarding the acquisition, in November 2016, of the Complainant's business by China's largest on-line travel agency, Ctrip, in a deal worth £1.4 billion.
- the Domain Name is used as a blocking registration inasmuch as the Complainant is prevented from registering a Domain Name in which it, and no other individual or business, has rights.
- the Domain Name is designed to benefit from the Complainant's reputation in its rights. Given that the Domain Name points to a parking page containing PPC links that guide consumers to competitors of the Complainant, the Domain Name is used to mislead consumers as to an affiliation with or connection to the Complainant when this is not the case. There is no conceivable way that the Respondent could use the Domain Name in a manner that does not constitute an abusive registration. The Respondent registered a domain name that it could not use lawfully. The Complainant says that that, of itself, amounts to registration and use in an abusive manner. In that regard, the Complainant refers to UK case law and the 'Telstra case' (presumably the WIPO UDRP case), in which was stated that the passive holding of a domain name can amount to bad faith in certain circumstances.

5.2 The Respondent simply stated the following: 'This is not an abusive registration, the domain was never used.'

6. Discussions and Findings

Pursuant to paragraph 2 of the Policy a Complainant must show, on the balance of probabilities, that:

- (i) it has Rights in respect of a name or mark which is identical or similar to the Domain Name, and that
- (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

'Rights' are defined in the Policy as 'rights enforceable by the Complainant, whether under English law or otherwise, and may include rights and descriptive terms which have acquired a secondary meaning'.

It is well accepted that the question of Rights falls to be considered at the time that the Complainant makes its Complaint and is a test with a low threshold to overcome.

The Complaint provided evidence of registered trade mark rights in the word SKYSCANNER, as well as evidence demonstrating trading activity under the SKYSCANNER brand name.

Therefore, the Expert finds that the Complainant has Rights in respect of the word SKYSCANNER.

The Domain Name incorporates the Complainant's SKYSCANNER trade mark in its entirety and simply adds the generic, non-distinctive geographical term 'UK'.

As mentioned in the Experts' Overview (available on the DRS website), such '*additional elements rarely trouble experts*'. There are numerous decisions which have found that the inclusion in a domain name of such suffixes (or prefixes) after (or before) a mark is insufficient to distinguish it from the mark in which the complainant has rights. Examples include *oculus-rift-vr.co.uk et al.* (DRS 21064) and *ukshedstore.co.uk* (DRS 08006).

It is well established under the Policy that the first and second level domains may be ignored for the purposes of similarity.

The Complainant has therefore satisfied paragraph 2.1.1 of the Policy and demonstrated that it has Rights in a name or mark which is identical or similar to the Domain Name.

Abusive Registration

Under Paragraph 1 of the Policy, an Abusive Registration means a domain name which either:

- (i) was 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

- (ii) has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

This definition covers both the time of the registration and later use. It is sufficient to satisfy either of the limbs for there to be a finding of an Abusive Registration.

Under Paragraph 5.1.1.2 of the Policy, 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 can be evidence of an Abusive Registration. Other evidence can include circumstances indicating that the Respondent is using 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 (para 5.1.2 of the Policy).

The Complainant claims that the Domain Name is used as a blocking registration inasmuch as the Complainant is prevented from registering a Domain Name in which it, and no other individual or business, has Rights. However, where the registration is alleged to be a 'blocking registration', the Complainant must prove on the balance of probabilities that the Respondent's principal objective in the registering or retaining of the Domain Name was to prevent the Complainant from doing so (see *club1830uncovered.co.uk et al.* (DRS 00583)). In the present case, the Expert finds that the Complainant does not provide sufficient evidence in that regard.

The Complainant further claims that the Domain Name, by referring to a parking page containing PPC links that guide consumers to competitors of the Complainant, is used to mislead consumers as to an affiliation with or connection to the Complainant.

Paragraph 8.5 of the Policy provides that the sale of traffic (*i.e.* connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:

- 8.5.1 the nature of the Domain Name;
- 8.5.2 the nature of the advertising links on any parking page associated with the Domain Name; and
- 8.5.3 that the use of the Domain Name is ultimately the Respondent's responsibility.

In the present case, the Domain Name is similar to the Complainant's SKYSCANNER word mark, and at least some of the advertising links refer to competitors of the Complainant. The Respondent did not contest the Complainant's arguments but simply stated that the Domain Name was never used. However, the advertising links showing on the parking page related to the Domain Name are ultimately the Respondent's responsibility.

In view of the nature of the Domain Name, comprising the entirety of the Complainant's well-known mark, the Expert considers it overwhelmingly likely that the Respondent had knowledge of the Complainant and its rights in the SKYSCANNER

mark at the time of registration. The Expert cannot envisage a legitimate use of the Domain Name by the Respondent.

Under these circumstances, the Expert finds that the Domain Name has been used in a manner which has taken unfair advantage of the Complainant's Rights. The Complainant has therefore, on the balance of probabilities, demonstrated Abusive Registration pursuant to paragraph 2.1.2 of the Policy.

7. Decision

The Expert finds that the Complainant has Rights in a name and mark which is identical or similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name <skyscanneruk.uk> be transferred to the Complainant.

Signed: Flip Petillion

Dated: November 8, 2019