

## **DISPUTE RESOLUTION SERVICE**

**D00022029**

### **Decision of Independent Expert**

Skyscanner Limited

and

Skyland Travels Limited

#### **1. The Parties:**

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

Respondent: Skyland Travels Limited  
29 Addenbrooke Street  
Wednesbury  
WS10 8HJ  
United Kingdom

#### **2. The Domain Name:**

skyscannerss.co.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.

04 November 2019 15:26 Dispute received  
06 November 2019 12:18 Complaint validated  
06 November 2019 13:02 Notification of complaint sent to parties  
06 November 2019 16:39 Response received  
06 November 2019 16:39 Notification of response sent to parties  
08 November 2019 15:29 Reply received  
08 November 2019 15:29 Notification of reply sent to parties  
13 November 2019 12:55 Mediator appointed  
19 November 2019 17:15 Mediation started  
05 December 2019 14:00 Mediation failed  
05 December 2019 14:03 Close of mediation documents sent  
17 December 2019 01:30 Complainant full fee reminder sent  
17 December 2019 12:48 Expert decision payment received  
17 December 2019 12:58 Expert decision payment received

#### **4. Factual Background**

The Complainant is an online travel company trading as Skyscanner. It is the owner of several trademark registrations including UK Trade Mark Registration No. 2313916 for SKYSCANNER.

The Domain Name was registered on 15th October 2019. At the time of writing, the Domain Name directs to a site offering flight bookings and related services under the trading name Cheap Flights Hub.

The contact for the Respondent company is identified by Nominet as Muhammad Waqar and the brief Response set out below was provided by Zain Zaheer. It is not known in what capacity Zain Zaheer acts on the Respondent's behalf.

#### **5. Parties' Contentions**

##### **5.1 The Complainant**

The Complainant claims registered and unregistered rights in the name SKYSCANNER by virtue of its substantial portfolio of trademark registrations in multiple jurisdictions and the wide notoriety of its trading name in the online travel business.

The Complainant maintains that the name in which it claims rights is virtually identical to the Domain Name, the sole difference being the addition of the letters 'ss' immediately before the .co.uk suffix.

The Complainant argues that the Domain Name is an Abusive Registration in the Respondent's hands on the following grounds:

The Respondent does not appear to have any registered rights or trademark applications in either SKYSCANNER or SKYSCANNERSS. No evidence has been found that the Respondent trades under the SKYSCANNERSS name or that it is in any sense known by this name.

The Complainant has not issued any licence or permission of any kind to the Respondent for the use of its protected mark.

The notoriety of the SKYSCANNER mark is such that the Respondent must have known about the Complainant and its prominence in the marketplace at the time of the Domain Name registration, some 17 years after the Complainant's initial registration of its trademark. It can be no coincidence that the Respondent registered a Domain Name that to all intents and purposes replicates the Complainant's trade mark. In doing so, the Respondent sought to take advantage of the Complainant's Rights at the time of registration.

## **5.2 The Respondent**

The Respondent's reply was very brief and is reproduced below in full:

Subject: DRS22029 - Response

Dear Team Sky scanners,  
The domain was free and not registered with any company,if it's illegal so why the domain provider did not highlight or warned us.  
skyscanners.net  
Skyscannersss.co.uk

It's totally a different website,Thank you

## **5.3 Complainant's Reply to the Response**

The Complainant exercised its right to reply to the Respondent's submission, pointing out that the Respondent appears to blame its registrar for failing to notify it that the Domain Name is virtually identical to the Complainant's mark. The Complainant argues that it is not the registrar's job to do so. The Complainant observes that domain name registrants are required to agree to registration terms & conditions, which include undertakings to the effect that registrants must not take advantage of third party trade marks.

The Complainant notes the Respondent's claim that its website is "totally different" to the Complainant's website. The Complainant submits that the fact that the Domain Name resolves to a website that offers travel arrangement services proves that (a) it must have been aware of the Complainant's Rights at the time of registration and (b) that it uses the Domain Name to create a likelihood of confusion with services in which the Complainant's enjoys a global reputation. There can be no doubt, says the Complainant, that the Respondent's ownership of the Domain Name seeks to benefit from the Complainant's reputation.

## **6. Discussions and Findings**

## **DRS Policy**

Paragraph 1 of the DRS Policy defines Abusive registration as a Domain Name which either:

*1.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*

*1.ii. is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights;*

Paragraph 2 of the Policy requires a complainant to show that

*2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

*2.1.2 The Domain Name, in the hands of the Respondent, is an Abusive Registration*

## **Complainant's Rights**

The Complainant has submitted evidence of its registered trademark rights in the name SKYSCANNER which I accept as sufficient to establish rights in this name for the purpose of this complaint.

The Complainant asserts that its protected mark is virtually identical to the principal element of the Domain Name. I accept this view. The "ss" addition to the name does not materially differentiate the Domain Name from the Complainant's mark.

I therefore find that the Complainant has rights sufficient to comply with the requirements of paragraph 2.1.1 of the DRS Policy.

## **Abusive Registration**

The Complainant argues that, in full knowledge of its existence, its protected trademark and its market position, the Respondent registered the Domain Name in a way which falls squarely within the definition of Abusive Registration in paragraph 1 of the DRS Policy quoted above.

In support of this argument, The Complainant points to the similarity of the Domain Name to the Complainant's mark. The Complainant refers also to the timing of the Domain Name registration, several years after the Complainant's trading name obtained trademark protection and its market prominence was well established.

From the very brief Response, it is possible to discern three grounds upon which the Respondent rejects the Complaint.

The first is that the Domain Name was available for purchase and was duly registered. This does not however address the matter of abusive registration. No obligation is placed upon rightholders to register or remove from circulation every conceivable domain name containing misspellings and other variants on its protected name or names. The domain name registration process is indeed based upon the first come, first served principle, but the DRS Policy indicates that where registrations are used

for purposes prejudicial to the interests of third parties or otherwise infringe their rights, a finding of Abusive Registration is likely to follow.

Secondly, the Respondent asks why, if this registration was “illegal”, did the Complainant not contact the Respondent or issue any kind of warning? This is a legitimate question but, again, of no help to the Respondent. Complainants in DRS proceedings are not obliged to contact, or offer any pre-emptive warning to registrants. Following DRS procedure, Nominet alerted the Respondent when this complaint was received. Informal mediation discussions were initiated but failed to resolve the matter, resulting in the Complainant’s request for a full Expert Decision. The very brief email response to the Complaint suggests that the Respondent chose not to make use of the DRS guidance material available on the Nominet website to assist parties in making their cases in the most effective way.

Thirdly, the Respondent argues that the website to which the Domain Name directs is “totally different”. I assume this to mean different from the Complainant’s online presence generally. From my own investigation, the Domain Name appears to direct to a site maintained by an entity trading under the name “Cheap Flights Hub”. This name and the site content offering cheap flight booking and related travel services clearly contradict the Respondent’s stated position. It is highly probable in my view that the Respondent uses the Domain Name in the hope or expectation of diverting to its own site traffic otherwise destined for the Complainant. The likely prejudice to the Complainant’s business is beyond doubt.

For completeness, I refer to paragraph 8 of the DRS Policy which offers a non-exhaustive list of circumstances which might allow a Respondent to argue that a registration was not abusive. Such circumstances involve registrations made in good faith, for example where a registrant acts in ignorance of the complainant’s existence, where a registration is intended to direct to a criticism site or where the use of the complainant’s mark in the domain name might otherwise qualify as fair use. I have carefully considered the Respondent’s case in the light of this paragraph 8 and conclude that it contains nothing which can assist the Respondent in this matter. Accordingly, I find that the Domain Name is an Abusive Registration in the Respondent’s hands.

## **7. Decision**

The Complainant has rights in a name which is identical or similar to the Domain Name. For the reasons given above I find that the Domain Name in the Respondent’s hands is an Abusive Registration within the terms of the DRS Policy and should be transferred to the Complainant.

**Signed Peter Davies**

**Dated 29 December, 2019**