

DISPUTE RESOLUTION SERVICE

D00022090

Decision of Independent Expert

Skyscanner Limited

and

Ian McBride
(For sale at SEDO website)

1. The Parties:

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

Respondent: Ian McBride (For sale at SEDO website)
96 Glen Shee Avenue
Neilston
Glasgow
East Renfrewshire
G78 3QD
United Kingdom

2. The Domain Name:

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

22 November 2019 16:09 Dispute received
25 November 2019 12:12 Complaint validated
25 November 2019 12:18 Notification of complaint sent to parties
02 December 2019 15:18 Response received
02 December 2019 15:19 Notification of response sent to parties
05 December 2019 01:30 Reply reminder sent
10 December 2019 16:30 No reply received
16 December 2019 12:16 Mediator appointed
16 December 2019 16:57 Mediation started
19 December 2019 12:17 Mediation failed
19 December 2019 12:36 Close of mediation documents sent
02 January 2020 01:30 Complainant full fee reminder sent
06 January 2020 14:11 Expert decision payment received

4. Factual Background

I have taken the following summary from the contents of the parties' submissions, their supporting documents and Nominet's records for the Domain Name :

- The Complainant is a very well-known global online business providing travel and flight information services under its SKYSCANNER name and trade mark.
- The Domain Name was registered by the Respondent on 25th November 2016, many years after the Complainant had established its business and only two days after the global media exposure surrounding the announcement of the acquisition of the Complainant's business by China's largest on-line travel agency.
- The Domain Name currently resolves to a website holding page referring to Namesco Ltd, the well-known domain name business. No evidence of any other use has been put forward.

5. Parties' Contentions

In summary, in its Complaint, which was supported by several documentary annexures, the Complainant made the following points:

- The Complainant is the owner of a global portfolio of trade mark registrations for its SKYSCANNER, Skyscanner & Cloud device, Scanner & Cloud Device and Cloud Device trade marks.
- The Complainant enjoys a global reputation in its SKYSCANNER trade mark. Currently, the Skyscanner website www.skyscanner.net attracts 100 million visits per month and, to

date, its SKYSCANNER smart device app has been downloaded over 70 million times. The Complainant's services are available in over thirty languages and in seventy currencies. Further, as of 12th November 2019 the Complainant's website www.skyscanner.net was ranked 1,671st globally for internet traffic and engagement and 107th in the United Kingdom.

- Several UDRP Panels have issued decisions that acknowledge the fame of the Complainant's SKYSCANNER trade marks.
- The Domain Name takes the Complainant's SKYSCANNER trade mark in its entirety, without amendment. The Domain Name is identical to the Complainant's Rights.
- 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". The Complainant has not given the Respondent consent to use confusingly similar variations of its trade marks within the disputed Domain Name.
- The Domain Name was registered on 25th November 2016, fourteen years after the Complainant first applied to register its SKYSCANNER trade mark in the United Kingdom and only two days after global media exposure announcing the acquisition of the Complainant's business by Ctrip, China's largest on-line travel agency, in a deal worth approximately GB £1.4 billion.
- It can be no coincidence that the Respondent chose to register a Domain Name that replicates the Complainant's distinctive trade mark. The Respondent will have been aware of the global media exposure surrounding the Complainant's acquisition by Ctrip and, in a cynical and abusive manner, sought to take advantage of the Complainant's Rights at the time of registration.
- The Domain Name resolves to a blank website and, therefore, is held passively. In the current circumstances the Domain Name is used as a blocking registration. However, once the Domain Name resolves to an active website, there is no conceivable use of the domain name that would not take advantage of the Complainant's Rights. This is recognised by several UDRP Panellists, including in Case No. D2019-0988 <skyscannerltd.com> and it is also consistent with the decision of the UK's Court of Appeal in British Telecommunications Plc and Others v. One In A Million Ltd & others [1998] 4 All ER 476; upholding the decision of Mr. Jonathan Sumption QC (as he then was) at first instance. In that case, Mr Sumption said at page 272: *"Any person who deliberately registers a domain name on account of its similarity to the name, brand name or trade mark of an unconnected commercial organization must expect to find himself on the receiving end of an injunction to restrain the threat of passing off, and the injunction will be in terms which will make the name commercially useless to the dealer."*
- Against this background, the Domain Name, in the hands of the Respondent, constitutes an Abusive Registration.

In summary, in his Response, which was supported by one annexure, the Respondent made the following points:

- The second of the two test criteria that has to be met in order to establish "Abusive Registration" has clearly not been met, in that at no time has the Domain Name been used in any capacity at any time to take unfair advantage or be unfairly detrimental to the Rights of the Complainant.
- Nor has the first test been met (that it 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) because the Domain Name was registered in November 2016 and this DRS complaint has only been made three years later and that is sufficient, on the balance of probability, to establish that the test has not been met unless the Complainant can answer the following:
 1. What was the unfair advantage gained on registration of the domain in 2016, which continues to remain passive?
 2. What has been unfairly detrimental to the Complainant, for the past 3 years, following on from registration of the Domain Name and, more importantly, can the Complainant provide evidence of any unfair advantage or anything that was detrimentally unfair?
- The Domain Name was purchased in complete good faith, openness and transparency in November 2016. No attempt was made to conceal the Respondent's identity with regard to ownership of the Domain Name which puts to rest the "cynical and abusive" claim made by the Complainant for the reason for the purchase and subsequent ownership.
- It is fair to say that it is the Complainant who is being cynical and abusive, in that they brought this DRS claim after waiting to see if the Respondent would renew the registration of the Domain Name for the year 2019 to 2020 and, when it was renewed, filed this DRS complaint a couple of days later. Not in 2016, 2017 or 2018, but in 2019. The Respondent asks the Complainant, what changed so dramatically to bring about a complaint, bearing in mind that there has been no change on the Respondent's part since purchasing the Domain Name in 2016?
- From the very first day of purchase of the Domain Name the Respondent has acted in a fair and responsible manner and continues to do so. The Complainant has not been disadvantaged, commercially, financially, morally or ethically in any way whatsoever. The Complainant is essentially claiming under the "*What if this should happen*" banner in an effort to have the Respondent's legally held, legally purchased and non-confrontational Domain Name forcibly removed and transferred to them. That is the "bully boy tactics" of a large global organisation.
- The Complainant's organisation was registered in 2002, some 14 years before the Respondent registered the Domain Name, so why did they not register the Domain Name themselves before if it was so vitally important to them as an organisation? More importantly is it fair to expect the Respondent to be punished due to an arguably colossal administrative oversight on the part of the Complainant?
- It appears that the Complainant, now fully realising their perceived implications of all of this, can just come along and take the Domain Name. That is somewhat outrageous and would not meet any test set in relation to fairness.

- The Complainant says it would take unfair advantage once the Domain Name resolves to an active website but where is the evidence demonstrated by the Complainant that this would take place? Surely the "what if this should happen" argument is insufficient to bring a DRS complaint.
- The Respondent asks why the Complainant has singled out the Respondent in a somewhat discriminatory manner as there are 11 other domain names not currently under the ownership or control of the Complainant, all with the word 'skyscanner'.

The Complainant chose not to file a Reply.

6. Discussions and Findings

Preliminary Matter

Before dealing with the details of the dispute I will deal with the identity of the Respondent. When registering the Domain Name, the actual registrant was named as "*For sale at SEDO website*" but the contact details provided gave the name of Ian McBride along with his address, email and phone number and it is he who has responded to the complaint. In his Response, the Respondent says he has always been open and transparent and did not try to hide his identity. I will take that at face value and in the circumstances I believe that Mr McBride should be treated and named as the Respondent in these DRS proceedings.

General

In order to succeed the Complainant must prove, on the balance of probabilities, two matters, namely that:

1. the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
2. the Domain Name, in the hands of the Respondent, is an Abusive Registration.

These terms are defined in the Nominet DRS 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.
- **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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

Does the Complainant have Rights?

The Complainant is an established well-known global business with a portfolio of trade mark registrations for its SKYSCANNER name and trade mark. In the circumstances, the Complainant clearly has Rights in that name for the purposes of the Nominet DRS.

Are the Rights under the registered trade mark in respect of a name or mark which is identical or similar to the Domain Name?

In assessing whether a domain name is identical or similar to a name or mark the relevant “.uk” suffix can be ignored, unless perhaps the name or mark concerned itself includes a particular domain suffix, which is not the case here. Accordingly, I find that the Domain Name is identical to the SKYSCANNER name and mark in which the Complainant has Rights.

Is the Domain Name, in the hands of the Respondent, an Abusive Registration?

Having considered the parties submissions and supporting evidence and as discussed below, I do not believe that the Respondent’s indignant protestations of innocence ring true.

In his Response, the Respondent has referred to the two limbs of the definition of an Abusive Registration, one dealing with the original registration or acquisition of a domain name and the other dealing with the subsequent use to which it has been put.

He says that when he purchased the Domain Name in November 2016, just two days after the takeover of the Complainant’s global business was announced, he did so in complete good faith, openness and transparency. But it is notable that the Respondent does not actually deny the Complainant’s point that the Respondent will have been aware of the takeover announcement and that his immediate subsequent registration of the Domain Name is not a coincidence. Instead, the Respondent relies on the fact that he did not seek to hide his identity as being a sufficient answer and seeks to blame the Complainant for not itself having registered the Domain Name at some time during the previous 14 years of being in business. The Respondent also points to 11 other ‘skyscanner’ domain name registrations held by third parties.

There are now over 1500 top level domain suffixes and countless number of different second level options to go with them. No business, no matter how established and global it may be, can be expected to seek to register every domain name variation of its main trading name. The fact that the Complainant had not previously itself registered this particular Domain Name variation is not a licence for anyone else to take unfair advantage of its Rights in the SKYSCANNER name by registering it for themselves. But once someone else does so, as in this case, it acts a blocking registration preventing the Complainant from doing so.

Paragraph 5 of the DRS Policy sets out a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration.

Paragraph 5.1.1.2 states as follows:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

5.1.1.1 ...;

5.1.1.2 as a blocking registration against a name or mark in which the Complainant has Rights;

It is noteworthy that the Respondent has not put forward any reason why he did in fact register the Domain Name and what his intentions were for it, although some insight may be provided by the fact that the registrant was named as “For sale at SEDO website” by the Respondent.

The Respondent has not commented at all on why he chose to name the registrant in that way. If the Complainant had been aware of the name of the registrant chosen by the Respondent when registering the Domain Name when it filed its complaint under the DRS (which is unlikely as ‘Whois’ searches no longer identify the registrant), it might also have pointed to Paragraph 5.1.1.1 of the DRS Policy which states as follows:

5.1.1 Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:

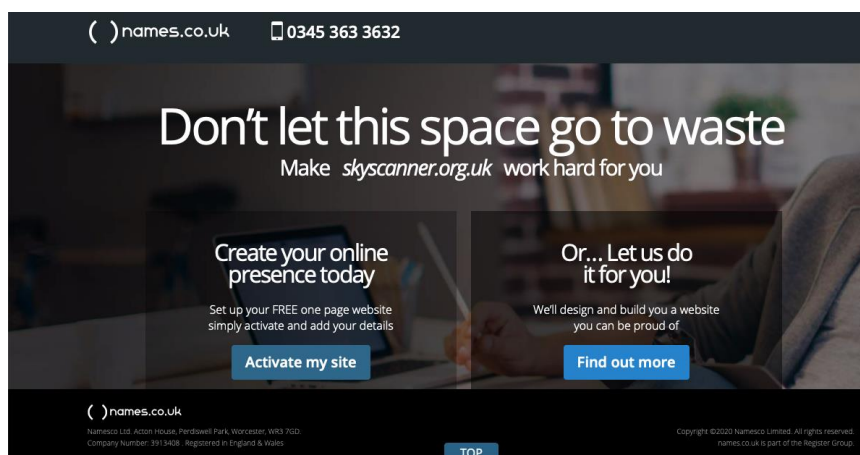
5.1.1.1 for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

However, no evidence has been put forward to suggest that the Respondent has made any active attempt to sell the Domain Name to anyone.

The Complainant instead relies on British Telecommunications Plc and Others v. One In A Million Ltd & and others [1998] 4 All ER 476 whilst the Respondent says he has not made any use of the Domain Name and there is no evidence that he intends or threatens to do so.

One In A Million is a leading case that held that mere registration of a domain name can, without more, be actionable passing off if it is the name is of a well-known third party and could not conceivably be put to any lawful use. That seems to apply full square to the circumstances of this DRS case.

The Complainant said the Domain Name resolved to a blank website. But when I checked, the Domain Name does in fact now resolve to a website referring to Namesco Ltd, the well-known domain name business. A screenshot of the main part of the website landing page is shown below:



Paragraph 5.1.2 of the DRS Policy states as follows

Circumstances indicating that the Respondent is 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;

The DRS Experts' Overview is published on the Nominet website to assist all participants or would-be participants in disputes under the DRS Policy by explaining commonly raised issues and how Experts, the members of Nominet's panel of independent adjudicators, have dealt with those issues to date and identifying any areas where Experts' views differ. Paragraph 3.3 deals with the *One In A Million* case and the concept of 'initial interest confusion' and states as follows:

3.3 Paragraph 5.1.2 concerns confusing use of the domain name. What is meant by confusing use?

The 'confusion' referred to in this paragraph of the Policy is confusion as to the identity of the person/entity behind the domain name. Will an Internet user seeing the domain name or the site to which it is connected believe or be likely to believe that "the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant"?

*In the case of *BT v One In A Million* [1999] 1 WLR 903, the Court of Appeal cited, as one example of how confusion of this kind could occur, the making of a Whois search of the registry/registrar database. The enquirer conducts such a search and because of the similarity of the domain name to the well-known trade mark (the case was concerned solely with well-known trade marks), assumes that the registrant is in some way associated with the trade mark owner. Whether or not this is still (if it ever was) a likely scenario, the English Courts have clearly held that mere registration of a domain name can constitute unfair use of a domain name for the purposes of passing off and trade mark infringement, even if nothing more is done with the domain name. The prevailing approach under the DRS is consistent with this.*

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue. Similarly, there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name for that purpose.

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not

advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name. In the High Court decision Och-Ziff Management Europe Ltd v Och Capital LLP [2010] EWHC 2599 (Ch), the court quoted the International Trade Mark Association definition of initial interest confusion as being “a doctrine which has been developing in US trademarks cases since the 1970s, which allows for a finding of liability where a plaintiff can demonstrate that a consumer was confused by a defendant’s conduct at the time of interest in a product or service, even if that initial confusion is corrected by the time of purchase”. In that case the court held that initial interest confusion is legally actionable under European trade mark legislation.

.....

Subsequent to the Och-Ziff case (supra) the Court of Appeal in Interflora v Marks and Spencer [2014] EWCA Civ 1403 criticised the use of “initial interest confusion” as a concept relevant to English trade mark law. This case was discussed by the Appeal Panel in DRS 15788 (starwars.co.uk) who concluded that initial interest confusion remained an applicable principle in determining whether or not a domain name registration was abusive.

.....

The Overview says that, where the names are identical and cannot sensibly refer to anyone other than the Complainant, there is bound to be a severe risk that a search engine will return the URL for the website connected to the Domain Name. That is the case here. The risk of initial interest confusion is therefore a real one. Even though the website page to which the Domain Name resolves is not offering competing services, an Internet user looking for one of the Complainant’s websites who arrives by mistake at the landing page website to which the Domain Name resolves, is met by an offer to “*make skyscanner.org.uk work hard for you*” rather than the Complainant’s flight information website that they were looking for. At the very least, that can lead to customer frustration and impatience which can rub off and tarnish the Complainant’s brand by association. In my view, this use of the Domain Name takes unfair advantage of and is unfairly detrimental to the Complainant’s Rights in its SKYSCANNER name and trade mark. The Respondent, as registrant of the Domain Name, is ultimately responsible for that use.

Finally, the Respondent counters the Complainant’s assertion of cynical and abusive behaviour by submitting that the Complainant was itself being cynical and abusive in waiting until after he had renewed the registration of the Domain Name before filing its complaint under the DRS. I find nothing remotely cynical or abusive in the Complainant adopting such a common sense approach when deciding to incur the cost of preparing and filing its DRS complaint. Nor is there anything in the Respondent’s point that the Complainant waited three years after he registered the Domain Name before filing its DRS complaint. It is quite possible the Complainant was not aware of the existence of the Domain Name until recently and, in any event, a delay of three years before making a DRS complaint is not a bar to the complaint succeeding.

7. Decision

For the reasons outlined above, I find that the Complainant has proved, on the balance of probabilities, that the Complainant has Rights in respect of a name or 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.

In the circumstances I order that the Domain Name be transferred to the Complainant.

Signed

Dated 24 January 2020

Chris Tulley