

ADMINISTRATIVE PANEL DECISION

Skyscanner Limited v. Kevin Tian
Case No. D2023-5220

1. The Parties

The Complainant is Skyscanner Limited, United Kingdom, represented by Lewis Silkin LLP, United Kingdom.

The Respondent is Kevin Tian, Malaysia.

2. The Domain Name and Registrar

The disputed domain name <skyscannermy.com> is registered with GoDaddy.com, LLC (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 14, 2023. On December 15, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amendment to the Complaint on December 19, 2023.

The Center verified that the Complaint together with the amendment to the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on December 28, 2023. In accordance with the Rules, paragraph 5, the due date for Response was January 17, 2024. The Respondent sent an email communication to the Center on January 2, 2024.

The Center appointed Mireille Buydens as the sole panelist in this matter on January 26, 2024. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant operates within the travel and tourism sector, offering both websites and an application that attracts millions of visitors on a global scale. The Skyscanner website “www.skyscanner.net” attracts millions of visits per month and the Complainant’s application has been downloaded over 70 million times. The Complainant’s services are available in over thirty languages and in seventy currencies.

The Complainant is the owner of several trademarks comprising of registrations for SKYSCANNER (“the Trademark”), including the following:

- The International registration no. 900393, registered on March 3, 2006 for various services in classes 35, 38, and 39.
- The International registration no. 1030086 registered on December 1, 2009 for various services in classes 35, 39, and 42.
- The Canadian registration no. 786689, registered on January 10, 2011 for various services in classes 35, 38 and 39.
- The Malaysian registration no. 2016065366 registered July 14, 2017 for services in class 39.

Further, the Complainant holds the domain names <skyscanner.net>, where the Internet users can find the Complainant’s websites.

The disputed domain name was registered on November 25, 2023. The disputed domain name resolved to a website reproducing the Trademark as well as the color and the device mark appearing on the Complainant’s official website. The website proposed to make searches (as on the Complainant’s website) and also contained a copyright notice “Copyright © 2023 Sky Scanner. All rights reserved”.

On January 2, 2024, the Respondent sent an email to the Center. The Respondent explains that “this site is one of our customers, and despite our attempts to contact them after receiving the complaint, we have not received any response as of today. We have already taken down the hosting associated with the relevant user”.

At the date of this decision, the disputed domain name resolves to an error page.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

First, the Complainant contends that it owns prior rights in the Trademark. The disputed domain name is virtually identical to the Complainant’s Trademark as it incorporates the Complainant’s Trademark alongside the term ‘MY’, which is an abbreviation for Malaysia where the Respondent is located. The Top-Level Domain (“TLD”) “.com” in the disputed domain name should be disregarded.

Second, the Complainant asserts that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent does not own any registered rights in any trademarks which comprise part or all of the disputed domain name. The term “Skyscanner” is not descriptive in any way, nor does it have

any generic, dictionary meaning. The Complainant has not given its consent for the Respondent to use a highly similar variation of its Trademark in a domain name registration.

Third, the Complainant asserts that the disputed domain name was registered and is being used in bad faith. The Complainant contends that the disputed domain name has been registered long after the registration and use of its well-known Trademark. The Complainant further holds that, at the date of the Complaint, the disputed domain name resolved to a website replicating the Complainant's Trademark and Sunrise logo in an attempt to deceive Internet users into believing they are dealing with the Complainant. Use of the disputed domain name in this manner poses a substantial fraud threat.

B. Respondent

The Respondent does not challenge the fact that the disputed domain name includes the Trademark and resolved to a website depicting the Complainant's Trademark and logo without the Complainant's authorization. The Respondent contends however that the website under the disputed domain name belongs to one of its customers. The Respondent further explains that it contacted the customer, who did not respond. As a result, the Respondent took the initiative to take down the website under the disputed domain name. The Respondent does not file any other argumentation as to the Complaint.

6. Discussion and Findings

Paragraph 4(a) of the Policy provides that the Complainant proves each of the following three elements to succeed in its Complaint:

- (i) the Disputed Domain Name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name; and
- (iii) the Disputed Domain Name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, (["WIPO Overview 3.0"](#)), section 1.7.

The Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The entirety of the Trademark is reproduced within the disputed domain name. The disputed domain name contains the Trademark in its entirety and differs only by the mere addition of the suffix "my", which refers to "Malaysia" or to the English possessive personal pronoun ("my"). Accordingly, the disputed domain name is confusingly similar to the Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms (here "my") may bear on assessment of the second and third elements, the Panel finds the addition of such term does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of “proving a negative”, requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a prima facie case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a prima facie case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant’s prima facie showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise. On the contrary, the Respondent has acknowledged that the disputed domain name is at least used by one of its customers without the Complainant’s authorization, id est without right or legitimate interest.

The Respondent is not licensed by or affiliated with the Complainant in any way. There is no evidence that the Respondent would be commonly known under the disputed domain name, nor is there any evidence of use or demonstrable plans to use the disputed domain name for a bona fide offering of goods or services. There is no evidence of legitimate noncommercial or fair use of the disputed domain name, either.

The Panel further notes that the composition of the disputed domain name, adding the term “my” to the Trademark, affirms the Respondent’s intention of taking unfair advantage of the likelihood of confusion between the disputed domain name and the Complainant’s Trademark and to mislead Internet users. This is the more so that, in first instance, the disputed domain name resolved to a website impersonating the Complainant’s website and offering services competing with the Complainant’s services. This confirms that there is no use, nor preparations to use of the disputed domain name in connection with a bona fide offering of goods or services. The fact that the Respondent, who registered the disputed domain name, explains that it was *used* by one of its customers for a website reproducing the Trademark and the Complainant’s logo does not constitute a proof of rights or legitimate interest. The Respondent took the initiative to register the disputed domain name which is, by its very composition, well-suited for misleading Internet users as it includes the Complainant’s Trademark and the abbreviation for Malaysia (or the possessive pronoun “my”).

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that, given that the disputed domain name contains the Complainant’s well-known Trademark which predates the registration of the disputed domain name, with the addition of the term “my” (abbreviation of Malaysia, where the Respondent is located, or possessive pronoun), the Respondent was more likely than not aware of the Complainant’s Trademark at the time of the registration of the disputed domain name ([WIPO Overview 3.0](#) section 3.1.4). Furthermore, the Complainant owns and uses a domain name (<skyscanner.net>) which is highly similar to the disputed domain name. The Respondent should have known about the Complainant’s rights, as such knowledge is readily obtainable through a simple browser search (See *Caesars World, Inc. v. Forum LLC*, WIPO Case No. [D2005-0517](#); *Compart AG v. Compart.com / Vertical Axis Inc.*, WIPO Case No. [D2009-0462](#)). Furthermore, the Respondent could have conducted a trademark search and would have found the Complainant’s prior registrations in respect of the Trademark (*Citrix Online LLC v. Ramalinga Reddy Sanikommu Venkata*, WIPO Case No. [D2012-1338](#)).

By registering the disputed domain name, the Respondent has sought to create a misleading impression of association with the Complainant. The registration of the disputed domain name creates an obvious likelihood of confusion with the Complainant and its Trademark. Furthermore, it appears that the disputed domain name has been used to abusively attract Internet users on a website impersonating the Complainant's website and offering competing services.

The Respondent argues that it is one of its customers who has used the disputed domain name and who managed the website impersonating the Complainant's website. However, it is established that the Respondent registered the disputed domain name. Besides, the Respondent is liable for the use of the disputed domain name as it has registered it and put it at the disposal of its customer.

The Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <skyscannermy.com> be transferred to the Complainant.

/Mireille Buydens/

Mireille Buydens

Sole Panelist

Date: February 9, 2024