

ADMINISTRATIVE PANEL DECISION

Skipton Building Society v. Privacy Service Provided by Withheld for Privacy ehf / Ken Bates, Dot Logix
Case No. D2022-1390

1. The Parties

The Complainant is Skipton Building Society, United Kingdom, represented by Appleyard Lees, United Kingdom.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Ken Bates, Dot Logix, United States of America.

2. The Domain Name and Registrar

The disputed domain name <skiptonsbank.com> is registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 19, 2022. On April 19, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 19, 2022, 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 and contact information in the Complaint. The Center sent an email communication to the Complainant on April 21, 2022 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 amended Complaint on April 26, 2022.

The Center verified that the Complaint together with the amended 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 April 29, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 19, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 30, 2022.

The Center appointed John Swinson as the sole panelist in this matter on June 7, 2022. 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 is the fourth largest building society in the United Kingdom.

The Complainant has been operating under the SKIPTON brand since as early as 1853. The Complainant provides financial and banking services. The Complainant operates 88 branches throughout the United Kingdom.

The Complainant owns United Kingdom trademark registrations for SKIPTON BUILDING SOCIETY with device, such as Registration No. UK00002412268 with a filing date of January 27, 2006 and a registration date of August 18, 2006. The Complainant also owns a pending United Kingdom trademark application for SKIPTON.

The Respondent did not file a response, so little information is known about the Respondent.

The disputed domain name was registered on May 9, 2021.

In the past, the disputed domain name resolved to a website titled “Skipton” that advertised banking and financial services, and in places referred to “Skipton Building Society”.

At the present time, the disputed domain name resolves to a website that states: “This account has been suspended.”

5. Parties’ Contentions

A. Complainant

In summary, the Complainant makes the following submissions:

The Complainant owns several United Kingdom trademark registrations and applications for trademarks that incorporate the word SKIPTON, including the registration referred to above in section 4.

The Complainant has used SKIPTON extensively since 1853, such that the Complainant has a reputation and unregistered rights in respect of SKIPTON.

The disputed domain name is confusingly similar to the Complainant’s trademarks. The design elements of the Complainant’s trademarks should be disregarded for the purposes of assessing confusing similarity.

The term “bank” in the disputed domain name is non-distinctive and is descriptive of the type of services offered. The addition of the letter “s” is a clear attempt to typosquat.

The disputed domain name does not correspond to the name of the Respondent. The disputed domain name has not been used in connection with a business operating in good faith or a genuine offering of goods or services. The Respondent has no rightful connection with the term “skiptonsbank” or any legitimate reason to use that trademark or incorporate it in a registered domain name.

The Respondent is using the disputed domain name in a way to confuse Internet users into believing that the website at the disputed domain name is operated by, or connected with, the Complainant.

The disputed domain name strongly implies a connection between the Complainant and the Respondent,

which does not exist and has been created purposefully by the Respondent to deceive visitors to the website at the disputed domain name. There is no logical explanation for use of SKIPTON within the disputed domain name, aside from that the Respondent intends to create a façade, that the disputed domain name is legitimate and hosts the website of the Complainant's business.

The website at the disputed domain name contains a large amount of information that has been copied from the Complainant's own website. In particular, the Financial Conduct Authority ("FCA") Registration Number, 153706, which appears at the bottom of the pages on both websites. The website at the disputed domain name also references being founded in 1853, which is the same year the Complainant's business was founded.

The website at the disputed domain name may also be used for phishing as there are a number of places on the website that prompt users to provide their information, including, via the login page.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all of the elements enumerated in paragraph 4(a) of the Policy have been satisfied, namely:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (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.

The onus of proving these elements is on the Complainant.

Paragraph 15(a) of the Rules directs the Panel to decide the Complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable.

A. Identical or Confusingly Similar

Paragraph 4(a)(i) of the Policy provides that the Complainant must establish that the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights.

As set out above, the Complainant owns trademark registrations for SKIPTON BUILDING SOCIETY and a device (such as a castle logo).

The Panel considers that on a side-by-side comparison, the disputed domain name is confusingly similar to the Complainant's SKIPTON BUILDING SOCIETY trademark.

The disputed domain name includes the entirety of the word SKIPTON which is a significant part and arguably the dominant feature of the Complainant's registered trademark.

When a domain name wholly incorporates the dominant feature of a complainant's registered mark, that is sufficient to establish confusing similarity for purposes of the Policy. *Cox Enterprises, Inc. v. Miguel Delsel*, WIPO Case No. [D2020-2676](#).

The addition of “bank” and the letter “s” in the disputed domain name does not prevent a finding of confusing similarity between the disputed domain name and the Complainant’s trademark under the Policy. Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element. The nature of such additional term(s) may however bear on assessment of the second and third elements. Section 1.8 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”).

Further, the design elements of the Complainant’s registered trademarks can be disregarded when assessing identity or confusing similarity under the first element.

The Complainant succeeds on the first element of the Policy in relation to the disputed domain name.

B. Rights or Legitimate Interests

The second requirement the Complainant must prove is that the Respondent has no rights or legitimate interests in the disputed domain name.

Paragraph 4(c) of the Policy provides that the following circumstances can be situations in which the Respondent has rights or legitimate interests in a disputed domain name:

- (i) before any notice to [the Respondent] of the dispute, [the Respondent’s] use of, or demonstrable preparations to use, the [disputed] domain name or a name corresponding to the [disputed] domain name in connection with a *bona fide* offering of goods or services; or
- (ii) [the Respondent] (as an individual, business, or other organization) has been commonly known by the [disputed] domain name, even if [the Respondent] has acquired no trademark or service mark rights; or
- (iii) [the Respondent] is making a legitimate noncommercial or fair use of the [disputed] domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.

These are illustrative only and are not an exhaustive listing of the situations in which a respondent can show rights or legitimate interests in a domain name.

The onus of proving this requirement, like each element, falls on the Complainant.

Previous UDRP panels have recognized the difficulties inherent in proving a negative, however, especially in circumstances where much of the relevant information is in, or likely to be in, the possession of the respondent. Accordingly, it is sufficient for a complainant to raise a *prima facie* case against the respondent under this head and an evidential burden of production will shift to the respondent to rebut that *prima facie* case.

The Complainant asserts that the disputed domain name does not correspond to the name of the Respondent and the disputed domain name has not been used in connection with a business operating in good faith or a genuine offering of goods or services. Further, the Complainant asserts that the Respondent has no rightful connection with the term “skiptonsbank” or any legitimate reason to use that trademark or incorporate it in a registered domain name. The Complainant also asserts that the Respondent is using the disputed domain name in a way to confuse Internet users into believing that the website at the disputed domain name is operated by, or connected with, the Complainant.

The website at the disputed domain name included the Complainant’s FCA registration number in the footer of that website. This is evidence of fraudulent use of the disputed domain name. Fraudulent use of a domain name does not give a registrant rights or legitimate interests in that domain name.

At the present time, the disputed domain name resolves to a website that states: “This account has been suspended.”

The Panel finds that the Respondent has failed to produce any evidence to establish its rights or legitimate interests in the disputed domain name. None of the circumstances listed in paragraph 4(c) apply in the present circumstances. Accordingly, the Panel finds the Respondent lacks rights or any legitimate interests in the disputed domain name.

The Complainant succeeds on the second element of the Policy in relation to the disputed domain name.

C. Registered and Used in Bad Faith

Paragraph 4(a)(iii) of the Policy provides that the Complainant must establish that the Respondent has registered and used the disputed domain name in bad faith.

In the present circumstances, the fact that the disputed domain name resolved to a website which impersonated the Complainant leads the Panel to conclude the registration and use of the disputed domain name are in bad faith.

The Respondent’s conduct demonstrates the Respondent’s knowledge of the Complainant and its trademark. By registering the disputed domain name that includes the Complainant’s longstanding trademark and the term “bank” which relates to the services provided by the Complainant, and then by using the disputed domain name to impersonate the Complainant, demonstrates that the Respondent specifically knew of and targeted the Complainant to impersonate the Complainant and suggest to the public that the Respondent is a trusted financial services provider. *L.M. Waterhouse & Co., Inc. v. Scott Myers, Intersearch Global*, WIPO Case No. [D2021-0962](#).

The Respondent’s website appears to be part of a fraudulent or “phishing” scheme, which is manifestly evidence of bad faith – see *Australia and New Zealand Banking Group Limited v. Bashar Ltd*, WIPO Case No. [D2007-0031](#), and the cases referred to in that case, for further analysis of why “phishing” activities amount to use in bad faith. This case was cited with approval in *Regal Funds Management Pty Limited v. WhoisGuard Protected, WhoisGuard, Inc. / John Clerk*, WIPO Case No. [D2020-2773](#), which involved a website that was masquerading as the website of a financial advisory firm. The present case has similar factual circumstances of the present case. See also *Comerica Bank v. Abdul Bhuiyan, ABD*, WIPO Case No. [D2021-1208](#). Accordingly, the Panel finds that paragraph 4(b)(iv) of the Policy applies in the present case.

The fact that presently the disputed domain name resolves to an inactive website does not prevent a finding of bad faith.

The Complainant succeeds on the third element of the Policy in relation to the disputed domain name.

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 <skiptonsbank.com> be transferred to the Complainant.

/John Swinson/

John Swinson

Sole Panelist

Date: June 21, 2022