

## **ADMINISTRATIVE PANEL DECISION**

Skyscanner Limited v. bai sheng  
Case No. D2023-5242

### **1. The Parties**

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

The Respondent is bai sheng, Malaysia.

### **2. The Domain Name and Registrar**

The disputed domain names <skyscannerserver.com>, <skyscannersystem.com>, and <skyscannerworking.com> are registered with Gname.com Pte. Ltd. (the "Registrar").

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on December 15, 2023. On December 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 19, 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 (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on December 21, 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 21, 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 January 10, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 30, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on January 31, 2024.

The Center appointed María Alejandra López as the sole panelist in this matter on February 14, 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 owns and operates a global search engine for buying flights, hotels and car rentals, through its website “www.skyscanner.net”, available in over 30 languages, and in 70 currencies. The service is free for users, who go to the airline, hotel or car service provider or travel agency to complete the booking process. According to the records, the Complainant’s website attracts tens of millions of unique visits per month, and its SKYSCANNER smart device app has been downloaded over 70 million times.

The Complainant, among others, including in Malaysia, owns the following SKYSCANNER trademarks (the “Trademarks”):

-International Trademark for SKYSCANNER (word mark), Reg. No. 900393, registered on March 3, 2006, and in force until March 3, 2026, in ICs 35, 38 and 39.

-United States of America Trademark for SKYSCANNER (word mark), Reg. No. 3242752, registered on May 15, 2007, and in force (initially) until May 17, 2027, in ICs 35, 38 and 39.

-International Trademark for SKYSCANNER (word mark), Reg. No. 1030086, registered on December 1, 2009, and in force until December 1, 2029, in ICs 35, 39 and 42.

The Complainant also owns the domain name <skyscanner.net>, registered on July 3, 2002, from which operates its official website.

The disputed domain names, <skyscannerserver.com> registered on November 25, 2023, <skyscannersystem.com> registered on December 10, 2023, and <skyscannerworking.com> registered on December 10, 2023, resolve to inactive websites.

#### 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.

Notably, the Complainant contends that previous UDRP panels have confirmed the reputation over its Trademark SKYSCANNER, citing, but not limited to *Skyscanner Limited v. Basit Ali*, WIPO Case No. [D2012-1983](#); *Skyscanner Limited v. Contact Privacy Inc. Customer 1244355693 / Mrs. K Ananthan*, WIPO Case No. [D2019-0988](#).

In relation to the first element of the Policy, the Complainant contends in summary that, the disputed domain names incorporate the Complainant’s Trademark in addition of dictionary words as “working”, “server” or “system”; which do not render distinctiveness to the disputed domain names from the Complainant’s rights.

In relation to the second element of the Policy, the Complainant contends in summary, that the Respondent does not own any registered rights in any trademarks which comprise part or all of the disputed domain names; that the term “Skyscanner” is not descriptive, nor does it have any generic, dictionary meaning; that the Complainant has not given to the Respondent its consent to use a highly similar variation of its registered trademarks in domain name registrations; that the Respondent was aware about the Complainant, given the

famous nature of its Trademark SKYSCANNER; that the inactivity doesn't prevent that visitors mistakenly believe that there is an association with the Complainant.

In relation to the third element of the Policy, the Complainant contends in summary that, the disputed domain names were registered and are being used in bad faith; that were registered very well after the Complainant acquired its Trademark rights over SKYSCANNER; that by the time the Respondent registered the disputed domain names, the Complainant's Trademark enjoyed a global fame, including a great deal of exposure in the international media on November 2016 (after the Complainant was acquired by Ctrip, China's largest on-line travel agency in a deal worth approximately GBP 1.4 billion); that the inactivity of each one of the disputed domain names, is consistent with the passive holding doctrine of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 4(a) of the Policy sets out that in order to succeed, a complainant must prove each of the following elements:

- (i) the disputed domain names are 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 names; and
- (iii) the respondent has registered and is using the disputed domain names in bad faith.

In this dispute, no Response or any kind of communication has been submitted by the Respondent, despite the fair opportunity given by the Center to present its case, in accordance with paragraph 2(a) of the Rules. In consequence, and in accordance with paragraph 15(a) of the Rules, this Panel "shall decide a 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". Additionally, as sets out by the UDRP jurisprudence, this Panel will consider that "the applicable standard of proof in UDRP cases is the 'balance of probabilities' or 'preponderance of the evidence'; some panels have also expressed this as an 'on balance' standard. Under this standard, a party should demonstrate to a panel's satisfaction that it is more likely than not that a claimed fact is true", see the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.2.

### **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 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 Panel finds the Trademark is recognizable within each of the disputed domain names. Accordingly, the disputed domain names are 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, "server", "system" and "working" may bear on assessment of the second and third elements, the Panel finds the addition of such terms do not prevent a finding of confusing similarity between the disputed domain name and the Trademark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

In relation to the generic Top Level Domain (“gTLD”) “.com”, it is well established that such element may typically be disregarded when assessing whether a domain name is identical or confusingly similar to a trademark, as it is a technical requirement of registration. [WIPO Overview 3.0](#), section 1.11.1.

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 names. 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 names such as those enumerated in the Policy or otherwise.

According to the submitted evidence before this Panel, and in particular given the absence of Response, and the non-use of the disputed domain names, nothing in the records have shown that the Respondent, before any notice of this dispute, has performed demonstrable preparations to use the disputed domain names in connection with a bona fide offering of goods or services; or that the Respondent has been commonly known by the disputed domain names, and since the disputed domain names are not being used the Respondent cannot rely on making a legitimate noncommercial or fair use of the disputed domain names.

In addition, the Complainant has never granted the Respondent any right or license to use its SKYSCANNER Trademark including within the disputed domain names, nor is the Respondent affiliated to the Complainant in any form or has endorsed or sponsored the Respondent or the Respondent’s websites.

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

## **C. Registered and Used in Bad Faith**

Paragraph 4(b) of the Policy sets out a list of non-exhaustive circumstances that may indicate that a domain name was registered and used in bad faith, but other circumstances may be relevant in assessing whether a respondent’s registration and use of a domain name is in bad faith. [WIPO Overview 3.0](#), section 3.2.1.

Panels have found that the non-use of a domain name (including a blank or “coming soon” page) would not prevent a finding of bad faith under the doctrine of passive holding. Having reviewed the available record, the Panel finds the non-use of the disputed domain names do not prevent a finding of bad faith in the circumstances of this proceeding. Although panelists will look at the totality of the circumstances in each case, factors that have been considered relevant in applying the passive holding doctrine include: (i) the degree of distinctiveness or reputation of the complainant’s mark, (ii) the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good-faith use, and (iii) the respondent’s concealing its identity or use of false contact details (noted to be in breach of its registration agreement). [WIPO Overview 3.0](#), section 3.3.

Having reviewed the available record, the Panel notes that the Complainant acquired its Trademark Rights over the term SKYSCANNER at least since 2006 (e.g., International Trademark Reg. No. 900393, registered on March 3, 2006), meaning more than 15 years before the Respondent registered the disputed domain names in November – December of 2023. This Panel also notes that, certainly, the Complainant's Trademark SKYSCANNER enjoys distinctiveness and it is subject of an strong worldwide reputation, which it has been consistently confirmed by previous UDRP panels along the years (see e.g., *Skyscanner Limited v. WhoisGuard Protected, WhoisGuard, Inc. / Miguel Angel*, WIPO Case No. [D2019-3131](#); *Skyscanner Limited v. Oleg Zasel*, WIPO Case No. [D2020-3278](#); *Skyscanner Limited v. James Newman*, WIPO Case No. [D2021-4150](#); *Skyscanner Limited v. Dibyajyoti mistry*, WIPO Case No. [D2022-4729](#); *Skyscanner Limited v. Shi Lei*, WIPO Case No. [D2023-4342](#)); furthermore, the composition of the disputed domain names, each of which incorporates in its entirety the Complainant's Trademark SKYSCANNER together with the terms "server", "system" and "working", can only emphasize the Respondent's knowledge in relation to the Complainant's business and its Trademark's value. Additionally, and as described along this Decision, the Respondent did not rebut any of the Complainant's contentions. Therefore, this Panel concludes that in the circumstances of this case the passive holding of the disputed domain names does not prevent a finding of bad faith under the Policy.

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 names <skyscannerserver.com>, <skyscannersystem.com>, and <skyscannerworking.com> be transferred to the Complainant.

/María Alejandra López/

**María Alejandra López**

Sole Panelist

Date: February 26, 2024