

BEFORE THE SOLE ARITRATOR C.A. BRIJESH

.IN REGISTRY

C/o NIXI (NATIONAL INFORMATION EXCHANGE OF INDIA)

NEW DELHI, INDIA

Skyscanner Limited

Suite 7-001, 1 Fore Street London, EC2Y 5EJ UNITED KINGDOM

...Complainant

Versus

Aman Sharma OF-6, First Floor, Odeon Plaza Main Market, Sector 6 Dwarka, Delhi, 110 075 INDIA

... Respondent



1. The Parties

The Complainant is Skyscanner Limited, a company duly incorporated and existing under the laws of United Kingdom, having its office at Suite 7-001, 1 Fore Street, London, EC2Y 5E, United Kingdom, through its Authorized Representative, David Yeomans, Senior Associate of Keltie LLP having office at 1 London Bridge, SE1 9BA, London, United Kingdom (hereinafter referred to as **Complainant**).

The Respondent is Aman Sharma of OF-6, First Floor, Odeon Plaza, Main Market, Sector 6, Dwarka, Delhi, 110 075, India (hereinafter referred to as **Respondent**).

2. The Domain Name and Registrar

The disputed domain name is <<u>skyscanners.in</u>>. The said domain is registered with 'GoDaddy.com, LLC'.

3. Procedural Timeline

- **February 05, 2020**: The .IN Registry appointed C.A. Brijesh as Sole Arbitrator from its panel as per paragraph 5(b) of INDRP Rules of Procedure.
- **February 06, 2020**: Arbitrator accorded his consent for nomination as Arbitrator and submitted Statement of Acceptance and Declaration of Impartiality and Independence to the .IN Registry.
- **February 11, 2020**: Parties to the dispute are informed of the constitution of the Arbitration panel and the effective date of handover i.e. February 10, 2020. NIXI also forwarded the soft copy of the Complaint to both the Arbitrator and the Respondent on this date, by means of the same email.



- **February 11, 2020**: Arbitral Tribunal (hereinafter, the Tribunal) addressed an email to the Respondent, with a copy marked to the Complainant's Authorized Representative and NIXI, directing the Respondent to file its response, if any, in ten days.
- **February 12, 2020**: The Respondent addressed an email to the Tribunal, with a copy marked to the Complainant's Authorized Representative and NIXI, stating that the Respondent has already filed a response.
- **February 12, 2020**: The Tribunal addressed an email to the Respondent, with a copy marked to the Complainant's Authorized Representative and NIXI, requesting for a copy of the response to be forwarded to the Tribunal, the Complainant as well as NIXI, in ten days.
- **February 24, 2020**: Absent a response from the Respondent, as a last opportunity and in the interest of justice, the Tribunal addressed an email to the Respondent, with a copy marked to the Complainant's Authorized Representative and NIXI, providing the Respondent with an additional time period of three days to forward a copy of its response.
- February 24, 2020:
 The Respondent forwarded an email to the Tribunal dated November 26, 2019 which was addressed by the Respondent to an email address

 <domain.disputes@wipo.int> wherein the Respondent had requested for a copy of the Complaint as well as sought advice as to whether the use of the domain name <<u>sykscanners.in</u>> by it was illegal. The Respondent in the Complaint in the Complaint. This Tribunal is not bound to provide any legal advice to the Respondent.



February 28, 2020: Absent any other correspondence/response from the Respondent thereafter, the pleadings in the proceeding were closed and the Tribunal proceeded to pass an Award on the basis of the material available on record.

The language of the proceedings shall be English.

4. Factual Background

4.1. Complainant's Activities

The Complainant states that it was founded in 2003 and claims to be a leading global travel search website offering millions of travel options at best prices. The Complainant further claims to employ more than 1000 staff members with offices in cities such as Barcelona, Beijing, Budapest, London, etc. In this regard, the Complainant has provided an extract from its official website <<u>www.skyscanner.net</u>> marked as **Annex 3** as part of the Complaint filed by it.

The Complainant further claims that as on the date of filing of the Complaint, the Complainant's core website attracted 80 million visits per month and its mobile application has been downloaded in excess of 70 million times. The Complainant further states that its services are available in over thirty languages and in seventy currencies (including in Indian Rupee). Extract from the Complainant's official website <<u>www.skyscanner.net</u>> as well as web traffic details obtained from the website of web analytic business 'Alexa' have also been marked as **Annex 3** as part of the Complaint. Therefore, the Complainant claims that the goodwill and reputation associated with the name/mark 'SKYSCANNER' rests with the Complainant and no one else.

4.2. Complainant's Use of 'SKYSCANNER'



The Complainant states that in India it has secured registration for the mark 'SKYSCANNER' in Classes 35, 38 and 39 under registration No. 1890840 dating back to December 02, 2009

and for the mark *figskyscanner* in Classes 35, 39 and 42 under registration No. 2287020 dating back to February 22, 2012. In this regard, the Complainant has provided extracts obtained from the website of 'Public Search of Trade Marks'/ <<u>https://ipindiaonline.gov.in/tmrpublicsearch/frmmain.aspx</u>> hosted by the Ministry of Commerce & Industry, Government of India marked as Annex 2 as part of the Complaint filed by it. The Complainant has further stated that the abovementioned marks are being used by it in respect of all the services that form part of the Class of goods and services in which registrations have been obtained. The Complainant submits that the aforementioned registrations pre-date the registration date of the domain name <<u>skyscanners.in</u>> of the Respondent by a good many years. In fact, the Respondent appears to have registered the impugned domain name <skyscanners.in> recently i.e. on September 29, 2019.

The Complainant has also placed reliance on various previous decisions of Panels of NIXI as well as the WIPO which involved the Complainant (which decisions were rendered in favour of the Complainant) to substantiate its rights in the mark 'SKYSCANNER'. Complainant relies on the case of *Skyscanner Limited v. Basit Ali*, WIPO Case No. D2012-1983 to substantiate its rights in the mark 'SKYSCANNER' as the Panel in the case had held that "*the Complainant enjoys exclusive rights to the trade mark 'SKYSCANNER' in connection with its business*".

The Complainant further relies on the case of *Skyscanner Limited v. Contact Privacy Inc. Customer 1244355693 / Mrs. K Ananthan,* WIPO Case No. D2019-0988 to establish that the Complainant has registered its 'SKYSCANNER' marks in many countries world over thereby resulting in considerable publicity by reference to its corporate name such that any use of the name/mark 'SKYSCANNER' by another is actionable. The Complainant also relies on the case



of *Skyscanner Limited v. Data Protected Data Protected*, INDRP Case No. 1139 to reiterate that the mark 'SKYSCANNER' has acquired immense goodwill and reputation amongst the public on account of extensive and continuous use thereof.

Based on the aforesaid, it is the Complainant's assertion that it enjoys immense goodwill and reputation in its trade mark 'SKYSCANNER' both in India and world over and that the mark 'SKYSCANNER' has acquired substantial goodwill and reputation to be exclusively associated with the business/products/services of the Complainant and any reference to the said name/mark is instantly associated with the Complainant alone.

4.3. Respondent's activities and its use of 'skyscanners' which is identical to 'skyscanner'

The Respondent has registered the domain name <<u>skyscanners.in</u>> on September 29, 2019 and it is due to expire on September 29, 2021, as is clearly discernible from the WHOIS records, evidenced through **Annex 1** forming part of the Complaint filed by the Complainant. The Complainant claims that the Respondent intends to use the domain name <<u>skyscanners.in</u>> for hosting a website offering similar services as that of the Complainant. However, the website <<u>www.skyscanners.in</u>> is not operational as on date, as is evidenced through **Annex 4** forming part of the Complaint filed by the Complainant.

Given that the Respondent has not participated in the present proceedings by filing a Response to the Complaint, no further information is available on its business activities and/or its use of the domain comprising the mark/name 'SKYSCANNER'.

5. Contentions of Parties as summarized in the pleadings

5.1. Complainant

a) The domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights

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- The Complainant submits that the domain name <<u>skyscanners.in</u>> is virtually identical to the Complainant's mark 'SKYSCANNER' and that addition of ccTLDs is to be disregarded when comparing a domain name and a trade mark.
- ii. The Complainant further submits that there is virtually no difference between the mark 'SKYSCANNER<u>S</u>' and 'SKYSCANNER' except that the former (i.e. the Respondent's domain name) simply takes the plural form of the latter (i.e. the Complainant's mark).
- iii. The Complainant also states that in terms of Rule 3 of the INDRP it was the Respondent's responsibility to ascertain whether the domain name it was proceeding to register violated the prior rights of a registered proprietor, which responsibility the Respondent has clearly failed to fulfil.

b) The Respondent has no rights or legitimate interest in respect of the domain name

- It is the contention of the Complainant that insofar as the Complainant is aware, the Respondent does not own any registered rights in favour of the mark 'SKYSCANNERS' which forms part of the disputed domain name <<u>skyscanners.in</u>>.
- ii. The Complainant submits that the term 'SKYSCANNER' is not descriptive and does not have any generic or dictionary meaning attached to it. The Complainant further states that the Respondent has not been authorized by the Complainant and neither has the Complainant's consent been sought, for use of its registered trade mark 'SKYSCANNER' by the Respondent.
- iii. It is the Complainant's submission that since the website resolving to the disputed domain name is not active/operational, there is no evidence of use of the disputed domain name for a legitimate purpose or for *bona fide* conduct of business/offering of goods and services by the Respondent. The Complainant further submits that since the Respondent does not own any legitimate enforceable rights in the mark 'SKYSCANNER<u>S</u>'/ 'SKYSCANNER', the



Respondent cannot be said to have any legitimate rights in respect thereof or in the domain name <<u>skyscanners.in</u>>.

iv. The Complainant further states that the Respondent is clearly not making any legitimate or fair use of the disputed domain name and has registered the disputed domain name with the sole intent to gain commercially by misleading and diverting customers. The Complainant relies on the case of *Mary-Lynn Mondich and American Vintage Wine Biscuits, Inc. v. Shane Brown, doing business as Big Daddy's Antiques*, WIPO Case No. D2000-0004 to assert that absence of any contrary evidence or response by the Respondent should lead to the presumption that the Respondent is not in a position to demonstrate any rights or legitimate interest in the disputed domain name and therefore, lead to an adverse inference insofar as the Respondent is concerned.

c) The domain name was registered and is being used in bad faith

- i. The Complainant contends that the bad faith of the Respondent can be established based on the fact that the Respondent knew or should have known of the Complainant's trade mark rights by virtue of the well-known status of its mark 'SKYSCANNER' at the time of registering the disputed domain name. The Complainant relies on the case of *Cho Yong Pil v. Sinwoo Yoon*, WIPO Case No. D2000-0310 to substantiate that bad faith registrations are deemed to be found in circumstances wherein the Complainant's trade mark was already famous at the time of registration of the disputed domain name.
- ii. The Complainant further submits that it cannot be a mere coincidence that the Respondent chose to register a domain name that is virtually identical to the Complainant's distinctive mark 'SKYSCANNER'. The Complainant relies on the cases of Aon PLC and Ors. v. Guanrui, INDRP Case No. 633; Wells Fargo & Co. and Anr. v. SreeDas Kumar, INDR Case No. 666; QRG Enterprises Limited & Anr. v. Zhang Mi, INDRP Case No. 852; and Santa Fe Transport International Limited and Santa Fe Moving Services Private Limited



v. Santa Fe Packers, Packers Movers, WIPO Case No. D2017-0754 to substantiate that the overwhelming likelihood in the present case is that the Respondent registered the disputed domain name with the intent to trade upon the goodwill of Complainant vesting in the mark 'SKYSCANNER' and that such trading cannot constitute a *bona fide* offering of goods or services.

- iii. The Complainant further states that the website to which the disputed domain name resolves contains a number of pay-per-click advertisements for services that compete directly with those offered by the Complainant, which is clear evidence that the Respondent registered the disputed domain name to trade upon the goodwill of the Complainant, in order to seek financial gain by misdirecting consumers to the services of the Complainant's competitors by virtue of the disputed domain name registration, to the clear and obvious detriment of the Complainant.
- iv. The Complainant points out that the Respondent's email address (discerned from the WHOIS records) is <<u>info@sagartravels.com</u>>. It is the Complainant's assertion that 'Sagar Travels' is a company that is active in the same field of business as the Complainant i.e. 'travel', which evidences that there can be no reasonable or meaningful reason to justify the Respondent's registration of the disputed domain name in a manner that would not take advantage of the Complainant's rights given that both of them were in the same industry.
- v. The Complainant further submits that there is a real risk of the disputed domain name being used by the Respondent for illegitimate purposes, such as the Respondent may set up email addresses associated with the disputed domain name to further mislead consumers. It is the submission of the Complainant that the Complainant has been targeted in this manner frequently in the past.
- vi. Lastly, the Complainant relies on the case of *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003 to submit that a finding of registration and



use in bad faith is to be found wherein there is passive use of a widely known trade mark in a domain name in the absence of any response or explanation as to why the said use could be in good faith and therefore, on the balance of probability, the Respondent can be said to have registered the disputed domain name in bad faith.

5.2. Respondent

As per the INDRP Rules of Procedure, a copy of the Complaint along with all annexures was forwarded to the Respondent on February 11, 2020 under the directions of this Tribunal. The Tribunal issued a notice on February 11, 2020 to the Respondent directing it to file a response within ten days to which the Respondent replied stating that it had already filed a response. Accordingly, the Tribunal *vide* its email dated February 12, 2020 provided the Respondent with a further period of ten days to forward a copy of the response filed by it to the Tribunal. Absent a response, the Tribunal as a last opportunity and in the interest of justice provided an additional period of three days to the Respondent to forward a copy of its response.

The Respondent on February 24, 2020 forwarded an email to the Tribunal dated November 26, 2019 which was addressed by the Respondent email address to an <<u>domain.disputes@wipo.int</u>> wherein the Respondent had requested for a copy of the Complaint as well as sought advice as to whether use of the domain name <<u>sykscanners.in</u>> by it was illegal. No response to the Complaint was filed by the Respondent. Since an electronic copy of the Complaint along with the Annexures were forwarded to the Respondent at the email address mentioned in the WHOIS records on February 11, 2020; correspondence with the Respondent thereafter also successfully followed at the said email address; and there was no bounce back/delivery failure notification, the Complaint was deemed to be delivered to the Respondent on February 11, 2020. Absent any other correspondence/response from the



Respondent thereafter, the pleadings in the proceeding were closed and the Tribunal proceeded to pass an Award on the basis of the material available on record.

6. Discussion and Findings

As per paragraph 4 of the .IN Domain Name Dispute Resolution Policy (INDRP), any person who considers that a registered domain name conflicts with his legitimate rights or interests may file a Complaint to the .IN Registry on the following premises:

i. The Registrant's domain name is identical or confusingly similar to the name, trade mark or service mark in which the Complainant has rights;

ii. The Registrant has no rights or legitimate interests in respect of the domain name;

iii. The Registrant's domain name has been registered or is being used in bad faith.

Based upon the pleadings, it is required to be examined as to whether the parties have been able to justify/rebut the aforesaid premises:

6.1. Identical or confusingly similar trade/service mark

As per the WHOIS records, the Respondent registered the disputed domain name <<u>skyscanners.in</u>> on September 29, 2019.

The Complainant is the proprietor of the registered trade/service marks 'SKYSCANNER' and

SKYSCANNER' in relation to its business/products/services.

The disputed domain name incorporates the mark 'SKYSCANNER' in its entirety, with the only variant from the Complainant's mark being the addition of the letter 'S' (i.e.



SKYSCANNERS) to make the disputed domain name nothing but a plural form of the Complainant's trade mark 'SKYSCANNER', rendering it phonetically and visually identical to the Complainant's mark. It has been held in *Inter-Continental Hotels Corporation vs. Abdul Hameed* (INDRP/278) as well as in *Indian Hotels Company Limited vs. Mr. Sanjay Jha* (INDRP/148) that when a disputed domain name incorporates a mark in entirety, it is adequate to prove that the disputed domain name is either identical or confusingly similar to the mark. Similarly, in the case of *Farouk Systems Inc. vs. Yishi*, WIPO Case No. D2010-006, it has been held that the domain name wholly incorporating a Complainant's registered mark may be sufficient to establish identity or confusing similarity, despite the additions or deletions of other words to such marks.

Further, the Complainant has placed on record various previous decisions of NIXI as well as the WIPO wherein Panels have held in favour of the Complainant when faced with disputed domain names such as <u>'skyscannerflights.com</u>', <u>'skyscannerltd.com</u>' and <u>'skyscan.co.in</u>' unequivocally recognized the prior proprietary rights of the Complainant in the mark 'SKYSCANNER' in each of those decisions. As compared to these earlier disputed domain names, it is evident that in the present case the disputed domain name is virtually an identical imitation of the Complainant's mark 'SKYSCANNER' with a negligible variation in the spelling by adding the letter 'S' in the end (i.e. SKYSCANNER<u>S</u>) only to make it the plural form of the Complainant's registered trade mark.

As seen from above, the Complainant has registered trade marks in India dating back to the year 2009 and is doing/operating business/website thereunder. The Respondent on the other hand registered the domain name <<u>skyscanners.in</u>> much subsequent to the Complainant i.e. on September 29, 2019.

In view of the foregoing discussions, the Complainant has satisfied this Tribunal that:



i. The domain name in question <<u>skyscanners.in</u>> is phonetically as well as visually identical to the Complainant's prior registered trade mark 'SKYSCANNER'; and

ii. It has both prior statutory and proprietary rights in respect of the mark 'SKYSCANNER'.

6.2 Rights and legitimate interests

The Complainant has asserted that the Respondent has no rights or legitimate interests in the disputed domain name. Paragraph 7 of the INDRP enumerates three circumstances (in particular but without limitation) and if the Arbitrator finds that the Registrant has proved any of the said circumstances that shall demonstrate its rights to or legitimate interests in the disputed domain name. The said paragraph is reproduced hereinbelow:

"7. Registrant's Rights to and Legitimate Interests in the Domain Name – Any of the following circumstances, in particular but without limitation, if found by the Arbitrator to be proved based on its evaluation of all evidence presented, shall demonstrate the Registrant's rights to or legitimate interests in the domain name for the purposes of Paragraph 4 (ii):

i. Before any notice to the Registrant of the dispute, the Registrant's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name with a bona fide offering of goods or services;

ii. The Registrant (as an individual, business, or other organization) has been commonly known by the domain name, even if the Registrant has acquired no trademark or service mark rights; or

iii. The Registrant is making a legitimate non-commercial or fair use of the domain name, without intent for commercial gain to misleading divert consumers or to tarnish the trademark or service mark at issue."



The Respondent has not filed any response in this case. In the absence of a response thereof, there is nothing on record to suggest that the Respondent has used or made demonstrable preparations to use the disputed domain name or a name corresponding to the disputed domain name in connection with *bona fide* offering of goods/services; or is commonly known by the disputed domain name; or has made fair use of the domain name. In fact, no website is functional as on date corresponding to the domain name <<u>skyscanners.in</u>>.

Further, as observed by the panel in the case of *Inter-Continental Hotels v. Abdul Hameed* (INDRP/278), it is well established that trade mark registration is recognized as *prima facie* evidence of rights in a mark. Complainant, in the instant case, is the owner of the registered trademark 'SKYSCANNER' in India and has sufficiently demonstrated its goodwill and reputation subsisting therein by citing previous Panel decisions of NIXI as well as the WIPO that have recognized and protected its exclusive proprietary rights vesting in the mark 'SKYSCANNER'.

It is a settled position that if the Respondent does not have trade mark rights in the word corresponding to the disputed domain name and in the absence of evidence that the Respondent was commonly known by the disputed domain name, the Respondent can have no rights or legitimate interest subsisting therein. [See *Shulton Inc. v. Mr. Bhaskar*, (INDRP/483)]

In the absence of any *bona fide* use on behalf of the Respondent, it appears that the domain name registration was obtained for potential commercial gain and to commercially exploit the virtual identity it bore to the Complainant's registered trade mark 'SKYSCANNER' and to free ride on the goodwill and reputation of the Complainant by being mistaken to be associated with the Complainant.

In view of the foregoing, it is evident that the Respondent has no rights or legitimate interests in the disputed domain name.

6.3 Bad faith

Paragraph 6 of the INDRP enumerates the circumstances evidencing registration and use of domain name in bad faith. The said paragraph is reproduced herein under:

"6. Evidence of Registration and use of Domain Name in Bad Faith – For the purposes of Paragraph 4(iii), the following circumstances, in particular but without limitation, if found by the Arbitrator to be present, shall be evidence of the registration and use of a domain name in bad faith:

i. Circumstances indicating that the Registrant has registered or acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant, who bears the name or is the owner of the trademark or service mark, or to a competitor of that Complainant, for valuable consideration in excess of the Registrant's documented out-of-pocket costs directly related to the domain name; or

ii. the Registrant has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that the Registrant has engaged in a pattern of such conduct; or

iii. by using the domain name, the Registrant has intentionally attempted to attract Internet users to the Registrant's website or other on-line location, by creating a likelihood of confusion with the Complainant's name or mark as to the source, sponsorship, affiliation, or endorsement of the Registrant's website or location or of a product or service on the Registrant's website or location."

It appears that by registering the impugned domain name, the Respondent has attempted to attract internet users by creating likelihood of confusion with the Complainant's mark/source of origin. [See *Colgate – Palmolive Company and Colgate Palmolive (India) Ltd. v. Zhaxia*,



(INDRP/887)]. Thus, it can be inferred that the Respondent has registered the disputed domain name in bad faith to tarnish the trade mark of the Complainant and cause confusion in the minds of the public.

It has also been held in the cases of *LinkedIn Corporation v. David Naranjo, All Play Media*, WIPO Case No. D2019-2784 and *V&V Vin&Sprit AB v. Wallin*, WIPO Case No. D2003-0437 that bad faith can be established where a domain name is so obviously connected with a well-known trade mark that its very use by someone with no connection to the trade mark suggests opportunistic bad faith. It is also evident that the objective of registering the disputed domain name was aimed at preventing the legitimate owner of the trade mark from reflecting the same in a corresponding domain name since to date no website is functional at the website corresponding to the disputed domain name.

Substantial number of precedents establish that registration of a domain name that is confusingly similar to a famous trademark by any entity that has no relationship to that mark is itself sufficient evidence of bad faith registration and use. [See *Pepperdine University v. BDC Partners, Inc.*, WIPO Case No. D2006-1003; *Veuve Clicquot Ponsardin, Maison Fonde en 1772 v. The Polygenix Group Co.*, WIPO Case No. D2000-0163, *Mastercard International Incorporated v. Total Card Inc.*, WIPO Case No. 2000 – 1411]. Further, considering that the Complainant has asserted that the Respondent is engaged in similar business activities as that of the Complainant i.e. travel, and while in the absence of a response from the Respondent the Tribunal cannot opine on the veracity of the said submission, *prima facie* the Tribunal deems it prudent to state that likelihood of confusion resulting from use of the disputed domain name would certainly be aggravated if the Respondent is engaged in identical business/services as that of the Complainant.

Considering that the current status of the webpage corresponding to the domain name <<u>skyscanners.in</u>> is non-operational/inactive and the WHOIS records do not indicate the domain name being available for sale, this would constitute passive/parked holding of the domain name/website, which further contributes to bad faith. [See: *HSBC Holdings plc v. Hooman Esmail Zadeh* (INDRP/032), *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. D2000-0003].

In view of the foregoing, the Tribunal is of the view that the Respondent has registered the domain name <<u>skyscanners.in</u>> in bad faith.

7. Award

From the foregoing findings, it is established beyond doubt that (1) the disputed domain name is identical to the mark 'SKYSCANNER' which is proprietary to the Complainant, (2) the Respondent has no rights or legitimate interests in respect of the disputed domain name, and (3) the disputed domain name is registered in bad faith.

Thus, in accordance with the Policy and Rules, this Arbitral Tribunal directs the Respondent to immediately transfer the disputed domain name <<u>skyscanners.in</u>> to the Complainant.

The parties shall bear their own cost.



C.A. Brijesh Sole Arbitrator

Dated: April 09, 2020