

DISPUTE RESOLUTION SERVICE

D00019110

Decision of Independent Expert

Virgin Enterprises Limited

and

PRIVACY SERVICES INC.

1. The Parties

Complainant: Virgin Enterprises Limited
The Battleship Building
179 Harrow Road
London
W2 6NB
United Kingdom

Respondent: PRIVACY SERVICES INC.
#1 Map Street
Belize City
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Belize

2. The Domain Name

virignmedia.co.uk

3. Procedural History

- 3.1 I 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 such a nature as to call in to question my independence in the eyes of one or both of the parties.
- 3.2 On 6 July 2017 the complaint was received. On 11 July 2017 the complaint was validated and notification of it sent to the parties. On 28 July 2017 a response reminder was sent. On 2 August 2017 a notification of no response was sent to the parties. On 14 August 2017 a summary/full fee reminder was sent and the Expert decision payment was received.
- 3.3 The Respondent has not filed a response. I am satisfied that the complaint was served upon the Respondent in accordance with paragraphs 3 and 6 of the Nominet Dispute Resolution Service Policy ("the Policy").

4. Factual Background

- 4.1 The Complainant was incorporated on 27 September 1972 and is a member of the Virgin group of companies. The Virgin group was founded by Sir Richard Branson in

the 1970's and has expanded significantly since then offering a wide range of goods and services. In 2016 the Virgin group had 60 million customers worldwide, 71,000 staff and group revenue of \$24 billion.

- 4.2 The Complainant is the owner of a number of registered trade marks for the VIRGIN mark and the stylised VIRGIN signature. It is also the owner of the following registered trade marks:
- (a) EU trade mark number 013867478 for VIRGIN MEDIA registered in classes 9, 35, 36, 38, 41 and 42 on 14 October 2015;
 - (b) UK trade mark number 00003100686 for VIRGIN MEDIA registered in classes 9, 35, 36, 38, 41 and 42 on 28 August 2015;
 - (c) UK trade mark number 00002429892 for VIRGIN MEDIA registered in classes 9, 35, 38 and 41 on 18 May 2007;
 - (d) EU trade mark number 014032163 for a VIRGIN MEDIA logo registered in classes 9, 35, 36, 38, 41 and 42 on 3 December 2015; and
 - (e) UK trade mark number 00002439120 for a VIRGIN MEDIA logo registered in classes 9, 35, 38, 41 and 42 on 5 October 2007.
- 4.3 The Complainant is responsible for the ownership, management and protection of all trade marks and intellectual property in the VIRGIN name, VIRGIN signature logo and associated marks on behalf of its licensees. Most of the Complainant's licensees are trading entities whose name begins with the VIRGIN name followed by an additional word, for example Virgin Atlantic, Virgin Media, Virgin Holidays, Virgin Mobile, Virgin Money and Virgin Trains. Other licensees use the VIRGIN name followed by a geographic indicator, for example Virgin America or Virgin Australia.
- 4.4 Virgin Media was established in 2007 and now operates a multi-media home entertainment service consisting of on-demand television, video content, broadband services, mobile services and landline telephone services across the United Kingdom and Ireland. As at 7 March 2017 Virgin Media had over 3 million mobile users, 5.7 million cable TV customers and serviced over 50,000 businesses nationwide. In 2007 Virgin Media (UK) was voted by readers as 'Best Broadband Provider' at the PC Advisor Awards.
- 4.5 The Complainant is the owner of virgin.com which was registered on 10 September 1997. This site provides information on the Virgin group and links to web pages for companies in the Virgin group. In 2008 the site had 6,953,547 visits from 230 countries/territories and in 2015 it had 25,474,395 visits from 242 countries/territories. The Complainant also owns virginmedia.com and virginmedia.co.uk which were registered respectively on 27 February 1999 and 11 March 2000. Customers can book various services via the site at virginmedia.com (virginmedia.co.uk routes to this site).
- 4.6 The Domain Name was registered on 30 April 2007. On 3 July 2017 it was used to re-direct to a Yahoo! Canada search page displaying results for a search on 'phone and mobile'.

5. Parties' Contentions

The Complainant's complaint

- 5.1 The Complainant submits that it has Rights in respect of a name or mark which is identical or similar to the Domain Name:

- (a) The Complainant says the VIRGIN mark is well known and that it has developed a significant reputation in this mark. It states VIRGIN is a leading global brand. The Complainant contends that the power of the VIRGIN name, Richard Branson's personal reputation and the Virgin management style are all factors which contribute towards the Virgin group's unrivalled reputation.
 - (b) The Complainant says the VIRGIN brand is year on year listed in brand surveys and is recognised for its distinctive nature and reputation spanning across numerous industry sectors. It states VIRGIN has been consistently ranked by independent surveys in the top ten of most successful, innovative, admired and respected brands. It relies on the Virgin group being ranked 14th in a 2011 survey conducted by the Reputation Institute.
 - (c) The Complainant says the VIRGIN mark is inherently very strong and distinctive and has acquired an enhanced distinctive character through the high profile use which has been made on a significant global scale.
 - (d) The Complainant relies on its trade mark registrations for VIRGIN and VIRGIN MEDIA. It says it has a reputation in the VIRGIN MEDIA brand.
 - (e) The Complainant contends that the Domain Name is highly similar to its VIRGIN MEDIA mark and would therefore be associated with the VIRGIN brand and businesses. The Complainant states 'virgin' is misspelled in the Domain Name and says this is an obvious example of typo squatting. It also says this misspelling does not make any difference to the overall visual impression of the Domain Name. The Complainant argues that any consumer would assume that the Domain Name is owned by it and relates to a service provided by it.
 - (f) The Complainant states it owns UK and EU trade marks for VIRGIN which pre-date the Respondent's registration of the Domain Name and that virgin.com and virginmedia.co.uk were registered before then.
- 5.2 The Complainant contends that the Domain Name, in the hands of the Respondent, is an Abusive Registration and relies on paragraphs 5.1.1.1, 5.1.1.2, 5.1.1.3 and 5.1.2 of the Policy:
- (a) The Complainant says the Domain Name re-directs to a Yahoo! search page which features a range of third party links to mobile phone options and deals and that all of these are competitors of the Virgin Media business. The Complainant contends the Domain Name has been registered and is being used in a manner which the Respondent knows would cause the Complainant concern. It says the Respondent would expect the Complainant to become aware of the Domain Name and to approach the Respondent and would also expect to be in a position to sell the Domain Name for consideration in excess of documented out-of-pocket disbursements.
 - (b) The Complainant contends that the Domain Name has been registered to gain from its reputation. It says the Domain Name is an obvious misspelling of VIRGIN MEDIA, a brand which is widely recognised as the Complainant's. It argues the Respondent is relying on the Complainant's consumers misspelling to reach the competing site at the Domain Name. It says the Respondent is intentionally attracting, for commercial gain, Internet users to the Respondent's site at the Domain Name by creating a likelihood of confusion with the Complainant.
 - (c) The Complainant contends the Domain Name was registered to unfairly disrupt its business. It says Internet users will be diverted to competing third party

providers rather than selecting Virgin Media services at virginmedia.co.uk or www.virginmedia.com.

- (d) The Complainant argues that use of the Domain Name for a search engine page displaying competing third party links undoubtedly results in consumer confusion.

6. Discussions and Findings

- 6.1 Paragraph 2.2 of the Policy sets out that the Complainant is required to prove to the Expert that both of the following elements are present on the balance of probabilities:

2.1.1 *The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and*

2.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration.*

- 6.2 In this case the Respondent has not submitted a response. Nevertheless the Complainant is still required to prove to the Expert that both the above elements are present on the balance of probabilities.

The Complainant's Rights

- 6.3 Under Paragraph 1 of the Policy, 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.*" It is well accepted that the question of Rights falls to be considered at the time the Complainant makes its complaint and is a test with a low threshold to overcome.

- 6.4 I am satisfied on the basis of the Complainant's registered trade marks for VIRGIN MEDIA as set out at paragraph 4.2 that the Complainant has Rights in the VIRGIN MEDIA mark. I am also satisfied that the Complainant (or its group company, Virgin Media) has established unregistered Rights through extensive use of the VIRGIN MEDIA mark.

- 6.5 I consider VIRGIN MEDIA to be identical or similar to the Domain Name. The only difference between VIRGIN MEDIA and the Domain Name is the misspelling of 'virgin'; in the Domain Name the 'i' is before the 'g' rather than after it. However this does not distinguish the Domain Name from the VIRGIN MEDIA mark. The Domain Name is visually highly similar to the VIRGIN MEDIA mark. I am therefore satisfied the Complainant has Rights in a name or mark which is identical or similar to the Domain Name.

Abusive Registration

- 6.6 Under Paragraph 1 of the Policy 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. *is being or has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.*

It is sufficient to satisfy either of these limbs for there to be a finding of an Abusive Registration.

- 6.7 A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration are set out at paragraph 5 of the Policy including:

- 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;*
 - 5.1.1.2 *as a blocking registration against a name or mark in which the Complainant has Rights; or*
 - 5.1.1.3 *for the purpose of unfairly disrupting the business of the Complainant.*
- 5.1.2 *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;*
- 6.8 A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration are set out at paragraph 8 of the Policy including:
- 8.5 *Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under this Policy. However, the Expert will take into account:*
 - 8.5.1 *the nature of the Domain Name;*
 - 8.5.2 *the nature of the advertising links on any parking page associated with the Domain Name; and*
 - 8.5.3 *that the use of the Domain Name is ultimately the Respondent's responsibility.*
- 6.9 Paragraph 5.1.1 of the Policy relates to the Respondent's motives at the time of registration of the Domain Name. For there to be an Abusive Registration under paragraph 1.i. of the Policy it must be established that the Respondent had knowledge of the Complainant and/or its Rights at the time of registration of the Domain Name.
- 6.10 The Complainant has adduced in evidence a witness statement of Victoria Wisener, a trade mark attorney employed by it. Ms Wisener states that Virgin Media was launched in the UK in February 2007. The Domain Name was registered shortly afterwards on 30 April 2007. The Respondent has not responded to this complaint and has therefore not given any explanation for its registration of the Domain Name.
- 6.11 I consider that the Respondent was aware of the VIRGIN MEDIA name and business when it registered the Domain Name. This is supported by the Domain Name being a misspelling of Virgin Media and it being registered so shortly after the launch of Virgin Media in the UK. I also consider the Respondent would have been aware at the time of registration of the Domain Name that Virgin Media was part of the Virgin group. The evidence establishes that the VIRGIN name was very well known at this time and was used in the names of Virgin group businesses. Ms Wisener explains in her statement that in all its new ventures the Virgin group relies heavily upon the substantial fame and goodwill in the VIRGIN name to rally support to each new enterprise or marketplace.
- 6.12 The Complainant relies on paragraphs 5.1.1.1 and 5.1.1.2 of the Policy. However, I do not consider there is evidence to support that the Respondent registered the Domain

Name primarily for the purposes set out in these paragraphs (see paragraph 6.7 above).

- 6.13 The Complainant also relies on paragraph 5.1.1.3 of the Policy. Virgin Media uses the VIRGIN MEDIA mark, virginmedia.co.uk and virginmedia.com for its business. In my view there is a real risk that Internet users, particularly those in the UK, guessing Virgin Media's URL will use virginmedia.co.uk. In my view there is also a real risk that such Internet users will mistype or misspell 'virgin' as 'virign' such that they find the Respondent's site instead of Virgin Media's. In this respect the misspelling or mistyping would only involve changing the order of the letters 'g' and 'i'.
- 6.14 I also consider that 'virginmedia' would be a common Internet search term for the Virgin Media business. In my view there is risk of Internet users mistyping or misspelling this search term as 'virignmedia' and thereby visiting the Respondent's site in response to a search engine request looking for Virgin Media. The Complainant has adduced in evidence the first page of the results of a Google search on 3 July 2017 using the search term 'virignmedia'. The displayed search results all relate to Virgin Media. However, at the top of the results it says that results are being shown for 'virgin media'. It may be that other search engines do not take into account the mistyping/misspelling of the search term as Google appears to have done.
- 6.15 In any event, as I have said at paragraph 6.13, I consider there is a real risk that Internet users guessing Virgin Media's URL will find the Respondent's site at the Domain Name. On 3 July 2017 the Domain Name was used to show the results of a Yahoo! Canada search on 'phone and mobile' which include various mobile phone related links. Part of the Virgin Media business relates to mobile phones. There is therefore a risk that Internet users who find the Respondent's site when looking for Virgin Media will be diverted to these third party sites.
- 6.16 In my view, the Respondent registered the Domain Name, with knowledge of the Virgin Media business, for the purpose of unfairly disrupting this business and thereby unfairly disrupting the business of the Virgin group which includes the Complainant. The Respondent's intention was to exploit the likely confusion of Internet users looking for Virgin Media to divert them to third party services. In reaching this conclusion I have taken into account that the evidence of use of the Domain Name is ten years after the Respondent's registration of the Domain Name. However, in my view it is still indicative of the Respondent's purpose for registering the Domain Name especially in the absence of any explanation from the Respondent for the registration. I therefore consider there is evidence that the Domain Name is an Abusive Registration under paragraph 1.i. of the Policy.
- 6.17 The Complainant relies on paragraph 5.1.2 of the Policy. As set out above I consider there is a likelihood of Internet users being initially confused into visiting the Respondent's web site in the expectation of finding Virgin Media and of potentially being diverted to third party web sites. Even if users appreciate that they have not found Virgin Media when they reach the Respondent's site, the Respondent has still used the Domain Name in a way to cause initial interest confusion that the Domain Name is registered to, operated or authorised by or otherwise connected with Virgin Media which is a Virgin group company. I therefore consider there is evidence that the Domain Name is an Abusive Registration under paragraph 1.ii. of the Policy.
- 6.18 As set out I have found paragraphs 5.1.1.3 and 5.1.2 of the Policy to be established. However, before I make a finding of an Abusive Registration I must bear in mind paragraph 8.5 of the Policy which sets out that sale of traffic is not of itself objectionable under the Policy; however the Expert will take into account the nature

of the Domain Name, the nature of the advertising links on any parking page associated with the Domain Name and that the use of the Domain Name is ultimately the Respondent's responsibility.

- 6.19 In this case it is unclear whether there is a 'sale of traffic', that is whether the Respondent earns revenue if users click through on the links at the site on the Domain Name. However, by analogy, the provision of links on a site without earning revenue should also in itself not be objectionable under the Policy subject to the Expert taking into account the factors at paragraph 8.5 of the Policy. I have found that the Respondent knew of the Virgin Media business when it registered the Domain Name, that the Domain Name is a misspelling of and is very similar to the Complainant's VIRGIN MEDIA mark and that the links on the site at the Domain Name are for competing or similar services to those of Virgin Media. I consider the Respondent registered and has used the Domain Name for the purpose of exploiting the likely confusion of Internet users looking for Virgin Media to divert them to third party services. In such circumstances I regard the registration and use of the Domain Name to be objectionable under the Policy.
- 6.20 Finally, I consider the issue of potential delay in this matter since the complaint has been brought 10 years after the registration of the Domain Name, although it is unclear when the Complainant first became aware of the registration. The Appeal Panel in DRS 15788 Lucasfilm Ltd.,LLC and ABSCISSA.COM Limited considered that delay does not automatically bar an action where the use complained of is ongoing (as is the case here) but, depending on the facts, it might mean that an otherwise Abusive Registration is acceptable.
- 6.21 In this case I do not consider that any delay in bringing the complaint has prejudiced the Respondent being able to argue its case nor do I consider there has been any unfair prejudice to the Respondent as a result of any delay. There is no evidence, for example, that the Respondent has developed a business under the Domain Name in the belief that the Complainant had no objection to his using it or with the encouragement of the Complainant. Accordingly I do not consider that any delay in the Complainant bringing its complaint after registration of the Domain Name makes the Abusive Registration in this matter acceptable.
- 6.22 I therefore find that the Domain Name, in the hands of the Respondent, is an Abusive Registration under paragraphs 1.i. and 1.ii. of the Policy.

7 Decision

- 7.1 I find that the Complainant has Rights in 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.
- 7.2 I therefore direct that the Domain Name be transferred to the Complainant.

Patricia Jones

Patricia Jones

8 September 2017