

ADMINISTRATIVE PANEL DECISION

Virgin Enterprises Limited v. WhoisSecure / Robert D Hunter D Hunter, Fargo Agency

Case No. D2022-2281

1. The Parties

The Complainant is Virgin Enterprises Limited, United Kingdom ("UK"), represented by AA Thornton IP LLP, UK.

The Respondent is WhoisSecure, United States of America / Robert D Hunter D Hunter, Fargo Agency, Nigeria.

2. The Domain Name and Registrar

The disputed domain name <thevirginonline.com> is registered with OwnRegistrar, Inc. (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 23, 2022. On June 24, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 24, 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 June 26, 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 July 1, 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 July 4, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 24, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 25, 2022.

The Center appointed Linda Chang as the sole panelist in this matter on July 29, 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 an affiliate of Virgin Group, which runs a diverse range of business including financial services, health and wellness, music and entertainment, people and planet, telecommunications and media, travel and leisure, and space industry, with over 60,000 employees all over the world.

The Complainant is the rightful owner of a number of VIRGIN trademark registrations, *inter alia*, UK Trademark VIRGIN Registration No. UK00001585773, registered on October 20, 1995; International Trademark VIRGIN Registration No. 1141309, registered on May 21, 2012; and European Union Trademark VIRGIN (logo) Registration No. 015404841, registered on December 2, 2016.

The Complainant has also a number of VIRGIN MONEY registrations, including UK Trademark VIRGIN MONEY Registration No. 00002177329, registered on May 21, 1999, and European Union Trademark VIRGIN MONEY Registration No. 014032247, registered on December 3, 2015.

The disputed domain name was registered on April 22, 2022, and, at the time of the filing of the Complaint, resolved to a website providing banking services in the name of Virgin Money Bank Limited.

5. Parties' Contentions

A. Complainant

The Complainant contends that the addition of "the" and "online" in the disputed domain name is not sufficient to avoid a finding of confusing similarity with the Complainant's VIRGIN trademark, and the disputed domain name therefore is confusingly similar to the VIRGIN trademark.

The Complainant further contends that by resolving the disputed domain name to a website displaying the VIRGIN MONEY logo, the Respondent is not using the disputed domain name in connection with a legitimate noncommercial or fair use, and therefore has no rights or legitimate interests in respect of the disputed domain name.

The Complainant finally contends that by reproducing the Complainant's trademarks and images on the website at the disputed domain name, the Respondent is confusing and diverting Internet users away from the Complainant's genuine business, and therefore registered and is using the disputed domain name in bad faith.

B. Respondent

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

6. Discussion and Findings

According to paragraph 4(a) of the Policy, the Complainant must demonstrate each of the following:

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

(ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain name; and

(iii) that the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel is satisfied that the Complainant has rights over the VIRGIN trademark.

“.com” as a technical requirement of generic Top-Level-Domain should be disregarded in the course of assessing the test of confusing similarity. Hence, the recognizable part of the disputed domain name is “thevirginonline”, which entirely contains the Complainant’s VIRGIN trademark and the words “the” and “online”. The Panel finds that the mere addition of the indications “the” and “online” does not prevent a finding that the disputed domain name being confusingly similar to the Complainant’s VIRGIN trademark.

The Panel concludes that the disputed domain name is confusingly similar to the Complainant’s VIRGIN trademark and that paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

The Complainant makes it clear that it has never authorized the registration or use of the disputed domain name by the Respondent. The Panel accepts the Complainant’s *prima facie* case that the Respondent does not have rights or legitimate interests in respect of the disputed domain name. The burden of production shifts to the Respondent to come forward with evidence demonstrating rights or legitimate interests in the disputed domain name (in order to rebut the Complainant’s *prima facie* case), but the Respondent failed to do so.

In the present case, the disputed domain name has been resolving to a website displaying VIRGIN and VIRGIN MONEY marks and providing banking services similar to that of the Complainant’s Virgin Money business. VIRGIN MONEY is another registered trademark of the Complainant’s, as mentioned above under section 4. It is hard to believe it is coincident that the Respondent registered the disputed domain name meanwhile used another identical trademark of the Complainant’s in the content of the website at the disputed domain name, hence such use does not amount to a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the disputed domain name.

The Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name and that paragraph 4(a)(ii) of the Policy is satisfied.

C. Registered and Used in Bad Faith

The Complainant’s registration of the VIRGIN trademark significantly predates the registration date of the disputed domain name. In the current case, the Respondent is not only reproducing on its website marks identical to the Complainant’s trademarks VIRGIN and VIRGIN MONEY, but also copying the images from the Complainant’s websites without authorization. The Panel consequently finds that the Respondent should have been aware of the Complainant and its VIRGIN trademark at the time of registering the disputed domain name, aiming at trading off the goodwill of the Complainant’s VIRGIN trademark to divert Internet traffic to its own website. The Respondent’s registration and use of the disputed domain name suggests opportunistic bad faith.

The disputed domain name is dominantly displaying VIRGIN MONEY logos on the website and purporting to provide various types of banking services in the name of Virgin Money Bank Limited, one of the UK’s largest banks with its headquarter in Preston, UK, and a banking hall in Liverpool, UK. According to the Complainant’s search, Virgin Money Bank Limited does not exist on the UK company register, while the Complainant has been indeed providing financial services under the name of Virgin Money since 2002 and is now the sixth largest bank in the UK.

The Panel determines that by using the disputed domain name, the Respondent is intentionally attempting to attract, for commercial gain, Internet users to the Respondent’s website by creating a likelihood of confusion

with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of the Respondent's website. Without evidence to the contrary, the Panel is convinced that this was the intention of the Respondent at the time of registering the disputed domain name, and bad faith can be inferred from the Respondent's registration and use of the disputed domain name.

The Panel concludes that the disputed domain name was registered and is being used in bad faith and that paragraph 4(a)(iii) of the Policy is satisfied.

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 <thevirginonline.com> be transferred to the Complainant.

/Linda Chang/

Linda Chang

Sole Panelist

Date: August 16, 2022