

ADMINISTRATIVE PANEL DECISION

Virgin Enterprises Limited v. James Oduro, Jodsuns Technology
Case No. D2023-5296

1. The Parties

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

The Respondent is James Oduro, Jodsuns Technology, Ghana.

2. The Domain Name and Registrar

The disputed domain name <virginprivateinvestment.com> is registered with Tucows Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on December 20, 2023. On December 21, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On December 21, 2023, the Registrar transmitted by email to the Center its verification response disclosing the 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 26, 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 27, 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 2, 2024. In accordance with the Rules, paragraph 5, the due date for Response was January 22, 2024. The Respondent sent an email communication to the Center on January 4, 2024, expressing willingness to resolve the matter amicably by negotiating a fair cost for the transfer of ownership of the domain.

Pursuant to paragraph 6 of the Rules, on February 6, 2024, the Center informed the Parties that it would proceed with the panel appointment process.

The Center appointed Marina Perraki as the sole panelist in this matter on February 18, 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

Complainant is part of the Virgin Group and is the owner of the VIRGIN brand and associated trademarks. The VIRGIN brand was originally established by its founder and chairman, Sir Richard Branson, when he started a business selling music records by mail order under the Virgin name. Since then, operations have expanded, and now VIRGIN branded businesses span a diverse range of sectors covering also financial services. There are currently more than 40 VIRGIN branded businesses which have over 50 million customers worldwide and employ more than 60,000 people.

Complainant's group comprises a financial services business operating under the brand name Virgin Money in South Africa, Australia and the United Kingdom. It was established in 1995 in the United Kingdom and operates the website "uk.virginmoney.com".

Complainant's group further comprises a not-for-profit organization under the brand name Virgin Start Up, operating in England and Scotland, which seeks to help entrepreneurs to start, fund and scale their business. It was founded in 2013 and operates under the website "www.virginstartup.org".

Complainant holds numerous trademark registrations for VIRGIN, including the European Union trademark registration VIRGIN No. 1141309, registered on May 21, 2012, for goods and services in international classes 9, 35, 36, 38 and 41.

The disputed domain name was registered on November 25, 2023, and resolved at the time of filing of the Complaint to a website that purported to offer private investment banking services, as well as mortgage products and internet banking (the Website). The Website provided online contact us and application forms that requested personal details including name, phone number, email address and home address. It also included contact email addresses. The only business address given on the Website was a United Kingdom address of 30 – 32 Haymarket, London, SW1Y 4EX which is near identical to an address where Complainant previously operated a store. Per Complaint, there was no record on the United Kingdom companies register Companies House of a company with the name Virgin Private Investment. The only contact number on the Website was a mobile number. There was no reference to any financial regulator and there were no privacy policies or terms and conditions. Many of the webpages were almost identical to the website found at <waveib.com>. Many of the photos used on the Website were stock photos that can be found elsewhere online. The disputed domain name currently leads to an error page.

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.

B. Respondent

The Respondent did not formally reply to the Complainant's contentions. On January 4, 2024, Respondent sent an email communication to the Center, claiming that Respondent is a duly registered web development and IT agency company in Ghana, that there was no bad faith in the acquisition of the disputed domain name, that it was done as part of a bulk purchase and that Respondent is willing to sell the disputed domain name to Complainant.

6. Discussion and Findings

Paragraph 4(a) of the Policy lists the three elements which Complainant must satisfy with respect to the Domain Name:

- (i) the Domain Name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- (ii) Respondent has no rights or legitimate interests in respect of the Domain Name; and
- (iii) the Domain Name has been registered and is being used in bad faith.

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 of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[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 entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "private" and "investment" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

The generic Top-Level Domain ("gTLD") ".com" is also disregarded, as TLDs typically do not form part of the comparison on the grounds that they are required for technical reasons only (*Rexel Developpements SAS v. Zhan Yequn*, WIPO Case No. [D2017-0275](#)).

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

On the contrary, as Complainant demonstrated, the disputed domain name resolved to a website purportedly offering services similar to those of Complainant and impersonating Complainant.

Panels have held that the use of a domain name for illegal activity here, claimed impersonation/passing off, or other types of fraud can never confer rights or legitimate interests on a respondent. [WIPO Overview 3.0](#), section 2.13.1.

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

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

The VIRGIN mark has been widely used by Complainant and is repeatedly recognized as a renowned trademark enjoying a worldwide reputation (*Virgin Enterprises Limited v. Bhavesh Tank, KUTCH WEB INFO*, WIPO Case No. [D2017-0934](#), *Virgin Enterprises Limited v. Hildegard Gruener*, WIPO Case No. [D2017-0429](#), *Virgin Enterprises Limited v. Simon Thompson*, WIPO Case No. [D2014-0266](#)).

In the present case, the Panel notes that the Respondent has registered and used the disputed domain name in bad faith. Because the VIRGIN mark is so well-known and had been widely used and registered at the time of the disputed domain name's registration, the Panel finds it more likely than not that Respondent had Complainant's mark in mind when registering the disputed domain name (*Parfums Christian Dior v. Javier Garcia Quintas and Christiandior.net*, WIPO Case No. [D2000-0226](#); *Société des Produits Nestlé SA v. Telmex Management Service*, WIPO Case No. [D2002-0070](#)).

Furthermore, the disputed domain name incorporates in whole Complainant's mark plus the additional terms "private" and "investment" respectively, that correspond to the business offered by Complainant's group members.

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 held that the use of a domain name for illegal activity, in this case, claimed impersonation/passing off, or other types of fraud constitutes bad faith. [WIPO Overview 3.0](#), section 3.4. Having reviewed the record, the Panel finds the Respondent's registration and use of the disputed domain name constitutes 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 name <virginprivateinvestment.com> be transferred to the Complainant.

/Marina Perraki/

Marina Perraki

Sole Panelist

Date: March 3, 2024