

## **ADMINISTRATIVE PANEL DECISION**

Virgin Enterprises Limited v. Privacy Service Provided by Withheld for Privacy ehf / Robert Burke, Weight Watchers  
Case No. D2022-1410

### **1. The Parties**

The Complainant is Virgin Enterprises Limited, United Kingdom, represented by A.A.Thornton & Co, United Kingdom.

The Respondent is Privacy Service Provided by Withheld for Privacy ehf, Iceland / Robert Burke, Weight Watchers, United States of America.

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

The disputed domain name <virginpulseonline.com> is registered with NameCheap, Inc. (the “Registrar”).

### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 20, 2022. On April 20, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On April 20, 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 April 21, 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 April 27, 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 May 5, 2022. In accordance with the Rules, paragraph 5, the due date for Response was May 25, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 28, 2022.

The Center appointed Eva Fiammenghi as the sole panelist in this matter on June 24, 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 founded Virgin Pulse in 2004, as an employee wellbeing solution which aims to support employees and employers, build health plans, sustain healthy behaviors, and drive measurable outcomes.

The Complainant's business comprises a digital platform, which provides health coaching and tailored personal wellbeing management. It offers a website at "www.virginpulse.com".

The Complainant is the owner of various registrations for the trademark VIRGIN PULSE including the following:

- United States of America trademark number 4804560 for the trademark VIRGIN PULSE, registered on September 1, 2015, in International Classes 9, 35, 41, 42, and 44;
- United Kingdom trademark number UK00003433371 for the trademark VIRGIN PULSE, registered on January 24, 2020, in International Classes 9, 35, 41, 42, and 44;
- European Union trademark number 018132528 for the trademark VIRGIN PULSE, registered on May 22, 2020, in International Classes 9, 35, 41, 42, and 44.

The Complainant is also the owner of numerous registrations for the trademark VIRGIN in jurisdictions throughout the world.

The disputed domain name was registered on March 14, 2022, and at the time of writing this decision does not resolve to an active website. According to evidence provided by the Complainant, the disputed domain name has been used to send fraudulent emails to members of the public, falsely claiming to be an employee of the Complainant.

#### **5. Parties' Contentions**

##### **A. Complainant**

The Complainant argues that the disputed domain name is confusingly similar to the Complainant's trademark VIRGIN PULSE.

The disputed domain name incorporates the VIRGIN PULSE mark in its entirety, adding the term "online". Internet users may believe that the disputed domain name is another official website of the Complainant, and more specifically a portal which would permit to access to or purchase Virgin Pulse services.

The Complainant argues that the Respondent has no rights or legitimate interests in the disputed domain name. The Respondent is not affiliated with the Complainant and there is no evidence to suggest that the Respondent has registered the disputed domain name to advance legitimate interests.

The Complainant argues that the disputed domain name was registered and is being used in bad faith. The disputed domain name is being used as part of a recruitment scam purporting to be an employee of the Complainant.

The Complainant requests that the disputed domain name be transferred to it.

## **B. Respondent**

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

## **6. Discussion and Findings**

Under paragraph 4(a) of the Policy, to succeed the Complainant must prove that:

- (i) the disputed domain name is 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 name; and
- (iii) the disputed domain name was registered and is being used in bad faith.

These elements are discussed in turn below. In considering these elements, paragraph 15(a) of the Rules provides that the Panel shall decide the Complaint on the basis of statements and documents submitted and in accordance with the Policy, the Rules and any other rules or principles of law that the Panel deems applicable.

### **A. Identical or Confusingly Similar**

In the present case, the disputed domain name incorporates the term "virgin pulse", which is identical to the Complainant's registered trademarks VIRGIN PULSE.

It is clear that the disputed domain name incorporates in its entirety the VIRGIN PULSE trademark to which the term "online" has been added.

It is well established that the addition of terms to a trademark in a domain name does not avoid confusing similarity. See *e.g.*, *eBay Inc. v. ebayMoving / Izik Apo*, WIPO Case No. [D2006-1307](#).

Moreover, it is well established that the generic Top-Level Domains ("gTLD") ".com", being a necessary component of a domain name, may be disregarded for the purpose of comparison under this ground. See, *F. Hoffmann-La Roche AG v. Macalve e-dominios S.A.*, WIPO Case No. [D2006-0451](#); and *Telstra Corporation Limited v. Nuclear Marshmallows*, WIPO Case No. [D2000-0003](#).

The Panel finds that the first element of the Policy has been met.

### **B. Rights or Legitimate Interests**

According to the Policy, paragraph 4(a)(ii), the Complainant has to demonstrate that the Respondent has no rights or legitimate interests in the disputed domain name.

There is nothing in the available case file to suggest that the Respondent is in any way affiliated with the Complainant, nor has the Complainant authorized or licensed the Respondent to use its trademarks, or to seek registration of any domain name incorporating its trademarks.

The Respondent has not made any submissions or any demonstrations that it has rights or legitimate interests in the disputed domain name.

In *Guerlain S.A. v. Peikang*, WIPO Case No. [D2000-0055](#), the panel stated that: "in the absence of any license or permission from the Complainant to use any of its trademarks or to apply for or use any domain name incorporating those trademarks, it is clear that no actual or contemplated bona fide or legitimate use of the domain name could be claimed by Respondent."

Moreover, the Complainant has provided evidence that the disputed domain name is used to disrupt the Complainant's business and reputation. The Respondent has attempted to communicate with the members of the public under the guise of a fraudulent email address whereby the Respondent impersonates the Complainant.

The Panel finds that the purpose of registering the disputed domain name was to engage in an email scam or a phishing scheme, none of which is a *bona fide* offering of goods or services. WIPO Overview of WIPO Panel Views on Selected UDRP Questions ("[WIPO Overview 3.0](#)"), section 2.13.1 ("Panels have categorically held that the use of a domain name for illegal activity (e.g., the sale of counterfeit goods or illegal pharmaceuticals, phishing, distributing malware, unauthorized account access/hacking, impersonation/passing off, or other types of fraud) can never confer rights or legitimate interests on a respondent."); see also, *CMA CGM v. Diana Smith*, WIPO Case No. [D2015-1774](#) (finding that the respondent had no rights or legitimate interests in the disputed domain name holding, "such phishing scam cannot be considered a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use of the Domain Name".) The undisputed evidence of impersonation, deception, and fraud nullifies any possible basis for the acquisition of rights or legitimate interests by the Respondent. See *Afton Chemical Corporation v. Meche Kings*, WIPO Case No. [D2019-1082](#).

The fact that the disputed domain name does not currently resolve to an active website does not obviate the Panel's finding of lack of rights or legitimate interests.

The Panel finds no evidence that the Respondent has used, or undertake any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

Likewise, no evidence has been adduced that the Respondent has been commonly known by the disputed domain name; nor, for the reasons mentioned above, is the Respondent making a legitimate noncommercial or fair use of the disputed domain name.

The Panel concludes, noting that the Respondent lacks any rights or legitimate interests in the disputed domain name, that the second element of the Policy has, therefore, been met.

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

The Panel, based on the evidence presented, accepts, and agrees with the Complainant's contentions that the disputed domain name was registered and is being used in bad faith.

The fact that the disputed domain name is being used to send phishing emails is a strong indication that the Respondent's intentions for the disputed domain name are also in bad faith.

Further, the Complainant submitted evidence that:

- the Respondent uses the Complainant's registered trademark VIRGIN PULSE within the disputed domain name and as a part of an unauthorized email address for fraudulent approaches made to members of the public as part of the recruitment scam;
- the sender of the email is using the name of the Complainant's employee;
- email signature includes the Virgin Pulse logo.

Therefore, the use of a confusingly similar, deceptive domain name for an email scam has previously been found by UDRP panels to be sufficient to establish that a domain name has been registered and is being used in bad faith. See *Samsung Electronics Co., Ltd. v. Albert Daniel Carter*, WIPO Case No. [D2010-1367](#); *Securitas AB, supra*, WIPO Case No. [D2013-0117](#). Moreover, in finding a domain name used only for an email scam was bad faith, the panel in *Kramer Law Firm, P.A. Attorneys and Counselors at Law v. BOA Online, Mark Heuvel*, WIPO Case No. [D2016-0387](#), pointed out that numerous UDRP panels have found such impersonation to constitute bad faith, even if the relevant domain names are used only for email.

See, e.g., *Terex Corporation v. Williams Sid, Partners Associate*, WIPO Case No. [D2014-1742](#) (“Respondent was using the disputed domain name in conjunction with an email address for sending scam invitations of employment with Complainant”).

The bad faith registration and use of the disputed domain name is also affirmed by the fact that the Respondent has not denied, or even responded to, the assertions of bad faith made by the Complainant in this proceeding.

Accordingly, the Panel finds, based on the evidence presented, that the Respondent registered and is using the disputed domain name in bad faith. Therefore, the Complainant has satisfied paragraph 4(a)(iii) 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, <virginpulseonline.com>, be transferred to the Complainant.

*/Eva Fiammenghi/*

**Eva Fiammenghi**

Sole Panelist

Date: July 8, 2022