ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Virgin Enterprises Limited v. Diane Bugg
Case No. D2024-2425

1. The Parties

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

The Respondent is Diane Bugg, United States of America.

2. The Domain Name and Registrar

The Disputed Domain Name <virginmegastore-sa.com> is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 13, 2024. On June 13, 2024, the Center transmitted by email to the Registrar with a request for registrar verification in connection with the Disputed Domain Name. On June 13, 2024, 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 (REDACTED FOR PRIVACY, PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on June 14, 2024, 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 June 17, 2024.

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 June 18, 2024. In accordance with the Rules, paragraph 5, the due date for Response was July 8, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on July 11, 2024.

The Center appointed Edward C. Chiasson KC. as the sole panelist in this matter on July 17, 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

The 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 popular music records by mail order under the Virgin name. Since then, operations have grown significantly. VIRGIN branded businesses span a diverse range of sectors: financial services, health and wellness, music and entertainment, people and planet, telecommunications and media, travel and leisure, and space. There are currently more than 40 VIRGIN branded businesses which have over 50 million customers worldwide and employ more than 60,000 people across five business sectors and five continents.

The Complainant is responsible for registering and maintaining registrations for trademarks containing the VIRGIN name and the VIRGIN signature logo and licensing these rights to the VIRGIN businesses. The Complainant owns a substantial portfolio of approximately 3,500 trademark applications and registrations in over 150 countries covering the majority of the 45 Nice classes of goods and services.

The Complainant owns the following trade mark registrations:

- United Kingdom Registration No. UK00003092381 for the mark VIRGIN in classes 39, 41, and 43, registered on May 1, 2015;
- European Union No. 1141309 for the mark VIRGIN in classes 9, 35, 36, 38, and 41, registered May 21, 2012;
- United States Registration No. 4325986 for the mark VIRGIN in classes 35, and 36, registered on April 23, 2013;
- United Kingdom Registration No. UK00003163127 for the mark  (the "**Virgin Signature Logo**") in classes 3, 5, 9, 11, 12, 14, 16, 31, 32, 33, 35, 36, 38, 39, 41, 42, 43, 44, and 45, registered on July 29, 2016;
- United Kingdom Registration No. UK00915404841 for the mark  (also the "**Virgin Signature Logo**") in classes 3, 5, 9, 11, 12, 14, 16, 31, 32, 33, 35, 36, 38, 39, 41, 42, 43, 44, and 45, registered on December 2, 2016;
- Saudi Arabia Registration No. 767/33 for the mark VIRGIN MEGASTORE in class 35 registered on January 7, 2005.
- Kuwait Registration No. KW1624781 for the mark  (the "**Virgin Megastore Logo**") in class 41 filed on January 5, 2021, and registered on March 30, 2021.
- Kuwait Registration No. KW1626086 for the mark  (also the "**Virgin Megastore Logo**") in class 35 filed on January 5, 2021, and registered on May 6, 2021.

The Complainant has a considerable online presence and is the registered proprietor of over 5000 domain names consisting of or incorporating the VIRGIN mark. The Complainant has operated a website at "www.virgin.com" since 2000 to promote the activities of the VIRGIN Group and its businesses, ventures and foundations. The "www.virgin.com" website contains links to the specific web pages for most of the companies in the VIRGIN Group.

The VIRGIN businesses operate pages on various social media platforms where the VIRGIN marks also feature prominently. Collectively these social media platforms receive over 37 million views each year. As is the case throughout all the VIRGIN businesses and ventures, the Complainant's Registered Marks are placed prominently on these materials.

Virgin Megastore was originally founded in 1976 by Sir Richard Branson as a record store on Oxford Street, London. The first Virgin Megastore was opened in 1979 at the end of Oxford Street and Tottenham Court Road. This store was sold and subsequently rebranded in 2007.

In 1989, the first Virgin Megastore in Australia opened in Sydney's Darling Harbour. A second Virgin Megastore in Australia opened the following year. In 1990, the first Virgin Megastore was opened in Japan alongside the third and fourth stores in Australia.

Throughout the 1980s and 1990s over 100 Virgin Megastore stores were opened in the United Kingdom, and around the world, including further expansion into Asia and North America. Following this, an emphasis and focus was placed on expanding into the Middle East. Since the first United Arab Emirates ("UAE") based Virgin Megastore opened in 2001, the brand has expanded to over 40 stores in the region with dedicated websites for Saudi Arabia, Kuwait, Qatar and UAE, which can be accessed via "www.virginmegastore.com/en/country-selector".

Today, the Virgin Megastore business retails a wide range of entertainment related items such as electronics, tech and gaming products, music and books, sports and lifestyle products, clothing, and toys in both physical Virgin Megastore branded stores and online. The services provided by the Virgin Megastore business are discussed frequently in third-party media.

The Complainant's Registered Marks, VIRGIN and VIRGIN MEGASTORE are used throughout the social media marketing of the business and consistently throughout the Virgin Megastore Websites.

The Respondent did not respond to this Complaint. There is no information concerning it other than some contact information.

The Disputed Domain Name, <virginmegastore-sa.com> was registered on May 2, 2024. The Disputed Domain Name has been used to send emails to potential suppliers purporting to be from Virgin Megastore requesting a quote for undisclosed goods and services.

The third-party company reported this correspondence to the Complainant suspecting it was fraudulent.

The Complainant states the email communication received by the Procurement Manager of Virgin Megastore was not authorized to do any of this and has no connection with the Complainant.

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.

The Complainant asserts that the Disputed Domain Name is confusingly similar to its trademarks because the Disputed Domain Name is comprised of the terms "virgin" and "virgin megastore". It incorporates the Complainant's Registered Marks VIRGIN and VIRGIN MEGASTORE in their entirety. The incorporation of a trademark in its entirety in a domain name, in this case the Complainant's Registered Marks VIRGIN and VIRGIN MEGASTORE, is often sufficient to establish that a domain name is identical or confusingly similar to a complainant's trade mark (see *Britannia Building Society v. Britannia Fraud Prevention*, WIPO Case No. D2001-0505).

The inclusion of "-sa" in the Disputed Domain Name is a clear reference to the standard country abbreviation for Saudi Arabia. It is established in WIPO Panel Decisions that the addition of geographical terms to a third-party trademark does not avoid a domain name being found confusingly similar (see *Allianz SE v. IP Legal, Allianz Bank Limited*, WIPO Case No. D2017-0287 and *Playboy Enterprises International, Inc. v. Zeynel Demirtas*, WIPO Case No. D2007-0768).

Given that the Virgin Megastore business is active in Saudi Arabia and the Complainant's Registered Marks have a reputation there, the addition of "-sa" in the Disputed Domain Name will exacerbate the likelihood of confusion. Internet users will understand the Disputed Domain Name to be the online location for the Virgin Megastore business in Saudi Arabia (see *Six Continents Hotels, Inc. v. CredoNIC.com v. Domain For Sale*, WIPO Case No. D2005-0755).

The Complainant contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. It refers to the material in Annex 11 to the Complaint, noting that the conduct of the alleged or misrepresented Procurement Manager of Virgin Megastore was not authorized by the Complainant.

The Complainant asserts that the Respondent is not using the Disputed Domain Name in connection with a bona fide offering of goods and services. There is no indication that the Respondent has ever used or plans to use the Disputed Domain Name in connection with a bona fide offering of goods or services.

The Complainant submits that the Disputed Domain Name was registered and is being used in bad faith.

The Complainant emphasizes the conduct noted above, evidenced by the material in Annex 11 to the Complaint, establishes bad faith use. This combined with the notoriety and long us of the Complainant's trademarks shows that the registration of the Disputed Domain Name was in bad faith,

B. Respondent

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

6. Discussion and Findings

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 ("-sa" in this case) may bear on assessment of the second and third elements, the Panel finds the addition of such term[s] 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 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.

Panels have held that the use of a domain name for illegal activity such as 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.

In the present case, the Panel notes that the Complainant's trademark VIRGIN and VIRGIN MEGASTORE were well know and that the Respondent used the Disputed Domain Name improperly to represent the Complainant. That is, its use of the Disputed Domain Name reinforces the bad faith registration of the Disputed Domain Name in this case.

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, 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 <virginmegastore-sa.com> be transferred to the Complainant.

/Edward C. Chiasson K.C./
Edward C. Chiasson K.C.
Sole Panelist
Date: July 30, 2024