

ADMINISTRATIVE PANEL DECISION

Virgin Enterprises Limited v. James M. Ellis
Case No. D2023-3013

1. The Parties

The Complainant is Virgin Enterprises Limited, United Kingdom (“UK”).

The Respondent is James M. Ellis, Norway.

2. The Domain Names and Registrars

The disputed domain names <virginstore.online> and <virginstore.space> are registered with PDR Ltd. d/b/a <PublicDomainRegistry.com> (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on July 13, 2023. On July 13, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On July 15, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (GDPR Masked) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 18, 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 July 20, 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 July 21, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 10, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 17, 2023. On August 18, 2023, the Center noted an error in the mailing of the Written Notice and provided the Respondent an extension until August 23, 2023, to respond to the Complaint. On August 24, 2023, the Center notified the Parties of the Respondent’s default.

The Center appointed Angela Fox as the sole panelist in this matter on August 30, 2023. 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, whose businesses span a diverse range of sectors including music, entertainment, travel, telecommunications, financial services, health, and wellness. The business was founded by well-known entrepreneur, Sir Richard Branson, and now has over 50 million customers worldwide, employing more than 60,000 people across five business sectors and five continents.

The Complainants carry out their business under the trademark VIRGIN and trademarks incorporating VIRGIN. The Complainant owns a substantial portfolio of approximately 3,500 trademark applications and registrations in over 150 countries, including the following:

- United Arab Emirates (“UAE”) Trademark Registration No. 094646 for the mark VIRGIN MEGASTORE in Class 35 registered on April 28, 2009;
- UAE Trademark Registration No. 340089 for VIRGIN MEGASTORE Logo in class 35 registered on March 29, 2021;
- European Union Trade Mark (“EUTM”) Registration No. 003421948 for VIRGIN MEGASTORE in Classes 35 and 43 registered on May 6, 2005;
- EUTM Registration No. 001798560 for VIRGIN in Classes 9 and 39 registered on June 5, 2002;
- UK Trademark Registration No. 3163127 for 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; and,
- UK Trademark Registration No. 915404841 for the mark 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.

The Complainant also has a considerable online presence under its VIRGIN trademarks and owns over 5,000 domain names consisting of or incorporating the VIRGIN mark. The Complainant has operated the website at “www.virgin.com” since 2000 to promote the activities of the VIRGIN Group.

The Complainant has a long history of operating physical stores under the VIRGIN mark, including in particular its VIRGIN MEGASTORE outlets, specializing primarily in the sale of musical recordings. The Complainant’s first VIRGIN MEGASTORE outlet opened on Oxford Street in 1979. By 1990, the Complainant had expanded to opening London VIRGIN MEGASTORE outlets. VIRGIN MEGASTORE outlets were opened in Australia, Europe, the United States, and Japan. Throughout the 1980s and 1990s, the Complainant opened over 100 VIRGIN MEGASTORE outlets in the UK and around the world, including further expansion into Asia and North America. The first UAE-based VIRGIN MEGASTORE outlet opened in 2001, and the brand has since expanded to over 40 stores in the region as well as dedicated websites for Saudi Arabia, Kuwait, Qatar and the UAE, which can be accessed via the website “www.virginmegastore.com”. Although the VIRGIN MEGASTORE outlets started out as record stores, they today retail a wide range of entertainment-related items such as electronics, tech and gaming products, music and books, sports and lifestyle products, clothing and toys, which are sold in physical outlets and online.

The disputed domain names were both registered on June 2, 2023. They do not currently link to any sites, but annexed to the Complaint were screenshots showing that they have both been used in the past to advertise the offer of electronic gaming apparatus using the Complainant’s Virgin Signature Logo trademark and including a copyright notice reading “© 2023 Virgin Megastore. All Rights Reserved”.

5. Parties' Contentions

A. Complainant

The Complainant submits that the disputed domain names are identical or confusingly similar to its VIRGIN trademarks. The disputed domain names both incorporate VIRGIN in its entirety and the non-distinctive word "store", and the gTLDs "online" and "space" reinforce the confusing similarity arising from the presence of the word "virgin".

The Complainant also submits that the Respondent has no rights or legitimate interests in the disputed domain names. The Respondent has not been authorized to use the Complainant's trademarks or to register the disputed domain names. There is no evidence that the Respondent has used, is using or has made demonstrable preparations to use the disputed domain names in connection with a legitimate business, nor that the Respondent has been commonly known by the disputed domain names. The Complainant submits that it is obvious from the Respondent's use of the disputed domain names to impersonate the Complainant that the Respondent has not been making a legitimate noncommercial or fair use of the disputed domain names, without intent for commercial gain, to misleadingly divert consumers or to tarnish the Complainant's registered marks.

Finally, the Complainant submits that the disputed domain names were registered and have been used in bad faith. The Complainant asserts that the Respondent has used the disputed domain names to impersonate the Complainant, in order to acquire personal details from internet users, with a view to defrauding consumers. The Complainant asserts that the disputed domain names were registered for the purposes of intentionally attracting, for illegitimate commercial gain, internet users to the Respondent's websites by creating a likelihood of confusion with the Complainant's registered marks as to the source, sponsorship, affiliation, or endorsement of the Respondent's websites.

B. Respondent

The Respondent did not reply to the Complainant's contentions and is in default. No exceptional circumstances explaining the default have been put forward. Therefore, in accordance with paragraphs 14 (a) and (b) of the Rules, the Panel will decide the Complaint and shall draw such inferences as it considers appropriate from the Respondent's default.

6. Discussion and Findings

Under paragraph 4(a) of the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the panel finds that:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights;
- (ii) the respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

All three elements must be present before a complainant can succeed in an administrative proceeding under the Policy.

A. Identical or Confusingly Similar

The Complainant has proved that it has registered trademark rights in VIRGIN which pre-date the registration of the disputed domain names.

The disputed domain names include VIRGIN in its entirety, followed only by the word “store”, and the Top-Level Domain name suffixes “.online” and “space”. As noted in the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“WIPO Overview 3.0”), at section 1.11.1, the Top-Level Domain suffix is a standard registration requirement and as such is typically disregarded under the first element confusing similarity test.

Under section 1.7 of the WIPO Overview 3.0, “in cases where a domain name incorporates the entirety of a trademark, or where at least a dominant feature of the relevant mark is recognizable in the domain name, the domain name will normally be considered confusingly similar to that mark for purposes of UDRP standing.”

In this case, the disputed domain names incorporate the entirety of the Complainant’s registered VIRGIN trademark, which is clearly recognizable within each of the disputed domain names regardless of the addition of the added word “store”. The Panel finds that the disputed domain names are confusingly similar to a trademark in which the Complainant has rights.

B. Rights or Legitimate Interests

The burden of proving absence of rights or legitimate interests in a domain name falls on complainants, but panels have long recognized that the information needed to prove such rights or legitimate interests is normally in the possession of respondents.

In order to avoid requiring complainants to prove a negative, which will often be impossible, UDRP panels have typically accepted that once a complainant has established a *prima facie* case that a respondent lacks rights or legitimate interests, the respondent carries the burden of proving that it does indeed have such rights or legitimate interests (see, *inter alia*, *Belupo d.d. v. WACHEM d.o.o.*, WIPO Case No. D2004-0110). In the present case, the Complainant has put forward a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. There is nothing on the record in this case to indicate that the Respondent might have any rights or legitimate interests in them, nor has the Respondent attempted to make out a case that it has. The Complainant has not authorized the Respondent to use the disputed domain names, nor is there any evidence that the Respondent has ever been commonly known by them. The Respondent is not currently making any commercial or noncommercial use of the disputed domain names.

The Complainant has provided evidence that the disputed domain names have been used to link to a website impersonating the Complainant and purporting to offer for sale a range of electronic goods, including electronic gaming apparatus. The Complainant submits that this use was not only unauthorized, but also fraudulent, in that it was made in order to acquire personal details from Internet users with a view to defrauding consumers. The Respondent has made no effort to respond to this allegation.

WIPO Overview 3.0, section 2.13.1 states, “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.”

Taking all of the above into account, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain names.

C. Registered and Used in Bad Faith

The Complainant has been carrying on business internationally under the VIRGIN mark for over 40 years and has built up a substantial international reputation and profile in this mark.

The past use of the disputed domain names to impersonate the Complainant and to use its Virgin Signature Logo, as well as to refer to “© 2023 Virgin Megastore” all indicate that the Respondent was aware of the Complainant and its VIRGIN marks and that this awareness is what prompted his registration and use of the disputed domain names.

Under paragraph 4(b)(iv) of the Policy, the Panel may find both registration and use in bad faith where there is evidence that by using the domain name, a respondent has intentionally attempted to attract, for commercial gain, Internet users to its website or other online location, by creating a likelihood of confusion with a complainant's mark as to the source, sponsorship, affiliation, or endorsement of the respondent's website or location or of a product or service on it.

In addition, WIPO Overview 3.0, section 3.4, states that "Panels have held that the use of a domain name for purposes other than to host a website may constitute bad faith. Such purposes include sending email, phishing, identity theft, or malware distribution."

In this case, the Complainant has shown that it does business in physical and online stores under its well-known VIRGIN trademark, and the disputed domain names are inherently liable to mislead Internet users into believing that they denote a website of the Complainant, at which the Complainant's VIRGIN-branded goods or services can be found and purchased. The Complainant has claimed, and the Respondent has not sought to deny, that the disputed domain names were in use with the intention of obtaining personal details from potential customers, with a view to defrauding them.

Taking all of the above into account, the Panel finds that the disputed domain names were registered and have been used in bad faith.

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 names, <virginstore.online> and <virginstore.space>, be transferred to the Complainant.

/Angela Fox/

Angela Fox

Sole Panelist

Date: September 26, 2023