

ADMINISTRATIVE PANEL DECISION

Virgin Enterprises Limited, O2 Worldwide Limited, VMED O2 UK Limited v.
Privacy Protection / Muhammad Abubakar /or Domain & Hosting Provider
Case No. D2022-2042

1. The Parties

The Complainants are Virgin Enterprises Limited, represented by A.A.Thornton & Co, United Kingdom, O2 Worldwide Limited, represented by Claire Breheny, Stobbs, United Kingdom, VMED O2 UK Limited, represented by Alex Damon, United Kingdom.

The Respondent is Privacy Protection, United States of America / Muhammad Abubakar /or Domain & Hosting Provider, Pakistan.

2. The Domain Name and Registrar

The disputed domain name <02-virgin.com> is registered with Sav.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on June 6, 2022. On June 7, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On the same day, 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 12, 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 amendments to the Complaint on June 17, 2022.

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 sent notification of the Respondent of the Complaint, and the proceedings commenced on June 21, 2022. In accordance with the Rules, paragraph 5, the due date for Response was July 11, 2022. The Center received email communications from the Respondent on July 13, 16, and 28, 2022.

The Center appointed Petra Pecar 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 Complainants in this administrative proceeding are Virgin Enterprises Limited (the First Complainant), O2 Worldwide Limited (the Second Complainant) and VMED O2 UK Limited (the Third Complainant), all companies incorporated under the laws of England and Wales.

The First Complainant is part of the Virgin Group and is the entity responsible for registering and maintaining registrations for trademarks containing VIRGIN name and VIRGIN signature logo and licensing these rights to Virgin businesses, which also includes licensing of the VIRGIN trademarks to the Virgin Media Group.

The Second Complainant is the group IP holding company for the O2 brand and trademark for the Telefonica group¹, which includes the Second Complainant among other companies ("Telefonica Group of Companies").

On May 7, 2020, it was first announced that the owner of the VIRGIN MEDIA UK business, Liberty Global, and Telefonica S.A., the owner of the O2 business in the United Kingdom ("UK"), had agreed a proposed joint venture, which would operate under the mark VIRGIN MEDIA O2 ("Joint Venture"). On May 20, 2021 the UK Competitions & Markets Authority (CMA) announced its final approval of Joint Venture which was launched on June 1, 2021.

The Joint Venture operates website at the domain name <virginmediao2.co.uk> and the First Complainant and the Second Complainant have agreed that any domain names associated with the Joint Venture should be owned by the Third Complainant.

The Complaint includes evidence of numerous trademark registrations made by the Complainants. The First Complainant's owns a substantial portfolio of approximately 3,500 trademark applications and registrations in over 150 countries, which include the following:

- United Kingdom Trademark registration No. UK00003163121 for VIRGIN registered on July 29, 2016;
- European Union Trademark registration No. 015255235 for VIRGIN registered on March 21, 2016;
- Australia, Bahrain, Egypt, EU, Morocco, Oman, Russian Federation, Ukraine and United States Designations of International Trademark registration No. 1141309 for VIRGIN registered on May 21, 2012;

The Second Complainant is the owner of numerous trademark registrations worldwide, which include the following:

- United Kingdom Trademark registration No. UK00002264516 for O2, registered on June 7, 2002;
- United Kingdom Trademark registration No. UK00002415862 for O2 registered on October 31, 2008;
- United Kingdom Trademark registration No. UK00003305021 for O2 and registered on July 13, 2018;
- United States Trademark registration No. 5329883 for O2 registered on November 7, 2017;
- European Union Trademark registration No. 002109627 for O2 registered on May 13, 2004;
- European Union Trademark registration No. 002284818 for O2 registered on June 16, 2004;

- European Union Trademark registration No. 009279456 for O2 registered on December 20, 2013;
- European Union Trademark registration No. 015301005 for O2 registered on October 5, 2016;
- European Union Trademark registration No. 015145188 for O2 registered on October 28, 2016;

The disputed domain name was registered on December 7, 2021, and resolves to a website that purports to offer customer service assistance with mobile phone services.

5. Parties' Contentions

A. Complainant

The Complainants contend that the disputed domain name is confusingly similar to the trademarks in which they have rights. First of all, the disputed domain name consists of the term VIRGIN. The disputed domain name comprises of the numbers zero and two, presented as "02", followed by term VIRGIN separated by a hyphen. Further, the initial component of the disputed domain name is identical to the entirety of the Second Complainant's O2 trademark, and also almost identical to its O2 registered trademarks. Visually the number "0" is nearly identical to the letter "O", the first element of the Second Complainant O2 registered marks, followed by the number "2", which is identical to the second element of the Second Complainant's O2 registered trademarks. Given their near identical shapes, the number "0" is commonly used in place of the letter "o" in formats where only a number can be used, and therefore a zero used as part of a domain name would very easily be perceived as the letter "O" by Internet users.

The Complainants also state that the disputed domain name is highly similar to the name of the Joint Venture, since it incorporates both of the distinctive verbal elements of Virgin Media O2 sign and Virgin Media O2 Logo. The Complainants further highlight that the fact that the "VIRGIN" and "O2" elements are presented in the disputed domain name in reverse order to the order of the presentation of the elements "O2" and "VIRGIN" in the Virgin Media O2 Mark and the Virgin Media O2 Logo does not reduce the confusing similarity of the disputed domain name to the Virgin Media O2 mark and Virgin Media O2 Logo.

Further, the Complainants contend that the Joint Venture had merged two of the most well-known telecommunication providers in the United Kingdom and that the Internet users will assume that the disputed domain name refers to online location related to the Joint Venture.

The Complainants state that the use of the confusingly similar sign "02-virgin" in relation to a website to purportedly offer assistance with and sell mobile phone services is a clear indication that the Respondent lacks any legitimate interest or rights in respect of the disputed domain name, given the extent of reputation and goodwill in the First Complainant's VIRGIN trademarks and the Second Complainant's O2 marks, and the extent of goodwill in the Virgin Media O2 mark and the Virgin Media O2 logo.

The Complainants also state that the website provides a contact phone number at the top of the homepage, which does not connect when called. This phone number, according to the Complainants allegations, has however been reported on the scam reporting website "www.whocalled.co.uk" as being used to make phishing calls to members of the public, and so has clearly been used to attempt to carry out fraud in the UK. This fraudulent activity is not a legitimate or fair use of a domain name and is evidence that the Respondent has registered the disputed domain name in order to target members of the public, and in particular customers of the Complainants' businesses, for the purposes of scamming.

It is also stated in the complaint that the confusion caused by the use of the disputed domain name on the part of Internet users could divert actual or prospective customers of the Complainants away from the Complainants' genuine businesses, as those customers may gain the impression that the Complainants do not provide adequate and helpful website information with accurate contact details. This confusion is liable to tarnish the significant reputation and goodwill that exists in the First Complainant's VIRGIN trademarks

and the Second Complainant's O2 trademarks, and damage the goodwill in the Virgin Media O2 mark and the Virgin Media O2 logo.

Furthermore, the Complainants state that the Respondent does not make a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish registered trademarks of the first and the Second Complainant and the Virgin Media O2 mark or Virgin Media O2 logo.

The Complainants state that there is no indication that the Respondent had ever been commonly known by the disputed domain name and that the Respondent does not have any legitimate interest or right in the disputed domain name.

The Complainants further contend that the disputed domain name was registered and is being used in the bad faith. It is highlighted that the use of the disputed domain name to purport to offer customer service assistance and sales of mobile phone products and packages under the sign "O2-virgin" via the website, is not good faith use of the disputed domain name. The Complainants also state that the phone number which is displayed at the website had been used to carry out phishing scams on members of public, which is a blatant fraudulent activity. Eventually, the Complainants claim that the Respondent must have been aware of the Complainants and that the Respondent is using the disputed domain name to intentionally attempt to attract, for commercial gain, Internet users to the website, by creating a likelihood of confusion with the First Complainant's VIRGIN trademarks, the Second Complainant's O2 and O2 trademarks, the Virgin Media O2 mark and the Virgin Media O2 logo.

B. Respondent

The Respondent did not reply to the Complainant's contentions. The Respondent did however send several unofficial communications to the Center and the Complainants expressing his willingness to sell the disputed domain name.

6. Discussion and Findings

6.1. Procedural Issues

Consolidation of Multiple Complainants

Pursuant to WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 4.11.1, the consolidation of multiple complainants filing a joint complaint against one or more respondents is subject to the discretion of the appointed panel.

In assessing whether a complaint filed by multiple complainants may be brought against one or more respondents, the appointed panel should consider whether (i) the complainants have a specific common grievance against the respondent, or the respondent has engaged in common conduct that has affected the complainants in a similar fashion, and (ii) it would be equitable and procedurally efficient to permit the consolidation.

The Panel finds that the disputed domain name targets two trademarks, VIRGIN and O2 (as well as its O2 variation). The First Complainant is part of the Virgin Group and is the entity responsible for registering and maintaining registrations for trademarks containing the VIRGIN name and VIRGIN signature logo and licensing these rights to the Virgin businesses.

The Second Complainant is the Group IP holding company for the O2 trademark for the Telefonica group whose ultimate parent company is Telefonica S.A. (the Telefónica Group of Companies). Liberty Global, which owns the VIRGIN MEDIA UK business, and Telefonica UK, which operates the O2 business in the UK and uses the O2 mark under license from the Second Complainant, have entered into a

Joint Venture known as VIRGIN MEDIA O2.

The First and the Second Complainants have agreed that any domain names associated with the Joint Venture should be owned by the Third Complainant, a company connected to the First and the Second Complainants and the Joint Venture. The registration and use of the disputed domain name affects all the Complainants, and they therefore have a common grievance against the Respondent.

For the mentioned reasons the Panel considers that the consolidation in this case is acceptable, especially because of the agreement between the First Complainant and the Second Complainant about the owner of the disputed domain name in case of success in the procedure.

Therefore, the Panel considers that it is fair and equitable and procedurally efficient under the circumstances of the case to permit the consolidation, as the Complainants have a specific common grievance against the Respondent, since their trademark and domain name rights are affected by the disputed domain name.

Consequently, the Panel allows the Complainants to proceed jointly with their complaint.

6.2. Findings

Even if the Respondent did not file a Response to the Complainants' contentions, the Panel shall consider the issues present in the case based on the statements and documents submitted by the Complainants. "A Panel shall decide a complaint on the basis of the statements and documents submitted and in accordance with the Policy, these Rules and any rules and principles of law that it deems applicable", as indicated in paragraph 15(a) of the Rules.

Under paragraph 4(a) of the Policy, the complainant is required to prove each of the following three elements:

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

6.3. Substantive Issues

A. Identical or Confusingly Similar

Pursuant to paragraph 4(a)(i) of the Policy, the Complainant must, firstly, establish rights in a trademark or service mark and, secondly, establish that the disputed domain name is identical or confusingly similar to a trademark in which the Complainant has rights.

A trademark registration provides a clear indication that the rights in the trademark belong to the Complainant (see section 1.2.1 of the [WIPO Overview 3.0](#)). The First Complainant is the owner of VIRGIN word and logo trademarks and the Second Complainant is the owner of O2 (and 02) trademarks and the Panel finds that the Complainants have provided sufficient evidence of rights in those trademarks.

The disputed domain name comprises the Second Complainant's O2 trademark in its entirety, followed by entire the First Complainant's VIRGIN trademark, being separated by a hyphen, and with addition of generic Top-Level Domain ("gTLD") ".com". The disputed domain name consists of number "0" instead of capital letter "o" which is almost identical to the Second Complainant's registered O2 trademarks. Given near shapes of number "0" and capital letter "o" and fact that number "0" is commonly used in place of capital letter "o" in formats where only a number can be used, and therefore a zero is used as part of a domain name can be easily perceived as capital letter "o" by Internet users. Furthermore, the Second Complainant

has registered marks 02 which demonstrates that the Complainant is well-aware of possible typo given the visual similarity of capital letter “o” and number “0”.

The disputed domain name incorporates as its second component the First Complainant’s VIRGIN trademark as the most distinctive verbal element. The hyphen emphasizes the inclusion of the disputed domain name of components identical or almost identical to the Complainants’ trademarks.

The O2 (in typo version 02) and VIRGIN trademarks are incorporated in their entirety within the disputed domain name. They are clearly recognizable within the disputed domain name. The substitution of the capital letter “o” with the number “0” does not prevent a finding confusing similarity, especially since besides the O2 trademark the Second Complainant has also registered the 02 trademark. Also, when a domain name consists of a common, obvious or intentional misspelling of a trademark, it is considered by UDRP panels to be confusingly similar to relevant mark for purposes of the first UDRP element. The substitution of similar-appearing characters such as numbers that use to look like letters, which is the case with number “0” and the capital letter “o”, is typical example of typosquatting, in accordance with section 1.9 of [WIPO Overview 3.0](#).

Finally, it is well accepted practice by UDRP panels that a gTLD, such as “.com”, is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark (see section 1.11.1 of the [WIPO Overview 3.0](#)). Accordingly, the Panel shall not take the applicable gTLD “.com” into account for the purpose of assessment of confusing similarity.

The Panel finds that the disputed domain name is confusingly similar to the 02, 02 and VIRGIN trademarks in which the Complainants have rights and that the Complainants have satisfied the requirements of the paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Under the second element of the Policy, a complainant is required to make out a *prima facie* case that the respondent lacks rights or legitimate interests in the disputed domain name. Once such *prima facie* case is made, the burden of production shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to do so, the complainant is generally deemed to have satisfied the second element, as set out in paragraph 4(a)(ii) of the Policy (see also section 2.1 of the [WIPO Overview 3.0](#)).

Moreover, the Policy provides guidance to respondents on how to demonstrate rights or legitimate interests in a domain name. In particular, paragraph 4(c) of the Policy gives examples that might show rights or legitimate interests in a domain name, including: (i) use of the domain name “in connection with a *bona fide* offering of goods or services”; or (ii) demonstration that the Respondent has been “commonly known by the domain name”; or (iii) “legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue”.

The Panel finds that there is no evidence in the records suggesting that the Respondent has rights to or legitimate interests in the disputed domain name.

Moreover, based on the evidence provided by the Complainants, the Panel finds that the Complainants do not have any business relationship with the Respondent, nor is the Respondent making a legitimate noncommercial or fair use of the disputed domain name. Also, there is no indication that the Respondent is commonly known by the disputed domain name or by any name similar to it or has made any demonstrable preparations to use the disputed domain name in connection with a *bona fide* offering of goods or services.

Further, the Panel notes that the disputed domain name revolves to a website that offer consumer service assistance and services related to mobile phones. The text of the website however contains numerous spelling mistakes and unusual wording such as “Billing Upgration” and “Track you usage, check you bills, upgrad” and more which put some doubt in genuine nature of such website (especially since it is primarily

designed for the UK consumers which are fluent in English). Such circumstances may be an indication that the Respondent is not using and does not have any plans to use the disputed domain name in connection with *bona fide* offering of goods and services. In addition, the website to which disputed domain name resolves contains telephone number which is in accordance with the evidence provided by the Complainant associated with the phishing scheme. As indicated in the section 2.13.1 of the [WIPO Overview 3.0](#), 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.

The Panel holds that the composition of the disputed domain name, comprising the entirety of the “02” and “VIRGIN” trademarks, cannot constitute fair use as if it effectively suggests sponsorship or endorsement by the Complainants (see section 2.5.1 of the [WIPO Overview 3.0](#)).

Finally, the Respondent has sent several emails to the Center and the Complainants (which do not constitute a formal response to the complaint) by which has offered to the Complainants to buy the disputed domain name – without indication of the price. Such behavior on the Respondent’s side additionally stresses the lack of legitimate interest, as it seems rather unusual that the Respondent would be willing to immediately sell the disputed domain name on which it operates a legitimate website for its business. In case that there was genuine legitimate interest on the Respondent’s side, it would be more logical that the Respondent would choose to fight for the disputed domain name by way of arguments through submission of the formal response, instead of immediate offer for sale of the disputed domain name.

Thus, the Panel concludes that nothing on the record it would support a finding that the Respondent is making a legitimate noncommercial or fair use of the disputed domain name.

The Panel therefore finds that the Complainants have made a *prima facie* demonstration of the Respondent’s lack of rights or legitimate interests in respect of the disputed domain name, which has not been rebutted by the Respondent, and that the Complainants have accordingly established the second element of the Policy in accordance with paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The third element of paragraph 4(a) of the Policy requires the Complainants to demonstrate that the Respondent registered and is using the disputed domain name in bad faith. The Policy describes several non-exhaustive circumstances demonstrating a Respondent’s bad faith registration and use. Under paragraph 4(b)(iv) of the Policy, a panel may find bad faith when, by using the domain name, the 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 the Complainants’ trademark as to the source, sponsorship, affiliation, or endorsement of the website or location or of a product or service on the website or location.

Based on the information and the evidence provided by the Complainants, the Panel finds that at the time of registration of the disputed domain name, the Respondent was or should have been aware of the existence of O2, 02 and VIRGIN registered trademarks since the trademarks were registered at least 14 years before the disputed domain name registration.

The prior panel in WIPO Case No. [D2021-2610](#) *Virgin Enterprises Limited, O2 Worldwide Limited, and VMED O2 UK Limited v. Bak J-seon* found that VIRGIN MEDIA and O2 marks are widely-known marks so that the Respondent was or should have been aware of the familiarity of the trademarks included in the disputed domain name. Furthermore, the activities of the Complainants and the combination of trademarks included in the disputed domain name create an association with the Joint Venture which additionally indicates registration of the disputed domain name in bad faith. In that sense and given the prior use and the fame of these marks, in the opinion of the Panel, the Respondent should have been aware of the First Complainant’s and the Second Complainant trademarks when registering the disputed domain name. Also,

a quick Internet search would have revealed the existence of these prior marks.

The Complaints have provided evidence that the Respondent attempted to attract, for commercial gain, Internet users to the Respondent's website by creating a likelihood of confusion with the Complainants' marks as the website is highly likely to confuse Internet users into believing that the disputed domain name is operated by or connected with the Complainants' business.

The Panel finds that the Respondent registered the disputed domain name to attract the Complainants' customers to its website by using a domain name that is confusingly similar to the Complainants' marks. The use of a domain name to intentionally attempt to attract Internet users to a Respondent's website by creating a likelihood of confusion with a Complainants' mark as to the source, sponsorship, affiliation or endorsement of the Respondent's website for commercial gain demonstrates registration and use in bad faith. Moreover, the Panel finds that the Complainants provided enough evidence that the registration of the disputed domain name is aimed to disrupt the Complainants' business by diverting Internet users who are searching for the Complainants' services from its genuine website as well as to prevent the Complainants from registering the disputed domain name.

Further, the website provides a contact phone number at top of the homepage, which due to the Complainants does not connect when called. According to the Complainants' allegations, the phone number has been reported on the scam reporting website "www.whocalled.co.uk" as being used to make phishing calls to members of the public. The Panel is of the opinion that the disputed domain name could divert actual or perspective consumers of the Complainants genuine business, and those consumers may gain the impression that the Complainants do not provide adequate and helpful website information with accurate contact details.

It should be also be added that the Respondent sent several emails after receiving the complaint offering to sell the disputed domain name which is an indication that they registered it with the aim of cashing in on the Complainants' reputation. In this sense, the Panel finds that the Respondent's intent was merely to capitalize on the Complainants' rights and this supports the Panel's assessment of bad faith (see section 3.10 of WIPO Overview).

The disputed domain was registered by Privacy Protection. The hidden identity of the Registrant can also be an indication of bad faith in certain circumstances. In accordance with section 3.6 of WIPO Overview where it appears that a respondent employs a privacy or proxy service merely to avoid being notified of a UDRP proceeding filed against it, panels tend to find that this supports an inference of bad faith. A respondent filing a response may refute such inference, however since the Respondent has not filed any substantive response, the Panel finds use of privacy shield as the indication of bad faith.

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

D. The disputed domain name transfer

The Complainants' request is to transfer the disputed domain name to the Third Complainant. The Complainants have informed the Panel on mutual agreement that all domain names reflecting the proposed joint venture operating under the mark VIRGIN MEDIA O2 should be registered in the name of the Third Complainant.

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 <02-virgin.com> be transferred to the Third Complainant.

/Petra Pecar/

Petra Pecar

Sole Panelist

Date: August 12, 2022