

## **ADMINISTRATIVE PANEL DECISION**

### **Virgin Enterprises Limited v. Virgin Burg Case No. D2023-2707**

#### **1. The Parties**

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

The Respondent is Virgin Burg, United States of America (“United States”).

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

The disputed domain name <virgincourier.com> is registered with Hostinger, UAB (the “Registrar”).

#### **3. Procedural History**

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on June 23, 2023. On June 26, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On June 27, 2023, 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 (Privacy Protect, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 6, 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 amended Complaint on July 11, 2023.

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 July 14, 2023. In accordance with the Rules, paragraph 5, the due date for Response was August 3, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on August 7, 2023.

The Center appointed Philippe Gilliéron as the sole panelist in this matter on August 21, 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. In 1984, the Complainant launched its first passenger and cargo airlines under the brand VIRGIN ATLANTIC. Its cargo service connects more than 350 destinations worldwide and saw a growth of 40% in revenue to GBP 448 million in 2021, with 207 million tons of cargo transported in that same year.

The Complainant is in charge of managing the Virgin Group's trademark portfolio. The Complainant owns numerous trademarks on a worldwide basis consisting in whole or in part of the term VIRGIN, such as:

- European Union Trademark Registration No. 1798560 VIRGIN filed on August 8, 2000, and registered on June 5, 2002, in respect of *inter alia* 'arranging transportation of goods or persons by road, rail, air and sea; freight services; ground transport services' in class 39;
- United Kingdom Trademark Registration No. UK00003163121 VIRGIN filed on May 5, 2016, and registered on July 29, 2016, in respect of *inter alia* 'transport; packaging and storage of goods; airline services' in class 39;
- United Kingdom Trademark Registration No. UK00003107248 VIRGIN ATLANTIC filed on May 5, 2015, and registered on November 27, 2015, in respect of *inter alia* 'transport; packaging and storage of goods; airline services' in class 39;
- European Union Trademark Registration No. 014030589 VIRGIN ATLANTIC filed on May 5, 2015, and registered on October 12, 2015, in respect of *inter alia* 'transport; packaging and storage of goods; airline and shipping services; arrangement of transport' in class 39;
- United Kingdom Trademark Registration No. UK00003163127 filed on May 5, 2016 in respect of *inter alia* 'transport; packaging and storage of goods; travel arrangement; arranging and organisation of flights; airline services' in class 39;
- International Trademark Registration No. 1290574 VIRGIN filed on February 3, 2015 in respect of *inter alia* 'transport; packaging and storage of goods' in class 39.

The Complainant further owns over 5,000 domain names consisting of or incorporating the VIRGIN trademark, and notably operates a website under the domain name <virgin.com> since 2000, to promote the activities of the Virgin Group, as well as <virginatlanticcargo.com> to provide information related to its passenger, cargo services and booking facilities. The Virgin businesses operate pages on various social media platforms which, altogether, receive over 37 million views a year.

On June 8, 2023, the Respondent registered the domain name <virgincourier.com>. The disputed domain name is used in relation to a website that purports to offer logistics, cargo and freight services. It displays the Complainant's VIRGIN trademark and signature logo in a prominent way in the top left-hand corner of each page of the website. The website identifies itself as "Virgin Courier" in numerous places, including at the bottom of each webpage. A number of images included on the website are taken from stock image libraries and the template for the website itself appears to be a stock template. The related website further contains a contact form.

#### 5. Parties' Contentions

##### A. Complainant

The Complainant first alleges that the disputed domain name is confusingly similar to its VIRGIN trademark as it entirely incorporates the VIRGIN trademark followed by the term COURIER, which appears to be a descriptive reference to a service of transporting goods or services, thus to one of the activities carried out by the Complainant.

The Complainant then affirms that the Respondent has no rights or legitimate interests in the disputed domain name. The use of the disputed domain name in relation to a website that purports to offer logistics, cargo and freight services as described above, further reproducing the Complainant's VIRGIN trademarks on numerous accounts, is a clear infringement of the Complainant's rights. Such use does obviously not amount to a *bona fide* business interest. Internet users are likely to mistakenly believe that the disputed domain name and related website may be owned by the Complainant. Furthermore, the contact form may lead users to provide their personal information, to possibly then use them for fraudulent purposes.

The Complainant finally considers that the Respondent registered and is using the disputed domain name in bad faith. Taking into account the use made by the Respondent of the website attached to the disputed domain name and the numerous reproductions of the VIRGIN trademarks, the Respondent was obviously aware of the Complainant's trademarks when it registered the disputed domain name. The use describes above further amounts to a usage in bad faith.

## **B. Respondent**

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

## **6. Discussion and Findings**

Paragraph 15(a) of the Rules instructs this Panel to "[...] 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".

Pursuant to paragraph 4(a) of the Policy, the Complainant must prove each of the following three elements to obtain an order that the disputed domain name should be cancelled or transferred:

- (i) the disputed domain name registered by the Respondent is identical or confusingly similar to a trademark or a 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 in bad faith.

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

The Complainant proves to hold numerous trademarks consisting of the term VIRGIN.

UDRP panels widely agree that incorporating a trademark in its entirety into a domain name can be sufficient to establish that the domain name is identical or confusingly similar to a registered trademark for purpose of the Policy (see, e.g., *Uniroyal Engineered Products, Inc. v. Nauga Network Services*, WIPO Case No. [D2000-0503](#); *Thaigem Global Marketing Limited v. Sanchai Aree*, WIPO Case No. [D2002-0358](#); and *F. Hoffmann-La Roche AG v. Relish Entreprises*, WIPO Case No. [D2007-1629](#)).

The addition of a term such as "courier" does not prevent a finding of confusing similarity between the VIRGIN trademark and the disputed domain name.

As a result, the Panel considers paragraph 4(a)(i) of the Policy to be satisfied.

### **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.

As the panel stated in *Do The Hustle, LLC v. Tropic Web*, WIPO Case No. [D2000-0624](#), demonstrating that the Respondent has no rights or legitimate interests in the domain name “would require complainant to prove a negative, a difficult, if not impossible, task”. Thus, in that decision, the panel opined that “[w]here a complainant has asserted that the respondent has no rights or legitimate interests in respect of the domain name, it is incumbent upon the respondent to come forward with concrete evidence rebutting this assertion”. Following that decision, subsequent UDRP panels acknowledged that it is deemed sufficient for a complainant to make a *prima facie* case that the respondent lacks rights or legitimate interests in a domain name. Once a *prima facie* case has been made, the burden of production shifts to the respondent to come forward with evidence to demonstrate its rights or legitimate interests. If it fails to do so, the complainant is deemed to have satisfied to paragraph 4(a)(ii) of the Policy (see, e.g., section 2.1 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”)).

In the present case, the Complainant is the owner of several numerous VIRGIN trademarks on a worldwide basis. The Complainant has no business or other relationships with the Respondent.

The Complainant thus has made a *prima facie* case showing that the Respondent has no rights or legitimate interests in the disputed domain name.

On his side, the Respondent has not answered to the Complaint.

Considering the absence of a Response and the fact that the Respondent has not made a legitimate noncommercial or fair use of the disputed domain name, the Panel finds that the Respondent has failed to demonstrate any rights or legitimate interests in the disputed domain name.

Consequently, in light of the above, the Panel considers paragraph 4(a)(ii) of the Policy to be fulfilled.

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

For a complaint to succeed, a panel must be satisfied that a domain name has been registered and is being used in bad faith (Policy, paragraph 4(a)(iii)).

Bad faith requires the Respondent to be aware of the Complainant’s trademarks. In the present case, the Complainant owns numerous VIRGIN trademarks on a worldwide basis, which enjoy a strong reputation.

Taking into account the composition of the disputed domain name with the addition of the term “courier”, which is merely descriptive and refers to the cargo activities carried out by the Complainant, and the fact that the website attached to the disputed domain name replicates the Complainant’s official website and reproduces as a result the Complainant’s official trademark and logo, there is no doubt that the Respondent was perfectly aware of the Complainant’s trademarks when he registered the disputed domain name.

The disputed domain name resolves to a website that is identical to the Complainant’s official website, and reproduces the Complainant’s official logo. As a result, a visitor who unknowingly visits the disputed domain name seeking to access the Complainant’s services is likely to believe that the website is affiliated to the Virgin Group and potentially decide to fill in the contact form, by inserting personal data that may then be used by the Respondent for fraudulent purposes. Such a use of a domain name amounts to a use in bad faith (see, for instance: *Fenix International Limited v. Leandro Vinicius Bau*, WIPO Case No. [D2021-0584](#)).

Consequently, the Panel is of the opinion that the disputed domain name <virgincourier.com> has been registered and is being used in bad faith under the 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 <virgincourier.com> be transferred to the Complainant.

*/Philippe Gilliéron/*

**Philippe Gilliéron**

Sole Panelist

Date: August 22, 2023