ARBITRATION
AND
MEDIATION CENTER

WIPO
WORLD
INTELLECTUAL PROPERTY
ORGANIZATION

ADMINISTRATIVE PANEL DECISION
Virgin Enterprises Limited v. John Seke
Case No. D2024-2796

1. The Parties

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

The Respondent is John Seke, UK.

2. The Domain Name and Registrar

The disputed domain name <virginukhotel.com> (the "Disputed Domain Name") is registered with NameSilo, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on July 9, 2024. On July 9, 2024, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Disputed Domain Name. On July 10, 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 (PrivacyGuardian.org llc) and contact information in the Complaint. The Center sent an email communication to the Complainant on July 22, 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 amended Complaint on July 26, 2024.

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 31, 2024. In accordance with the Rules, paragraph 5, the due date for Response was August 20, 2024. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on August 26, 2024

The Center appointed Catherine Slater as the sole panelist in this matter on September 12, 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 a company incorporated in England and Wales. It is a member of a group of companies known collectively as "the Virgin Group". The Virgin Group was originally established in the United Kingdom in 1970. Since then, the Virgin Group has grown significantly and is now engaged in a range of business sectors including travel and leisure, telecoms and media, music and entertainment, financial services, and health and wellness. There are currently more than 40 Virgin businesses with over 50 million customers worldwide and employing more than 60,000 people.

The Complainant maintains a worldwide portfolio of registered VIRGIN trademarks, which it licenses to companies both within and outside the Virgin Group. The Complainant's trademark portfolio includes:

- UK Registration 3163121 for VIRGIN (plain word), registered on July 29, 2016; and

- UK Registration 3423222 for VIRGIN HOTELS (plain word), registered on November 15, 2019; and

- United States of America Registration 4865666 for VIRGIN HOTELS (plain word), registered on December 8, 2015.

The Complainant is the registered proprietor of over 5,000 domain names either consisting exclusively of the VIRGIN trademark or in which the VIRGIN trademark is used in combination with other words and/or numbers. Its domain name portfolio includes <virgin.com>, <virgin.co.uk> and <virginhotels.com>. The <virginhotels.com> website is hereinafter referred to as "the Complainant's Website".

The Disputed Domain Name was registered on June 5, 2024.

The filed evidence shows that the Disputed Domain Name resolved to a website ("the Respondent's Website") which copied the text, content and layout of a 2022 version of the Complainant's Website. As at the date of this Decision it does not resolve to an active website. Evidence also shows the Disputed Domain Name has been used as part of an email address ending "…@virginukhotel.com" to contact members of the public and which purports to be from the Complainant's founder. The email seeks to persuade the recipient to become financially involved in some form of venture.

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.

Notably, the Complainant contends that the Disputed Domain Name is confusingly similar to both its VIRGIN and VIRGIN HOTELS trademarks because:

- it is similar to the former trademark because it adds the descriptive terms "uk" (referring to the United Kingdom) and 'hotel'; and

- it is similar to the latter because it merely omits the final "s" of the VIRGIN HOTELS trademark and adds only the descriptive term "uk".

The Complainant further contends that the Respondent has no rights or legitimate interests in respect of the Disputed Domain Name. In this regard, it says that the content of the Respondent's Website will confuse Internet users into believing that the Disputed Domain Name is operated by, or connected to, the Virgin Group and the phishing emails sent amount to illegal activity and that both actions indicate a lack of legitimate interests. The Complainant further contends that there is no evidence that the Respondent has ever been known by the Disputed Domain Name, used or has plans to use the Disputed Domain Name in connection with a bona fide offering and that it is hard to conceive of a legitimate use to which the Disputed Domain Name could be put.

The Complainant draws attention to *Virgin Enterprises Limited v. eby bakas*, WIPO Case No. D2024-1041, relating to the domain name <virginukhotels.com>, in which: the respondent's website was identical to the Respondent's Website; an identical email address was mentioned in the text of the scam emails; and there was a finding of a pattern of bad faith behaviour. Further, that the Respondent's email address in this case is identical to that used by the respondent in *Virgin Enterprises Limited v. WhoisSecure / Ebuka Uche*, WIPO Case No. D2021-2955, relating to the domain name <virginwideband2.com>, which again suggests a lack of legitimate interests or rights in the Disputed Domain Name as well as a pattern of bad faith.

Finally, the Complainant contends that the Disputed Domain Name was registered and is being used in bad faith because the Respondent's Website was set up to intentionally deceive consumers into thinking that the Respondent's website is operated by, or connected to, the Virgin Group, the Disputed Domain Name has been set up in order to operate a scam and the Respondent has intentionally attempted to attract, for commercial gain, Internet users by creating a likelihood of confusion as to the source, sponsorship, affiliation or endorsement of the Respondent's Website. The Complainant says that, taking into account the extensive copying of the Complainant's Website and the emails claiming to be from the Complainant's founder, it is clear that the Respondent was aware of the Complainant and its hotel business at the time of registering the Disputed Domain Name. It says that the Respondent is engaged in a pattern of registering and using domain names in bad faith.

B. Respondent

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

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 Panel finds that the VIRGIN HOTELS mark is recognizable within the Disputed Domain Name. That trademark appears within the Disputed Domain with only the final 's' omitted. 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 here, "UK" may bear on assessment of the second and third elements, the Panel finds the addition of such term 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.

Indeed, the Panel finds that the use made of the Disputed Domain Name is the opposite of legitimate. The Respondent has used the Disputed Domain Name to engage in a phishing campaign and this demonstrates a lack of legitimate rights or interests. Panels have held that the use of a domain name for illegal activity, here phishing, 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

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, here phishing, 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.

In the present case, the Panel notes that the Respondent has been linked to domain names in respect of which the Complainant has successfully taken action under the UDRP and that in this case it has copied a version of the Complainant's Website. As such, the Respondent clearly had actual knowledge of the Complainant and its trademarks at the time of registering the Disputed Domain Name. The Panel infers that the Respondent's choice of the Disputed Domain Name was deliberate and done with the clear intention (which it has carried through) of impersonating the Complainant in order to conduct a phishing scam for commercial gain.

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 <virginukhotel.com> be transferred to the Complainant.

/Catherine Slater/
Catherine Slater
Sole Panelist
Date: September 25, 2024