

DISPUTE RESOLUTION SERVICE

D00015205

Decision of Independent Expert

Virgin Enterprises Limited

and

My Claim Solved.com Limited

1. The Parties

Complainant: Virgin Enterprises Limited
The Battleship Building
179 Harrow Road
London
W2 6NB
United Kingdom

Respondent: My Claim Solved.com Limited
8 St Pauls Road
Torquay
Devon
TQ1 3QF
United Kingdom

2. The Domain Name

virgin-money-ppi.co.uk ('the Domain Name')

3. Procedural History

Nominet checked that the complaint received on 15 December 2014 complied with its UK Dispute Resolution Service ('DRS') Policy ('the Policy') and the Procedure for the conduct of proceedings under the Dispute Resolution Service ('the Procedure'). It then notified the Respondent of the complaint and invited it to file a response, which was received on 8 January 2015. On 15 January, the Complainant replied to that response. The same day, a mediator was appointed to help resolve the dispute informally. Mediation proved unsuccessful so, on 5 February, Nominet advised both parties that the matter would be referred to an independent expert for a decision, on payment of the appropriate fee. Nominet received that fee on 13 February.

On 13 February 2015 I, Mark de Brunner, agreed to serve as an expert under the Policy and Procedure. I have confirmed that I am independent of each of the parties and that there are no facts or circumstances that might call into question my independence.

4. Factual Background

I have visited the web site to which the Domain Name resolves. From the complaint, the response, the reply, that visit and the administrative information routinely supplied by Nominet, I accept the following as facts.

The Complainant is responsible for the ownership, management and protection of intellectual property for the Virgin Group of companies. The 'Virgin' brand was established by Richard Branson in 1970 and now covers a wide range of goods and services. The Virgin Group includes a financial services business, which trades as 'Virgin Money'.

The Complainant holds trade mark registrations for the names 'Virgin' and 'Virgin Money'. It registered the domain name virgin.com in September 1997.

The Respondent operates a business offering a service to people who may have been mis-sold financial products, in particular payment protection insurance, and who may be entitled to compensation.

The Domain Name was registered on 26 August 2014. At the time of writing, it resolved to a web page containing the following, among other text:

Virgin Money

Have you ever had a loan, credit card or mortgage with Virgin Money?
 You could be owed £1,000s in PPI compensation if Virgin Money mis-sold you PPI.

Start Your Virgin Money PPI Claim Below

My Claim Solved Ltd are an independent claims service and not a Virgin Money site or service, nor are they in any way connected to Virgin Money.

Mr Graham Kenny, apparently an officer of the Respondent company, has been the respondent in other DRS cases cited by the parties here:

| DRS Reference | Domain name | Decision | Date |
|---------------|---|-----------|------------|
| 11286 | natwest-ppi-reclaim.co.uk | transfer | 19.07.2012 |
| 11478 | barclays-ppi-reclaim.co.uk | transfer | 03.09.2012 |
| 12328 | barclaycard-ppi-reclaim.co.uk | transfer | 03.04.2013 |
| 12477 | bankofscotland-ppi-reclaim.co.uk blackhorse-ppi-reclaim.co.uk halifax-ppi-reclaim.co.uk hbos-ppi-reclaim.co.uk lloyds-ppi-reclaim.co.uk | transfer | 20.05.2013 |
| 12592 | marksandspencer-ppi-reclaim.co.uk | no action | 29.05.2013 |
| 13790 | virginmoney-ppi-reclaim.co.uk | transfer | 16.06.2014 |

5. Parties' Contentions

Complaint

The Complainant says it has rights in the names 'Virgin' and 'Virgin Money' and that the Domain Name is an abusive registration because:

- (i) it must have been made
 - a. in order to sell at a profit or
 - b. as a blocking registration or
 - c. in order to disrupt the Complainant's business by damaging its brand.
- (ii) the use of the Complainant's branding on the web page to which the Domain Name resolves is bound to confuse visitors into believing that that the Domain Name is connected with the Complainant.
- (iii) the Respondent has been engaged in a pattern of registrations where it is the registrant of domain names which correspond to well known names in which the Respondent has no apparent rights, and the Domain Name is part of that pattern.

Response

The Respondent argues that this is not an abusive registration because:

- (i) there can be no disruption to the Complainant's business because the Complainant does not trade in compensation for mis-selling. Indeed it is the Complainant that is attempting to disrupt the Respondent's business as a claims adviser and manager, securing compensation for financial-product mis-selling.
- (ii) there is no evidence of confusion and none is possible because the Respondent is not identified in the Domain Name. Any issues there may have been with the content at the web site have been addressed, reflecting the approach endorsed by the expert in DRS 12592 (which involved a different domain name and Complainant but, by implication, a broadly similar fact pattern). In particular, the web site no longer contains the Complainant's logo and it bears a disclaimer making clear that the web site is not run by the Complainant. The incorporation of 'ppi-reclaim' (*sic*) in the Domain Name makes clear the purpose of the registration and of the site.
- (iii) there is no relevant pattern of registrations because the Respondent here was not the respondent in those other cases.
- (iv) the Domain Name is generic or descriptive and the Respondent is making fair use of it.
- (v) expert decisions in previous cases involving Mr Kenny are inconsistent. In particular, DRS 13790 was wrongly decided: the content examined was out of date, the decision relied on assertion rather than evidence in various places and the domain name itself was considered without adequate weight being attached to the content of the associated web site. It is important to look at the content of the web site to which a domain name resolves, alongside the domain name itself.

Reply

(The numbering here is consistent with the numbering of the arguments in the *Complaint* and *Response* sections above.)

In reply, the Complainant makes the following points.

- (i) The complaint is not an attempt by the Complainant to disrupt the Respondent's business. The Complainant is merely acting to protect its brand. On the other hand, the Complainant's business is being disrupted by the Respondent's use of the Domain Name, in that the suggestion that PPI may have been mis-sold by the Complainant necessarily leaves its customers and potential customers with a negative impression.
- (ii) The web site to which the domain name resolves is designed to look and feel like a 'Virgin Money' site. There is bound to be confusion.
- (iii) The Respondent here and Mr Graham Kenny are 'the same party'.
- (iv) The Domain Name is not generic or descriptive and the Respondent is not making fair use of it.
- (v) Alterations to web site content in response to any previous decisions are not directly relevant here. In any event, those alterations were not reflected in the content of the web site at the Domain Name which continued (as late as November 2014) to use the Complainant's branding. (The screenshots carry 'Virgin Atlantic' branding and the content is to do with choosing flights.)
- (vi) The Respondent has been acting in bad faith in registering the Domain Name, when the guiding mind is Mr Graham Kenny and other similar registrations have made by him personally. The bad faith is, in the Complainant's view, the use of a separate legal entity to avoid the rule in the Policy (paragraph 3 c) that establishes a presumption of abusive registration if the complainant proves that the respondent has been found to have made an abusive registration in three or more DRS cases in the two years before the complaint was filed.

6. Discussion and Findings

To succeed in this complaint, the Complainant must prove, on the balance of probabilities, that

- it has rights in respect of a name or mark which is identical or similar to the Domain Name; and that
- the Domain Name, in the hands of the Respondent, is an abusive registration.

Rights

The Complainant has registered rights in the names 'Virgin' and 'Virgin Money'. It has also invested in the brands globally, including in the UK, over many years, establishing unregistered rights.

Ignoring the .co.uk suffix as merely a generic feature of the domain name register, the Domain Name comprises a name in which the Complainant has rights and a generic descriptor (PPI) relating to a particular kind of financial product.

I conclude that the Complainant has rights in respect of a name or mark which is identical or similar to the Domain Name.

Registration

As defined by the Policy, an abusive registration is a domain name which:

- was registered or otherwise acquired in a manner which, at the time when the registration or acquisition took place, took unfair advantage of or was unfairly detrimental to the complainant's rights; or
- has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the complainant's rights.

The Policy contains a non-exhaustive list of factors that may be evidence that a domain name is an abusive registration and an equivalent list of factors that may point the other way. The parties refer to the elements of both lists.

The Complainant speculates about the Respondent's motives in acquiring the Domain Name, noting the potential for confusion and offering its assessment of disruption caused to its business. The Respondent rejects those arguments and argues that the Domain Name is generic and that it is using it fairly. Both parties claim or imply that the other is acting in bad faith.

However, despite the length of the submissions, including references to other DRS cases, the analysis here seems to me straightforward. Two parts of the *Experts' Overview* appear especially relevant. Section 3.3 says:

Commonly, Internet users will visit web sites either by way of search engines or by guessing the relevant URL. If the domain name in dispute is identical to the name of the Complainant and that name cannot sensibly refer to anyone else, there is bound to be a severe risk that a search engine, which is being asked for the Complainant, will produce high up on its list the URL for the web site connected to the domain name in issue...

In such cases, the speculative visitor to the registrant's web site will be visiting it in the hope and expectation that the web site is a web site "operated or authorised by, or otherwise connected with the Complainant." This is what is known as 'initial interest confusion' and the overwhelming majority of Experts view it as a possible basis for a finding of Abusive Registration, the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived...

Findings of Abusive Registration in this context are most likely to be made where the domain name in issue is identical to the name or mark of the Complainant and without any adornment (other than the generic domain suffix)...However...[generally condemned] are those people who attach as appendages to the Complainant's name or mark a word appropriate to the Complainant's field of activity.

But reading section 4.8 of the *Overview* alongside that, it is clear that it is not always abusive for a domain name to include a name in which someone else has rights:

This issue crops up most commonly in the so-called 'reseller' cases, the cases where the domain name registrant is using the domain name to sell the trade mark owner's goods. The generally accepted principles to be derived from the cases, as reviewed by the appeal panel in *Toshiba Corporation v Power Battery Inc* (DRS 07991) <toshiba-laptop-battery.co.uk> are:

1. It is not automatically unfair for a reseller to incorporate a trade mark into a domain name and the question of abusive registration will depend on the facts of each particular case.
2. A registration will be abusive if the effect of the respondent's use of the domain name is falsely to imply a commercial connection with the complainant.
3. Such an implication may be the result of "initial interest confusion" and is not dictated only by the content of the web site.
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller's incorporation of the domain name

is unfair. One such reason is the offering of competitive goods on the respondent's web site.

In the Toshiba appeal, the majority of the panel felt that there would be nothing inherently abusive about the domain name if it were being used to sell only Toshiba laptop batteries. (The minority view was that even that situation would be abusive because the Respondent was not Toshiba - or connected with Toshiba - and the domain name did not make that clear.) The majority panelists' issue was that the web site at the domain name also sold batteries by Toshiba's competitors.

In the present case, the Domain Name consists of a name in which the Complainant has rights ('Virgin Money') and a label for a financial product (payment protection insurance, commonly abbreviated to 'PPI'). It therefore appears to relate to the Complainant and to a particular type of financial product which (correctly or not) a prospective internet visitor might believe the Complainant sells. That visitor would then find herself drawn to a web site offering a different financial service (assistance in claiming compensation for having been mis-sold PPI) by someone other than the Complainant. Though *appearing* to sell something you are in fact *not* selling does not necessarily take unfair advantage of someone's rights, the use of the Complainant's name here, together with an appendage ('ppi') relevant to the Complainant's financial services business, appears to me to make this a text-book example of initial interest confusion and conclusive of the character of the registration.

Comparing this with the Toshiba case, the present circumstances are equivalent to a situation in which the domain name toshiba-laptop-battery.co.uk was being used by someone who was not Toshiba and who was not selling Toshiba laptop batteries or indeed any kind of battery.

To the extent that there is initial interest confusion, it does not matter that this is cleared up once the visitor is on the web site. There is a factual disagreement about that between the parties, based on the content of the web site. But I do not need to resolve that disagreement because, even on the Respondent's case that any possible confusion is dispelled by a clear disclaimer, by then it is too late.

I should say that, as a matter of general approach, I agree with the Respondent's suggestion that the acquisition and use of a domain name needs to be considered in the round. The particular form of the content at a web page to which a domain name resolves may be relevant. The expert in DRS 12592 looked very carefully at the effect of the content of the web site to which the domain name marksandspencer-ppi-reclaim.co.uk resolved and the Respondent argues that a similarly forensic approach to the look and wording of the web site is appropriate here. I disagree, though, because - recognising that the web site at the Domain Name is broadly for the purposes of alerting potential customers to the Respondent's mis-selling compensation service - there appears to me to be such a strong case that internet visitors will already have been confused before they arrive.

I can now run briefly through the arguments advanced by each side.

(i) disruption

In the absence of direct evidence, I do not find it helpful to speculate about the Respondent's motive at registration. But the Respondent's argument, that there can be no disruption to the Complainant's business because the Complainant does not trade in compensation for mis-selling, strikes me as plainly wrong.

(ii) confusion

There is a factual disagreement about the content of the web site before the date on which I viewed it myself. The Complainant says that its branding has been used. The Respondent says it has not and that there is a disclaimer making clear that the site is not connected with the Complainant. As noted above, however, I do not need to resolve the factual question because it does not matter: by the time visitors arrive, the confusion is already likely to have occurred.

The Respondent says there can be no false inference about a connection between it and the Complainant because the Respondent is not identified in the Domain Name. But that is not the kind of confusion envisaged in this part of the Policy.

The Respondent's reference to 'the incorporation of 'ppi-reclaim' (*sic*) in the Domain Name (as identifying the purpose of the registration and of the site) is clearly an error.

(iii) pattern

It is undeniable that the registrations claimed to form an objectionable pattern did not involve the Respondent, a company and therefore a distinct legal person. There is no provision in the Policy for brushing aside the veil of incorporation, so the terms of the relevant factor set out there do not apply. Of course the list is non-exhaustive and in determining the character of the registration the expert is looking at all the circumstances to address the underlying question of whether the acquisition or use of the domain name takes unfair advantage of or is unfairly detrimental to the Complainant's rights. But, in any event, there is no need for the Complainant to rely on a reversal of the burden of proof: in my judgement it has discharged the default obligation, imposed by the Policy on complainants, to prove its case.

(iv) generic/descriptive and fair use

The Domain Name is descriptive, though it is not descriptive of a financial product available through the web site. Though there is a

generic descriptor ('ppi'), the Domain Name as a whole is not generic in that it refers specifically to the Complainant's brand rather than (for example) to payment protection insurance generally. Even if the Domain Name had been generic and wholly descriptive, there would remain a question about fair use.

(v) inconsistency in expert decisions

The Respondent seems to me on uncertain ground when arguing that there has been an inconsistent approach to deciding earlier cases relating to domain names ending 'ppi-reclaim.co.uk'. In the papers before me, nine out of ten disputed domain names have been transferred away from Mr Kenny.

It is for the expert to determine the admissibility, relevance, materiality and weight of the evidence (the Procedure, paragraph 12 b). The appropriate way to challenge an expert decision is to appeal against it – though even appeal decisions within the DRS are only of 'persuasive' rather than 'precedent' value (the Policy, paragraph 10 c). Together, the Policy and Procedure are clear that it is up to the expert in each case to make up his or her own mind.

(vi) bad faith

I do not have enough information to form a view about whether the Domain Name was registered by the Respondent company rather than by its officer, Mr Kenny, in order to avoid the 'three strikes' rule. As a consequence, I do not draw an adverse inference and I do not accept the Complainant's claim of bad faith.

Equally, though, I discount the Respondent's implication that the Complainant is acting in bad faith in seeking to disrupt the Respondent's business. I accept that the Complainant is merely acting to protect its brand, as it is entitled to do.

Overall, the Domain Name uses the Complainant's brand to attract interest in a business that is not connected with the Complainant and not selling the Complainant's products or services but is instead founded on the premise that the Complainant has mis-sold financial products. That, it seems to me, must take unfair advantage of or be unfairly detrimental to the Complainant's rights.

7. Decision

I find that the Complainant has rights in respect of a name which is identical or similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an abusive registration.

In the light of that, I direct that the Domain Name be transferred to the Complainant.

Mark de Brunner

6 March 2015