

DISPUTE RESOLUTION SERVICE

D00017485

Decision of Independent Expert

Virgin Enterprises Limited

and

Anthony Rundle

1. The Parties:

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

Respondent: Anthony Rundle
32 Lowther Crescent
Grangeside
St Helens
Merseyside
WA10 3PW
United Kingdom

2. The Domain Name(s):

virginfm.co.uk ("the Domain Name")

3. Procedural History:

The Complaint was submitted to Nominet on 17 May 2016. On 18 May 2016, Nominet validated the Complaint and notified it to the Respondent. The Respondent was informed in the notification that he had 15 working days, that is until 9 June 2016, to file a response to the Complaint.

On 7 June 2016 the Respondent filed a Response. On 14 June 2016 the Complainant filed a Reply to the Response and the case proceeded to the mediation stage. On 6 July 2016, Nominet notified the Parties that mediation had been unsuccessful and invited the Complainant to pay the fee for referral of the matter for an expert decision pursuant to paragraph 8 of Nominet's Dispute Resolution Service Procedure Version 3 ("the Procedure") and paragraph 7 of the corresponding Dispute Resolution Service Policy Version 3 ("the Policy"). On 15 July 2016, the Complainant paid the fee for an expert decision. On 21 July 2016, Andrew D S Lothian, the undersigned, ("the Expert") confirmed to Nominet that he was not aware of any reason why he could not act as an independent expert in this case. Nominet duly appointed the Expert with effect from 26 July 2016.

4. Factual Background

The Complainant is a company incorporated in England and Wales with company number 01073929, is a wholly owned subsidiary of a group of companies known collectively as 'the Virgin Group', and is responsible for the ownership, management, licensing and protection of intellectual property in the 'Virgin' name and associated trade marks. The Virgin Group was established by its founder and chairman Sir Richard Branson in 1970 and is now engaged in a diverse range of business sectors including transport, travel, mobile telephony, media and broadcasting, fitness and financial services. In the UK, the Complainant's group operates more than 20 'Virgin' branded businesses employing 30,000 people and having approximately 18 million customers. The Complainant's group spent approximately £92 million on marketing the 'Virgin' brand in 2010. In recent independent surveys, the 'Virgin' brand was ranked at number 5 in the Official Top Business Superbrands and Global Brand Tracker Research reported that 99% of people surveyed in the UK were aware of the brand.

The Complainant maintains a worldwide registered trade mark portfolio for the VIRGIN family of marks. These are licensed by it to companies within and outside the Virgin group. For example, the Complainant is the proprietor of UK registered trade mark no. 1371870 for the word mark VIRGIN in class 38 (television and radio broadcasting and satellite communications), registered on 16 August 1991. The Complainant also maintains a large portfolio of over 5,000 domain names including <virgin.com> (created on 10 September

1997), <virgin.co.uk> (created before August 1996) and <virginfm.com> (created on 14 May 1999).

The Complainant's group launched 'Virgin Radio' in 1993 as the UK's first national commercial radio station. 'Virgin Radio Asia', later 'Virgin Radio International' followed, covering such countries as Canada, France, Italy and Thailand. The Complainant broadcast in the UK between 1993 and 2008 as 'Virgin Radio', followed by 'Absolute Radio'. In January 2015, it was announced that Virgin Radio International and UTV Media had partnered to re-launch 'Virgin Radio' in the UK subject to regulatory approval. Such approval was granted by the regulator, OFCOM, and publicly announced on 27 March 2015, which was followed by the re-launch of 'Virgin Radio UK' on 30 March 2016.

The Respondent appears to be a Facilities Manager by occupation. The Respondent registered the Domain Name on 27 April 2015. On 29 April 2015, a UK limited company was incorporated under the name VirginFM Ltd (company number 9567608). This company's registered office was the same as the Respondent's residential address and the Respondent was listed as its sole shareholder and director. On 22 May 2015, the Complainant contacted the Respondent by letter regarding the use of the VIRGIN mark in the Respondent's company name and the Domain Name. The Complainant indicated in that letter that it was concerned that the Respondent's use of the name 'VirginFM' would confuse the public regarding the forthcoming re-launch of 'Virgin Radio'. The Complainant followed up that letter with a further letter on 25 June 2015 but did not receive a response to either letter. On 2 July 2015, VirginFM Ltd changed its company name by resolution to Sure MT Ltd.

On 7 October 2015, a UK limited company was incorporated under the name VirginFM (Facilities Management) Ltd (company number 9813193). This company's registered office was also the same as the Respondent's residential address and the Respondent was listed as its sole shareholder and director. The Complainant wrote to the Respondent on 2 November 2015 regarding its use of the VIRGIN mark in this company name and followed that letter with a further letter on 2 December 2015 but did not receive a response to either letter. The Complainant's solicitors wrote to the Respondent regarding this company on 25 January 2016. On 29 January 2016, the Respondent replied stating that he was prepared to change the name of the company as a gesture of goodwill and also mentioning that he was the registrant of the Domain Name. He stated that he was willing to come to an agreement on name change and transfer of the Domain Name. He did not mention the nature of his company's business nor his reason for registering the Domain Name. The Complainant's solicitors replied on 9 February 2016 giving instructions on how to change the company name and transfer the Domain Name.

On 11 February 2016, the Respondent replied to the Complainant's solicitors confirming that in previous correspondence he had indicated that there would

be a financial cost to the name change and that he was willing to assign the Domain Name for the sum of £1 million. He indicated that this figure was based on past sales of .co.uk domain names. On 22 February 2016, the Complainant's solicitors replied stating that there was no reasonable basis for the valuation of the Domain Name and indicating that the Complainant would be prepared to reimburse the Respondent for reasonable documented out-of-pocket costs in relation to the Domain Name in return for a transfer thereof and suitable undertakings. On 2 March 2016, the Respondent replied that he was proceeding to change the company name, that the Domain Name had been valued by his web designer based on comparables obtained from two .com and two .co.uk domain name sales and that it had been purchased for an indefinite period. The Respondent added that he was 'new to the FM industry', that the Domain Name was not an Abusive Registration and that as he would not be able to use the Domain Name it would be advertised for sale once the company details were changed and the website rebranded 'unless a buyer wants a private sale'. The Respondent instigated a motion to voluntarily strike the said company from the register on or about 20 March 2016.

Initially the website associated with the Domain Name displayed a 'website coming soon' message. By 9 May 2016, the relative website referred to a business named "Virgin Facilities Management" featuring services such as building management and maintenance, hotel and housekeeping services, corporate real estate management and strategic asset management. The accompanying text stated in part "VirginFM aims to provide facilities management and support services across the UK...". By the date of appointment of the Expert, the account for the associated website appeared to have been suspended by the hosting provider.

5. Parties' Contentions

Complainant

The Complainant asserts that the Domain Name is identical or similar to marks in which the Complainant has Rights and that it is an Abusive Registration.

The Complainant notes that the Domain Name incorporates the Complainant's VIRGIN mark together with the addition of the .co.uk suffix and the letters 'FM'. With regard to the .co.uk suffix, the Complainant notes it to be well established that this should be disregarded for the purposes of comparison. With regard to the letters 'FM', the Complainant asserts that these do not prevent the Domain Name from being identical or similar as the 'virgin' element is the dominant feature while the additional letters are widely used as a descriptive acronym for radio broadcast services. The Complainant refers to the expert's decision in *Virgin Enterprises Limited v. SJT Consultancy Limited* (DRS 013891) in which the expert found that the formula "Virgin [plus

activity]" (e.g. Virgin Records) was in common use by the Virgin Group and that the public was therefore accustomed to seeing the VIRGIN mark being followed by a wide range of types of activity which connected the composite mark with the Virgin Group.

The Complainant asserts that as Virgin branded businesses have been trading since 1970 it is inconceivable that at the time of registration of the Domain Name, the Respondent was not aware of the existence of the Complainant's and its group's extensive reputation, particularly in light of the overwhelming awareness of the Virgin brand among the UK public.

The Complainant asserts that it may be inferred from the facts that the Domain Name was registered by the Respondent primarily for the purpose of selling it to the Complainant for valuable consideration in excess of the Respondent's out-of-pocket costs. The Complainant submits that the Respondent has failed to provide a reasonable explanation for his valuation of the Domain Name in the sum of £1 million and adds that the Complainant's offers to meet the Respondent's reasonable out-of-pocket costs have been ignored. The Complainant notes that the Respondent stated that he would advertise the Domain Name for sale "unless a buyer wants a private sale".

The Complainant states that it is of the view that the Respondent registered the two limited companies noted in the factual background to give the appearance of legitimacy and to boost its bargaining position in seeking a substantial sum for the Domain Name from the Complainant. The Complainant asserts that such view is supported by the Respondent's subsequent motion to strike company number 9813193 (VirginFM (Facilities Management) Ltd) off the Companies Register, suggesting that it was never intended to be a genuine trading business in the first place.

The Complainant submits in the alternative that it is reasonable to infer that the Domain Name was registered as a blocking registration against the Complainant's VIRGIN marks and for the purpose of unfairly disrupting the Complainant's business. The Complainant refers to the timing of the registration and suggests that it was made to take advantage of the re-launch of Virgin Radio UK which was anticipated by public announcements and media coverage and prevents the Complainant from making the registration itself when the Respondent has no *prima facie* right to use the VIRGIN marks nor any valid reason for choosing to register it. Finally, on the matter of registration of the Domain Name, the Complainant adds that the Domain Name has been registered to divert traffic from the Complainant's websites to capitalise on the Complainant's reputation and pressurise the Complainant into paying an excessive sum of money in order to protect its Rights.

With regard to the use of the Domain Name, the Complainant asserts that the Respondent is using the Domain Name in a way which is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by the Complainant. The Complainant states that the

website associated with the Domain Name purports to offer facilities management services to UK consumers under reference to the VIRGIN marks and thereby creates a likelihood of confusion. The Complainant notes that the word "VIRGIN" appears in prominent typeface and larger text than the words "FACILITIES MANAGEMENT" on the Respondent's website and asserts that this, together with the fact that the name of the business is stated to be "VirginFM" throughout, reinforces the impression that there is an association between the Complainant and the Domain Name. The Complainant contends that the addition of "FM" after the word "Virgin" in the Domain Name perpetuates the likelihood of confusion due to the Complainant's interests in radio broadcasting. The Complainant provides the first page of a Google.co.uk search for the term "Virgin FM" which shows that all of the entries refer to the Complainant or its radio stations. The Complainant indicates that initial interest confusion will arise from the Respondent's use of the Domain Name in connection with the "Virgin Facilities Management" business.

The Complainant submits in the alternative that the Respondent never intended to use the Domain Name for a *bona fide* offering of goods and services and states that it reasonably considers the launch of the Respondent's website as an attempt to give an appearance of legitimacy to the Respondent's purported business with a view to coercing the Complainant into purchasing the Domain Name for an extortionate sum. The Complainant asserts that such website was never intended to be a genuine trading business and in particular contravenes the trading disclosure requirements for UK private limited companies in a number of respects and only displays the Respondent's email address.

Respondent

The Respondent states that he set up his company when he was in the Falkland Islands with the military and explains that the "Virgin" component of his intended name represented the fact that his venture was a new start for him. He notes that he had intended to call the company "VirginIA (i.e. Virginia)" representing "the new work I was doing since working with the military". The Respondent notes that as the corresponding domain name was not available in the .com or .co.uk space a colleague suggested "FM" rather than "IA" since much of the Respondent's work was for "Military DIO" as he is ex-army.

The Respondent says that he did not foresee any problem with the ultimate name of the company and Domain Name, since any company operating in this area would have registered the Domain Name straight away. The Respondent asks rhetorically whether such name can infringe rights when it is all one word, and asks the same question of a hypothetical name "virginmaryFM".

The Respondent states that he felt bullied and intimidated by the Complainant's correspondence requiring him to change the company name

and return the Domain Name. The Respondent adds that he told the Complainant that he would re-name and re-brand his company, that this had now been done and he was starting to trade under the name VirginFM (Facilities Management) Ltd. The Respondent notes that he has since de-registered this company and is in the process of re-branding for the second time. He says that the Domain Name is a different matter because he can still use it and explains that he has no intention of selling it but fixed a high price "to put off VEL from making their threats". The Respondent adds that in response he received further threats from the Complainant.

The Respondent asserts that he has received a number of requests with regard to selling the Domain Name but has indicated to all such parties that the Domain Name is not for sale. The Respondent notes that he is in the process of setting a company up in which the Domain Name could be used for email rather than as a web address.

The Respondent concludes that he is being victimised by a multinational company in an abuse of wealth and power.

Complainant's Reply to Response

The Complainant notes that it cannot comment on the history of the Respondent's choice of name, in the absence of evidence or further information other than a submission that the explanation is at odds with the Respondent's explanation in his letter of 2 March 2016 in which he states that he was new to the FM industry, virgin meaning "new" and that he was looking for any domain name which represented "virginfm".

The Complainant denies that it engages in bullying or victimisation, adding that it is entitled to protect its intellectual property and has always acted reasonably towards the Respondent.

The Complainant states that the Respondent's asserted position regarding the offer to sell the Domain Name for £1 million is wholly at odds with the correspondence between the parties, noting that (1) from the Respondent's very first letter of 29 January 2016, the Respondent said he was willing to come to an agreement on both company name and the Domain Name, before the Complainant was aware of any connection between the Respondent and the Domain Name and before the Complainant had requested transfer thereof; (2) the Respondent repeated the offer to assign the Domain Name to the Complainant in his letter of 11 February 2016 but coupled with a price of £1 million; (3) the Respondent suggested in his final letter of 2 March 2016 that the Domain Name will be advertised for sale, which is at odds with the assertion that he had no intention to sell it; and (4) when asked to justify the valuation of the Domain Name, the Respondent referred to comparables obtained by his web developer, again at odds with any contention that he had made it clear to the Complainant that the Domain Name was not for sale.

The Complainant points out that the Respondent indicated in the letter of 2 March 2016 that he would be advertising the Domain Name for sale after re-branding yet he asserts in the Response that he can still use the Domain Name for email. The Complainant notes the apparent inconsistency between the Respondent re-branding but continuing to use an “@virginfm.co.uk” domain name and also submits that use of the Domain Name as part of an email address can constitute an Abusive Registration within the meaning of paragraph 3(a)(ii) of the Policy, citing section 3.3 of the Expert’s Overview. The Complainant comments that in view of the distinctive nature of the VIRGIN mark and the scope of the Complainant’s group’s businesses the Respondent’s threatened use of the Domain Name for email purposes is likely to lead to confusion in terms of paragraph 3(a)(ii) particularly in light of the Complainant’s interests in radio broadcasting.

6. Discussions and Findings

General

In terms of paragraph 2(b) of the Policy the onus is on the Complainant to prove to the Expert on balance of probabilities each of the two elements set out in paragraph 2(a) of the Policy, namely that:

- (i) the Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- (ii) the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Complainant’s Rights

Paragraph 1 of the Policy provides that Rights means “rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning”.

The requirement to demonstrate Rights under the Policy is not a particularly high threshold test. Rights may be established in a name or mark by way of a trade mark registered in an appropriate territory, or by a demonstration of unregistered so-called ‘common law rights’.

In the present case, the Complainant relies upon its various registered trade marks for the VIRGIN word mark. Disregarding the .co.uk suffix, as is customary in cases under the Policy, it may be seen that the Domain Name is alphanumerically identical to the Complainant’s VIRGIN mark, save with the addition of the letters “fm” at the end. The Expert considers that the VIRGIN element of the Domain Name is the dominant feature, the letters “FM” having considerably more of a generic or descriptive quality in that they are typically

used in tandem with one or more words to denote the name of a radio station or broadcaster, where “FM” indicates the broadcast method of frequency modulation. There is particular significance where the term “FM” is added to the Complainant’s mark given that the Complainant is well-known in the UK for its broadcasting activities. In other words, the juxtaposition of a common broadcasting term with the Complainant’s mark in a domain name is likely to strengthen the apparent association of that domain name with the Complainant and its mark. The Expert also accepts that the Complainant typically uses its mark according to the formula “Virgin [plus activity]” (e.g. Virgin Records) and that this is also likely to enhance the similarity between the Domain Name and the Complainant’s mark in the present case (see the discussion on this topic in *Virgin Enterprises Limited v. SJT Consultancy Limited* (DRS 013891)).

In all of these circumstances, the Expert finds that the Complainant has proved on the balance of probabilities that it has Rights in the mark VIRGIN and that such mark is similar to the Domain Name.

Abusive Registration

Paragraph 1 of the Policy defines “Abusive Registration” as a domain name which either:

i. 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

ii. has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant’s Rights;

This general definition is supplemented by paragraph 3 of the Policy which provides a non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration. Paragraph 4 of the Policy provides a similar non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration.

The essence of the Complainant’s case is, first, that the Respondent registered the Domain Name primarily for the purpose of selling it to the Complainant for valuable consideration in excess of the Respondent’s documented out-of-pocket costs; and secondly, that the Respondent is using or threatening to use the Domain Name in a way which is likely to confuse people or businesses into believing that it is registered to, operated or authorised by or otherwise connected with the Complainant. These submissions are based upon paragraphs 3(a)(i)(A) and 3(a)(ii) of the Policy respectively.

The essence of the Respondent's case, although he does not make specific reference to the Policy in his submissions, is that before being aware of the Complainant's cause for complaint, he has used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods or services, effectively a submission in terms of paragraph 4(a)(i)(A) of the Policy. In addition, the Respondent asserts that he did not have any intent to sell the Domain Name to the Complainant in the manner which it contends.

Turning first to the question of the Respondent's intent at the time of registration, the registration of the Domain Name along with the incorporation of an associated limited company between 27 and 29 April 2016 could be consistent with the Complainant's interpretation, namely that the Respondent was reacting to news of the forthcoming re-launch of the Complainant's 'Virgin Radio' radio station in order to take advantage of the Complainant's pre-existing Rights. The company incorporation could therefore merely have been a 'cover' to provide an air of legitimacy to the Domain Name registration. On the other hand, the registration of the Domain Name and incorporation of the company could be consistent with the Respondent's explanation that he came up with the name 'VirginFM' entirely independently of the Complainant's mark in order to use it for his new facilities management business, "FM" standing for "Facilities Management".

It cannot be denied that there is a close proximity in time between the public announcement of OFCOM's award of a broadcast licence to the Complainant's group, allowing the re-launch of a 'Virgin' branded radio station in the UK, and the registration date of the Domain Name in that these events are only one month apart. The Respondent's case effectively requires the Expert to believe that such proximity is a mere coincidence. The possibility of such coincidence is additionally challenged by the Respondent's selection of the letters "FM" allegedly to represent the term "Facilities Management" when those initials happen to be used extensively in radio broadcasting and are widely understood by the public in that particular context, for example, in the names of many radio stations. These two features, taken together, raise a degree of doubt regarding the credibility of the Respondent's explanation. In short, the coincidence is extremely unlikely and, if the Respondent is to be believed, extremely unfortunate to say the least.

The alleged coincidence is tested yet again by the fact that the Complainant's VIRGIN mark underpins one of the best known brands in the UK which is widely understood by the public to be in use in a variety of fields including broadcasting. This fact is supported by the Complainant's submission that, in recent independent research, 99% of people surveyed in the UK were aware of the Complainant's VIRGIN brand. The Expert has no reason to call the findings of that survey into question. Nor does the Respondent appear to take any issue with it. The Complainant supplements this with a Google UK search of the terms "Virgin" and "FM", the top ten results of which exclusively denote the Complainant's group and its international radio stations. This leaves the

Respondent, who is silent on the subject of his prior knowledge of the Complainant's brand, effectively either in the 1% of people in the UK who may not know the Complainant's brand or as someone who is more likely than not to have known of the Complainant's Rights yet proceeded with the registration of the Domain Name. On the statistical basis alone, the latter is more likely.

Turning to the question of the Respondent's alleged facilities management business, it is notable for the Respondent's case in terms of paragraph 4(a)(i)(A) of the Policy that he chose not to mention any details regarding his company's alleged business nor his reason for registering the Domain Name in his first letter to the Complainant dated 29 January 2016 (the Respondent states that he wrote an earlier letter dated 20 November 2015 but he has not provided this in evidence). In the Expert's view, this is a surprising omission given the Respondent's subsequent position as stated in the Response. The Expert would reasonably expect the nature of the Respondent's business to be the headline item that he would want to bring to the Complainant's attention on first contact.

The Expert observes that in the Respondent's first letter, rather than discussing his business activities, the Respondent immediately indicated that he was willing to come to an agreement on re-assignment of the Domain Name. This also seems a curious position for the Respondent to have taken up on first contact given his later position in the Response. It is notable too that the Response gives almost no details regarding the Respondent's alleged activities in the field of facilities management. This does not give the Expert any confidence that there is much in the way of substance behind the Respondent's case in terms of paragraph 4(a)(i)(A) of the Policy.

The circumstance of most significance to this aspect of the Complaint, however, is the Respondent's demand for the sum of £1 million in return for a transfer of the Domain Name to the Complainant, initially made in his letter of 11 February 2016. In the Expert's view, this demand is wholly inconsistent with any alleged intention to use the Domain Name in connection with a genuine offering of goods or services. Furthermore, it runs contrary to the Respondent's express statement in the Response that he never had any intention of selling the Domain Name to anyone. The Expert finds the Respondent's explanation that he fixed a high price to put the Complainant off from making further threats unconvincing. The quoting of a price early on in the correspondence effectively underlines the Respondent's apparent willingness to sell and lends some credence to the contention that this may have been the Respondent's original purpose. Likewise, the suggestion in the letter of 11 February 2016 that the cost to the Respondent of re-branding what was allegedly a newly established business could be equated with the sum demanded is fanciful to say the least and tends to detract from the Respondent's position that he was making or intended to make a genuine offering of services under the Domain Name.

The Respondent's letters of 11 February and 2 March 2016 also mention a method of valuation of the Domain Name, the fact that it had been purchased for an indefinite period and an apparent threat that it would be advertised for sale after re-branding of the website 'unless a buyer wants a private sale'. These strike the Expert as somewhat transparent pressure sales tactics. In the Expert's opinion, they are not the actions of a person who wishes their correspondent to leave them alone. The assertion in the Response that the Respondent has received a number of requests to sell the Domain Name and has turned these down has a rather similar quality, particularly where that assertion is unsupported by any evidence. In terms of the valuation methodology provided in both letters, the Expert considers it to be significant that the Respondent decided to embark upon a process of valuation of the Domain Name itself, rather than simply addressing the alleged cost of re-branding. This provides further support to the contention that the Respondent was viewing the Complainant's concerns regarding the Domain Name as something of a sales opportunity.

The Expert notes that the Respondent has put forward two alternative and mutually inconsistent positions, in the correspondence and the Response respectively, regarding what he proposed to do with the Domain Name on completion of the alleged re-branding. In the correspondence, he notes that the Domain Name will be advertised for sale. However, in the Response, he says that he will continue to use the Domain Name for email purposes. This lack of consistency does not help the credibility of the Respondent's case and it is certainly not supportive of any suggestion that the Respondent only ever intended to use the Domain Name for his business.

The Respondent's motion to strike company number 9813193 (VirginFM (Facilities Management) Ltd) off the Companies Register exposes a further inconsistency in the Respondent's case. The Respondent's position is predicated on the basis that his company is a genuine trading vehicle which was using the Domain Name for an offering of services. However, while maintaining that he is entitled to use the Domain Name in the manner contended, the Respondent nevertheless decided that the company should be struck off. The Expert accepts that the Respondent was on the receiving end of correspondence from the Complainant requesting him to cease use of the name "VirginFM" and that this is the most likely reason why he made the application for striking off. That noted, the Expert considers it to be a curious action for the Respondent to take particularly where he continued to maintain an entitlement to use the Domain Name. The Respondent's argument that the Domain Name would still be of use for email purposes seems odd to say the least, particularly in the context of the remainder of his business having re-branded to some other name. It seems more likely to the Expert that the Respondent's actions are best explained by the notion that he wished to retain the Domain Name as a lever in further negotiations with the Complainant.

Having considered the Respondent's possible intent at the time of registration, the Expert turns to consider the Respondent's use of the Domain Name. The evidence before the Expert shows that after a period where an "under construction" page was displayed, a website was associated with the Domain Name referring to the Respondent's alleged facilities management company. The only evidence for this use of the Domain Name consists of screenshots provided by the Complainant dated 9 May 2016 and, as noted above, no details have been supplied by the Respondent. The screenshots have the title "Welcome to Virgin Facilities Management" and feature a header with the word "VIRGIN" in very prominent type above the words "FACILITIES MANAGEMENT". The "VIRGIN" element is the same width as the words below and approximately four times the height, thus focusing the visitor on this as the most prominent element. The identity of the business is referred to variously as "Virgin Facilities Management", "part of Sure Management (SureMT)", and "Virgin FM". In these circumstances, the Expert finds the Respondent's position to be somewhat confusing. It appears that rather than completely re-branding via the change of company name to Sure MT Ltd. on 2 July 2015, the Respondent continued to use the Domain Name in association with the trading names "VIRGIN FACILITIES MANAGEMENT" and "Virgin FM" at least until the website was taken down some time after the screenshots were taken.

The Expert has no doubt that the Respondent's use of the Domain Name is likely to confuse people or businesses into believing that there is some connection with the Complainant, due to the prominence of the term "VIRGIN" both within the Domain Name itself and as used on the relative website. As the expert noted in *Virgin Enterprises Limited v. SJT Consultancy Limited* (DRS 013891):-

"...the use of "virgin" in connection with a business activity prevents it being understood as a generic term in everyday use. It is a phrase with trade mark (or brand) significance and a strong association with the Complainant... Given the observations above about the strength of the VIRGIN mark and of the associated goodwill the Expert agrees that any active use by the Respondent of the Domain Names would be likely to confuse the public into the mistaken belief that the Domain Names are associated with the Complainant."

In the Expert's opinion, these comments apply with equal and arguably even greater force in the present case, particularly in light of the fact that the term "VirginFM" is extremely likely to be seen by the public as not only associated with the Complainant, by virtue of its incorporation of the VIRGIN mark, but specifically connected with the Complainant's radio broadcasting activities. It follows that use of the Complainant's mark in this manner for an offering of goods or services could not be regarded as genuine within the meaning of paragraph 4(a)(i)(A) of the Policy.

Furthermore, even if the wording on the website would lead visitors to believe that there was no connection between the operator of that site and the Complainant, as to which the Expert is in some doubt in light of the rather ambiguous copy regarding the identity of the operator and the prominence of the term "VIRGIN" throughout, the Expert is satisfied that the use of the Domain Name gives rise to "initial interest confusion" which can be viewed as a basis for a finding of Abusive Registration in and of itself. "Initial interest confusion" is explained in the Expert's Overview as where, if the name within the domain name cannot sensibly refer to anyone else, "there is bound to be a severe risk that an Internet user guessing the URL for the Complainant's web site will use the domain name... 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"... 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."

With regard to the actual and threatened use of the Domain Name as an email address, the Expert considers that the Complainant correctly refers to the discussion in paragraph 3.3 of the Expert's Overview under the heading "Paragraph 3(a)(ii) concerns confusing use of the domain name. What is meant by confusing use?" in which it is stated:-

"Another potential for confusion (frequently overlooked) is the use of a domain name for the purposes of email. There are many examples of registrants of domain names receiving email traffic intended for the Complainant. See for example Global Projects Management Ltd v Citigroup Inc. (citigroup.co.uk) [2005] EWHC 2663 Ch., and DRS 0114 (penquin.co.uk). Whether evidence of this occurring will lead to a finding of Abusive Registration will, of course, depend to a large extent on the nature of the domain name and the circumstances of its use. If, at the third level, it is a name which is lawfully in use by a number of people (e.g. a surname), the resultant confusion may just be a hazard which the Complainant will have to accept."

In the present case, in terms of actual use of an email address, there is evidence from the screenshot provided by the Complainant that the Respondent has listed an email address "enquiries@virginfm.co.uk" on the website until recently associated with the Domain Name. There is no evidence before the Expert that the Respondent has received any actual email traffic intended for the Complainant. That said, the wording in the above extract refers to the "potential for confusion" and paragraph 3(a)(ii) of the Policy itself encompasses threatened use which is likely to confuse people or businesses as much as an actual use. The Expert is in no doubt that in the present case the threatened use of the Domain Name for business email purposes is as likely to confuse people or businesses into believing that it is associated with the Complainant as is the use for the purposes of a website.

In light of all of the above considerations, the Expert has reached the view that the Domain Name, in the hands of the Respondent, is an Abusive Registration within the meaning of the Policy. While there is no direct evidence of the Respondent's primary purpose in registering the Domain Name, the manner in which the Respondent offered the Domain Name for sale coupled with a significant number of inconsistencies in the Respondent's case render it more likely than not in the Expert's mind that the Respondent registered the Domain Name with intent to sell it to the Complainant in circumstances consistent with the provisions of paragraph 3(a)(i)(A) of the Policy. Even if the Expert were wrong on this point, the Expert also finds that the actual use to which the Domain Name has been put in connection with the Respondent's former website, together with the actual and threatened use regarding a business email address, constitute circumstances which are more than sufficient to meet the requirements of paragraph 3(a)(ii) of the Policy. Furthermore, for the reasons outlined above, the Expert is not satisfied that the Respondent used or made demonstrable preparations to use the Domain Name in connection with a genuine offering of goods and services, such that the Respondent's case in terms of paragraph 4(a)(i)(A) of the Policy must be rejected.

7. Decision

The Expert finds that the Complainant has proved that it has Rights in a name or mark which is similar to the Domain Name and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Expert therefore directs that the Domain Name be transferred to the Complainant.

Signed

Andrew D S Lothian

Dated 10 August, 2016