

# **DISPUTE RESOLUTION SERVICE**

**D00017892**

## **Decision of Independent Expert**

Virgin Enterprises Limited

and

DAVID CRITCHLEY

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

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

Respondent: DAVID CRITCHLEY  
Haresfield  
Stockton Lane  
Grappenhall  
Warrington  
Cheshire  
WA4 3HQ  
United Kingdom

### **2. The Domain Name(s):**

virginbrandlicensing.co.uk  
virgintrademarks.co.uk

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

I can confirm that I am independent of each of the parties. To the best of my knowledge and belief, there are no facts or circumstances, past or present, or that could arise in the foreseeable future, that need be disclosed as being of such a nature as to call in to question my independence in the eyes of one or both of the parties.

The following steps have taken place in this matter:

24 August 2016 14:35 Dispute received  
25 August 2016 10:09 Complaint validated  
25 August 2016 10:13 Notification of complaint sent to parties  
14 September 2016 02:30 Response reminder sent  
16 September 2016 12:27 Response received  
16 September 2016 12:28 Notification of response sent to parties  
21 September 2016 02:30 Reply reminder sent  
22 September 2016 17:45 Reply received  
22 September 2016 17:45 Notification of reply sent to parties  
27 September 2016 12:07 Mediator appointed  
29 September 2016 16:20 Mediation started  
19 October 2016 08:33 Mediation failed  
19 October 2016 08:34 Close of mediation documents sent  
01 November 2016 15:29 Expert decision payment received

### **4. Factual Background**

The following facts appear from the documents submitted to me and which I find as proven and which form the basis of my Decision:

- i. The Complainant is part of the larger Virgin Group of companies and is responsible for holding, licensing and administering the Virgin Group's trade mark portfolio.
- ii. The Virgin Group was originally set up in or about 1970 as a company selling records by mail, but has since expanded into a wide range of sectors, including transportation and travel, mobile communications, media (including the internet, television and telephone), music, radio, fitness and financial services.
- iii. The Complainant holds a large number of trade marks, of which a prominent element is the word "VIRGIN", whether in a plain or stylised format, and often accompanied by some further descriptive word or words indicating the nature of the business being conducted by that business in the Virgin Group.
- iv. The Complainant maintains the Virgin Group's portfolio of trade marks and issues guidelines for correct usage of trade marks that it owns, which it supervises and enforces.
- v. The Complainant has become a well known and easily recognisable brand for use of the basic element "VIRGIN" combined with some further element descriptive of the particular business being conducted e.g. "VIRGIN TRAVEL".
- vi. The Respondent registered the Domain Names on 22 August 2014 and on 21 January 2016 incorporated two companies, Virgin Brands Limited and Virgin Trademarks Limited, in the UK.

- vii. The Domain Names do not appear to be carrying out any business and the pages to which they point appear to be holding pages, though with some advertisements present.

## **5. Parties' Contentions**

The Complainant in its Complaint makes the following submissions:

- i. The Complainant is part of a Group of companies established in 1970, and has since become famous for a wide variety of activities in the consumer sector.
- ii. The "VIRGIN" brand is protected by trade marks worldwide and is actively protected by maintained by the Complainant.
- iii. The "VIRGIN" brand is well known and is among the most respected and recognised brands in the world.
- iv. The Domain Names are identical with or similar to the Complainant's Rights, after leaving out the ".co.uk" and the addition of the further elements, "trademarks" and "brandlicensing".
- v. The Domain Names are Abusive Registrations because they were registered or otherwise acquired by the Respondent as blocking registrations and/or unfairly disrupting the Complainant's business, and further or alternatively the Respondent is using the Domain Names in a way which is likely to confuse people or business into believing the Domain names are registered to, operated or authorised by, or otherwise connected with the Complainant.
- vi. The Respondent has incorporated two companies with names identical with the Domain Names, although the web pages to which the Domain Names point do not as of yet show any business usage.

The Respondent in his Response makes the following submissions<sup>1</sup>:

- i. The Domain Names were registered to be used with limited companies in the UK.
- ii. They are going to be used actively when the companies begin trading in unused and unexploited trade marks, brands and patents.
- iii. The word, "VIRGIN" is being used in a descriptive capacity to denote the unexploited nature of the trade marks, brands and patents.

The Complainant in its Reply makes the following submissions:

- i. The Respondent has confirmed that the Domain Names were intended to be used in conjunction with the Respondent's two limited companies' respective businesses.
- ii. The use of "VIRGIN" cannot be purely descriptive as it is used in conjunction with further elements, "trade marks" and "brand licensing".
- iii. The Respondent has failed to produce evidence to illustrate his intended usage.

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<sup>1</sup> The Complainant takes the point in its Reply that the Respondent's Response does not in fact comply with paragraph 5 of the DRS Procedure: this is correct. In particular, it does not contain a statement of truth as required by paragraph 5(c)(v). The letter does not seem to be complete, omitting references such as date and addressee and it is not even signed. I have recited it here and take such account of it as I can, given its brevity and lack of detail.

## 6. Discussions and Findings

Any complainant in the Nominet DRS procedure must prove, on the balance of probabilities, that he has Rights and that the respondent's registration or continued registration of a domain name, is an "Abusive Registration". I shall look at each of these concepts in order.

### ***Rights***

"Rights" are defined in the DRS Policy as "*rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning*".

Under paragraph 2(a) of the DRS Policy, a complainant must show that it "*has Rights in respect of a name or mark which is identical or similar to the Domain Name*".

Where there are registered trade marks demonstrating the existence of Rights, it is relatively simple to show the existence of those trade marks by exhibiting a copy of the relevant certificate. As the Experts Overview<sup>2</sup> states at paragraph 2.2,

*"... Bare assertions will rarely suffice. The Expert needs to be persuaded on the balance of probabilities that relevant rights exist. ..."*

*"If the right arises out of a trade mark or service mark registration, a copy of the registration certificate or print out of the registry database will suffice ..."*

The Complainant has included a lengthy list of trade marks in Annex 1 to its Complaint, and further has included in Annex 3 some examples of trade marks held in respect of "VIRGIN" across a wide range of classes.

The Rights asserted by the Complainant are included in their entirety in the Domain Names. I accept that the suffix, ".co.uk" can be ignored for this purpose. I also accept the Complainant's submissions to the effect that the descriptive words following "VIRGIN" can also be ignored. I further accept that the Complainant commonly uses the word "VIRGIN" with some further descriptive word or words intended to indicate the nature of the business being conducted using the "VIRGIN" brand. In my view, the Rights asserted by the Complainant are similar to the Domain Names.

Based on the evidence and submissions before me, I find that the Complainant has shown that it has Rights as required by the DRS Policy.

### ***Abusive Registration***

The DRS Policy defines an Abusive Registration as a Domain Name "*which either:*

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<sup>2</sup> The Experts Overview is a distillation of Experts' Decisions given under the Nominet DRS Policy and provides a helpful summary of how the DRS Policy is applied in practice.

- 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;”*

The Complainant has relied on various grounds contained in the DRS Policy to support its contention that the Domain Names are Abusive Registrations and I shall deal with them in turn.

**Paragraph 3(a)(i)(B) – registered by the Respondent as blocking registrations**

The full text of the DRS Policy reads:

*“A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*

*Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

...

*B. as a blocking registration against a name or mark in which the Complainant has Rights;”*

The relevant paragraph directs me to reviews the circumstances of the Respondent's registration of the Domain Names. From those circumstances, I have to find that the Respondent registered the Domain Names “primarily” as blocking registrations.

In fact, I have very little information about the circumstances of registration. The evidence appears to show that the Respondent has a number of business interests represented by a small number of limited companies of which he is a director. However, there is little, if anything, to show that the Respondent was pursuing some sort of policy of registering Domain Names in general so as to block third parties from using domain names that he personally had registered. There is no evidence to show that he did so on this particular occasion and there is nothing in the circumstances to show that he did: indeed, the Respondent appears to have registered these Domain Names in the belief, whether rightly or wrongly, that he would be free to use them in businesses he was planning to establish and operate.

There is nothing to show that the Respondent somehow registered the Domain Names as a means of preventing the Complainant subsequently registering them.

From the limited material before me on the subject, the Complainant has not shown on the balance of probabilities that the Domain Names were registered “primarily” as blocking registrations.

**Paragraph 3(a)(i)(C) – registered for the purpose of unfairly disrupting the Complainant’s business**

The full text of the DRS Policy reads:

*“A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*

*Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:*

...

*C. for the purpose of unfairly disrupting the business of the Complainant;”*

Again, the paragraph directs me to have regard to the circumstances surrounding the Respondent’s registration of the Domain Names. As I stated above, there is relatively little evidence of the circumstances in which the Respondent registered the Domain Names. From what little evidence there is, I accept that the Respondent registered the Domain Names with the intention, rightly or wrongly, of using them in conjunction with businesses he was intending to establish and operate. I accept that he did so without regard to any possible objection that the Complainant might have on the basis of its Rights.

Based on the limited material before me on the subject, the Complainant has not shown on the balance of probabilities that the Domain Names were registered “primarily” with an intention of unfairly disrupting the Complainant’s business.

**Paragraph 3(a)(ii) – using the Domain Names in a way which is likely to confuse people or businesses into believing the Domain names are registered to, operated or authorised by, or otherwise connected with the Complainant**

The full text of the DRS Policy reads:

*“A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:*

...

*(ii) circumstances indicating that the Respondent is using or threatening to use the Domain Name in a way which has confused or is likely to confuse people or businesses into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant;”*

I have no evidence of actual confusion in front of me. There is also no evidence of actual usage of the Domain Names for business purposes.

The question then becomes whether I find that the threatened usage is likely to cause confusion with the result that people or businesses believe that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant.

The word, “threatened” might suggest some sort of menacing demeanour adopted by the Respondent. The Complainant has in fact complained of little contact from the Respondent, even in response to its letters to him. The Respondent has not adopted any sort of menacing or threatening position.

However, I think that the paragraph is aimed at “threatening” in the sense of “intending”. From the Respondent’s brief communications, it seems clear to me that he fully intended at the time of registration, and still intends as of today, to use the Domain Names in connection with businesses he intends to establish and operate. Indeed, he has incorporated two companies with names identical to the Domain Names.

Is this likely to cause confusion with the result required by the paragraph I quoted above from the DRS Policy? In my view, it is. The Complainant’s Rights are extremely well known and have been for some decades. It is unlikely that the Respondent was entirely unaware of them at the time he registered the Domain Names. Given that the Complainant’s Rights are commonly used in conjunction with another word or words describing the particular business being conducted by the Complainant (e.g. Virgin Active, Virgin Atlantic, Virgin Rubber Technologies, Virgin Trains and so on – see Annex 1 to the Complaint), it is very likely in my view that people or businesses would believe that the Domain Names were either registered by the Complainant or were in some way licensed or authorised by it.

On the balance of probabilities, I find that the Complainant has made out this ground.

### **Countervailing considerations**

While the Respondent has not specifically raised any matters, I have also had regard to paragraph 4 of the DRS Policy to see whether there were any reasons why, notwithstanding my findings above, the Domain Names are not in fact Abusive Registrations.

The most relevant consideration is to be found at paragraph 4(a)(ii) – are the Domain Names generic or descriptive and is the Respondent making fair use of them?

It is correct that “VIRGIN” is normally used to denote someone who is sexually inexperienced; more rarely it is used to denote someone or something inexperienced or untested in other ways (one such use is “virgin territory”). People rarely describe themselves as “virgins” in a particular area other than in sexual relations, except perhaps for humorous effect.

In my view, most people would not think of the Respondent’s intended business use as being for e.g. a “virgin” trade mark in the sense of a trade mark which had never been used, but would rather think of some sort of connection with the Complainant.

I therefore find that the use made by the Respondent of the Complainant’s Rights is not descriptive or generic, and the Respondent would not be making a fair use of the Domain Names if they were used in businesses licensing or otherwise dealing in unused trade marks, brands and patents.

Having carefully considered the grounds set out in paragraph 4 of the DRS Policy and generally, I find that there are no reasons not to conclude that the Domain Names are Abusive Registrations.

## **7. Decision**

I find that the Complainant has Rights similar to the Domain Names and that the registration of the Domain Names by the Respondent is an Abusive Registration.

I direct that the Domain Names be transferred to the Complainant.

**Signed Richard Stephens**

**Dated 20 November 2016**