

DISPUTE RESOLUTION SERVICE**D00019823****Decision of Independent Expert**

Virgin Enterprises Limited

and

Virgin Media Cloud

1. The Parties:

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

Respondent: Virgin Media Cloud
96 Gloucester Terrace
London
W2 6HP
United Kingdom

2. The Domain Names:

<virginglobalmedia.co.uk>
<vmediacloud.co.uk>

3. Procedural History:

On 05 February 2018 the Dispute was received. The complaint was validated on 06 February and notification of the complaint was sent to the parties. On 23 February a Response reminder was sent but by the deadline on 27 February no Response had been received and notification of this was sent to both parties. On 28 February a non-standard submission was received by Nominet from the Respondent. On 12 March a full fee reminder was sent and an Expert decision payment was received. The Expert – Tim Brown – was appointed on 16 March.

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 they might be of a such a nature as to call in to question my independence in the eyes of one or both of the parties.

4. Factual Background

The Complainant is a company incorporated in England and Wales with company number 01073929 and is a wholly owned subsidiary of a group of companies known collectively as 'the Virgin Group'. The Complainant is responsible for the management of the Virgin Group's intellectual property, including its registered trade marks.

The Complainant was established in 1970 and is now engaged in a diverse range of business sectors including travel and leisure, telecoms and media, music and entertainment, financial services and health and wellness. The Complainant has approximately 53 million customers worldwide and employs more than 69,000 people in 35 countries. Its annual revenue is approximately GBP£16.6 billion.

The Respondent is an entity called "Virgin Media Cloud" which appears to be the former name of a limited company operated by an individual named Mr Ervin Remus Radosavlevici.

<virginglobalmedia.co.uk> was registered on 27 November 2017 and <vmediacloud.co.uk> was registered on 09 February 2017. At the time of this decision, neither domain name resolved to an active web site.

The Complainant has previously brought proceedings under the DRS against domain names registered by Mr Radosavlevici in his personal name rather than in the name of "Virgin Media Cloud" (the Respondent in the present matter). The previous dispute related to the domain names <virgincloud.co.uk> and <virginmediacloud.co.uk>. [**DRS 00018647** and **DRS 00018649**]¹ In that case the Expert ordered the transfer of both domain names to the Complainant.

5. Parties' Contentions

The Parties' contentions are as follows:

5.1 Complainant – Rights

The Complainant maintains a worldwide registered trade mark portfolio for the VIRGIN and related trade marks which it licences to companies both within and outside the Virgin Group. These include European Union Trade Mark No. EU011991882 registered on 10 December 2013 for the word mark VIRGIN; United Kingdom Trade Mark No. UK00003100686 registered on 28 August 2015, for the word mark VIRGIN MEDIA; and United Kingdom Trade Mark No. UK00002638445 registered on 25 January 2013, for the VIRGIN 'V' logo. Extracts from the relevant trade mark databases have been exhibited by the Complainant.

In respect of <virginglobalmedia.co.uk>, the Complainant says that it is similar to its VIRGIN MEDIA mark and that the additional word "global" is generic and descriptive and does not prevent the Domain Name from being identical or similar to the Complainant's VIRGIN marks. Additionally, the Complainant says that the word 'global' is likely to be perceived as indicating the geographic reach of the Complainant's business.

¹ Two disputes were consolidated during the early procedural stages

Turning to <vmediacloud.co.uk>, the Complainant contends that there are numerous examples of where the letter 'V' has been used in the place of the VIRGIN name to indicate a connection with the Virgin Group. Specifically, the letter 'V' was used in the name of the popular music festival 'V Festival' which, until October 2017 when the festival announced its closure, was sponsored by Virgin Media. Additionally, the letter 'V' is also used by the Complainant's group in association with its set-top box for its Virgin TV service, initially launched as the 'V+' box.

In terms of the additional words "Media Cloud", the Complainant notes that until 8 March 2016, Virgin Media operated a service under the name "Virgin Media Cloud". Various screenshots have been exhibited to demonstrate its previous use. The Complainant avers that the 'V' together with the words "Media Cloud" perpetuates the likelihood of association between <vmediacloud.co.uk> and the Complainant's VIRGIN marks.

5.2 Complainant – Abusive Registration

By way of background, the Complainant narrates that it has previously dealt with the Respondent in connection with his registration of a UK private limited company under the company name 'Virgin Media Cloud Ltd' (company no. 10276057). The Respondent was ordered to change its name in accordance with section 73(1) of the Companies Act 2006. Furthermore, the Complainant notes it has taken action in relation to the Respondent's registration of a number of domain names incorporating the VIRGIN and VIRGIN MEDIA names.

The domain name disputes carried out under the DRS [**D00018647** & **D00018649**], as noted in the Factual Background above, related to the domain names <virginmediacloud.co.uk> and <virgincloud.co.uk>. The dispute carried out under the UDRP² [**D2017-0505**] related to the domain names <virginmediacloud.com>, <virginmedia.cloud> and <virginmedia.host>. In both cases the expert / panellist ordered the transfer of the related domain names.

Copies of these domain name disputes and the Company Names Tribunal decision have been exhibited by the Complainant.

The Complainant says that, given the Complainant's past dealings with the Respondent, it is reasonable to infer that the Domain Names were registered by the Respondent for the purpose of unfairly disrupting the business of the Complainant or its associated group companies. Equally, the Complainant contends that the Respondent was aware of the Complainant's reputation in the VIRGIN and VIRGIN MEDIA names at the time of the Domain Names' registration.

The Complainant avers that given the strength of the VIRGIN brand and the fact that the Domain Names are descriptive of services undertaken by its group company Virgin Media, there is a strong likelihood that the use of the VIRGIN and VIRGIN MEDIA names together with the word "global" in the <virginglobalmedia.co.uk> domain name, and the use of the 'V' together with the words 'Media Cloud' in the <vmediacloud.co.uk> domain name, will confuse the public into the mistaken belief that both Domain Names are associated with the Complainant.

The Complainant says that while the Domain Names are not currently being used by the Respondent to host active websites, there is a clear risk that any subsequent website content commissioned or designed by the Respondent may imply a connection with the Complainant or its group companies. The Complainant contends that the Respondent intends to

² The Uniform Domain Name Dispute Resolution Policy (UDRP) is a dispute mechanism, similar to the DRS, which relates to generic top-level domain names such as .com.

appropriate the VIRGIN name in some form or another, as evidenced by his attempts to register domain names and company names incorporating the Complainant's brands.

The Complainant contends that given the factual background the Respondent is engaged in a pattern of registrations incorporating well-known marks in which the Respondent has no apparent rights and it says that the Domain Names are part of that pattern.

5.3 Respondent – non-standard submission

As noted in the Procedural History above, the deadline by which the Respondent could respond to the Complaint was 27 February. Deadlines under the DRS are set out in the Policy and I see from the case file that both Parties were correctly informed of these dates by Nominet in its correspondence with the Parties.

The DRS is designed to be a simple, straightforward procedure and this aim is not facilitated by lengthy drawn-out proceedings, hence the need for certain deadlines. However, in the present matter the Respondent's Response fell only one day after the deadline and the Complainant has not raised any specific objections to the Respondent's correspondence being considered. That said, the Respondent has not followed the proper procedures, of which the most important is including the declaration noted in paragraph 7.3.6 of the Policy with any submissions. The required declaration states:

The information contained in this response is to the best of the Respondent's knowledge true and complete and the matters stated in this response comply with the Policy and applicable law.

The Respondent has not done this and while I am prepared to accept his Response, I have accorded it the lesser weight of a statement unsupported by the declaration above.

The Response is short and I have copied the salient part of it below:

I am writing to you to raise an issue about Domain registrar at Nominet on July 26th, 2017.

Have suspended the website damages to my company and transfer without permission away from my account.

The domains it's under company register and registered By Ervin Remus Radosavlevici , Virgin Media Cloud Ltd , 10276057.

Give back the domains and Pay the damages for transferred without permission the domains virginmediacloud.co.uk , virgincloud.co.uk . and suspended the website this make late the business and losing access with the partners register with the email domain.

6. Discussions and Findings

According to paragraph 2 of the Policy a Respondent must submit to proceedings under the DRS if a Complainant asserts 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. The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.

I will therefore discuss each of these elements in turn.

6.1 Rights

The Complainant has established that it has extensive Rights in the terms VIRGIN and VIRGIN MEDIA. Equally, it has set out to my satisfaction that it has registered rights in the letter "V" through its related figurative mark or, in the alternative, unregistered rights through its use of the letter in association with various commercial endeavours, including the "V Festival" and its "V+" device.

The Domain Names therefore only materially differ from the Complainant's marks by the addition of the words "cloud" and "global". I find that these words are entirely generic and are indeed, especially in the case of "cloud", descriptive of the Complainant's services.

As is usual in DRS proceedings, the .co.uk suffixes are only required for technical reasons and can be ignored for the purposes of comparing the Complainant's marks to the Domain Names.

I therefore find that the Complainant has Rights in respect of a name or mark which is similar to the Domain Names.

6.2 Abusive Registration

As noted in the Factual background above, the Respondent is given as "Virgin Media Cloud", a former name of a limited company operated by the Respondent. The Complainant has set out that it took action against the Respondent to have this company name changed and I note the company is now named "10276057 Ltd".

The first question is therefore whether the Respondent's company, originally named "Virgin Media Cloud", confers any legitimacy on the Respondent and his registration of the Domain Names. In my view it does not. Registering a limited company in the United Kingdom is straightforward and inexpensive and is not evidence, in and of itself, that someone has made a *bona fide* offering of goods and services under that name. If that were not the case, the DRS could be simply circumvented by registering a company name that was identical or similar to a disputed domain name. The mere existence of a company name does not prevent a finding of Abusive Registration.

Turning to the Domain Names themselves, paragraph 3.3 of the Expert's Overview³ concerns what is meant by confusing use under the Policy and discusses a species of confusion known as "initial interest confusion":

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. Similarly, 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 for that purpose.

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

³ The Expert's Overview version 3 is a document which discusses common issues that arise under the DRS. It can be found on Nominet's website.

connected with the Complainant, the visitor has been deceived. Having drawn the visitor to the site, the visitor may well be faced with an unauthorised tribute or criticism site (usually the latter) devoted to the Complainant; or a commercial web site, which may or may not advertise goods or services similar to those produced by the Complainant. Either way, the visitor will have been sucked in/deceived by the domain name.

As set out above, the Domain Names are clearly similar to the Complainant's marks and, in my view, web users who find the Domain Names through a search engine or who might type them into their browser would expect to find a website operated by the Complainant rather than by the Respondent. In these circumstances the Domain Names undoubtedly take unfair advantage of the Complainant's Rights through the kind of initial interest confusion described in the Overview.

That the Domain Names do not currently resolve to active websites does not negate the potential for confusion; by the time web users have found their way to any website (whether operational or not) they will have already been sucked in or deceived by the Domain Names themselves.

I therefore find that on the balance of probabilities there are circumstances indicating that the Respondent is using or threatening to use the Domain Names in a way which has confused or is likely to confuse people or businesses into believing that the Domain Names are registered to, operated or authorised by, or otherwise connected with the Complainant per paragraph 5.1.2 of the Policy.

Based on the submissions and evidence presented by the Parties, I find that the Domain Names in the hands of the Respondent are Abusive registrations

7. Decision

Having determined that the Complainant has Rights in respect marks that are similar to the Domain Names and that the Domain Names, in the hands of the Respondent, are Abusive registrations, I order that the Domain Names are transferred to the Complainant.

Signed
Tim Brown

Dated 16 March 2018