

DISPUTE RESOLUTION SERVICE

D00013790

Decision of Independent Expert

Virgin Enterprises Limited

and

Mr Graham Kenny

1. The Parties:

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

Respondent: Mr Graham Kenny
The Forum
Barnfield Road
Exeter
Devon
EX1 1QR
United Kingdom

2. The Domain Name(s):

virginmoney-ppi-reclaim.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 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.

28 January 2014 12:22 Dispute received
28 January 2014 13:08 Complaint validated
28 January 2014 13:11 Notification of complaint sent to parties
14 February 2014 01:30 Response reminder sent
18 February 2014 10:00 Response received
18 February 2014 10:01 Notification of response sent to parties
21 February 2014 01:30 Reply reminder sent
26 February 2014 08:31 Reply received
26 February 2014 08:31 Notification of reply sent to parties
26 February 2014 09:37 Mediator appointed
03 March 2014 16:11 Mediation started
09 May 2014 12:48 Mediation failed
09 May 2014 12:49 Close of mediation documents sent
19 May 2014 10:33 Expert decision payment received
21 May 2014 Keith Gymer appointed as Expert with effect from 27 May 2014.

4. Factual Background

The Complainant, Virgin Enterprises Limited, is the company responsible for the ownership, management and protection of intellectual property for the Virgin Group of companies, originally founded under the VIRGIN name by Richard Branson. The Virgin Group includes a financial services business, which trades as VIRGIN MONEY.

The Respondent, Mr Graham Kenny, operates a business My Claim Solved Limited, which offers services to people who may have claims against financial services businesses, particularly in respect of alleged mis-selling of payment protection insurance ("PPI").

The Nominet WHOIS records show that the disputed Domain Name, virginmoney-ppi-reclaim.co.uk was registered on 19 July 2012.

The Domain Name has been used for a website operated by the Respondent to invite clients who may have been mis-sold PPI to pursue claims through the Respondent's business, My Claim Solved Limited.

5. Parties' Contentions

Complainant

The Complainant notes that the VIRGIN business was founded in 1970 when Richard Branson began selling music records under the Virgin name and rapidly expanded to offer a wider range of consumer facing goods and services.

The Complainant provided a substantial Witness Statement of Victoria Wisener, in-house trade mark attorney for the Complainant, which outlines the very broad range of activities of the Virgin Group and the extent of its operations. The Witness Statement contains information to establish the well-known nature of the VIRGIN mark and to demonstrate the extent of its use of the VIRGIN mark.

It is claimed that VIRGIN has now become a leading global brand and household name, which is recognised as standing for value for money, quality, innovation, fun and a sense of competitive challenge. The power of the VIRGIN name, Richard Branson's personal reputation, and the Virgin management style are all factors, which are alleged to contribute towards the Virgin Group's unrivalled reputation.

Evidence is provided of the rating of VIRGIN in brand surveys. It is stated that Virgin has been consistently ranked in the top ten of most successful, innovative, admired and respected brands by independent survey companies. A global "Rep Trak" reputation study is cited, where the Virgin Group ranked at 14th and it is said that any company within the top 50 has demonstrated that, "in the eyes of the British public, they are perceived as having a good reputation based on high levels of trust, admiration, esteem and good feeling".

The Complainant asserts that the VIRGIN mark is clearly inherently very strong and distinctive and the mark has quite clearly acquired an enhanced distinctive character through the high profile use, which has been made on a significant global scale.

The Complainant claims to own a significant portfolio of trade mark registrations for the VIRGIN and VIRGIN MONEY marks. It provides a private schedule which lists various UK and CTM applications and registrations for VIRGIN and VIRGIN MONEY marks. These registrations are said to be valid, subsisting and in full force and effect.

The Virgin Group is said to have been "a major player in the UK in the financial services industry since as early as 1995".

The Complainant asserts that its earlier rights are confusingly similar to the domain name virginmoney-ppi-reclaim.co.uk, and that the addition of the words ppi-reclaim add nothing from a brand perspective. A Google search for the elements "VIRGIN" "MONEY" "PPI" and "RECLAIM" is presented as evidence that this term would be closely associated with the Complainant.

Referring to the claimed nature of the reputation and the rights owned by the Complainant in the VIRGIN and VIRGIN MONEY trade marks and brands, in relation to financial services, it is alleged that any relevant consumer seeing the name virginmoney-ppi-reclaim.co.uk would assume that this relates to a service provided by the Complainant and that it is a domain and site owned and provided by the Complainant. As such this name is confusingly similar to the Complainant's rights for the purposes of the Dispute Resolution Service Policy, and the Complainant asserts that it has established that it owns relevant rights in accordance with paragraph 2a.i of the Dispute Resolution Service Policy.

The Complainant submits that the domain name in question is an Abusive Registration in line with the Nominet DRS Policy Paragraphs 3a.i.A, 3a.i.B, 3a.i.C, 3a.ii and 3a.iii in that:

The Complainant submits that the domain was registered and has been used in a manner which has taken unfair advantage of and has been unfairly detrimental to the Complainant's rights. There is absolutely no legitimate reason to register the domain name virginmoney-ppi-reclaim.co.uk except to benefit in some way from the Complainant's well known VIRGIN mark by either attempting to sell, rent or otherwise transfer the Domain to the Complainant, or by using it to refer to the Complainant, and/or to interrupt the Complainant's business in the UK or block registration of the domain.

On originally becoming aware of the existence of this domain name, the Complainant determined that the domain resolved to a live site, a screenshot of which was provided. It is alleged that this site has been devised to look and feel like the site of Virgin Money and that anyone arriving at this site would quite likely assume that it was a legitimate site of Virgin Money. In the Complainant's opinion, the site was quite clearly being used to mislead customers into believing they were arriving at a site of Virgin Money, or at least being used to confuse people or businesses into believing that the Domain Name is connected with the Complainant.

The Complainant refers to three earlier decisions in relation to the Respondent's domain registrations for natwest-ppi-reclaim.co.uk, barclays-ppi-reclaim.co.uk and a variety of domains referring similarly to financial services businesses owned by Lloyds Banking Group Plc (Decisions DRS 11286, DRS 11475 & DRS 12477). These prior decisions dating from May, July and September 2013 are said to be on all fours with the present dispute, and in all cases the respective domain names were held to be Abusive Registrations. The Complainant therefore draws attention to the presumption of Abusive Registration applicable under Paragraph 3c of the DRS Policy 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 present Complaint was filed.

The Complainant submits that the Domain Name is, in the hands of the Respondent, an Abusive Registration and requests that it should be transferred to the Complainant.

Respondent

In its Response, the Respondent says that the Complainant does not refer to any specific aspect of the Domain Name and corresponding website, which it contends infringes its marks or is otherwise abusive. In the Respondent's submission, this is of particular relevance because the Complainant seeks to rely upon the decisions of DRS 11286, DRS 11475 and DRS 12477 in establishing a presumption of abusive registration, but makes no reference to the more recent decisions of DRS 12328 (barclaycard-ppi-reclaim.co.uk) and DRS 12592 (marksandspencer-ppi-reclaim.co.uk).

The Respondent interprets the first of these latter two decisions as having precisely identified the steps that the Respondent should take in order to ensure that similar registrations were *not* abusive. The Respondent says it took all of those steps and, in consequence, the subsequent complaint of Marks and Spencer Plc in DRS 12592 was rejected, the Expert in that case being satisfied that nothing in the nature of the domain name marksandspencer-ppi-reclaim.co.uk or its website was abusive.

In consequence of the DRS 12328 decision, the Respondent claims to have altered all of his other similarly formed domain names and websites to accord with the DRS 12328 Expert's requirements. All sites including virginmoney-ppi-reclaim.co.uk are said to accord with that Expert's decision. The Respondent asserts that this more recent precedent overrides the presumption, which the Complainant seeks to apply.

Under the DRS policy the Complainant is obliged to establish that it has rights identical or similar to that which is the subject of the complaint. It is submitted, on behalf of the Respondent, that the Complainant has failed to do so. The Complainant claims to own a significant portfolio of trademark registrations for VIRGIN and VIRGIN MONEY, and the schedule referred to in the Complaint lists alleged trade mark registrations for Virgin Money dating from 1998, 2005, 2012 and 2013. However, copies of those registrations are not provided. It is insufficient merely to state that VIRGIN is a well-established brand. The Domain Name and website in dispute are by specific reference to Virgin Money. This issue is important given that the Complainant does not specify whether the marks concerned are simply a name or a logo or other form of brand. According to the Respondent, the Domain Name and website in question do not, for example, contain any logo belonging or relating to VIRGIN or VIRGIN MONEY, and does not use any colour scheme that may have been adopted by Virgin or Virgin Money.

The Complaint asserts that the Domain Name is an Abusive Registration as there are alleged to be circumstances indicating that the Respondent has registered or acquired the Domain Name primarily for selling it to the Complainant for valuable consideration. No evidence has been given in the Complaint, in the Witness Statement or in any of the attached documentation setting out such circumstances. This is simply a bald and unsubstantiated assertion. In fact the

Respondent has not on any occasion sold a domain name or site to a Complainant for valuable consideration or otherwise.

The Complainant also asserted that the Domain Name is either a blocking registration or aimed at unfairly disrupting the Complainant's business. Again no evidence is advanced by the Complainant to substantiate this. No evidence has been adduced that the Complainant has sought to register a domain name, identical or similar to that used by the Respondent. No approach has been made by the Complainant, or its representatives, in that regard. No complaint has been made directly to the Respondent of disruption, unfair or otherwise.

In the Respondent's view, the businesses conducted by the Complainant and the Respondent are distinctly different and do not in anyway compete with each other. Through the long history set out in the Statement of Victoria Wisener it is clear that the Complainant in its many guises does not and never has provided a service seeking or claiming compensation for the mis-selling of financial products. The Respondent's business solely concerns the provision of such a service, and that has been the case throughout the previous DRS proceedings and has been accepted and acknowledged in each and every decision referred to in the Complaint and this Response.

It is commonly known that all if not the vast majority of financial services organisations selling and advising upon the sale of financial products have met and are continuing to meet claims for the mis-selling of those products. Payment protection insurance is perhaps the most prominent of these, the majority of large financial institutions expressly setting aside sums to meet such compensation claims. This is therefore a perfectly legitimate area of trade, which the Respondent has conducted through My Claims Solved Limited for several years and continues to do so. Indeed the Respondent's business is registered with, authorised and monitored by the Ministry of Justice, that registration being renewed on a 12-monthly basis.

The Domain Name and site do specifically contain the words 'VIRGIN MONEY'. The purpose of doing so is not in any way to undermine or disrupt the Complainant's business, but with a view to minimising confusion on the part of the general public. This is not a site for those members of the public seeking compensation for the mis-selling of a product by, for example, Standard Life or Scottish Widows. This site and service specifically concern the mis-selling of financial products by Virgin Money. The insertion of 'ppi-reclaim' further specifically identifies the genuine service offered by the Respondent to the general public. In so far as the Complainant asserts that any aspect of this is unfair it is in essence asserting that it is unfair to provide a service to the general public to assist them in seeking compensation in respect of unlawful acts by the Complainant. For such grounds to succeed the Complainant would in effect be achieving an unfair restraint of legitimate trade.

The Complainant also states that it can demonstrate a pattern of Abusive Registrations, but it does not then go on to do so either in the Complaint, the Witness Statement or the corresponding documentation. Yet again this is a bare

assertion. The Respondent does possess a number of domain names and corresponding sites for the claiming of compensation and of premiums arising from mis-selling by a range of financial services organisations including banks and building societies. Each and every site is identical to the site now complained of save for replacing 'VIRGIN MONEY' with the name of the organisation mis-selling products. Each and every site concerns a legitimate business for the reclaiming of compensation and premiums for mis-selling. Each such business is registered with the Ministry of Justice as aforesaid and thereby fully approved. The purpose of the reference to the name in each case has been set out above and is aimed at avoiding confusion and specifically identifying the service provided.

It is submitted that this is a fundamental issue. The Complainant relies upon three previous adverse decisions, all of which were founded upon complaints of abusive registration likely to cause confusion to the general public. It is accepted that if the domain name in question and the corresponding site were of a similar design and content to that which were the subject of decisions DRS 11286, DRS 11475 and DRS 12477, then inevitably it would be construed as an abuse of registration and transfer would be ordered.

However the present website and Domain Name are said to be distinctly different from those referred to in the three earlier DRS proceedings. The Respondent claims to have followed the recommendations of the Expert in DRS 12328 and asserts that the website is now analogous with the formal considered acceptable in DRS 12592, a complaint brought by Marks and Spencer Plc.

It should be stressed that the Complainant does not assert unfair competition and produces no evidence of actual confusion on the part of the general public. Instead the Complaint is more in the nature of a theoretical confusion and abuse in relation to two businesses which do not compete with each other. The Respondent and the company My Claims Solved Limited have not encountered a single event of confusion on the part of any member of the general public with regard to the service that it offers or with regard to the fact that My Claims Solved Limited has no connection with Virgin Money nor is it part of that organisation.

At the time of three earlier adverse decisions DRS 11286, DRS 11475 and DRS 12477, the websites corresponding to the domain names complained of in those cases incorporated the logo of the companies in question and a colour scheme which could have been construed as similar to those of the companies in question. Furthermore no disclaimer was set out on the site and the company providing the services offered on the sites was not adequately identified.

The Respondent did not wish to in any way infringe the trademarks or other rights of the companies to which the sites and domain names referred. He wished My Claims Solved Limited to be able to continue to pursue its entirely legitimate and state registered service.

In consequence, during the course of the various DRS complaints the Respondent proceeded to take steps to vary the domain names and sites in order to take on board each complaint and each Expert's decision. That has continued to be the case through the process of DRS 12328 and DRS 12592 to the end result of approval of the Respondent's domain name and site by the Expert in that latter matter.

According to the Respondent, the specific features of the Domain Name and website in the current dispute which correspond with those features which were approved in the Marks and Spencer case DRS 12592 are:-

- i. The site does not contain Virgin Money's or Virgin's logo.
- ii. Neither the domain name nor the site has a colour scheme identical or similar to that used by Virgin or Virgin Money
- iii. My Claims Solved, together with its logo and distinctive colour scheme, are obviously set out on the site and the name and details of the company are set out in the print below this.
- iv. A disclaimer is inserted specifically stating that My Claims Solved Limited has no connection with Virgin Money.
- v. The print of the disclaimer and the font used for the name of the Respondent's company is set out in bold and easily identifiable, indeed obvious, size and prominence.

All of the aforesaid features accord with the findings of the Expert in DRS 12328, forming the basis of the approval of the domain name and site in DRS 12592. It is perhaps ironic that the same changes were made to the site and domain name complained of in DRS 12477 and were submitted as part of the DRS process as a paragraph 13(b) submission. In DRS12477 the Expert declined to take into account that paragraph 13(b) submission. Had the expert done so, the Respondent claims that Expert would have approved the domain name and website in precisely the same way that these were approved in DRS 12592. The paragraph 13(b) submission in that matter was made in good time. At the time of that submission the Respondent changed every domain name and site in exactly the same manner and that has remained the case.

The Expert in DRS 12592 made specific findings in the paragraphs cited above, which it is submitted are binding or at least strongly informative for the purposes of this present matter, the two sites being identical in design, font, content, colour and the absence of any logo.

The Expert's determination in the aforesaid DRS complaint from Marks and Spencer Plc concluded that the domain name was not an Abusive Registration. That Expert was considering a domain name and website of identical form and design and complaints similar to those brought by Virgin Money in the present matter.

The Respondent seeks dismissal of the present Complaint on the same basis.

Complainant's Reply

The Complainant made a number of observations in reply, but provided no additional supporting evidence.

The Complainant reiterates that VIRGIN is a globally recognised and respected brand. The Witness Statement acts to provide information on the uniquely broad scope of use and massive brand recognition. The VIRGIN brand has acquired an unprecedented level of notoriety. The Complainant asserts that the schedule detailing some of the Complainant's trade mark registrations "more than suffices for the purposes of evidencing ... rights in the VIRGIN and VIRGIN MONEY names."

Grounds for Abusive Registration – with reference to the examples in the Policy: Paragraph 3a.i - in view of the nature of the Complainant's reputation in the VIRGIN brand the Complainant asserts that "it is quite reasonable to assume that the Respondent would expect the Complainant to feel aggrieved with the registration and use, and offer to buy the domain".

Paragraph 3a.ii - In the Complainant's view, the website which the domain resolves to, as shown in the screenshot submitted with the Complaint, has the look and feel of a VIRGIN site. A user arriving at the site – which contains the "virginmoney" element in the domain name – and which is heavily branded with "Virgin Money" - would assume this is a domain of the Complainant. The Respondent claims that the site does not contain the Complainant's logo or colour scheme. The words Virgin Money are prominently displayed at the top of the screen. The first thing a viewer's eyes are drawn to are the words VIRGIN (which is shown in red – being the colour the Complainant is renowned for using) and MONEY – the element the Complainant has shown they have rights in. The disclaimer is very small and might well not even be read by someone visiting the site. It is not in bold or large letters. As for the "my claim solved.com" logo, this is small and included at the bottom of the site. Including the logo in this way suggests that the site may be in conjunction with this company. The primary branding appears to be that of "Virgin Money".

A potential user looking to find a PPI reclaim service, which relates to a product they purchased through Virgin Money might type in "Virgin Money" and "PPI Reclaim" and locate the site in question. Faced with a site which is branded VIRGIN MONEY they may assume they have got to where they want to be, and type in and submit a claim. In the Complainant's view, the disclaimer would go entirely unnoticed and even if it didn't, the user would assume some affiliation.

Paragraph 3a.iii - As discussed in the Complaint, the Respondent has been found to have registered domains containing a number of well known names in which the Respondent has no apparent rights - domains which were in fact deemed Abusive Registrations.

Whilst the Complainant does not seek to rely entirely on the previous decisions quoted in the Complaint to establish a presumption of bad faith, the decisions are

very relevant. What is not so relevant is that the Respondent considers he has taken the steps identified in one of the later decisions, apparently in order to ensure that the registration is not abusive.

The decisions in the Complaint were cited because there is a presumption of Abusive Registration if the Respondent has been found to have made an Abusive Registration in three or more DRS cases in the last two years, and this presumption should still stand. The decisions found abusive registrations. It is entirely irrelevant that subsequent action may have been taken to correct the abusive use. Furthermore it is irrelevant whether the Respondent considers that the site in question complies with steps laid down in an unrelated dispute. The parties, the names and the sites in question are entirely different. Each case has to be considered on its own merits. The Domain Name in question is confusingly similar to a name in which the Complainant has rights, and is being used in a manner which, in accordance with the DRS Policy, is abusive use.

The test here is not one of trade mark infringement but whether the Domain Name is, in the hands of the current holder, an Abusive Registration.

The Respondent claims to be providing a legitimate business using the Domain Name. If this were the case why not use ppi-reclaim? The website located at reclaimppitoday.co.uk is an example of a legitimate business. This party is providing a legitimate business without confusing the user. There is no legitimate reason for including the Complainant's well known brand in the Domain Name in the present case. The reason can only be to attract users to the site and confuse them that this is a site linked to the Complainant.

The Complainant asserts that in fact, several years ago, Virgin Money decided not to sell PPI products to their customers, either directly or through a Virgin Money branded PPI product sold by another bank. They did, however, agree that their partner MBNA could sell its own PPI product to their customers. Therefore any PPI complaint regarding the Virgin Money Credit Card or Virgin Money Personal Loan issued by MBNA would relate to an MBNA PPI Policy.

The Complainant reiterates its position that the Domain Name is, in the hands of the Respondent, an Abusive Registration and it should be transferred to the Complainant.

6. Discussions and Findings

General

Paragraph 2 of the Policy requires that, for the Complainant to succeed, it must prove to the Expert, on the balance of probabilities, both 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 as defined in Paragraph 1 of the Policy.

Complainant's Rights

The Complainant has asserted earlier registered trade mark rights in VIRGIN and VIRGIN MONEY, and that VIRGIN is a "global brand" and is "recognised for its distinctive nature and reputation spanning across numerous industry sectors. It has provided a detailed Witness Statement supporting this claim and a Schedule of UK and Community Trade Mark (CTM) registrations for VIRGIN and VIRGIN MONEY marks. It has asserted that this Schedule "more than suffices" as evidence of such registered rights.

The Respondent has rightly pointed out that this privately compiled Schedule does not include copies of any of the actual registrations, and fails to show clearly to what extent marks may be in some stylised or logo form or in plain text.

The Expert agrees with the Respondent's assessment that this Schedule is inadequate. In the Expert's view, the Complainant's assertions otherwise are unjustified and presumptuous. Whilst such a private listing may be indicative of the number of claimed registrations, current details from the relevant official register(s) should be provided at least for the most directly pertinent registrations. The Expert has seen before that claims on private listings have not been accurate – and found to have lapsed or unassigned details for example. Of course, the Expert can check official registers, but there is no obligation on an Expert to do so, and there is really no justification for a Complainant to fail to provide such current information. How difficult would it have been for the Complainant to have provided simple copies of the UK register entries for UK 1585773 VIRGIN and UK 2177329 VIRGIN MONEY in Class 36, for example? It seems careless and presumptuous indeed not to have done so.

As it is, the Complainant's assertion of registrations is insufficiently evidenced.

However, the Witness Statement and the survey information regarding the international reputation of VIRGIN do provide evidence to support a claim to have established significant common law rights, even without considering the registrations, through long-established and widespread use of the VIRGIN brand across an extensive range of businesses, including as VIRGIN MONEY.

It is claimed that VIRGIN MONEY was established in the UK in 2000-2001 (Witness Statement §7 page 3) although later in §110 it is stated that "in February 2002 Virgin Direct was renamed Virgin Money..." so there seems to be some inconsistency there. Overall however, it is clear that the Complainant's VIRGIN MONEY business has been operating under that name, and will have established rights through such use for many years prior to the registration of the Domain Name (Witness Statement §109-123)

Given the talents of Richard Branson for publicity and self-promotion in relation to his VIRGIN businesses, realistically it is likely that very few adults in the UK could claim to be unaware of the VIRGIN brand, and the Expert is no exception.

Notwithstanding the careless deficiencies in the Complainant's evidence in this respect, the Expert considers that there can be no serious doubt that the Complainant has Rights, as defined under the Policy, in respect of VIRGIN and VIRGIN MONEY.

The Domain Name includes the additional elements "-ppi-reclaim.co.uk". This is a readily recognisable descriptive reference to the service of making a claim to recover mis-sold payment protection insurance ("PPI"), which may be understood as a financial service which could be provided by the Complainant's VIRGIN MONEY business.

The Respondent has also acknowledged that the Domain Name was intentionally selected to refer directly to the Complainant's business in this respect.

Consequently, the Expert finds that the Complainant has Rights in respect of a name or mark, which is identical or similar to the Domain Name, so that the conditions of Paragraph 2a.i. of the Policy are met.

Abusive Registration

The Complainant also has to show that a disputed Domain Name is an 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights.

A non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration are set out in Paragraph 3a of the Policy.

From the Complainant's submissions, the following examples are claimed to be potentially applicable in this case:

- 3a.i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
 - A. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;
 - B. as a blocking registration against a name or mark in which the Complainant has rights; or
 - C. for the purpose of unfairly disrupting the business of the Complainant;

- 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;
 - iii. The Complainant can demonstrate that the Respondent is engaged in a pattern of registrations where the Respondent is the registrant of domain names (under .uk or otherwise) which correspond to well known names or trademarks in which the Respondent has no apparent rights, and the Domain Name is part of that pattern;
- ...

Paragraph 4 of the Policy additionally provides observations on “How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration”, of which the following may be considered pertinent to the present Complaint:

4a.i.C. [The Respondent has] made legitimate non-commercial or fair use of the Domain Name.

4a.ii The Domain Name is generic or descriptive and the Respondent is making fair use of it.

...

The factors listed in Paragraphs 3 and 4 of the Policy are only intended to be exemplary and indicative. They are not definitive either way. It is Paragraph 1 of the Policy, which provides the applicable definition as indicated above.

In accordance with the Policy Paragraph 2b, it is for the Complainant to prove, on the balance of probabilities, that the Domain Name is an Abusive Registration.

However, in this dispute, Paragraphs 3c and 4a.iv and 4c are also to be considered:

3c There shall be a presumption of Abusive Registration if the Complainant proves that the Respondent has been found to have made an Abusive Registration in three (3) or more DRS cases in the two (2) years before the Complaint was filed. This presumption can be rebutted (see paragraphs 4(a)(iv) and 4 (c)).

4a.iv. In relation to paragraphs 3(a)(iii) and/or 3(c); that the Domain Name is not part of a wider pattern or series of registrations because the Domain Name is of a significantly different type or character to the other domain names registered by the Respondent.

4c If paragraph 3(c) applies, to succeed the Respondent must rebut the presumption by proving in the Response that the registration of the Domain Name is not an Abusive Registration.

The Complainant has asserted that Paragraph 3c is applicable because the Respondent has been found to have made three previous Abusive Registrations (DRS 11286, DRS 11475 & DRS 12477) within the two years preceding this Complaint.

The Respondent claims that the decision in his favour in a subsequent, similar dispute (DRS 12592) should be applied to override such a presumption.

This Expert disagrees. The provisions of Paragraph 3c simply require the Respondent to have been found to have made three Abusive Registrations in the specified period. There is no provision for a net calculation allowing for a Respondent's wins to cancel out losses in that period. In any event, there is also a fourth recent previous decision against him in DRS 12328.

Furthermore, as all the decisions adverse to the Respondent relate to domain names of a similar format (i.e. BRANDNAME-ppi-reclaim.co.uk), the saving in Paragraph 4a.iv is not available either.

The Expert therefore considers that the presumption under Paragraph 3c does apply to the present dispute.

The Complainant has alleged a number of grounds for a finding of Abusive Registration under Paragraphs 3a.i.A, B, C, 3a.ii and 3a.iii.

With respect to the grounds under 3a.i.A the Expert considers that the Respondent's stated rebuttal is sufficient, as the Complainant has shown no evidence of any intent to sell, rent or transfer the Domain Name to another party.

Likewise, the Respondent's arguments against the 3a.i.B grounds are accepted. There is no evidence that the Complainant has been blocked from making any similar registrations of its own.

The grounds under Paragraphs 3a.i.C, 3a.ii and 3a.iii merit further discussion.

Taking 3a.iii first, the Respondent admits that it indeed "does possess a number of domain names and corresponding sites for claiming of compensation and of premiums arising from mis-selling by a range of financial services organisations" and "Each and every site is identical to the site now complained of save for replacing Virgin Money with the name of the organisation mis-selling products". It has also lost four previous disputes against similarly formed domain names. It is clear that there is a *prima facie* case that Paragraph 3a.iii applies. There is a pattern and that pattern includes a number of domain names, which have already been held to be Abusive Registrations.

However, the Respondent's submission is that "Each and every site concerns a legitimate business for the reclaiming of compensation and premiums for mis-selling", and that this is "a legitimate pattern of registration and trade".

The same argument is employed by the Respondent to rebut the assertion of unfairly disrupting the business of the Complainant under Paragraph 3a.i.C.

The Respondent further argues that the grounds of confusion under Paragraph 3a.ii do not apply because of all the changes to his original site format that he claims to have made following the decision in DRS 12328, which he represents as having “precisely identified the steps that the Respondent should take in order to ensure that his registration was not abusive”.

The Expert considers that representation puts a somewhat self-serving gloss on points in the critical analysis in that decision, which led the Expert in that case to find the subject domain name to be an abusive registration.

The Respondent further relies heavily upon the one decision in his favour in DRS 12592, citing in particular a number of paragraphs from that decision:

DRS 12592 Page 6, paragraph 5:-

“It can be seen immediately that the web page has sought to address the problems raised by the expert in D00012328. The impression now given is quite to the contrary in my view. The topmost line asks whether the visitor to the web page has ever had a loan or credit card from the Complainant and the line below it, albeit in smaller and greyer text, announces that ‘You could be owed £1,000.00 in compensation if Marks and Spencer mis-sold you PPI.”

Page 7, paragraph 3:-

“Whatever may have been the case with decision D00012328, it is abundantly clear to my mind that no-one could seriously be confused by this webpage into thinking that the Complainant in some way was authorising it or that there was some sort of connection between the Complainant and the Respondent. On the contrary, it is clear that the purpose of the webpage is to facilitate the bringing of claims against the Complainant using services offered by the Respondent.”

Page 9, middle paragraph:-

“... there is no evidence actually before me of confused members of the public.”.

Final paragraph on page 10:-

“Unlike the other cases involving this Respondent, there is nothing to sway me by looking at the webpage – indeed, looking at the webpage, I am swayed in the opposite direction.”

The Expert making that decision was evidently particularly influenced by the appearance of the webpage rather than the domain name and its form.

The present Expert shares the view expressed by the Expert in another earlier decision in DRS 11478 (Barclays-ppi-reclaim.co.uk) with reference to the Appeal Panel in Hanna-Barbera Productions Inc. v Graeme Hay DRS 00389 (“scoobydoo.co.uk”), which stated that “the sensible way of addressing whether or not the Domain Name is an Abusive Registration is to start by evaluating the Domain Name and reviewing the use made of it as a whole.”

The Domain Name in this case comprises the initial term “virginmoney”, which is recognisable by any English speaker as simply a concatenation, without the space, of the Complainant’s business and trade mark, VIRGIN MONEY. This is followed by “-ppi-reclaim”, which would again be a familiar to any adult user of financial services as a descriptive reference to the process of reclaiming premiums paid for payment protection insurance (“PPI”), which has been the subject of much publicity and much encouragement for people to submit claims, if they believe they have been the victims of alleged mis-selling of such insurance.

The Respondent has admitted the Domain Name was chosen specifically to refer to Virgin Money and to seek ppi-reclaim business from potential claimants against Virgin Money. The Respondent asserts that this is simply a descriptive use for the purpose of identifying the nature of the website connected with the Domain Name to prospective customers i.e. that it is for those seeking to reclaim ppi premiums from Virgin Money.

As the Experts in a number of the previous cases involving the Respondent have noted, this domain name structure has analogies with the situation in DRS07991 toshiba-laptop-battery.co.uk, where the Appeal Panel in that case summarised the principles to be applied as follows:

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 as a result of “initial interest confusion” and is not dictated only by the contents of the website;
4. Whether or not a commercial connection is implied, there may be other reasons why the reseller’s incorporation of the domain name was unfair. One such reason is the offering of competitive goods on the respondent’s website”.

In the present Expert’s view, the structure of this Domain Name, with the Complainant’s business name and trade mark presented first, has the familiar appearance of a trade mark use. The first presumption which is going to be

conveyed to most ordinary internet users when this Domain Name is connected to a website, or used in an email address, is that it is operated or authorised by the Complainant's VIRGIN MONEY business.

It may be debatable whether the VIRGIN businesses are necessarily all quite so cosy and consumer friendly as they might like us to think, but the evidence does support the view that they are widely respected and trusted. Consequently, it must be quite possible that consumers with that impression would readily believe that the VIRGIN MONEY business would provide its customers with service for dealing with mis-sold ppi claims, and that such a service would be provided using a domain name much like the Respondent's.

In this situation, the Expert feels that it is inherent that the Domain Name will be conveying a false impression of a commercial connection with the Complainant's business and that this will be the case regardless of what may appear on a website using this Domain Name.

As the Complainant also says that VIRGIN MONEY did not sell its own-branded ppi policies, the Domain Name may arguably be considered to be misleading on that score too.

It is worth reiterating at this point that the nature of an Abusive Registration under the Policy is not defined with respect to actual or likely confusion nor on the basis of putative trade mark infringement, but on whether the registration or use of the Domain Name has taken unfair advantage of or been unfairly detrimental to a Complainant's rights.

The Respondent himself has acknowledged that if the Domain Name in question and the corresponding website were of a similar design and content to those which were the subject of decisions DRS 11286, DRS 11475 and DRS 12477, "then inevitably it would be construed as an abuse of registration, and transfer would be ordered."

The Respondent claims to have changed the website associated with the present Domain Name from the earlier design and content, in the expectation that this should be sufficient to convey a different impression and avoid a finding of Abusive Registration.

The present Expert is not swayed by the apparent change in website design, which found favour in the decision in DRS 12592.

In this Expert's view, the evidence is that this Domain Name (and the others like it) were all intentionally registered by the Respondent with the respective distinctive business name and trade mark first and foremost to exploit the reputation and goodwill in those names to attract traffic for the benefit of the Respondent. The original websites at these domain names were also admittedly set up with the respective business names and trade marks most prominently displayed and also using some complainants' logos.

Such uses assuredly have taken unfair advantage of the relevant rights, even if the changes were to be considered sufficient to mitigate that now.

And as for the Respondent's claims to have acted assiduously to change the originally offending website designs – including for the present Domain Name – that is not consistent with the screenshot submitted by the Complainant with the Complaint, where prominent references to “Virgin Money” appear at the top of the page, including in red, and the references to My Claim Solved Ltd less prominently at the bottom.

Furthermore, when the Expert inspected the website at www.virginmoney-ppi-reclaim.co.uk himself to view the purported changes for consistency with the format at www.marksandspencer-ppi-reclaim.co.uk, the site had evidently been changed again, and the first screen appeared thus:

Webpage Screenshot

Virginmoney

Have you ever had a loan, credit card or mortgage with **Virgin Money**?

You could be owed £1,000s in compensation if Virgin Money mis-sold you PPI.

To register a Virgin Money PPI reclaim, please fill out the following form and a member of our customer service team will be in touch within 24 hours.

Full name (required)

Telephone (required) e.g. 01803 322 411

SUBMIT CLAIM

In this Expert's view, that is clearly a screen likely to confuse and mislead users into believing such a site is run by or authorised by the VIRGIN MONEY business itself. Moreover, it is not consistent at all with the Respondent's claims to have acted to remedy the objections raised in earlier disputes, and suggests a continued deceptive intent rather than otherwise.

When a DRS Complaint is first filed, Nominet will also take a screenshot of the associated primary webpage associated with the domain name in dispute and place that on the dispute file as a record of how it was at that time. There is a copy of Nominet's screenshot for www.virginmoney-ppi-reclaim.co.uk on the present file.

It provides a cautionary reminder of why the inclusion of business names and trade marks in a domain name by parties other than the genuine business or rights owner may be abusive.

Nominet's installed Windows security program did not allow that website itself to be displayed. It popped up a message "ACCESS DENIED", stating that the URL had been blocked, with the explanatory line "Reason: phishing web address".

The Windows security program may have been mistaken – the Respondent's business itself in this case is indeed legitimate and regulated – but one can understand how a software security program, perhaps using algorithms, finding a domain name like this not on the same server as the Virgin Money main site and asking users to enter personal data, might be programmed to react with such an alert.

The Respondent was certainly not 'phishing' with a view to exploiting individuals' personal financial details, but there are plenty of scammers using domain names in a similar format who are, and financial businesses are surely right to be sensitive about how their names and marks are used in domain names when that risk is so prevalent.

However, it could be said that the Respondent was 'fishing for business' from customers of the banks specified in the various domain names, and using the names and marks of the respective banks as an initial bait to draw potential customers in to make use of the Respondent's services, rather than those of a competitor or of the complaints services which may be offered by the banks themselves.

This Expert therefore does not accept that the Respondent's arguments are sufficient to rebut a presumption of Abusive Registration on grounds at least analogous to 3a.ii and 3a.iii, but shares the views of the majority of those previous Experts who have considered the various similar disputes, that the registration and use of a Domain Name like this by the Respondent has taken unfair advantage of the Complainant's Rights.

For the purposes of the Policy the Expert therefore finds that the conditions of Paragraph 2a.ii. of the Policy are met.

Decision

Having found that the Complainant has Rights, and that the Domain Name, virginmoney-ppi-reclaim.co.uk, is an Abusive Registration in the hands of the Respondent, the Expert orders that the Domain Name should be transferred to the Complainant.

Signed
Keith Gymer

Dated 16 June, 2014