

DISPUTE RESOLUTION SERVICE

D00018647 & D00018649

Decision of Independent Expert

Virgin Enterprises Limited

and

Ervin Remus Radosavlevici

1. The Parties

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

Respondent: Ervin Remus Radosavlevici
96 Gloucester Terrace
London
London
W2 6HP
United Kingdom

2. The Domain Names

<virgincloud.co.uk>
<virginmediacloud.co.uk>

3. Procedural History

Case Number 00018647

10 March 2017 15:23 Dispute received
13 March 2017 10:48 Complaint validated
13 March 2017 11:19 Notification of complaint sent to parties
14 March 2017 11:35 Response received
17 March 2017 14:23 Notification of response sent to parties
22 March 2017 01:30 Reply reminder sent
24 March 2017 17:30 Reply received
24 March 2017 17:30 Notification of reply sent to parties
05 April 2017 14:41 Dispute suspended
24 May 2017 16:09 Dispute opened
24 May 2017 16:14 Notification of response sent to parties
30 May 2017 02:30 Reply reminder sent
05 June 2017 10:31 Reply received
05 June 2017 10:32 Notification of reply sent to parties
07 June 2017 17:22 Mediator appointed
07 June 2017 17:23 Mediation started
14 June 2017 16:14 Mediation failed
14 June 2017 16:14 Close of mediation documents sent
21 June 2017 10:43 Expert decision payment received

Case Number 00018649

10 March 2017 18:20 Dispute received
13 March 2017 11:26 Complaint validated
13 March 2017 11:31 Notification of complaint sent to parties
30 March 2017 02:30 Response reminder sent
30 March 2017 13:36 Response received
30 March 2017 13:36 Notification of response sent to parties
04 April 2017 02:30 Reply reminder sent
05 April 2017 14:42 Dispute suspended
24 May 2017 16:08 Dispute opened
24 May 2017 16:13 Notification of response sent to parties
30 May 2017 02:30 Reply reminder sent
05 June 2017 10:32 Reply received
05 June 2017 10:32 Notification of reply sent to parties
07 June 2017 17:28 Mediator appointed
08 June 2017 11:37 Mediation started
14 June 2017 16:16 Mediation failed
14 June 2017 16:16 Close of mediation documents sent
21 June 2017 10:43 Expert decision payment received

The Complaints in the two above-referenced cases were consolidated by Nominet on 16 June 2017 upon it becoming apparent that the underlying registrant in each case was the same.

Expert Declaration

The Expert has confirmed that he is independent of each of the parties. To the best of the Expert's 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 his independence in the eyes of one or both of the parties.

4. Factual Background

Virgin Enterprises Limited is a UK limited company which is responsible for the management of trade marks and associated intellectual property rights on behalf of the group of companies known as the Virgin Group. For convenience, the various entities within this group are referred to collectively as the Complainant in the remainder of this Decision.

The Complainant was founded in 1970 and is currently active in the fields of travel and leisure, telecoms and media, music and entertainment, financial services and health and wellness.

The Complainant is the owner of numerous trade mark registrations comprising or including the mark VIRGIN in territories throughout the world. The Complainant's trade mark registrations include:

- United Kingdom trade mark number 1009534 for VIRGIN registered on 11 April 1973 for sound recordings in Class 9.
- European Union Trade Mark number 013867478 for VIRGIN MEDIA registered on 16 October 2015 for a variety of goods and services in Classes 9, 35, 36, 38, 41 and 42 including Internet services in Class 38.

Both of the Domain Names were registered on 10 March 2016.

Neither of the Domain Names appears to have resolved to any active website.

The Respondent is the principal of a UK limited company named Virgin Media Cloud Limited which was incorporated on 13 July 2016.

5. Parties' Contentions

The Complaint

The Complainant contends that its VIRGIN mark represents one of the world's most respected brands. It states that there are more than 60 VIRGIN branded businesses with more than 60 million customers worldwide, having combined annual revenues in excess of USD 24 billion. The Complainant states that the VIRGIN brand was ranked at number 5 of Top Business Superbrands by the Centre for Brand Analysis in 2013

and that in 2014, 99% of individuals surveyed in the UK were aware of the VIRGIN brand.

The Complainant provides details of its worldwide trade mark registrations for the mark VIRGIN, which it says amount to over 3,000 registrations in over 150 countries across the majority of the 45 classes of goods and services. It also provides details of over 5,350 domain names including the term “virgin” of which it is the owner.

The Complainant states that one of its group companies is Virgin Media, Inc which was founded in March 2006. The Complainant submits that it has offered television, broadband and mobile telephone services under the VIRGIN MEDIA name and that it is the leading cable operator in the UK and Ireland, with over 5.7 million cable customers and 3 million mobile subscribers.

The Complainant submits that, until 28 April 2016, it operated an online storage system named “Virgin Media Cloud” which allowed users to access and share data electronically. The Complainant announced on 8 March 2016 that it was closing this service with effect from 28 April 2016 and exhibits its online announcement dated 8 March 2016 to this effect.

The terms “Rights” and “Abusive Registration” as referred to below are as defined in the Nominet UK Dispute Resolution Service Policy (“the Policy”).

The Complainant submits that it has Rights in respect of a name or mark which is identical or similar to each of the Domain Names.

With regard to the Domain Name <virgincloud.co.uk> the Complainant submits that the Domain Name incorporates the whole of the Complainant’s mark VIRGIN with the addition of the purely descriptive term “cloud”. The Complainant asserts that this descriptive term does not distinguish the Domain Name from the Complainant’s trade mark and submits that it has used numerous descriptive terms together with the mark VIRGIN and is understood by the public to do so. The Complainant adds that the term “cloud” is widely associated with the storage of data on remote servers, being a service which it has offered, and therefore adds to the risk of confusion between the Domain Name and the Complainant’s services.

Concerning the Domain Name <virginmediacloud.co.uk>, the Complainant makes similar submissions, save to point out that both VIRGIN and VIRGIN MEDIA are registered trade marks of the Complainant.

The Complainant submits that the each of the Domain Names, in the hands of the Respondent, is an Abusive Registration.

The Complainant submits that it has never licensed or authorized the Respondent to use its VIRGIN or VIRGIN MEDIA trade marks and that there is no evidence that the Respondent has any independent trade mark rights or other legitimate interest in respect of either of the Domain Names. The Complainant says that it is inconceivable that the Respondent was unaware of the Complainant’s trade marks when he registered the Domain Names and points out that the Domain Names were registered

two days after the Complainant's announcement concerning its "Virgin Media Cloud" service to above.

The Complainant submits, in particular, that the Respondent registered each of the Domain Names as a blocking registration against a name or mark in which the Complainant has rights (paragraph 5.1.1.2 of the Policy) and/or that the Respondent is using or threatening to use each of 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 (paragraph 5.1.2 of the Policy). In this regard, the Complainant relies on the distinctive character and reputation of its VIRGIN and VIRGIN MEDIA trade marks and argues that a speculative visitor to any website linked to either of the Domain Names is likely to assume that that website is operated or authorized by the Complainant. The Complainant argues that the Respondent is thereby taking unfair advantage of its goodwill in its VIRGIN and VIRGIN MEDIA trade marks, regardless of the fact that the Domain Names have not resolved to any active website.

The Complainant also exhibits copies of letters dated 5 September 2016, 26 September 2016 and 4 January 2017 sent by its representatives to the Respondent concerning the Domain Names. The Complainant states that no response was received to these letters, which it relies on as further evidence that the registrations of the Domain Names are abusive.

The Complainant seeks the transfer of each of the Domain Names.

The Response

The Respondent has filed a short Response in which he states, first, that he paid for the Domain Names and, secondly, that he is the registrant of the UK limited company named Virgin Media Cloud Limited referred to above.

The Reply

The Complainant submits that the fact that Companies House did not object to the registration of the Respondent's company is not an indication that the Respondent's use of the Complainant's trade marks in connection with that company is legitimate. The Complainant further contends that the registration of the company name in question does not of itself confer any rights in the Domain Names upon the Respondent.

6. Discussions and Findings

Under paragraph 2 of the Policy:

"2.1 A Respondent must submit to proceedings under the DRS if a Complainant asserts to us, according to the Policy, that:

2.1.1 The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

2.1.2 *The Domain Name, in the hands of the Respondent, is an Abusive Registration*

2.2 *The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*

Under paragraph 1 of the Policy the term “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.”

Also under paragraph 1 of the Policy, the term “Abusive Registration” means 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. is being or has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant's Rights.”*

Paragraph 5 of the Policy sets out a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. Paragraph 8 of the Policy sets out a non-exhaustive list of factors that may be evidence that it is not an Abusive Registration. However, all such matters are subsidiary to the overriding test for an Abusive Registration as set out as in paragraph 1 of the Policy.

Rights

The Complainant has established that it has registered trade mark rights in respect of the names VIRGIN and VIRGIN MEDIA. Ignoring the formal suffix “.co.uk”, the Domain Names are respectively identical to the Complainant’s trade marks but for the inclusion of the term “cloud” in each case. The Expert accepts the Complainant’s submissions that the term “cloud” is descriptive and does not distinguish the Domain Names from the Complainant’s trade marks and, further, that the term “cloud” is indicative of the remote storage of electronic data, being a service that has been offered by the Complainant, and liable therefore to increase the likelihood of confusion between the Domain Names and the Complainant’s services.

In the circumstances, the Expert finds that the Complainant has Rights in respect of names or marks which are identical or similar to each of the Domain Names.

Abusive Registration

In the light of the Complainant’s trading history under the marks VIRGIN and VIRGIN MEDIA and its announcement concerning its “Virgin Media Cloud” service two days prior to the registration of the Domain Names, the Expert considers it

inconceivable that the Respondent was unaware of the Complainant's trade marks on the date when he registered the Domain Names.

The Respondent argues that he paid for the Domain Names and also that he is the registrant of a company named Virgin Media Cloud Limited. However, it is trite to say that the fact of registration of a domain name does not of itself confer any legitimacy in that registration upon the registrant. Furthermore, the company Virgin Media Cloud Limited was registered in July 2016, some time after the Complainant's announcement concerning its "Virgin Media Cloud" service. In the view of the Expert, therefore, that company registration is not evidence of demonstrable preparations to use the Domain Names in connection with a genuine offering of goods or services, but is indicative instead of an attempt to circumvent the provisions of the Policy by providing a pretext for the registration of the Domain Names. To the extent that the Respondent argues that there mere existence of the company prevents a finding of Abusive Registration, then that argument is simply mistaken.

The Respondent has not advanced any legitimate reason for his registration and use of the Domain Names, and in all the circumstances of the case the Expert readily infers that the Respondent registered each of the Domain Names in the knowledge of the Complainant's trade marks VIRGIN and VIRGIN MEDIA and its "Virgin Media Cloud" service and with the intention of taking unfair advantage of the Complainant's Rights in those names. In particular, the Expert concludes on the balance of probabilities that 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 (paragraph 5.1.2 of the Policy). The fact that neither of the Domain Names has resolved to any active website does not affect the Expert's conclusion.

7. Decision

The Complainant has established that it has Rights in respect of names or marks that are identical or similar to each of the Domain Names and that each of the Domain Names in the hands of the Respondent is an Abusive Registration. The Complaint therefore succeeds and the Expert directs that the Domain Names <virgincloud.co.uk> and <virginmediacloud.co.uk> be transferred to the Complainant.

Steven A. Maier
Independent Expert

5 July 2017