

ADMINISTRATIVE PANEL DECISION

Virgin Enterprises Limited v. Juan Montes

Case No. D2016-0679

1. The Parties

The Complainant is Virgin Enterprises Limited of London, the United Kingdom of Great Britain and Northern Ireland (“UK”), represented by Stobbs IP Limited, UK.

The Respondent is Juan Montes of Panama.

2. The Domain Name and Registrar

The disputed domain name <virgincasinoreview.com> is registered with TierraNet d/b/a DomainDiscover (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 6, 2016. On April 7, 2016, the Center transmitted, by email, a request to the Registrar for registrar verification in connection with the disputed domain name. On the same date, the Registrar transmitted, by email, its verification response to the Center confirming that the Respondent is listed as the registrant and also providing the Respondent’s contact details.

The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and that the proceedings commenced on April 22, 2016. In accordance with the Rules, paragraph 5, the due date for Response was set to May 12, 2016. The Respondent did not submit any response. Accordingly, the Center notified the parties of the Respondent’s default on May 13, 2016.

The Center appointed Peter L. Michaelson as the sole panelist in this matter on May 23, 2016. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

As reflected in the registration record for the disputed domain name in the Whois database (a copy of the record appears in Annex A to the Complaint), the disputed domain name <virgincasinoreview.com> was registered on July 24, 2007 and is due to expire on July 24, 2016. The disputed domain name resolves to a website displaying the Complainant's marks, providing information about the Complainant's game offerings and linking to the Complainant's website "www.virgingames.com".

A. The Complainant's VIRGIN Marks

As listed in Annex 4 to the Complaint, the Complainant owns approximately 100 UK and European (CTM) registrations for the mark VIRGIN, by itself or with another term, in either block letter or stylized forms. From the limited data provided in this annex, the following is a small sample of these registrations which carry relatively early dates of registration:

- 1) VIRGIN
UK trademark registration 1009534; registration date: April 11, 1973
This mark was registered in international class 9.
- 2) VIRGIN (stylized)
UK trademark registration 1259731; registration date: February 6, 1986
This mark was registered in international class 16.
- 3) VIRGIN
UK trademark registration 1287268; registration date: October 2, 1986
This mark was registered in various international classes including class 41.

B. The Parties and Their Activities

The Complainant, a corporation incorporated in England and Wales, is the brand owner and is responsible for the ownership, management and protection of all trademarks and intellectual property in the VIRGIN name for the Virgin Group of Companies ("Virgin Group").

The Virgin Group originated in 1970 when founder and current chairman Richard Branson began selling popular music records under the name "Virgin". Since that date, the Virgin Group has significantly expanded in size, geographic reach and the industries in which it operates. The Virgin Group now comprises over 300 branded companies operating in a corresponding array of businesses, including gaming, and across 30 countries worldwide including the US and various countries throughout Europe. The Virgin Group currently employs approximately 50,000 and generates annual revenues exceeding GBP 11.5 billion. Witness Statement of Victoria Wisener (trademark attorney employed by the Complainant), paragraphs 5-6 (a copy of the statement appears in Annex 6 to the Complaint). This statement highlights some of the growth, since 1970, in the lines of business that form the Virgin Group and the concomitant and expanding use of the VIRGIN mark in connection with those businesses. The Virgin Group annually expended between GBP 14 million to GBP 233 million worldwide during 2001-2010 to advertise and promote its goods and services bearing the mark VIRGIN. *Id.* at paragraph 225.

The Virgin Group uses all types of media within the markets in which it operates. Every company in the Virgin Group, particularly those in the retail field as well as in the electronic, entertainment, mobile telecommunications, and personal finance markets, make extensive use of social media, websites and publications in countries where they trade. *Id.* at paragraph 229.

Each of the Virgin Group's companies identifies to its respective consumers and publicly brands (in its consumer facing trade name) its principal goods and services by consistently using the mark VIRGIN

followed by a common generic identifier of those goods or services. Illustrative early examples include: “Virgin Records” (record stores, started in 1973), “Virgin Games” (computer games and software publisher, started in 1983), “Virgin Holidays” (a tour operator specializing in long haul holidays to various destinations including Australia, started in 1985), “Virgin Atlantic Airways” (later shortened to “Virgin Atlantic”) and “Virgin Atlantic Cargo” (for commercial airline and air freight services, respectively; started in 1984). *Id.* at paragraph 7. The Virgin Group extends across media and mobile, travel and transport, money, music, retail, leisure, social and environmental and lifestyle sectors. *Id.* at paragraph 12.

Further, with respect to gaming, in June 2004, the Virgin Group launched “Virgin Games” which allowed customers in the UK to play a wide selection of skill based games (including puzzles and trivia games) as well as casino games, poker and bingo online. *Id.* at paragraph 145.

Further, the Complainant owns over 4,500 domain names (some of which are listed in Annex 5 to the Complaint) including <virgin.com> and <virgincasino.com>, which it registered on September 10, 1997 and January 7, 1988, respectively. Wisener statement, paragraph 17.

Though the Complainant sent a communication to the Respondent presumably, *inter alia*, notifying the Respondent of the Complainant’s trademark rights and demanding that the Respondent cease use of the disputed domain name, the Complainant has not received any response. Complaint, section B.

5. Parties’ Contentions

A. Complainant

(i) Identical or Confusingly Similar

The Complainant contends that the disputed domain name is confusingly similar to its VIRGIN Marks.

Specifically, the disputed domain name contains the mark VIRGIN to which the terms “casino review” have been appended, with those additional terms, given the substantial notoriety of the mark VIRGIN, being incapable of adding sufficient distinctiveness whatsoever to the disputed domain name to mitigate any resulting user confusion between the disputed domain name and that mark.

Hence, the Complainant believes that it has satisfied the confusing similarity/identity requirement in paragraph 4(a)(i) of the Policy.

(ii) Rights or Legitimate Interests

The Complainant contends that the Respondent has no rights or legitimate interests in the disputed domain name pursuant to paragraph 4(a)(ii) of the Policy.

Specifically, the Respondent has no rights in any of the VIRGIN Marks as it is neither a licensee of the Complainant nor has it been authorized by the Complainant to use any of the VIRGIN Marks. Consequently, any use which the Respondent makes of the mark VIRGIN can only be to exploit the mark for his own advantage.

Additionally, the Respondent is not commonly known by the name “Virgin Casino”, as this term is Complaint’s brand and one of its marks.

Furthermore, the disputed domain name resolves to the Respondent’s website (screen shots of the home and subsequent pages are provided in Annex 7 to the Complaint) which uses the mark VIRGIN throughout, thus repeatedly referencing the Virgin Group’s business. The site has the look and feel of an official site associated with the Virgin Group and also contains numerous links to the official website of VIRGIN CASINO – one of the businesses within the Virgin Group, along with unauthorized links to the VIRGIN CASINO

website. As the Respondent has no valid relationship to the Virgin Group, it is not using the name in relation to a *bona fide* offering of goods or services and thus has no legitimate interest in that name.

(iii) Registered and Used in Bad Faith

The Complainant also contends that the Respondent has registered and is using the disputed domain name in bad faith in violation of paragraph 4(a)(iii) of the Policy.

The disputed domain name was intentionally registered by the Respondent in spite of his prior knowledge of the Complainant's exclusive trademark rights and is being used by the Respondent solely for his own commercial gain.

Traffic only reaches the Respondent's website due to the inclusion of the Complainant's mark VIRGIN within the disputed domain name. Consequently, Internet users think they have reached an official site of the Virgin Group when, in fact, they have not. Inasmuch as the Respondent's website has the same look and feel of an official Virgin Group website and includes the Complainant's VIRGIN-based branding throughout, this commonality only heightens user confusion even further. Moreover, once on the site, those users are faced with information which encourages them to click on displayed third-party links which will take them to the official site of VIRGIN GAMES (at <virgingames.com>) – one of the Virgin Group's businesses. The Respondent likely receives click-through revenue each time a user clicks on such a link. An example of such information is text associated with one of the links which reads "play at Virgin Games Casino now". Clearly, the Respondent is not only economically benefitting at the expense of the Complainant from the exploitation of the latter's marks and reputation but also, in doing so, disrupting the business of the Virgin Group.

B. Respondent

In view of the lack of a Response filed by the Respondent as required under paragraph 5 of the Rules, this proceeding has proceeded by way of default. Hence, under paragraphs 5(f), 14(a) and 15(a) of the Rules, the Panel is directed to decide this administrative proceeding on the basis of the Complainant's undisputed factual representations.

6. Discussion and Findings

A. Identical or Confusingly Similar

The Panel finds that the disputed domain name is confusingly similar to the Complainant's VIRGIN Marks.

From a simple comparison of the disputed domain name to the Complainant's mark VIRGIN, no doubt exists that the disputed domain name is confusingly similar to it. The disputed domain name consists of the addition of the generic words "casino review" to the mark and to which the generic Top-Level Domain ("gTLD") ".com" has been appended, with the addition of the gTLD being irrelevant in this case in assessing confusing similarity or identity under paragraph 4(a)(i) of the Policy and thus ignored.

It is now very well-established in UDRP precedent, including numerous decisions previously rendered by this Panel, that a minor variation to a mark is usually insufficient in and of itself, when used in forming a domain name that results from modifying the mark, to confer requisite and sufficient distinctiveness to that name to avoid user confusion. Here, the Respondent's addition of the generic terms to the Complainant's mark VIRGIN clearly results in such a minor variation. See, e.g., *Chicago Mercantile Exchange Inc. and CME Group Inc. v. Domains By Proxy, LLC / Phupinder Gill*, WIPO Case No. D2015-1842; *Cummins Inc. v. Jamie Lent*, WIPO Case No. D2015-0188; *Staatliche Porzellan-Manufaktur Meissen GmbH v. Buy Meissen*, WIPO Case No. D2013-1687; *Forideas Pty Limited v. Movember Organization*, WIPO Case No. D2013-1385; *AlgaeCal Inc. v. AlgaeCal Fraud*, WIPO Case No. D2013-1248; *General Motors LLC v. Carol Schadt*, WIPO Case No. D2012-2106; *National Westminster Bank plc v. Steve Mart*, WIPO Case No. D2012-1711; *Tommy Bahama Group, Inc. v. Berno Group International*, WIPO Case No. D2012-0531; *National Association of*

Realtors v. Hammerberg & Associates, Inc., WIPO Case No. D2012-0075; *Space Needle LLC v. Erik Olson*, WIPO Case No. D2011-0931; *Oakley, Inc. v. Kate Elsberry, Elsberry Castro*, WIPO Case No. D2009-1286; *Clearwire Legacy, LLC v. Leon Ganesh*, WIPO Case No. D2010-0148; *Burberry Limited v. Domain Admin*, WIPO Case No. D2009-0703; *Krispy Kreme Doughnuts, Inc. v. John Sharp*, WIPO Case No. D2009-0099; *MasterCard International Incorporated v. Global Prepaid*, WIPO Case No. D2008-2008; *HRB Innovations Inc., Express Tax Service Inc. v. Calvin Brown*, WIPO Case No. D2008-1072; *Dreamworks Animation, LLC v. Creahq, Mike Furlong*, WIPO Case No. D2008-0505; *Marvel Manufacturing Company Inc. v. Koba Internet Sales, LP*, WIPO Case No. D2008-0265; *MySpace, Inc. v. Edwin De Jesus, EDJ Associates Inc.*, WIPO Case No. D2007-1878; *BlackRock, Inc. v. blackrockfinancialservices.com*, WIPO Case No. D2007-1627; *F. Hoffmann-La Roche AG v. Transliner Consultants*, WIPO Case No. D2007-1359; *National Football League v. Peter Blucher d/b/a BluTech Tickets*, WIPO Case No. D2007-1064; *Toilets.com, Inc. v. Rons Porta Johns*, WIPO Case No. D2007-0952; *Associated Bank Corp. v. Texas International Property Associates*, WIPO Case No. D2007-0334; *Gerber Childrenswear Inc. v. David Webb*, WIPO Case No. D2007-0317; *The Cheesecake Factory Inc. and The Cheesecake Factory Assets Co., LLC v. Say Cheesecake*, WIPO Case No. D2005-0766; *Napster, Inc. v. Giovanni Vinscani*, WIPO Case No. D2005-0531; *Caesars Entertainment, Inc. v. Nova Internet Inc.*, WIPO Case No. D2005-0411; *Lockheed Martin Corporation v. The Skunkworx Custom Cycle*, WIPO Case No. D2004-0824; *Lockheed Martin Corporation v. Deborah Teramani*, WIPO Case No. D2004-0836; *National Collegiate Athletic Association v. Dusty Brown*, WIPO Case No. D2004-0491; and *National Association of Professional Baseball Leagues, Inc., d/b/a Minor League Baseball v. John Zuccarini*, WIPO Case No. D2002-1011.

Moreover, given the substantial notoriety, reputation and ultimately fame which the Complainant's mark VIRGIN has acquired over the years starting from 1970 and continuing to the registration date (July 24, 2007) of the disputed domain name, it is beyond doubt that the potential for user confusion was likely to be exacerbated, not reduced, by the Respondent's addition of the generic terms "casino review" to the Complainant's mark.

It is quite conceivable, given current common naming conventions and patterns in use on the Internet, that an Internet user, who seeks information on Virgin Group's casinos, as part of the gaming business operated by the Virgin Group, would likely form a domain name by including the term "casino" and "review" to the mark VIRGIN to yield a composite name and then add the common gTLD ".com" to generate a resulting domain name <virgincasino.com>. The user would then insert that domain name into his/her browser with a reasonable expectation that doing so would direct that browser to the Virgin Group's gaming website.

However, inasmuch as the Respondent registered that domain name, then the user's action would have caused that person not to be taken to the Virgin Group's gaming website or one associated with or authorized by the Complainant, but rather, and without that user realizing the diversion, to the Respondent's website instead. This diversion, in fact, occurred here with that user obtaining information on the Complainant's casino gaming business but not from the Virgin Group or a source authorized by the Complainant. Thus, the user would be deceived into thinking that the Respondent's website was affiliated with, authorized by or related in some fashion to the Virgin Group when, in fact, it was not.

Hence, adding the terms "casino review" to the mark VIRGIN, as the Respondent did, only heightens the likelihood of the Respondent having caused user deception and ensuing confusion to the Respondent's ultimate benefit and the detriment of the Complainant. See, e.g., *Cummins Inc., Tommy Bahama Group, Inc., Krispy Kreme Doughnuts, National Association of Realtors, Space Needle, Burberry, Dreamworks and MySpace*, all cited *supra*.

Therefore, the Panel finds that the disputed domain name is confusingly similar to the Complainant's mark VIRGIN. Hence, the Complainant has satisfied its burden under paragraph 4(a)(i) of the Policy.

B. Rights or Legitimate Interests

Based on the evidence of record here, the Panel finds that no basis exists which would appear to legitimize a claim of rights or legitimate interests by the Respondent to the disputed domain name under paragraph 4(c)

of the Policy.

The Respondent's unauthorized use of the disputed domain name as an address of his website through which the Respondent unfairly exploits, for his own commercial benefit, the Complainant's reputation acquired through its VIRGIN Marks in the form of click through links, does not constitute a *bona fide* offering of goods or services. Accordingly, the Respondent's use of the disputed domain name does not satisfy paragraph 4(c)(i) of the Policy.

Further, the Complainant has never authorized the Respondent to utilize any of the Complainant's marks, whether in a domain name or otherwise, nor does the Complainant apparently have any relationship or association whatsoever with the Respondent.

The record before the Panel is simply devoid of any evidence which proves that the Respondent actually acquired any recognition in the marketplace to become commonly known by the disputed domain name, a name similar to it, or more generally the term "Virgin". Given the exclusive trademark rights that reside in the Complainant and the extensive, substantial and undeniable global reputation now inherent in its marks, the Respondent could not legitimately acquire any public association between itself and the Complainant's mark VIRGIN or likely even any mark similar thereto, and certainly not for any of the goods and services provided by the Virgin Group under its marks. This is so in light of the Complainant's exclusive trademark rights which date back to 1970 in connection with the mark VIRGIN and the extensive global reputation and recognition which its VIRGIN marks have since acquired – all of which clearly predate July 24, 2007, when the Respondent registered the disputed domain name. See, e.g., *Facebook Inc. v. Stuart West, West & Associates, A PC*, WIPO Case No. D2015-1766; *Cummins Inc., Staatliche Porzellan-Manufaktur Meissen GmbH, Forideas, National Westminster, Tommy Bahama Group, Inc., Space Needle, Oakley, Burberry, HRB Innovations, MySpace and General Motors LLC*, all cited *supra*. As such, the Respondent could never likely become commonly known by the disputed domain name or the Complainant's marks for a wide range of goods and services without infringing on the exclusive trademark rights of the Complainant. There can simply be no question that the Respondent was well aware of the Complainant, its VIRGIN Marks and the Complainant's exclusive rights and reputation in those marks, when the Respondent registered the disputed domain name. Hence, the Respondent does not fall within paragraph 4(c)(ii) of the Policy.

Lastly, as the Respondent's use of the disputed domain name is illicit, it does not qualify as a legitimate noncommercial or fair use under paragraph 4(c)(iii) of the Policy.

For the sake of completeness, the Panel notes that, despite the presence of the word "review" in the disputed domain name, the website to which it resolves is not in the nature of commentary or criticism for the purposes of Policy, paragraph 4(c)(iii). As discussed above, it appears to be a commercial website featuring click-through links.

Accordingly, based on the evidence presently before the Panel, the Respondent does not fall within any of circumstances under paragraph 4(c) of the Policy. Also, there is simply no evidence that the Respondent has acquired, through any other means, any rights or legitimate interests in the disputed domain name.

Thus, the Panel concludes that the Respondent has no rights or legitimate interests in the disputed domain name within paragraph 4(a)(ii) of the Policy.

C. Registered and Used in Bad Faith

The Panel finds that the Respondent's actions, with respect to the disputed domain name, constitute bad faith registration and use.

It is indisputable that the Respondent was well aware of the Complainant, its reputation, its VIRGIN Marks and the exclusive rights which the Complainant had in those marks when the Respondent registered the disputed domain name. Yet, in spite of that knowledge and in the absence of any authority to do so from the Complainant, the Respondent intentionally chose and registered the disputed domain name containing the

term "Virgin" for its potential to cause confusion with those marks. Relying on that confusion, the Respondent used the disputed domain name to direct Internet users to his own website which very closely resembled, in terms of look and feel, an official website of the Virgin Group and through which he derived click-through revenue as a result of Internet users clicking on links, within the site, that directed those users to a gaming site associated with the Virgin Group. Thus, the Respondent, through the confusion it intentionally caused, economically benefited from his illicit exploitation of the Complainant's marks and their reputation.

Hence, the Panel concludes that the Respondent's registration and use of the disputed domain name fall within the bad faith provision of paragraphs 4(a)(iii) and 4(b)(iv) of the Policy.

Thus, the Panel concludes that the Complainant has provided sufficient proof of their allegations, with respect to the disputed domain name, to establish a case under paragraph 4(a) of the Policy upon which the relief it now seeks can be granted.

7. Decision

Accordingly, under paragraphs 4(i) of the Policy and 15 of the Rules, the Panel grants the relief sought by the Complainant. The disputed domain name <virgincasinoreview.com> is to be transferred to the Complainant.

Peter L. Michaelson

Sole Panelist

Date: June 2, 2016