

DISPUTE RESOLUTION SERVICE

D00009719

Decision of Independent Expert

Barclays PLC

and

Domain Governance, Inc.

1. The Parties:

Complainant: Barclays PLC
1 Churchill Place
London
E14 5HP
United Kingdom

Respondent: Domain Governance, Inc.
3 Winchester St
Nassau
Bahamas
BH004
Bahamas

2. The Domain Name(s):

barclaybankonline.co.uk

3. Procedural History:

3.1 Overview

24 March 2011	Dispute received
25 March 2011	Complaint validated
25 March 2011	Notification of Complaint sent to parties

13 April 2011	Response reminder sent
18 April 2011	No Response Received
18 April 2011	Notification of no response sent to parties
26 April 2011	Expert decision payment received

Capitalized terms used in this decision have the meaning given to them in the Nominet Dispute Resolution Service (“DRS”) Policy and Procedure, Version 3 of July 2008 (“the Policy” and “the Procedure” respectively).

3.2 Service

Nominet served the Respondent with the Complaint on 25 March 2011.

1) By email to:

- a) namefarm@googlemail.com;
- b) postmaster@barclaybankonline.co.uk.

2) By registered post to:

- a) Domain Governance, Inc., 3 Winchester St, Nassau, Bahamas, BH004, Bahamas with Royal Mail reference RI696442318GB.

The email to postmaster bounced back with an undeliverable message. Nothing turns on this however. The Royal Mail track and trace service shows item RI696442318GB was passed to the overseas postal service for delivery. On 13 April 2011, Nominet sent a Response Reminder Notice to the Respondent at the postal address at (2) and the email address at 1(b) above. No Response was received by 15 April 2011, or at all.

The DRS derives its jurisdiction from the terms and conditions of the contract of registration between the Respondent and Nominet (“the Contract”). §14 of the Contract incorporates the Policy and Procedure by reference. §4.1 requires a Registrant’s details to be entered in the Register and the Registrant agrees to ensure that Nominet has his correct postal address, telephone and fax number and email address and some of this information is also posted on the public WHOIS database. Failure to provide correct details, or keep them current, may be grounds for cancelation or suspension of a domain name, per clause 17.2.

§2(a) of the Procedure provides a Respondent may be served with a Complaint, at Nominet’s discretion by any of: first class post, fax or email to the contact details in the Register; or by email to postmaster@<the domain name in dispute> etc. The Contract clearly renders the Respondent responsible for any failure to notify Nominet of changes to his details.

The Respondent’s WHOIS entry gives the postal address above and the googlemail. I am therefore satisfied the Respondent is duly served.

3.3 Default

Although the Respondent has failed to submit a Response, or make any other submission, the Procedure does not provide for a default decision in favour of the Complainant. The Complainant must still prove its case to the requisite standard, see §15(b) of the Procedure. However, an expert may draw such inferences from a party's default as appropriate.

4. Factual Background

The Complainant is a major global financial services provider engaged in retail banking, credit cards, corporate banking, investment banking, wealth management and investment management services with an extensive international presence in Europe, the Americas, Africa and Asia.

The Complainant currently operates in over 50 countries and employs approximately 144,000 people. The Complainant moves, lends, invests and protects money for more than 48 million customers and clients worldwide. The Complainant's domain names include barclays.co.uk registered sometime before 1996 and barclays.com, registered in 2003.

The Respondent registered the Domain Name on 4 March 2009. No further details are available about the Respondent who has not submitted a Response. The Domain Name resolves to a pay per click website displaying finance related sponsored links. I visited the site on 27 April 2011.

5. Parties' Contentions

The Complainant says it has Rights in a name or mark similar to the Domain Name and in the hands of the Respondent, the Domain Name is an Abusive Registration.

The Complainant is the registered proprietor of a variety of UK registered and Community registered trade marks in the name BARCLAY (in both singular and plural form) in a range of classes and evidence was submitted of marks including the word mark BARCLAY/ BARCLAYS in class 36 UK registration 1286579 (1986) and the word mark BARCLAYBANK in the same class UK No. 1336098 (1988). Evidence was provided of some 67 registered UK and Community trade marks, being word marks and figurative marks.

In addition, the Complainant has acquired goodwill and a significant reputation through its use of the name BARCLAYS in its businesses over the last 300 years. It was first incorporated in 1896 as Barclay & Company Limited, changing its name to Barclays Bank in or about 1917. The current form of the name, Barclays PLC, was adopted in 1985. The name BARCLAYS has become a distinctive identifier associated with the Complainant and the services it provides.

The Complainant says the Domain Name contains a word confusingly similar to BARCLAYS and the addition of the generic word 'online' adds nothing.

As to Abusive Registration, given the widespread use and notoriety of the famous BARCLAYS marks, the Respondent must have been aware that in registering the Domain Name it was misappropriating the BARCLAYS trade marks. No trader would choose the Domain Name unless to create a false impression of association with the Complainant. The Respondent has intentionally attempted to attract, for commercial gain, internet users by creating a likelihood of confusion with the Complainant's trade marks.

The Domain Name resolves to a pay per click website displaying finance related sponsored links which relate to competitor products and services to those of the Complainant. The Domain Name is being used to generate income for the Respondent and divert potential custom from the Complainant.

The Respondent is not known by the Domain Name. The Respondent has not acquired any right or licence from the Complainant. The Respondent is not making a legitimate non-commercial or fair use of the Domain Name. The pay per click sponsored links for financial services are commercial use. The notoriety of BARCLAYS is such that members of the public will always assume that there is an association between the Respondent and the Complainant and that can never be fair use.

The Complainant's solicitors wrote to the Respondent on 13 August 2010 advising of the Complainant's registered trade marks and seeking a transfer of the Domain Names. The Respondent failed to respond to this letter and subsequent letters on 8 and 26 October 2010. The Respondent failed to alter the content at the site of the Domain Name.

6. Discussions and Findings

The DRS is designed as a fast, simple alternative to litigation. Domain names are registered on a first come, first served, basis and a registration will only be disturbed if it is found to be an Abusive Registration, as defined in the Policy. Paragraph 2(a) of the Policy requires the Complainant to prove 2 elements:

- “i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

The Complainant bears the onus of proof and must prove both elements on the balance of probabilities. As mentioned above, even where no Response is submitted, the Complainant must meet this burden.

The DRS's jurisdiction under the Contract is limited to these issues and the remedies of cancellation, suspension, transfer or amendment of the Domain Name. The Policy

does not provide for the determination of allegations of trade mark infringement or passing-off proper.

6.1 Rights

The Complainant clearly has Rights in the name BARCLAY(S) from its long trading history and its various registered marks. Paragraph 2(a)(i) of the Policy requires that the name or mark in which a Complainant has Rights “is identical or similar to the Domain Name.” For these purposes, hyphens spaces and ampersands are ignored. Descriptive terms add nothing to the inquiry, see *Alliance & Leicester plc v. Paul’s Cameras* [2006] DRS 3280 and the word online is descriptive. The word bank is also descriptive and adds nothing. I am satisfied the Complainant has Rights in a mark and name identical or similar to the Domain Name.

6.2 Abusive Registration

The second element the Complainant must prove under §2(a) of the Policy, is that the Domain Name is an Abusive Registration, defined in §1 thereof. §3 of the Policy provides a non-exhaustive, illustrative, list of factors, which may evidence an Abusive Registration. Conversely, §4a of the Policy provides a non-exhaustive list of factors which may evidence that a registration is not an Abusive Registration.

Confusion is relevant to the inquiry under §3aiC of the Policy (circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily: ..for the purpose of unfairly disrupting the business of the Complainant) and also 3aii (circumstances indicating 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).

The Complainant says that given the fame of Barclays, the Respondent must have known of the Complainant and can only have chosen the Domain Name in order to leverage that fame so that the Domain Name is incapable of legitimate use. Knowledge is required for Abusive Registration under §3a of the Policy (see Appeal Panel in DRS 04331), and I am satisfied given the Complainant’s fame, and the inclusion of the word bank in the Domain Name, that the Respondent must have had knowledge of the Complainant.

It is also clear that the Respondent benefits financially from the resulting confusion by the income from the sponsored links at the site to which the Domain Name resolves-- which primarily relate to competing financial products and services. I find grounds §3aiC and 3aii of the Policy made out. There is no need to go on to consider other grounds.

I would note however that this case also falls within the principles set out in *Chivas Bros Ltd v. D. W. Plenderleith* DRS 00658, namely, where a Respondent registers a domain name: (1) identical to a name in respect of which a Complainant has Rights; (2) that name is exclusively referable to the Complainant; (3) there is no obvious justification for the Respondent having adopted that name; and (4) the Respondent has come forward with no explanation for having selected the domain name; it will

ordinarily be reasonable to infer that the Respondent registered the domain name for a purpose and that that purpose was Abusive.

I am obliged to consider any obvious factors militating against Abusive Registration, even in a default case where no response has been filed. I note §4e of the Policy provides that while the sale of traffic is not objectionable per se, this depends on the nature of the domain and the links -- and stipulates that the Respondent is responsible for the manner of use (e.g. even where an algorithm serves the ads). Here the Complainant is a regulated bank and consumers looking for it may be diverted. While it does not appear to be a phishing site, consumer diversion and confusion in this sector in particular is unwelcome. The Respondent's use is purely commercial and I can see no basis for any legitimate use. It appears the Respondent's sole purpose was to harvest traffic from the Complainant's reputation for financial gain. I find the registration is an Abusive Registration.

7. Decision

I find that the Complainant has Rights in a mark identical or similar to the Domain Name, which is an Abusive Registration in the hands of the Respondent. Accordingly, the Domain Name should be transferred to the Complainant.

Signed: Victoria McEvedy

Dated 27/04/2011