

DISPUTE RESOLUTION SERVICE

D00010802

Decision of Independent Expert

Barclays PLC

and

Mr Martin Sayers

1. The Parties:

Lead Complainant: Barclays PLC
c/o Pinsent Masons LLP
123 St Vincent Street
Glasgow
G25EA
United Kingdom

Respondent: Mr Martin Sayers
Way Cottage, Sherwood Green
St. Giles-in-the-Wood
Torrington
Devon.
EX38 7JU
United Kingdom

2. The Domain Name:

mybarclays.co.uk

3. Procedural History:

23 January 2012	Dispute received
24 January 2012	Complaint validated
24 January 2012	Notification of complaint sent to parties
13 February 2012	Response received
13 February 2012	Notification of response sent to parties
17 February 2012	Reply received
21 February 2012	Notification of reply sent to parties
21 February 2012	Mediator appointed

24 February 2012	Mediation started
09 March 2012	Mediation failed
09 March 2012	Close of mediation documents sent
15 March 2012	Expert decision payment received

On March 21, 2012, Clive N.A. Trotman was appointed Independent Expert to decide the dispute in accordance with the current Nominet Dispute Resolution Service Policy (the "Policy") and the Nominet Dispute Resolution Service Procedure (the "Procedure"). The Expert confirmed his independence and impartiality in the terms of paragraph 9(a) of the Procedure.

On March 22, 2012, the Expert received from the Respondent, through Nominet, an Explanatory Note dated March 20, 2012, presaging an intended non-standard submission.

Paragraph 13 of the Procedure governs the submission of any non-standard submission in the following terms:

"13. Further Statement

- a. In addition to the complaint, the response and if applicable the reply and any appeal, the Expert may request further statements or documents from the Parties. The Expert will not be obliged to consider any statements or documents from the Parties which he or she has not received according to the Policy or this Procedure or which he or she has not requested.
- b. Any communication with us intended to be passed to the Expert which is not part of the standard process (e.g. other than a complaint, response, reply, submissions requested by the Expert, appeal notice or appeal notice response) is a 'non-standard submission'. Any non-standard submission must contain as a separate, first paragraph, a brief explanation of why there is an exceptional need for the non-standard submission. We will pass this explanation to the Expert, and the remainder will only be passed to the Expert at his or her sole discretion. If there is no explanation, we may not pass on the document or information.
- c. On receipt of a non-standard submission we shall copy to the other Party the explanatory first paragraph, but we will only send the remainder to the other Party if and when the Expert requests sight of the remainder."

Having read all of the evidence and submissions, and the Explanatory Note, the Expert has decided that the thrust of the Respondent's intended non-standard submission is already clear from the Response and that neither the non-standard submission nor any further statements or documents will be accepted from the Parties.

4. Factual Background

On the basis of information supplied by the Complainant, Barclays Bank PLC, company number 00048839, is a global provider of financial services and is well known in Europe, the Americas, Africa and Asia. It has been known by the name Barclays Bank PLC since 1985, previously as Barclays Bank Limited since 1917, and before that as Barclay & Company Limited since 1896. It operates in over 50 countries and employs approximately 144,000 people servicing more than 48 million customers and clients.

The Complainant lists numerous trade marks for the word BARCLAYS either alone or in combination, for example UK trade mark BARCLAYS, registration number 1314306, registered June 24, 1987, in class 36 (insurance and financial services).

The Complainant is the registrant of domain names that incorporate its name and trade mark, including "barclays.co.uk" and "barclays.com".

The Respondent is an individual whose stated intention is to operate a website at which people may post and discuss tributes and criticism relating to Barclays Bank. He registered the disputed Domain Name "mybarclays.co.uk" on October 28, 2008 and appears not to have used it for the stated purpose before being notified that some links had been placed on it by the hosting service. He arranged for the links to be removed in November 2011 and replaced them with a brief announcement of a stated intention to provide a forum for tributes and criticism of the Complainant.

5. Parties' Contentions

Complainant

Complainant's Rights

The Complainant contends that it has rights in the disputed Domain Name for reasons that include the following:

The Complainant, named Barclays Bank PLC, 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.

The Complainant has traded as Barclays Bank PLC since 1985, with a history incorporating the name Barclays Bank dating back to 1917, and incorporating the name Barclay dating back to 1896.

The Complainant attaches a schedule of its registered UK and Community trade marks in the term BARCLAYS in a range of classes.

The Complainant says that it has not assigned any trade mark to the Respondent.

The Domain Name contains a word which is identical and therefore confusingly similar to the word BARCLAYS in which the Complainant has common law rights and registered trade marks.

Given the worldwide fame and notoriety of the trade mark BARCLAYS, no trader would choose the Domain Name "mybarclays.co.uk" unless to create a false impression of association with the Complainant in order to attract business from the Complainant or misleadingly to divert the public from the Complainant to the Respondent.

Abusive Registration

The Complainant contends that the Domain Name is an Abusive Registration for reasons that include the following:

The Domain Name was being used as a pay per click website. Internet traffic was attracted by use of the name BARCLAYS, with an intention to generate income for the Respondent.

The Complainant initiated contact with the Respondent on December 9, 2011. In reply the Respondent claimed to have registered the Domain Name for the purpose of developing a moderated forum for the public to air their complaints or tributes about the practices of Barclays Bank, and that the Domain Name would never be used for trading. The Domain Name now displays a page entitled "Barclays Bank Tribute and Criticism".

For 3 years from October 28, 2008 to December 9, 2011 there were no demonstrable preparations by the Respondent to develop a moderated public forum for complaints or tributes about Barclays Bank. It is not coincidental that the first move towards setting this up was made after hearing from the Complainant.

The use of the word "my" in this Domain Name suggests that it is in some way associated with the Complainant. It is not unreasonable to assume that the Complainant's customers would be confused into believing that a Domain Name called "mybarclays" would in some way relate to their accounts with Barclays Bank, and not as the Respondent suggests, as a public forum for discussion.

The registration of the Domain Name is anticipated to disrupt unfairly the business of the Complainant.

The Respondent is not known by the Domain Name.

The Respondent is not making a legitimate noncommercial or fair use of the Domain Name, and a pay per click operation does not qualify as such.

Given the widespread use and notoriety of the famous BARCLAYS trade mark, and the Respondent's statement as to why he registered the Domain Name, it is clear that the Respondent was aware he was misappropriating the valuable intellectual property of the Complainant.

The Respondent's registration of the Domain Name has prevented the Complainant from registering the same Domain Name, which corresponds to the Complainant's trade marks.

The Respondent has intentionally attempted to attract, for commercial gain, internet users to the website by creating a likelihood of confusion with the Complainant's trade marks.

Respondent

The Respondent denies the Complaint and contends that his registration and use of the Domain Name is not an Abusive Registration for reasons that include the following:

The Domain Name was legitimately registered for the purpose of producing a moderated forum for the general public to air their complaints or otherwise about the Complainant, of which the Respondent expresses certain criticisms.

Years after registration of the Domain Name by the Respondent, the Complainant launched online 'sub-domain' products which are named similarly to the Domain Name. The Complainant wants to gain ownership of the Domain Name to match its product and is engaged in attempted reverse domain name hijacking.

The Respondent says that the Domain Name will never be used or intended to capture traffic destined for the Complainant and that the public will eventually become aware of the website as a critique website. He strongly denies intending to create a false association with the Complainant.

The Respondent says it is incorrect that the Domain Name was initially used as a pay per click website because it only pointed to a placeholder for the registering agent Namesco Ltd. Later, however, Namesco Ltd., introduced pay per click links into the placeholder page, in direct contravention of Nominet's opt out policy for a non-trading registrant. The Respondent says he took corrective action on November 17, 2011 to have the links removed after being notified of them by Nominet, and not as a result of the Complainant's letter to him dated December 9, 2011.

The Respondent says: "I followed this up with a recorded delivery and signed for letter to Namesco Ltd., (see attachment) asking them on what date and why they inserted paid per click links on a placeholder page in direct contravention of Nominet's policy. When a registrant opts out as a non trading individual from the Whois data base I feel that it is reasonable to assume that their privacy would be upheld".

The Respondent says his delay since acquisition of the Domain Name, without setting up his intended criticism site, is not a matter for others to dictate.

Complainant's Reply

The Complainant in its Reply reiterates points made in the Complaint and says:

The Respondent has confirmed that he purchased the Domain Name with the intention of using it as a moderated forum, but the content displayed on the website at the Domain Name when it was acquired by the Respondent included finance related sponsored links.

The Complainant says its position is in accordance with the general opinions of Panels, in that a domain name registrant is responsible for content appearing on the corresponding website. The Complainant submits that this is the case even if a registrant may not be exercising direct control over such content, for example, in the case of advertising links generated automatically.

Schedule A, section 2(d) of the Namesco Terms and Conditions says that Namesco will publish courtesy pages containing advertisements on the domain name of their customer in the absence of content. Crucially, a customer is "free to remove the courtesy page at his/her sole discretion using the tools at his/her disposal". Therefore it is clear that the Respondent was able to remove the finance related sponsored links and chose [not to] or failed to do so due to his ignorance of the Namesco terms and conditions.

The Respondent has indicated that the Domain Name is not displayed in any search engine results. It is the Complainant's position that when an Internet user enters the URL "mybarclays.co.uk", they will be re-directed to the Respondent and not the Complainant and this causes harm to the Complainant's relevant trade mark rights.

It would be for the Respondent to prove reverse domain name hijacking by evidencing bad faith on behalf of the Complainant. The Complainant has not made the Complaint in bad faith but on perfectly legitimate grounds to protect Barclays' brand from being hijacked.

The Respondent must have been aware that in registering the Domain Name he was misappropriating the valuable intellectual property of the owner of the BARCLAYS trade marks. The Respondent acknowledges the Complainant's trade marks to be "highly distinctive". He was well aware of the Complainant's valuable intellectual property when he registered the Domain Name. The Respondent has no legitimate rights in the Domain Name and the registration was an Abusive Registration.

6. Discussions and Findings

Paragraphs 2(a) and 2(b) of the Policy require the Complainant, in order to succeed, to prove on the balance of probabilities that:

- 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."

Complainant's Rights

It is not contested that the Complainant is a major bank that has been known as "Barclays Bank" since at least as early as 1917. In evidence the Complainant lists a substantial portfolio of trade marks incorporating the word BARCLAYS either standing alone or in combination.

The disputed Domain Name is "mybarclays.co.uk", of which the domain designation ".co.uk" may generally be disregarded in the determination of identity or similarity. What remains is "mybarclays", which is easily read as "My Barclays".

The distinctive, operative and immediately recognisable part of the Domain Name is “Barclays”, which is identical to the Complainant’s name and registered trade mark. The word “Barclays” is sufficiently dominant in the Domain Name that the addition of a prefix or suffix word or string is unlikely to be distinguishing. The prefix “my”, furthermore, is in common use in domain names for the purpose of designating a service or facility whereby customers may consult and update personal data such as delivery address, airline bookings, bank balances and the like. In the circumstances I find that the prefix “my” not only fails to create any distinction between the Domain Name and the Complainant’s name, but compounds the similarity by being typical of an offering to be expected of a bank. Accordingly I find the Domain Name to be similar to a name in which the Complainant has rights.

Abusive Registration

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights”.

Paragraph 3 of the Policy sets out a non-exhaustive list of factors that may be evidence that the Domain Name is an Abusive Registration, and reads in part, and in so far as may be relevant to the present case:

“3. Evidence of Abusive Registration

- a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:
 - 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;

[.....]”

The Complaint is made principally on the grounds that the Respondent is blocking the Complainant from registering a Domain Name corresponding to its name (paragraph 3(a)(i)(B) of the Policy); is unfairly disrupting the business of the Complainant (paragraph 3(a)(i)(C) of the Policy); and is creating confusion between itself and the Complainant (paragraph 3(a)(ii) of the Policy). The onus of proof is upon the Complainant. The Respondent, however, claims that he is making or intends to make a fair use of the Domain Name, which therefore would not be an Abusive Registration. Paragraph 4 of the Policy provides a non-exhaustive list of factors whereby the Respondent may show that the Domain Name is not an Abusive Registration, and reads in part:

“4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

[A - B]

C. made legitimate non-commercial or fair use of the Domain Name;

or

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

[iii - iv]

b. Fair use may include sites operated solely in tribute to or in criticism of a person or business.

[.....]”

Paragraph 4(b) of the Policy gives discretion for a particular tribute or criticism website to be included within the definition of fair use. The Respondent claims his website is for tribute or criticism. The Complainant was aware of this claim as a result of correspondence between the Parties in December 2011, produced in evidence, in which the Respondent outlined an intended “moderated public forum for the general public to air their complaints or tributes about the practices of Barclays Bank”.

The Complainant has pre-empted the Respondent's position by asserting that between October 28, 2008 and the Complainant's letter of December 9, 2011, the Respondent had parked the Domain Name and not used it for the purpose claimed. The Complainant says the minimal notice of an intended public forum appeared on the website as a consequence of the Complainant's letter of December 9, 2011. The Respondent denies this, implying the development work began on November 17, 2011.

In order to succeed with a defence of fair use under paragraph 4(a)(i)(C) of the Policy, the Respondent would have to demonstrate fair use “before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS)”. Awareness of a cause for complaint need not mean the receipt of any notification of a Complaint (paragraph 4.2, *Dispute Resolution Service - Experts Overview (2009)*). It is sufficient for the Respondent, when registering the Domain Name, to have been aware of the Complainant's name or trade mark forming the basis of the Complaint. Manifestly the Respondent was aware of Barclays Bank PLC when he registered the Domain Name for the subsequently declared purpose of soliciting tributes and criticism.

In any case, the Respondent has stated that he inserted the brief announcement of a future tribute or criticism site on November 17, 2011, after being notified by Nominet of a cause for complaint. The Respondent's letter to Namesco Ltd., dated December 19, 2011, confirms receiving notification of a cause for complaint on November 16, 2011. There is no evidence that the Domain Name was other than parked prior to November 17, 2011. Accordingly I find that the Respondent cannot establish fair use before having become aware of a cause for complaint in the terms of paragraph 4(a)(i)(C) of the Policy.

In the alternative, fair use may be found under paragraph 4(a)(ii) of the Policy provided the Respondent can establish that the Domain Name is generic or descriptive. Concise Oxford

Dictionary definitions of “generic” include “characteristic of a group or class” and “not specific”. Definitions of “descriptive” include “serving to describe”.

I find the words “Barclays” and “My Barclays” to be far removed from generic or descriptive. The key word “Barclays” is not characteristic of a group or class and does not serve to describe; on the contrary it is specific for one discrete entity in the present context, namely the Complainant, Barclays Bank PLC.

The effect of paragraph 4(b) of the Policy is not to absolve a tribute or criticism site from being an Abusive Registration, but to enable its use to be considered as possibly fair if other necessary conditions of fairness are met. The style of the Domain Name portrays every indication of being an authentic banking website of the Complainant and no indication of being intended by an external entity as a tribute or criticism website or of having any other plausible function not associated with the Complainant.

Accordingly I find that the Respondent cannot succeed in claiming fair use of the Domain Name either generally or as a tribute or criticism website, and that any use of the Domain Name by the Respondent for his stated intention, irrespective of its content, would constitute an Abusive Registration.

It remains for Abusive Registration to be proven on the evidence. I find it more probable than not that any use of the Domain Name, including its intended use as a tribute or criticism site, would have the consequence of causing many Internet users to be confused into thinking that it looked like, and would offer, an authentic service of Barclays Bank PLC. The Respondent makes entirely clear his intention to attract Barclays Bank PLC customers and his awareness of the Complainant is not in contention. I find that the Respondent is creating and intending to create initial interest confusion with the Complainant, constituting an Abusive Registration under paragraph 3(a)(ii) of the Policy. In reaching this decision it has not been necessary to resolve the contested question of whether and to what extent pay per click links may have been offered through the Domain Name.

Furthermore, having regard to the fame of the Complainant’s name and trade marks, it is not reasonably possible to conceive of any legitimate use to which the Domain Name could be put by the Respondent. There is adequate evidence for a finding, on the balance of probabilities, that the Domain Name was registered primarily for the purpose of unfairly disrupting the business of the Complainant, whether by the operation of a website in conflict with the Complainant or otherwise, within the meaning of paragraph 3(a)(i)(C) of the Policy, and I find Abusive Registration proven accordingly.

It follows that the Respondent’s claim of attempted Reverse Domain Name Hijacking (paragraph 16(d) of the Procedure) is dismissed.

7. Decision

The Expert finds that the Complainant has Rights in respect of the name “Barclays”; that the disputed Domain Name “mybarclays.co.uk” is similar to the Complainant’s name; and that the Domain Name, in the hands of the Respondent, is an Abusive Registration. The Domain Name “mybarclays.co.uk” is ordered to be transferred to the Complainant.

Signed Clive N. A. Trotman

Dated April 12, 2012