

## Dispute Resolution Service

DRS 11896

### Decision of Independent Expert

Barclays Bank PLC

and

BB Money Net

#### 1. Parties

Complainant : Barclays Bank PLC  
c/o Pinsent Masons LLP  
123 St Vincent Street  
Glasgow  
G25 EA  
United Kingdom

Respondent : BB Money Net  
426 Hoe Street  
London  
E17 9AA  
United Kingdom

#### 2. Domain Name

bbarclaymoneynet.co.uk (the "Domain Name")

### 3. Procedural Background

On 13<sup>th</sup> September 2012 the Complaint was lodged with Nominet UK Limited (“Nominet”) and on 13<sup>th</sup> September 2012 it was validated. Also on 13<sup>th</sup> September 2012 Nominet sent the notification of the complaint letter to the Respondent by e-mail and post, advising it to log into its account to view the details of the Complaint and giving it 15 working days within which to lodge a Response on or before 4<sup>th</sup> October 2012. On 2<sup>nd</sup> October 2012 Nominet sent a Response reminder to the Respondent.

The Respondent did not reply and on 5<sup>th</sup> October 2012 Nominet sent the notification of no response to the parties. On 9<sup>th</sup> October 2012 the Complainant paid the appropriate fee for a Decision to be made by an Expert pursuant to paragraph 6 of Nominet’s DRS Policy (“the Policy”).

On 9<sup>th</sup> October 2012 Mr. Niall Lawless (“the Expert”) was selected and on 15<sup>th</sup> October 2012 was formally appointed to act as Expert in this dispute, having confirmed that he knew of no reason why he could not properly accept the appointment and knew of no matters which ought to be drawn to the attention of the parties which might appear to call in-to question his impartiality and -/- or independence. He is required to give his Decision by 5<sup>th</sup> November 2012.

### 4. Outstanding Formal -/- Procedural Issues

On 14<sup>th</sup> September 2012 Mr John Wayne on behalf of the Respondent sent an e-mail to Nominet saying *“we are no longer using this service and has been deleted. Kindly close down the address accordingly”*.

On 18<sup>th</sup> September 2012 Nominet wrote to Mr Wayne asking for permission to transfer the bbarclaymoneynet.co.uk domain name to Barclays PLC. Nominet confirmed that if it did not receive a response by 4<sup>th</sup> October 2012 the Complainant could pay for an expert decision which would result in the name of the registrant being published on Nominet’s website. The Respondent did not reply to Nominet’s 18<sup>th</sup> September 2012 e-mail.

There are no outstanding formal or procedural issues.

## 5. Factual background

The Complainant, 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 in Europe, the Americas, Africa and Asia. The Complainant currently operates in over 50 countries and employs approximately 144,000 people.

The Complainant is the registered proprietor of a variety of UK registered and Community registered trademarks containing or consisting of the terms “Barclay” and “Barclays” in a range of classes.

On 5<sup>th</sup> August 2011 the Respondent registered the Domain Name.

The Complainant seeks transfer of the Domain Name.

## 6. The Parties’ contentions

### The Complainant

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under Nominet’s Dispute Resolution Service Policy (the "Policy") because:-

- The Respondent’s registration and continuous holding of the Domain Name has prevented the Complainant from registering a domain name, which corresponds to the Complainant’s trademarks.
- The Domain Name consists of the Complainant’s distinctive “Barclay” and “Barclays” marks and has been used in a way that has confused (or is likely to confuse) people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.
- The Domain Name takes unfair advantage of the Complainant’s established reputation because the Respondent is using the Domain Name to provide a link to a holding page displaying a number of finance related sponsored links, which relate to products and services which are competitors to those offered by the Complainant.

- Although the Domain Name includes the words “money” and “net” and includes an extra letter “b”, the dominant factor in the Domain Name is clearly the word "Barclay" and these additions fail to distinguish the Domain Name from the Complainant’s name.
- The Respondent is a typosquatter (a form of cybersquatter which relies on mistakes such as typographical errors made by Internet users when inputting a website address into a web browser) attempting to attract visits from internet users who misspell the Complainant's name when typing a web address into a web browser.

#### The Respondent

The Respondent did not respond to the Complaint.

## **7. Discussions and Findings**

### 7.1 General

Nominet’s Policy requires that for a Complaint to succeed the Complainant must prove to the Expert 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.

Rights include, but are not limited to, rights enforceable under English Law.

In order to show that the Domain Name is an Abusive Registration, the Complainant must prove that the Domain Name either:-

- i. 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.

The Complainant is required to prove to the Expert that the Complainant has Rights and that the Domain Name in the hands of the Respondent is an Abusive Registration; both elements must be present.

## 7.2 Complainant's Rights

The Complainant is the registered proprietor of a variety of UK registered and community registered trademarks in the terms "Barclay" and "Barclays" in a range of classes. In addition to its registered trademarks, through its use of the name BARCLAYS over the last 300 years the Complainant has acquired goodwill and a significant reputation in providing financial services. The Complainant is the registrant of a variety of domains including www.barclays.co.uk and www.barclays.com.

Although the Domain name includes the words "money" and "net" and includes an extra letter "b", the dominant factor in the Domain Name is clearly the word "Barclay" and I agree that the additional words and letter fail to distinguish the Domain Name from the Complainant's name.

Because of this, I decide that the Complainant has Rights in respect of a name or mark, which is identical or similar to the Domain Name.

## 7.3 Abusive Registration

The Complainant says that the Domain Name controlled by the Respondent is an Abusive Registration under the Policy, but it does not state under which part of the Policy. Under Paragraph 3 - Evidence of Abusive Registration - guidance is given as to what factors may evidence that the Domain Name is an Abusive Registration.

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

3(a)(i). Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily :-

3(a)(i)(B). as a blocking registration against a name or mark in which the Complainant has Rights; or

3(a)(i)(C). for the purpose of unfairly disrupting the business of the Complainant;

3(a)(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;

### Blocking Registration

The Complainant says that Respondent's registration and continuous holding of the Domain Name has prevented the Complainant from registering a domain name, which corresponds to the Complainant's trademarks.

Because of this the Domain Name is an Abusive Registration under Nominet's DRS Policy section 3(a)(i)(B).

Nominet operates a "first-come, first-served" system of domain name registration and there is no requirement for the Respondent to show that it has Rights in the name (unlike the Complainant, who must prove that). However, it can help the Respondent's case if he can show that it has rights in the name, as it suggests that the registration (and possibly the use) of the name is not abusive.

The Respondent has not responded to the above and offered no evidence.

Although the registration and use of the Domain Name is offensive to the Complainant, it is unlikely that in its absence the Complainant would have had any interest in registering the Domain Name, which incorporates a misspelling of its "Barclay" and "Barclays" Marks. Therefore I do not decide that the Respondent registered the Domain Name as a blocking registration against a name or mark in which the Complainant has Rights.

### Using Domain Name to Confuse

The Complainant says the Domain Name consists of the Complainant's distinctive "Barclay" and "Barclays" marks and has been used in a way that has confused (or is likely to confuse) people into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant.

Because of this the Domain Name is an Abusive Registration under Nominet's DRS Policy section 3(a)(ii).

The Respondent has not responded to the above and offered no evidence.

At the time of making this Decision, the Domain Name is resolving to a webpage parked free courtesy of GoDaddy.com, and which on 12<sup>th</sup> September 2012 linked to websites offering to lend money.

On 12<sup>th</sup> September 2012 the Domain Name was being used to offer services similar to those offered the Complainant. However, the holding page is bereft of any Barclays recognisable branding; the quality of the design of the holding page lacks professionalism, and the primary purpose of the holding page is to offer website building services. Because of that, I do not accept that the Domain Name is being used in a way, which has confused people into believing that the Domain Name is operated by or connected with the Complainant.

I decide that the Domain Name is not being used in a way which has confused and will confuse people or businesses and under the test in Nominet's DRS Policy 3(a)(ii) in the control of the Respondent the Domain Name is not an Abusive Registration.

#### Unfairly Disrupting the Complainant's Business

The Complainant says that the Respondent's use of the Domain Name takes unfair advantage of the Complainant's established reputation because the Respondent is using the Domain Name to provide a link to a holding page displaying a number of finance related sponsored links, which relate to products and services which are competitors to those offered by the Complainant.

The Complainant says that the Respondent, being fully aware of the "Barclay" and "Barclays" marks, registered the Domain Name in order to drive traffic to its website and thereby take advantage of the substantial goodwill in and reputation of the "Barclay" and "Barclays" marks. In particular, the Complainant says that the content on the website at the Domain Name is tailored to match the Complainant's core goods and services. It says that the Respondent receives a payment each time a user clicks on the sponsored links, which relate to financial services.

The Respondent has not responded to the above and offered no evidence.

The Respondent's use of the Domain Name in this way unfairly disrupts the Complainant's Business and is evidence of circumstances falling within paragraph 3(a)(i)(C) of Nominet's DRS Policy.

However, the test under Nominet’s DRS Policy 3(a)(i)(C) is not that the Domain Name is unfairly disrupting the Complainant’ Business, but that it was acquired for that purpose.

To help me decide if the Domain Name was acquired for that purpose, I have to consider the prominence of the Complainant’s brand and reputation as it would have existed on 5<sup>th</sup> August 2011, the date the Respondent registered the Domain Name.

The Complainant says and has provided evidence that at the time the Domain Name was created, the Complainant owned trademark applications and registrations for “Barclay” and “Barclays. Furthermore, at that time “Barclay” and “Barclays” were world-famous brands that had been in existence for 300 years and had a considerable national and international reputation.

Because of this I accept that the Respondent was aware of the “Barclay” and “Barclays” brand when it registered the Domain Name, and consciously chose a domain name incorporating the “Barclay” and “Barclays” marks.

When that is linked with the Respondent’s subsequent use of the Domain Name, resolving to a webpage linked to websites offering to lend money, I decide on the balance of probabilities that the Domain Name was acquired to unfairly disrupt the Complainant’s business and under the test in Nominet’s DRS Policy 3(a)(i)(C) in the control of the Respondent the Domain Name is an Abusive Registration.

#### 7.4 Conclusion

The Expert finds on the balance of probabilities that the Complainant has Rights in respect of a name identical or similar to the Domain Name and that the Complainant has proved, on the balance of probabilities, that the Domain Name in the hands of the Respondent is an Abusive Registration.

### **8. Decision**

For the reasons set out in detail above, having decided that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name be transferred to the Complainant.



**Niall Lawless, Nominet Expert**

**25<sup>th</sup> October 2012**