

DISPUTE RESOLUTION SERVICE

D00009717

Decision of Independent Expert

Barclays PLC

and

Afred Williams

1. The Parties:

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

Respondent: Afred Williams
32 Viola Ave
London
SE2 0TQ
United Kingdom

2. The Domain Name:

barclaysgroupintl.co.uk

3. Procedural History:

The Complaint was received by Nominet on 24 March 2011, and validated and notified to the parties the same day. The due date for a Response was 14 April 2011. No Response was received by the due date, despite a reminder having been sent to the Respondent on 12 April 2011. On 20 April 2011, notification that no Response had been received was sent to the parties. The fee to obtain an independent Expert's decision under Nominet's Dispute Resolution Service Policy (the 'Policy') was paid to Nominet on 26 April 2011 and Jon Lang was appointed as the independent Expert on 3 May 2011.

The Expert confirmed to Nominet that he was independent of the parties and knew of no facts or circumstances that might call into question his independence in the eyes of the parties.

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. It has traded as Barclays Bank PLC since 1985 and before then as Barclays Bank Limited (from 1917) and Barclay & Company Limited (from 1896).

The Complainant currently operates in over 50 countries and employs approximately 144,000 people. It moves, lends, invests and protects money for more than 48 million customers and clients worldwide.

The Complainant is the registered proprietor of a variety of UK registered and Community registered trade marks for BARCLAYS in a range of classes, including, by way of example, UK registered trade mark number 1314306 (for BARCLAYS), with a registration date of 24 June 1987.

Through its extensive use of the name BARCLAYS, the Complainant has acquired goodwill and a significant reputation in the areas in which it specialises. Accordingly, the name BARCLAYS has become a distinctive identifier associated with the Complainant and the services it provides.

The Complainant is the registrant of a variety of domain names including <barclays.co.uk> (registered before 1996) and barclays.com (registered in November 2003).

The Respondent registered the domain name in dispute, <barclaysgroupintl.co.uk>, (the Domain Name) on 1 May 2010.

5. Parties' Contentions

As the Respondent did not respond to the Complaint, the following paragraphs contain the contentions of the Complainant only.

The Domain Name contains a word, which is identical to the Complainant's registered trade mark BARCLAYS, a mark in which the Complainant also enjoys common law rights.

The goodwill associated with the name BARCLAYS is the property of the Complainant and cannot pass to any third party without a formal assignment. No such assignment in favour of the Respondent has taken place.

Given the worldwide fame of the mark BARCLAYS, no trader would choose the Domain Name unless trying to create a false impression of association with the Complainant so as to attract business from the Complainant, or misleadingly divert the public from the Complainant to the Respondent.

Abusive Registration

The Domain Name in the hands of the Respondent is abusive because:

- the Domain Name is being used for a pay per click website which displays finance related sponsored links relating to competitor products and services. The Domain Name is being used to redirect internet traffic intended for the Complainant, with the intention to generate income for the Respondent;
- the Respondent is not known by the Domain Name;
- the Respondent is not making a legitimate non-commercial or fair use of the Domain Name. The content found at the website to which the Domain Name points contains pay per click sponsored links relating to financial services. Such activity does not qualify as non-commercial or fair use;
- the Respondent has never asked for, and has never been given permission by the Complainant to register or use any domain name incorporating the Complainant's trade mark;
- the Complainant's lawyers, Pinsent Masons LLP, wrote to the Respondent on 29 June 2010 complaining about its use of the Domain Name. The Respondent failed to respond and so further letters were sent on 9 August

2010 and 19 August 2010. The Respondent failed to respond to these letters too. Despite this correspondence, the use of the Domain Name remained unchanged;

- given the widespread use and fame of the BARCLAYS mark, the Respondent must have been aware that in registering the Domain Name, he was misappropriating the valuable intellectual property of its owner;
- the Respondent's registration of the Domain Name has also prevented the Complainant from registering a domain name which corresponds to the Complainant's trade marks;
- the Respondent has intentionally attempted to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant's trade marks;
- the Respondent will never be capable of using the Domain Name for a legitimate purpose as the fame of BARCLAYS is such that members of the public will always assume that there is an association between the Respondent and the Complainant, and/or between the Respondent and the BARCLAYS mark;
- it is anticipated that the Domain Name will divert potential custom from the Complainant's business due to the presence of links to competitor sites on the website to which the Domain Name points.

6. Discussions and Findings

Under the provisions of the Policy, for a Complaint to succeed, a Complainant is required to prove, on the balance of probabilities, that it has rights in respect of a name or mark which is identical or similar to the domain name in issue and that the Domain Name in the hands of the Respondent is an Abusive Registration. Both elements are required.

Complainant's 'Rights'

The meaning of 'Rights' is defined in the Policy as follows: *'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'.

The Complainant enjoys long-standing registered and unregistered rights in the mark BARCLAYS. It has several trade mark registrations for, or incorporating, the mark BARCLAYS and has made extensive use of such mark in its financial services activities in the UK and elsewhere over many years.

The Domain Name encapsulates the Complainant's mark BARCLAYS in its entirety. It is the first and dominant word of the Domain Name, being followed by the generic terms 'group' and then 'intl', (a common abbreviation of the term 'international' (both of which terms are commonly associated with or used to describe companies). Ignoring the suffix '.co.uk', the Complainant's mark and Domain Name are similar.

Accordingly, the Expert is satisfied that the Complainant has Rights in a name or mark that is similar to the Domain Name.

Accordingly, the Expert must now consider whether the Domain Name is an Abusive Registration in the hands of the Respondent.

Abusive Registration

Paragraph 1 of the Policy defines Abusive Registration as a domain name which was either *'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 which *'has been used in a manner which has taken unfair advantage of or was unfairly detrimental to the Complainant's Rights;'*.

The best guide as to what might constitute an Abusive Registration is contained in paragraph 3(a) of the Policy. It contains a non-exhaustive list of factors, which may indicate that a domain name is an Abusive Registration. Such factors include circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily as a blocking registration against a name or mark in which a Complainant has rights, or for the purpose of unfairly disrupting the business of a Complainant.

Other factors suggesting an Abusive Registration include the

Respondent 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.

A non-exhaustive list of countervailing factors is set out in paragraph 4 of the Policy. This paragraph contains the best guide as to what does not constitute an Abusive Registration and as mentioned further below.

The Domain Name incorporates the Complainant's mark and is very much its dominant element. There is clearly a likelihood that internet users will be confused into believing that the Domain Name is registered to, operated or authorised by, or otherwise connected with the Complainant. Given the nature of the website to which the Domain Name resolves, in particular, that it displays finance related sponsored links relating to competitor products and services, it might be said that any such initial confusion may dissipate as soon as an internet user arrives at the Respondent's website. However, this is no answer to an allegation of Abusive Registration based on confusion. Such initial confusion, or 'initial interest confusion' as it has come to be known, has been held to provide a basis for a finding of Abusive Registration. The recent DRS appeal decision in *Emirates v Michael Toth* (DRS 8634) provides a very useful account of the current position on initial interest confusion. In that decision the Appeal Panel dealt with the issue in this way:

'Initial interest confusion

As the panellist found in the complaint regarding <emirates.eu>, the Respondent's business model depends on attracting Internet users to his website who then generate revenue by click-throughs. Visitors drawn to the site following an Internet search are far more likely to have been looking for the Complainant's website than a general resource on the United Arab Emirates, and are likely to have assumed that the site they were visiting was associated with or authorised by the Complainant. Similarly those accessing the Website directly are very likely to have been users guessing (incorrectly) at the URL of the Complainant's UK website.

As paragraph 3.3 of the Nominet DRS Expert Overview (the "Overview") records, "the overwhelming majority of Experts"

view "initial interest confusion" as a possible basis for a finding of Abusive Registration,

"...the vice being that even if it is immediately apparent to the visitor to the web site that the site is not in any way connected with the Complainant, the visitor has been deceived."

In the present case, it is likely that a visitor to the Respondent's website would have been looking for the website of the Complainant, rather than one which displays a variety of finance related sponsored links to products and services of others.

In all the circumstances, the Expert is satisfied that the Respondent is using 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.

Given this finding, it is unnecessary to go on to consider whether there is any other basis upon which the Complainant could found an allegation of Abusive Registration.

It is also not necessary to consider in any detail what counter arguments the Respondent may have advanced had he chosen to participate in these proceedings. However, it is perhaps appropriate to note that, in the hands of the Respondent, it is difficult to conceive of a use of the Domain Name that would not amount to an Abusive Registration. For instance, a cursory review of the albeit non-exhaustive, but nevertheless best guide as to what would not be regarded as an Abusive Registration contained in paragraph 4 of the Policy, would not appear to assist the Respondent in any way.

For instance, paragraph 4.a.i provides (as examples of what may indicate that a domain name is not an Abusive Registration) that:

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

- A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;*
- B. been commonly known by the name or legitimately*

connected with a mark which is identical or similar to the Domain Name;
C. made legitimate non-commercial or fair use of the Domain Name;

The Respondent registered the Domain Name on 1 May 2010. He appears to be a UK resident. It seems inconceivable that the Respondent would not have known of the Complainant or that his registration of the Domain Name would not likely give rise to complaint. In any event, it would be difficult to accept, given the nature of the use made of the Domain Name, (in particular, to attract internet users to a website containing links to competing products of the Complainant in circumstances where, at least initially, there is a likelihood of confusion), that the Respondent's use was, for instance, fair or in respect of a genuine offering of goods or services.

In all the circumstances, the Expert is of the view that there is sufficient evidence to support a finding of Abusive Registration.

7. Decision

The Expert finds that the Complainant has rights in a name or mark that is similar to the Domain Name and is satisfied on the evidence before him that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly, the Expert directs that the Domain Name, <barclaysgroupintl.co.uk> be transferred to the Complainant.

Signed Jon Lang

Dated 18 May 2011