

DISPUTE RESOLUTION SERVICE

D00010646

Decision of Independent Expert

Barclays Bank PLC

and

Bridgeport Enterprises Limited

1. The Parties:

Complainant:

Barclays Bank PLC
1 Churchill Place
London
E14 5HP
United Kingdom

Respondent:

Bridgeport Enterprises Limited
Box 1491
St Johns
AG
00
Antigua and Barbuda

2. The Domain Name:

<barclayloans.co.uk>

3. Procedural History:

13 December 2011 14:59 Dispute received
13 December 2011 17:07 Complaint validated
13 December 2011 17:22 Notification of complaint sent to parties

04 January 2012 01:30 Response reminder sent
09 January 2012 11:22 No Response Received
09 January 2012 11:22 Notification of no response sent to parties
10 January 2012 10:46 Expert decision payment received

4. Factual Background

The Complainant is a global provider of banking and other financial services and is the proprietor of registered trade marks including BARCLAYS and BARCLAY.

The Respondent registered the Domain Name on 10 November 2004.

5. Parties' Submissions

Complainant

The Complainant states that it is a major, global provider of financial services. It operates in over 50 countries and employs 144,000 people worldwide, servicing some 48 million customers.

The Complainant is the proprietor of numerous UK and Community registered trade marks consisting of or containing the terms BARCLAYS or BARCLAY. The Complainant submits evidence of those registrations including, for example, UK registration number 1286579 dated 3 March 1989 for the marks BARCLAYS and BARCLAY for financial services in Class 36.

Furthermore the Complainant has traded under a name including the term "Barclay" since 1896 and has acquired significant reputation and goodwill in the areas in which it specialises. It is also the operator of websites located at www.barclays.co.uk and www.barclays.com Accordingly the mark BARCLAYS has become a distinctive identifier of the Complainant and the services which it provides.

The Domain Name includes the term "barclay" which the Complainant submits is identical and/or confusingly similar to the Complainant's marks BARCLAYS and BARCLAY. (The Complainant asserts that no trader would choose the domain name <barlcays.co.uk> otherwise than to create a false association with the Complainant, which I assume to be a submission copied in error from the complaint in another case. Equally the Complainant does not comment on the use of the term "loans" as part of the Domain Name.)

The Complainant submits evidence that the Domain Name is being used for the purposes of a holding page including a number of sponsored links for finance-related products and services which are competitive with those offered by the Complainant.

In the circumstances, the Complainant contends that the Domain Name is an Abusive Registration.

The Respondent registered the Domain Name knowing it would attract attention from internet users who were looking for the Complainant and its products. It is using the

Domain Name to direct those internet users away from the Complainant and to competitor products and services with a view to making a profit for itself.

Given the widespread use and notoriety of the Complainant's marks, the Respondent must have known that by registering the Domain Name it was misappropriating the Complainant's goodwill. The nature of the Domain Name is such that the Respondent will never be able to use it for legitimate purposes as internet users will always assume it to refer to the Complainant.

The Respondent is not known by the Domain Name, the Complainant has never authorised it to use the Domain Name and it is not on any view making fair use of the Domain Name.

Moreover the Respondent failed to respond to two letters from the Complainant's legal representatives requiring it to cease and desist from its activities and to transfer the Domain Name to the Complainant.

The Complainant submits that the Respondent is intentionally using the Domain Name to attract, for commercial gain, internet users to its website by creating a likelihood of confusion with the Complainant's marks. In addition, the Respondent is using the Domain Name as a blocking registration.

The Complainant seeks a transfer of the Domain Name.

Respondent

The Respondent did not file a Response to the Complaint.

6. Discussion and Findings

This matter falls to be determined under the Nominet Dispute Resolution Service Policy ("the Policy") and the Nominet Dispute Resolution Service Procedure ("the Procedure"). Under paragraph 2 of the Policy:

- “(a) A Respondent must submit to proceedings under the Dispute Resolution Service if a Complainant asserts to [Nominet], according to the Procedure, 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.**
- (b) The Complainant is required to prove to the Expert that both elements are present on the balance of probabilities.”*

Under paragraph 1 of the Policy the term “Rights”:

“includes, but is not limited to, rights enforceable under English law...”

Also under paragraph 1 of the Policy, the term “Abusive Registration” means a domain name which 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 took unfair advantage of or was 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 a domain name is an Abusive Registration. Paragraph 4 sets out a non-exhaustive list of factors that may be evidence that it is not. However, all these factors are merely indicative of, and subject to, the overriding test of an Abusive Registration as set out above.

Rights

The Complainant has established that it has registered trade mark rights for the marks BARCLAY and BARCLAYS for services including financial services. It has also provided evidence of significant worldwide reputation and goodwill attaching to those marks in the financial services sector.

The Domain Name consists of the term “barclay” together with the term “loans” and the formal suffix “.co.uk”. The distinctive part of the Domain Name is the term “barclay” and the term “loans” is descriptive of services including those for which the Complainant’s marks are registered.

I therefore find that the Complainant has Rights in respect of a name or mark which is similar to the Domain Name and the first limb of the test under paragraph 2(a) of the Policy is therefore satisfied.

Abusive Registration

Although the Respondent has not responded to the Complaint, it is still for the Complainant to establish circumstances that indicate that the registration is abusive in nature.

In this case the Domain Name consists of the term “barclay” which is a well-known name and mark in the financial services sector, together with the term “loans” which is descriptive of one of the services for which the mark is registered and known. The Domain Name resolves to a directory website offering sponsored links to providers of services competitive with those of the Complainant. The Respondent has responded neither to the Complainant’s representatives’ letters nor to the present proceedings with any explanation of its actions.

In the circumstances, I readily infer that the Respondent registered and has used 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 and that the Domain Name was registered

and has been used in a manner which has taken unfair advantage of or has been unfairly detrimental to the Complainant's rights.

The second limb of the test under paragraph 2(a) of the Policy is therefore also satisfied.

7. Decision

The Complainant has established for the purposes of the Policy that it has Rights in respect of a name or mark which is similar to the Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. Accordingly the Complaint succeeds and I direct that the Domain Name <barclayloans.co.uk> be transferred to the Complainant.

Signed Steven A. Maier

11 January 2012