

DISPUTE RESOLUTION SERVICE

D00011478

Decision of Independent Expert

Barclays PLC

and

Mr Graham Kenny

1. The Parties:

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

Respondent: Mr Graham Kenny
8 St. Pauls Road
Torquay
TQ1 3QF
United Kingdom

2. The Domain Name(s):

barclays-ppi-reclaim.co.uk

3. Procedural History:

14 June 2012 16:50 Dispute received
15 June 2012 09:30 Complaint validated
15 June 2012 09:32 Notification of complaint sent to parties
04 July 2012 02:30 Response reminder sent
05 July 2012 13:07 Response received

05 July 2012 13:08 Notification of response sent to parties
10 July 2012 02:30 Reply reminder sent
13 July 2012 08:49 Reply received
13 July 2012 10:00 Notification of reply sent to parties
13 July 2012 10:00 Mediator appointed
18 July 2012 09:35 Mediation started
01 August 2012 17:27 Mediation failed
01 August 2012 17:28 Close of mediation documents sent
06 August 2012 16:59 Expert decision payment received

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 has traded as Barclays Bank PLC since 1985 (Company number 00048839). Prior to which the Complainant had traded as Barclays Bank Limited since 1917 and Barclay & Company Limited since 1896. The Complainant currently operates in over 50 countries and employs approximately 144,000 people with 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 in the term BARCLAYS in a range of classes including BARCLAY/ BARCLAYS (series of 2) registration number 1286579 registered on 1 October 1986.

In addition to its registered trade marks, through its use of the name BARCLAYS over the last 300 years the Complainant has acquired goodwill and a significant reputation in the areas in which it specialises. As such, the name BARCLAYS has become a distinctive identifier associated with the Complainant and the services it provides.

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

The Complainant is the registrant of a variety of domains including www.barclays.co.uk and www.barclays.com. www.barclays.co.uk was registered before 1996 and www.barclays.com was registered in November 2003.

The Respondent provides a service to consumers wishing to claim or reclaim compensation in respect of mis-sold payment protection insurance.

The disputed domain name was registered on 24 June 2011, last updated on 31 August 2011 and due to expire on 24 June 2013.

5. Parties' Contentions

Complaint

The Complainant relies on, its large portfolio of registered trademarks which consist of or incorporate the name and mark BARCLAYS details of which have been listed in a schedule to the Complaint and the goodwill which it has acquired through its extensive use of the name and mark BARCLAYS in the United Kingdom and throughout the world.

The Complainant alleges that the disputed domain name contains a word which is identical and confusingly similar to the Complainant's common law rights and registered trade marks BARCLAYS.

Given the worldwide fame and notoriety of the mark BARCLAYS, no trader would choose the disputed domain name <barclays-ppi-reclaim.co.uk> unless to create a false impression of association with the Complainant to attract business from the Complainant or misleadingly to divert the public from the Complainant to the Respondent. Indeed given the current use being made of the disputed domain name it is apparent that the Respondent registered the disputed domain name deliberately in order to benefit from the fame and reputation of the mark BARCLAYS.

The Complainant further alleges that the disputed domain name in the hands of the Respondent is abusive because the disputed domain name is being used to encourage members of the public to make mis-sold PPI compensation claims against the Complainant; the website displayed at the disputed domain name displays BARCLAYS branding and when the "Click Here" button is selected, Internet users are taken to an online form requesting the users to enter their personal details; and it is clear that the Respondent is using the disputed domain name for a commercial purpose.

The Complainant submits that the Respondent registered the disputed domain name knowing that it is likely to attract interest from Internet users who may wish to bring a compensation claim against the Complainant in respect of mis-sold PPI. Screenshots of the offending disputed domain name are provided as an annex to the Complaint.

The Respondent is not known by the disputed domain name. It is clear that the Respondent is not making fair use of the disputed domain name. The content posted on the website to which the disputed domain name resolves is of concern to the Complainant because the sole purpose of the Respondent appears to be to gather personal details of customers and potentially generate revenue by expressly referring to BARCLAYS in the disputed domain name. While the Complainant is aware of other websites dedicated to assisting the public with seeking compensation in respect of mis-sold PPI, these websites operate from

domain names which are not targeted at specific companies nor do they use these companies registered trade marks in the domain names.

The Complainant asserts that the Respondent has never asked, and has never been given any permission by the Complainant to register or use any domain name incorporating the Complainant's trade mark or confusingly similar mark.

The Complainant alleges that the Respondent has intentionally attempted to attract, for commercial gain, internet users to the website through the inclusion of BARCLAYS in the disputed domain name.

The Respondent will never be capable of using the disputed domain name for a legitimate purpose as any unauthorised use of the Complainant's registered trade marks for a commercial purpose which is finance related, monetary affairs or information, advisory or consultancy services will amount to trade mark infringement.

Response

The Respondent argues that the Complainant had not acquired any rights in the disputed domain name or any similar domain name prior to the registration of the domain name in suit. The Respondent asserts that the Complainant does not provide any service for claiming or reclaiming compensation in respect of payment protection insurance or any similar product either in relation to the Complainant's own products or products sold or supplied by other institutions. The Respondent argues that therefore no degree of competition exists between the Complainant and the Respondent and equally there is no existing service of the Complainant which would lead that institution to seek a registration of this or a similar domain name.

The Respondent submits that he seeks to gain no goodwill whatsoever from the BARCLAYS name but on the contrary seeks to gain business and revenue from what the Respondent alleges is the mis-selling of products by the Complainant and other institutions. The Respondent alleges that its service is therefore unconnected to the Complainant.

Addressing the issue of alleged similarity, the Respondent argues that BARCLAYS is a relatively common name; that all intellectual property rights and registrations referred to in the application use BARCLAYS with a capital letter "B" whereas the domain name uses the word "Barclays" in lower case; the addition of the two distinctive and descriptive elements "PPI" and "reclaim" in the disputed domain name are sufficient to distinguish the disputed domain name from the Complainant's BARCLAYS name and mark.

The Respondent further submits that there has been no evidence of confusion and asserts that eleven contacts and enquiries that it has received as a result of its use of the disputed domain name have exclusively concerned the mis-selling of PPI and other similar products. The Respondent therefore claims that there has been no confusion or loss of revenue by the Complainant as a result of its use of the disputed domain name.

The evidence of the extensive intellectual property rights claimed by the Complainant and listed in the Complaint, is not evidence of any misappropriation by the Respondent of any of the Complainant's rights. Indeed the Respondent argues that the extensive intellectual property protection which the Complainant claims should in fact serve to satisfy all concerned that the Complainant is adequately protected both in terms of its identity, business and goodwill to such an extent that there is no prospect of collusion on the part of the general public with regard to the disputed domain name.

Furthermore, the Respondent argues that in terms of the alleged Abusive Registration he has acted in good faith at all times. The Respondent submits that he provides a genuine and recognised service to the general public. The service is provided by a number of other businesses and organisations in relation to Barclay's products as well as those of many other institutions. The Respondent has made every effort to specifically identify this service that he provides. The reality of the Complainant's case is that by challenging the registration of the disputed domain name in relation to the mis-selling of its products the Complainant seeks to reduce the prospects of genuine claims being brought against the Complainant in relation to what the Respondent alleges is its mis-selling of products.

Reply

In supplementary submissions the Complainant submits that in the United Kingdom section 10 of the Trade Marks Act 1994 specifies the situations in which trade mark infringement may be found to have occurred. Only infringement in terms of section 10(1) of that act demands that the goods or services offered by the rights holder and the infringer be identical before trade mark infringement can be found to have occurred. Sections 10(2) and 10(3) do not require the goods or services being offered by an infringer to be identical to those for which the trade mark provides protection. The Respondent's submissions relating to confusion, similarity of goods and services or competition between the Complainant and the Respondent are not relevant to a consideration of whether the disputed domain name is an Abusive Registration, or if it were relevant, to trade mark infringement.

The Respondent states that he seeks to obtain no goodwill whatsoever from the BARCLAYS name yet goes on to confirm that he seeks to gain business and revenue from the mis-selling by the Complainant and other institutions of its products. He cannot maintain both positions. The Respondent cannot say that he seeks no benefit from using the term BARCLAYS in the disputed domain name but then go on to confirm that his business proposition is centered around using the term BARCLAYS to target members of the public who would at one point, or are still, customers of the Complainant, to assist those current or previous customers of the Complainant in claiming compensation from the Complainant for PPI products sold by the Complainant.

The Complainant submits that it has carried out an online review of other domain name registrations held by the Respondent and has identified 20 domain name registrations which the Respondent currently owns. The domain name registrations are as follows: Welcome-finance-ppi-reclaim.co.uk; Egg-banking-ppi-reclaim.co.uk; Freedom-finance-ppi-reclaim.co.uk; tesco-bank-ppi-reclaim.co.uk; mbna-ppi-reclaim.co.uk; britannia-ppi-reclaim.co.uk; picture-loans-ppi-

reclaim.co.uk; alliance-leister-ppi-reclaim.co.uk; first-national-ppi-reclaim.co.uk; northernrock-ppi-reclaim.co.uk; first-plus-ppi-reclaim.co.uk; ge-money-ppi-reclaim.co.uk; i-group-ppi-reclaim.co.uk; postoffice-ppi-reclaim.co.uk; marksandspencer-ppi-reclaim.co.uk; abbey-ppi-reclaim.co.uk; halifax-ppi-reclaim.co.uk; hsbc-ppi-reclaim.co.uk; natwest-ppi-reclaim.co.uk; lloyds-ppi-reclaim.co.uk.

The Complainant submits that all of these domain names owned by the Respondent incorporate well known third party trade marks in which the Respondent has no apparent right. The Complainant submits that the Respondent is therefore clearly engaged in a pattern of conduct the purpose of which, the Complainant anticipates, is to take advantage of third parties trade marks for his own benefit.

The Complainant wholly refutes the Respondent's claim that BARCLAYS is a relatively common name and asserts that BARCLAYS is a distinctive identifier for the Complainant and it has invested in and developed a significant reputation in the BARCLAYS name. In any event the Respondent has confirmed that he included the name BARCLAYS in the disputed domain name in order to gain business and revenue from the miss-selling from that...of its products. It is therefore unhelpful to suggest that the name BARCLAYS is common when the Respondent has already advanced a very different contradictory position earlier in the Response.

The Respondent states that any similarity between the Complainant's name and mark and the disputed domain name is overcome by the fact that the letter "b" in the disputed domain name is in lower case. The Complainant does not consider that the use of the lower case "b" would overcome any confusion because the Complainant's trade mark is so distinctive and well known that it is highly unlikely that a member of the public would identify that there was no association between the disputed domain name and Complainant given the use of the lower case letter. In addition, search engines such as Google operate case insensitive searches and so the lower case "b" is irrelevant.

The Respondent has made what appear to be unsubstantiated statements of fact that there is established evidence of no confusion on the part of the general public yet no evidence of lack of confusion has been filed.

The Respondent further states that it is evident that the Complainant has not been deprived of any business or potential instruction or suffered any financial loss. Absent any evidence to support these statements, the Respondent has no reasonable basis on which to draw these conclusions. The Complainant considers that the only reason why members of the public would review the content displayed on the Respondent's website is because of the inclusion of the term BARCLAYS in the address. The Respondent's business is clearly intended to assist members of the public to try to recover compensation from the Complainant and if those claims are successful then this will naturally have a financial repercussion for the Complainant.

The Respondent is mistaken in his assumption that Complainant's decision not to commence court proceedings to date is indicative of a lack of financial loss as a

result of the registration and use of the disputed domain name. As a matter of fact the Complainant is entitled to refer matters concerning domain name disputes to either Nominet or to a court for determination.

The Complainant has not exhibited lists of its complete domain name portfolio to the Respondent. The fact that the Complainant maintains a portfolio of registered trade marks does not mean that the Complainant should be barred from taking action to stop a third party from taking advantage of its rights.

In the Complaint the Complainant acknowledged that there are organisations who are dedicated to assisting the public with seeking compensation in respect of miss-sold PPI. The difference between those organisations and the Respondent is that those other organisations do not use the Complainant's registered trade mark in the same way as the Respondent in order to generate revenue.

The Complainant disputes the Respondent's submission that it has acted in good faith throughout this matter.

6. Discussions and Findings

Paragraph 2 of the DRS Policy requires the Complainant to 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.

Identical or Similar

The Complainant has asserted and the Respondent has not challenged that the Complainant is a long established international bank with a global reputation in the use of the name and mark BARCLAYS and the owner of a substantial portfolio of registrations for trade marks consisting of, or incorporating the word BARCLAYS.

Ignoring the .co.uk ccTLD extension, the disputed domain name <barclays-ppi-reclaim.co.uk> consists of three elements, each separated by a hyphen viz. "barclays", "ppi" and "reclaim". The latter two elements are descriptive and intentionally refer to reclaim of ppi insurance premiums.

The word element "barclays" is identical to the Complainant's name and mark and is the dominant element of the disputed domain name. Not only is it the first and therefore prominent element of the domain name, it is separated by a hyphen from the following descriptive elements and it is also the only distinctive element.

Furthermore the Respondent acknowledges that the disputed domain name refers to the Complainant's business. This Expert therefore finds that the disputed domain name is similar to the Complainant's name and mark.

Abusive Registration

The DRS Policy at paragraph 1, defines an Abusive Registration as 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.

When deciding on how to approach the issue of alleged Abusive Registration the Appeal Panel in *Hanna-Barbera Productions Inc. v Graeme Hay DRS 00389* ("scoobydoo.co.uk") stated that "the sensible way of addressing whether or not the Domain Name is an Abusive Registration is to start by evaluating the Domain Name and reviewing the use made of it as a whole."

While there are many differences between the facts and issues in the present case and *Hanna-Barbera Productions Inc. v Graeme Hay DRS 00389*, for example in the latter the domain name was identical to the complainant's mark and the respondent claimed that it was a tribute site as expressly exempted under the DRS Policy, there are nonetheless many similarities in the issues in the two cases and this Expert adopts the Appeal Panel's approach as guidance in the present case.

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In the view of this Expert, the disputed domain name is not only similar to the Complainant's name and mark it is confusingly similar. The only distinctive element in the disputed domain name is the Complainant's BARCLAYS name and mark and it has been intentionally chosen, registered and used to refer to the Complainant's business.

There are no distinguishing elements in the disputed domain name and on the balance of probabilities a significant number of Internet users visiting the website to which the disputed domain name resolves will be doing so in the expectation that the website is an official site of the Complainant.

The Respondent has admitted that he registered the disputed domain name specifically to target the Complainant's customers and by the time the Internet user sees the Respondent's website, the Respondent will have achieved a business opportunity that he otherwise would not have had.

Because there are no distinguishing features in the disputed domain name, the Respondent's use of the disputed domain name amounts to impersonation of the Complainant by the Respondent, at least at the stage of initial interest by Internet users. The Appeal Panel in *Hanna-Barbera Productions Inc. v Graeme Hay DRS 00389* stated that "[i]mpersonation can rarely be fair."

Furthermore, there is nothing posted on the home-page of the website to which the disputed domain name resolves to inform the casual visitor, or the visitor

actively seeking the Complainant that the website is not associated with the Complainant.

Paragraph 3 of the DRS Policy sets out a non-exhaustive, illustrative list of factors which may be evidence of Abusive Registration among which, included in paragraph 3(a)(ii) of the DRS Policy, are “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”

In the circumstances, for reasons given above, this Expert finds on the balance of probabilities that the Respondent is using the disputed domain name in a way which is likely to confuse people or businesses into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant.

On the evidence therefore, this Expert finds that the domain name is an Abusive Registration in the hands of the Respondent and the Complainant is entitled to succeed in this application.

For completeness, it should be noted that this Expert has considered and rejected the Respondent’s arguments in relation to the Complainant’s rights, the distinctiveness of the BARCLAYS name and mark, the similarity of the disputed domain name and the Complainant’s name and mark and the use to which the disputed domain name is being put by the Respondent. The BARCLAYS name and mark are both well-known and distinctive. Both the Complainant and the Respondent are engaged in the provision of services relating to payment protection insurance. The Respondent has not acquired, nor does he claim to have acquired any rights in the BARCLAYS name or mark and the disputed domain name was admittedly specifically chosen and registered to refer to the Complainant’s business activities.

Furthermore, this Expert has considered the Respondent’s submissions that he seeks to gain no goodwill whatsoever from the BARCLAYS name but on the contrary seeks to gain business and revenue from what he alleges is the mis-selling of products by the Complainant and other institutions. The Respondent alleges that its service is therefore unconnected to the Complainant. An analysis of the facts shows that the disputed domain is likely to confuse Internet users into the initial belief that the domain name is registered to, operated or authorised by, or otherwise connected with the Complainant and the initial content seen on the website does nothing to clarify this misconception. Furthermore the use of the Complainant’s name and mark to attract business which relates to third parties must also in itself be objectionable.

Finally this is not a case of what has been described by the expert in the recent decision DCM (Optical Holdings) Limited v Sasha Rodov [DRS 00011271, 3 August 2012] as “nominative fair use of the [mark] for critical purposes”. The disputed domain name consists of the Complainant’s domain name in combination with two elements that refer to a financial services product supplied by the

Complainant and the Respondent is targeting the Complainant's customers and former customers for a commercial purpose.

7. Decision

This Expert finds that proper procedures have been followed in accordance with the DRS Policy and the DRS Procedure and Directs that the disputed domain name, barclays-ppi-reclaim.co.uk be transferred forthwith from the Respondent to the Complainant.

Signed James Bridgeman

Dated 3 September 2012