

**DISPUTE RESOLUTION SERVICE**

**DRS012035**

**Decision of Independent Expert**

Barclays Bank Plc

and

Portcullis Agencies

**1. The Parties:**

Lead Complainant: Barclays Bank Plc  
1 Churchill Place  
London  
E14 5HP  
United Kingdom

Respondent: Portcullis Agencies  
27 Aintree Road  
Middlesex  
Perivale  
UB6 7LA  
United Kingdom

**2. The Domain Name(s):**

<barclaycardppclaim.co.uk>

**3. Procedural History:**

19 October 2012 14:43 Dispute received  
22 October 2012 11:14 Complaint validated  
22 October 2012 11:22 Notification of complaint sent to parties  
08 November 2012 01:30 Response reminder sent  
13 November 2012 09:23 No Response Received  
13 November 2012 09:24 Notification of no response sent to parties  
15 November 2012 11:01 Expert decision payment received  
20 November 2012 the Expert requested that the Complainant to provide further information in accordance with paragraph 13a of the DRS Procedure setting a deadline of 23 November 2012 for submission of same and allowing the Respondent until 28 November to furnish comments in response

22 November 2012 the Complainant furnished the additional information requested. No comments were received from the Respondent. The Expert proceeded to make the decision.

#### **4. Factual Background**

The Complainant is the registered proprietor of a portfolio of UK registered and Community registered trade marks incorporating the words BARCLAYS and BARCLAYCARD in a range of classes including the following:

- UK registered trade mark BARCLAYCARD, registration number 1286580 registered on 1 October 1986 in class 36
- UK registered trade mark BARCLAY/ BARCLAYS (series of 2) registration number 1286579 registered on 1 October 1986 in class 36.
- UK registered trade mark BARCLAYS registration number 2004486 registered on 8 December 1994 in class 16.

The Complainant is the registrant of a number of Internet domain names including

- <barclaycard.co.uk> registered before 1996
- <barclays.co.uk> registered before 1996;
- <barclaycard.com> which was registered on 6 August 1997, and
- <barclays.com> registered in November 2003.

The disputed domain name was registered on 27 March 2012.

As no Response was filed, the only information available about the Respondent is that found in the WhoIs database and the Complaint.

#### **5. Parties' Contentions**

##### **The Complainant's Submissions**

The Complainant has traded as Barclays Bank PLC since 1985 (Company number 00048839). Prior to this the Complainant 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. The Complainant moves, lends, invests and protects money for more than 48 million customers and clients worldwide.

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 submits that in addition to its above-mentioned 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 Complainant argues that the disputed domain name contains a word which is identical and confusingly similar to the word BARCLAYCARD in which the Complainant has common law and registered trade mark rights.

Given the worldwide fame and notoriety of the mark BARCLAYCARD, no trader would choose the domain <barclaycardppclaim.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 BARCLAYCARD.

The Complainant submits that disputed domain name in the hands of the Respondent is an Abusive Registration.

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

The disputed domain name is being used to automatically redirect internet traffic to website at <www.debtreview.co.uk>. At the <debtreview.co.uk> website internet users are encouraged to make mis-sold payment protection insurance ( hereinafter "PPI") compensation claims against the Complainant. It is clear that the Respondent is using the disputed domain name for a commercial purpose. The Complainant submits that this redirection service was set up in order for the Respondent to exploit the reputation of the Respondent for its own gain. 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 website to which the disputed domain name resolves have been provided in an annex to the Complaint.

The Complainant argues that it is clear that the Respondent is not making fair use of the disputed domain name. The Respondent is not known by the disputed domain name and 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.

Furthermore, the content found 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 redirect internet traffic with a view to generating revenue by expressly referring to BARCLAYCARD 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 incorporated in their addresses.

The Complainant refers to the decision of this Expert in *Barclays PLC v. Mr Graham Kenny* Nominet Case D00011478 which concerned a disputed domain name <barclays-ppi-reclaim.co.uk> and asserts that the use being made of the domain name at issue in that case was broadly similar to the use being made of the disputed domain name underpinning the present dispute.

In an annex to the Complaint, the Complainant has exhibited correspondence sent by its agent to the Respondent. The initial cease and desist letter sent on 23 May 2012 asserted *inter alia* that the Respondent's use of the disputed domain name infringed the Complainant's trade mark and demanded that the Respondent transfer the disputed domain name to the Complainant. Further letters were sent on 3 July 2012 and 18 July 2012. No response was received by the Complainant to any of these letters and despite the correspondence the content on the website to which the disputed domain name resolves remained unchanged.

The Complainant submits that given the widespread use and notoriety of its famous BARCLAYCARD mark, the Respondent must have been aware that in registering the disputed domain name it was misappropriating the valuable intellectual property of the Complainant as owner of the BARCLAYCARD trade mark, or was seeking to benefit directly from the valuable intellectual property of the owner of the BARCLAYCARD trade mark.

Furthermore the Complainant submits that the Respondent's registration of the disputed domain name has also prevented the Complainant from registering a domain name which corresponds to the Complainant's trade marks should it wish so to do.

The Complainant submits that the Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website to which the disputed domain name resolves through the inclusion of BARCLAYCARD in the disputed domain name.

The Complainant further argues that 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.

#### **The Respondent's Submissions**

There was no Response or other communication from the Respondent.

## **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.

#### The Complainant's Rights

The Complainant has provided evidence of its ownership of the BARCLAYS name and mark and the BARCLAYCARD trade mark and service mark through its above-referenced UK trademark registrations and its long-established use of the terms in commerce.

This Expert finds that the disputed domain name <barclaycardppclaim.co.uk> is confusingly similar to both the BARCLAYCARD trademark and the BARCLAYS trademark.

The disputed domain name barclaycardppclaim.co.uk is composed of four elements. The first elements are the words "BARCLAYS" and "card". These two elements in combination create the element "BARCLAYCARD". This Expert finds that the elements "BARCLAY" and "BARCLAYCARD" are both the dominant elements in the disputed domain name and directly refer to the distinctive name of the Complainant and its bank-card product and services.

The subsequent elements "ppi" refers to payment protection insurance and the final element is the generic word "claim". These are descriptive elements. They do not in any way serve to distinguish the disputed domain name. On the contrary they are likely to serve to add to the likelihood of confusion as the express reference to payment protection insurance is a reference to a product that has been sold by the Complainant and the word "claim" could well be taken to refer to claims on such policies.

#### Abusive Registration

As to the question of whether the disputed domain name is an Abusive Registration, in response to a request for additional information the Complainant clarified that when the disputed domain name was first registered it resolved to a website which stated *inter alia*: "Welcome to barclaycardppclaim.co.uk". The disputed domain name subsequently was switched to resolve to the website at <www.debtreview.co.uk> and the Complainant confirmed that this remained the case as of 22 November 2012. The content of the website at <www.debtreview.co.uk> contains content which refers in turn to services provided at <crunchmycredit.com> relating *inter alia* to refunds of premiums for PPI and cancellation of credit agreements and debts.

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.”

The disputed domain name is not only similar to the Complainant’s BARCLAYS and BARCLAYCARD trademarks, it is confusingly similar; the distinction between the disputed domain name and the Complainant’s trade marks are merely the addition of descriptive elements that refer to payment protection insurance that the Complainant supplies; there are no distinguishing elements in the disputed domain name and it is clear that the disputed domain name was created and registered to make direct reference to the Complainant and its products.

On the balance of probabilities therefore, applying the reasoning that this Expert applied in *Barclays PLC v. Mr Graham Kenny* Case D11478, this Expert finds that the Respondent’s use of the disputed domain name is likely to confuse Internet users into believing that the disputed domain name is registered to, operated or authorised by, or otherwise connected with the Complainant. Paragraph 3(a)(ii) of the DRS Policy cites such confusing use as an example of Abusive Registration.

It is also significant that the disputed domain name is being put to a commercial use to attract customers to the services provided by the controllers of the [debtreview.co.uk](http://debtreview.co.uk) and/or [crunchmycredit.com](http://crunchmycredit.com) domain names.

Having considered the Complaint, the evidence adduced, including the additional information submitted by the Complainant in response to the Expert’s request, this Expert finds that on the balance of probabilities, the disputed domain name, in the hands of the Respondent is an Abusive Registration.

The Complainant is therefore entitled to succeed in this Application.

**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 [barclaycardppclaim.co.uk](http://barclaycardppclaim.co.uk) be transferred forthwith from the Respondent to the Complainant.

Signed .....  
James Bridgeman  
Expert

Dated 4 December 2012