

DISPUTE RESOLUTION SERVICE

D00009406

Decision of Independent Expert

Barclays PLC

and

Mr Markus Schnermann

1. The Parties:

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

Complainant's Representative
Gillian Smullen
Pinsent Masons LLP
123 St Vincent Street
Glasgow
G2 5EA
United Kingdom

Respondent: Mr Markus Schnermann
Keyworddomains.com,
Alter Steinweg 50
Muenster,
NWR 48143
Germany

2. The Domain Name(s):

baclays-bank.co.uk

3. Procedural History:

Capitalized terms used in this decision have the meaning given to them in the Nominet Dispute Resolution Service (“DRS”) Policy and Procedure, Version 3 of July 2008 (“the Policy” and “the Procedure” respectively)

20 December 2010 Dispute received
21 December 2010 Complaint validated
21 December 2010 Notification of complaint sent to parties
17 January 2011 No Response Received
17 January 2011 Notification of no response sent to parties
26 January 2011 Expert decision payment received
31 January 2011 Expert Appointed

Nominet served the Respondent with the Complaint on 21 December 2010.

1) By email to:

- a) markus@keyworddomains.com;
- b) postmaster@barclays-bank.co.uk (this is in error, it should have been baclays);

2) By registered post to:

- a) Mr Markus Schnermann, Keyworddomains.com, Alter Steinweg 50, Muenster, NWR 48143, Germany;

The Complaint was sent by post to the German postal address and to the email address of Mr Markus Schnermann who is shown in WHOIS as the registrant.

The postmaster email address was wrong as the Complainant had supplied the wrong information—it therefore bounced. Nothing turns on this however.

The DRS derives its jurisdiction from the terms and conditions of the contract of registration between the Respondent and Nominet (“the Contract”). Clause 14 of the Contract incorporates the Policy and Procedure by reference. Clause 4.1 requires a Registrant’s details to be entered in the Register and the Registrant agrees to ensure that Nominet has his correct postal address, telephone and fax number and email address and some of this information is also posted on the public WHOIS database. Failure to provide correct details, or keep them current, may be grounds for cancelation or suspension of a domain name, per clause 17.2. The relevance of this is that §2(a) of the Procedure provides a Respondent will be served with a Complaint, at Nominet’s discretion by any of: first class post, fax or email to the contact details in the Register; by email to postmaster@<the domain name in dispute>; or any email addresses shown on any active web pages to which the domain name resolves. The Contract clearly renders the Respondent responsible for any failure to notify Nominet of changes to his details. The Complaint is therefore deemed validly served.

The Respondent's WHOIS entry, provided as an Annex to the Complaint, gives the German postal address and the Respondent will have supplied his email address also. I am satisfied that Nominet sent the Complaint to both, and that the Respondent is therefore duly served under the Policy.

4.2 Default

Although the Respondent has failed to submit a Response, or make any other submission, the Procedure does not provide for a default decision in favour of the Complainant. The Complainant must still prove its case to the requisite standard, see §15(b) of the Procedure. However, an expert may draw such inferences from a party's default as appropriate.

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 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.

In 2009, the Complainant received various industry awards including Lender of the Year; Best Leadership Team in Global Private Banking; Best Credit Card Provider (Standard Rate) Moneyfacts Award; Best Local Bank UK Euromoney Award. In 2008 the Complainant was made a Business Superbrand by the Superbrand Council.

The Complainant's domain names include barclays.co.uk registered sometime before 1996 and barclays.com, registered in 2003.

The Respondent registered the Domain Name on 22 December 2007. No further details are available about the Respondent who has not submitted a Response. The Domain Name resolves to a pay per click website displaying finance related sponsored links. I visited the site on 4 February 2011.

5. Parties' Contentions

The Complainant says it has Rights in a name or mark similar to the Domain Name and in the hands of the Respondent, the Domain Name is an Abusive Registration.

The Complainant is the registered proprietor of a variety of UK registered and Community registered trade marks in the name BARCLAYS in a range of classes and evidence was submitted of marks including the word mark BARCLAYS in class

36 UK registration No. 1314306 (1987) and No. 2461096 (2008) and the word mark BARCLAYBANK in the same class UK No. 1336098 (1988). In total, evidence was provided of the Complainant's 34 UK marks, including word marks for many variations of the Complainant's name, and figurative marks.

In addition, the Complainant has acquired goodwill and a significant reputation through its use of the name BARCLAYS in its businesses over the last 114 years. It was first incorporated in 1896 as Barclay & Company Limited, changing its name to Barclays Bank in or about 1917. The current form of the name, Barclays PLC, was adopted in 1985. The name BARCLAYS has become a distinctive identifier associated with the Complainant and the services it provides. The Complainant says the Domain Name contains a word confusingly similar to BARCLAYS and the fact the Domain Name is a misspelt version of it is irrelevant.

As to Abusive Registration, given the widespread use and notoriety of the famous BARCLAYS marks, the Respondent must have been aware that in registering the Domain Name he was misappropriating the BARCLAYS trade marks. No trader would choose the Domain Name unless to create a false impression of association with the Complainant. The Respondent has intentionally attempted to attract, for commercial gain, internet users by creating a likelihood of confusion with the Complainant's trade marks. The Domain Name resolves to a pay per click website displaying finance related sponsored links which relate to competitor products and services to those of the Complainant. The Domain Name is being used to generate income for the Respondent and divert potential custom from the Complainant.

The Respondent is not known by the Domain Name. The Respondent has not acquired any right or licence from the Complainant. The Respondent is not making a legitimate non-commercial or fair use of the Domain Name. The pay per click sponsored links for financial services is commercial use. The notoriety of BARCLAYS is such that members of the public will always assume that there is an association between the Respondent and the Complainant and that can never be fair use.

The Complainant's solicitors wrote to the Respondent on 25 June 2010 advising of the Complainant's registered trade marks and seeking a transfer of the Domain Names. The Respondent failed to respond to this letter and subsequent letters. The Respondent failed to alter the content at the site of the Domain Name.

6. Discussions and Findings

The DRS is designed as a fast, simple alternative to litigation. Domain names are registered on a first come, first served, basis and a registration will only be disturbed if an Abusive Registration, as defined in the Policy. Paragraph 2(a) of the Policy requires the Complainant prove 2 elements:

- “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 bears the onus of proof and must prove both elements on the balance of probabilities. As mentioned above, even where no Response is submitted, the Complainant must meet this burden.

The DRS’s jurisdiction under the Contract is limited to these issues and the remedies of cancellation, suspension, transfer or amendment of the Domain Name. The Policy does not provide for the determination of allegations of trade mark infringement or passing-off proper.

6.1 Rights

The Complainant clearly has Rights in the name BARCLAYS from its long trading history and its various registered marks.

Paragraph 2(a)(i) of the Policy requires that the name or mark in which a Complainant has Rights “is identical or similar to the Domain Name.” For these purposes, hyphens spaces and ampersands are ignored. Bank is a generic term and adds nothing to the inquiry, see *Alliance & Leicester plc v. Paul’s Cameras* [2006] DRS 3280. This leaves a comparison between barclays and baclays –which are identical but for the missing r –and for our purposes, identical or similar. I am satisfied the Complainant has Rights in a mark and name similar to the Domain Name.

6.2 Abusive Registration

The second element the Complainant must prove under §2(a) of the Policy, is the Domain Name is an Abusive Registration, defined in §1 thereof. §3 of the Policy provides a non-exhaustive, illustrative, list of factors, which may evidence an Abusive Registration. Conversely, §4a of the Policy provides a non-exhaustive list of factors which may evidence that a registration is not an Abusive Registration.

Confusion is relevant to the inquiry under §3aiC of the Policy (circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily: ..for the purpose of unfairly disrupting the business of the Complainant) and also 3aii (circumstances indicating 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).

The Complainant says that given the fame of the Barclays mark the Respondent must have known of the Complainant and can only have chosen it in order to leverage that fame and benefit from the confusion –per click ---via the sponsored links at the site, all of which relate to competing products and services in the same field of endeavor. I agree and find both grounds §3aiC and 3aii made out.

Some degree of knowledge is required for an Abusive Registration under §3a of the Policy, per the Appeal Panel in DRS 04331 and I am satisfied that the

Respondent had knowledge of the Complainant. This is a classic typosquatting case.

It also fits within the principles set out in *Chivas Bros Ltd v. D. W. Plenderleith DRS 00658*, namely, where a Respondent registers a domain name: (1) identical to a name in respect of which a Complainant has Rights; (2) that name is exclusively referable to the Complainant; (3) there is no obvious justification for the Respondent having adopted that name; and (4) the Respondent has come forward with no explanation for having selected the domain name; it will ordinarily be reasonable to infer that the Respondent registered the domain name for a purpose and that that purpose was Abusive.

While I am obliged to consider any obvious factors militating against Abusive Registration, even in a default case where no response has been filed, none of the factors in §4a of the Policy are apposite. The Respondent's use is commercial and I can see no basis of any kind for any justification that it is legitimate use. The Respondent has neither right nor consent –and ignored correspondence from the Complainant.

7. Decision

I find that the Complainant has Rights in a mark similar to the Domain Name, which is an Abusive Registration in the hands of the Respondent. Accordingly, the Domain Name should be transferred to the Complainant.

Signed: Victoria McEvedy

Dated 07/02/2011