

DISPUTE RESOLUTION SERVICE

D00009716

Decision of Independent Expert

Barclays Bank PLC

and

Whois-privacy.net

1. The Parties:

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

Respondent: Whois-privacy.net
PO Box 20
Port Vila
Vanuatu

2. The Domain Name:

barclayshomemortgage.co.uk

3. Procedural History:

24 March 2011 11:28 Dispute received
24 March 2011 14:05 Complaint validated
24 March 2011 14:09 Notification of complaint sent to parties
12 April 2011 02:30 Response reminder sent
15 April 2011 08:49 Response received
15 April 2011 08:49 Notification of response sent to parties
15 April 2011 15:04 Reply received

15 April 2011 15:05 Notification of reply sent to parties
23 May 2011 10:15 Expert decision payment received
3 June 2011 Expert appointed

4. Factual Background

The Nominet records show that the Domain Name was registered on 2 March 2007.

Based on the parties' submissions (see section 5 below) and a review of the materials annexed to the Complaint, set out below are the main facts which I have accepted as being true in reaching a decision in this case:

- (1) The Complainant is long established and very well known banking and financial services business.
- (2) The Complainant owns numerous UK and Community trade mark registrations for marks consisting of, or including, BARCLAYS.
- (3) The Domain Name has been used for a pay per click website.
- (4) The Domain Name is still recorded as being owned by the Respondent.

5. Parties' Contentions

Complaint

The Complainant's submissions are as follows:

The Complainant has rights in the Domain Name because:

- (1) 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. A screenshot of the Complainant's website is provided.
- (2) The Complainant has traded as Barclays Bank PLC since 1985. 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 client moves, lends, invests and protects money for more than 48 million customers and clients worldwide.
- (3) 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. The Complainant's registered trade marks are listed in the Schedule provided.

- (4) 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.
- (5) 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.
- (6) 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. Prints of the WHOIS register for both of these domains are provided.
- (7) The Respondent registered the Domain Name on 7 March 2007 (domain name registration details are provided).
- (8) The Domain Name contains a word which is identical to the Complainant's common law rights and registered trade marks BARCLAYS.
- (9) Given the worldwide fame and notoriety of the mark BARCLAYS, no trader would choose the domain barclayshomemortgage.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.

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

- (1) The Domain Name was being used as a pay per click website. The Domain Name displayed finance related sponsored links which relate to competitor products. The Domain Name was being used to redirect internet traffic intended for the Complainant, with an intention to generate income for the Respondent. Screenshots of the offending Domain Name showing the pay per click content are provided.
- (2) The Respondent is not known by the Domain Name.
- (3) It is clear that the Respondent is not making a legitimate non-commercial or fair use of the Domain Name. The content found at the Domain Name was pay per click sponsored links which relate to financial services. Such activity does not qualify as non commercial or fair use.
- (4) The Respondent has never asked for, and has never been given any permission by the Complainant to register or use any domain name incorporating the Complainant's trade mark.
- (5) The Complainant's agent, Pinsent Masons LLP wrote to the Respondent on 11 October. The Respondent failed to respond to this letter so chaser letters

were sent on 26 October and 5 November (copies of correspondence provided). The Respondent failed to respond to either of the chaser letters.

- (6) Given the widespread use and notoriety of the famous BARCLAYS mark, the Respondent must have been aware that in registering the Domain Name he was misappropriating the valuable intellectual property of the owner of the BARCLAYS trade mark.
- (7) 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.
- (8) The Respondent has intentionally attempted to attract, for commercial gain, internet users to the website by creating a likelihood of confusion with the Complainant's trade marks.
- (9) The Respondent will never be capable of using the Domain Name for a legitimate purpose as 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/or between the Respondent and the BARCLAYS trade mark.
- (10) It is reasonably anticipated that this Domain Name will divert potential custom from the Complainant's business due to the presence of links to competitor websites on the Domain Name.

Response

The Respondent filed the following response:

"This domain name was sold on 23 June 2009 and the new owners failed to do the required Nominet registrant transfers at the time.
We do not have any ownership of the domain name in our accounts."

Reply

The Complainant's submissions in reply are as follows:

- (1) The Respondent has indicated that they sold the Domain Name on 23 June 2009. No evidence has been filed to support this claim. Absent evidence of the transfer of ownership, neither the Complainant nor Nominet can investigate this claim fully.
- (2) The WHOIS registrant details for the Domain Name remain as WHOIS-privacy on 15 April 2011.
- (3) The Complainant's agents wrote to the registrant of the Domain Name using the contact details provided on WHOIS on three occasions, as detailed in the Complaint. The Respondent failed to reply to any of this correspondence and at no point alleged that the Domain Name was no longer in their control, ownership or otherwise.

6. Discussions and Findings

Preliminary matter

The Respondent claims that it is no longer the owner of the Domain Name. However, no evidence of this has been adduced by the Respondent and, as at the date of this decision, the Respondent remains the recorded registrant on Nominet's records, and there is nothing to suggest that this was not the case when the Complaint was filed on 24 March 2011 (and when the Response was lodged on 15 April 2011). Accordingly I can see no reason why a decision cannot properly be made in this case.

General

Paragraph 2 of the Policy provides that, to be successful, the Complainant must prove on the balance of probabilities that:

- i it 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 (as defined in paragraph 1 of the Policy).*

Complainant's Rights

In light of the factual findings set out in section 4 above, it is clear that the Complainant has Rights in the nature of legally protectable goodwill in the name BARCLAYS; as well as Rights in the nature of registered trade marks in relation to BARCLAYS. Disregarding the generic .co.uk suffix, and making allowance for the fact that the "home mortgage" element of the Domain Name is entirely descriptive, the Domain Name is very similar to the name and mark in which the Complainant has Rights.

I therefore find that the first limb of paragraph 2 of the Policy is satisfied.

Abusive Registration

Paragraph 1 of the Policy 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."*

Paragraph 3 of the Policy sets out a non-exhaustive list of factors which may be evidence that a Domain Name is an Abusive Registration. The main factor under paragraph 3a on which the Complainant implicitly relies in this case is as follows:

- " ii. 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 considering whether the Domain Name is an Abusive Registration, it clearly must be taken into account that the Complainant's name BARCLAYS is a very well-known mark and one of which the Respondent must have been aware at the time when the Domain Name was registered and during its subsequent use. The way in which the Domain Name is used is to trade off the well-known nature of the BARCLAYS name to attract users to the website at www.barclayshomemortgage.co.uk in order to generate pay per click revenue from the financial services links on that website. The Respondent obviously benefits financially from this confusing use.

Before reaching a conclusion, paragraph 4e of the Policy needs to be considered. This provides as follows:

"Sale of traffic (i.e. connecting domain names to parking pages and earning click-per-view revenue) is not of itself objectionable under the Policy. However, the Expert will take into account:

- i. the nature of the Domain Name;*
- ii. the nature of the advertising links on any parking page associated with the Domain Name; and*
- iii. that the use of the Domain Name is ultimately the Respondent's responsibility."*

The nature of the Domain Name is such that people are bound to assume that a website to which it resolves belongs to the Complainant. Instead, however, the website contains links to various mortgage related websites, most (if not all) of which have no connection at all with the Complainant. Given that financial services are regulated and a sector in which it is particularly important for consumers not to be misled, the onus falls particularly strongly on the Respondent to ensure that the Domain Name is not used in a way which causes confusion. The Respondent has failed to do this.

Accordingly paragraph 4e of the Policy does not assist the Respondent in this case.

Taking all of the above into account, it is clear that the Respondent's use of the Domain Name has taken unfair advantage of the Complainant's rights, and that the Domain Name is therefore an Abusive Registration.

7. Decision

Having found that the Complainant has rights in respect of a name and marks which are identical or similar to the Domain Name, and that the Domain Name in the hands of the Respondent is an Abusive Registration, the Expert directs that the Domain Name *barclayshomemortgage.co.uk* be transferred to the Complainant.

Signed: Jason Rawkins

Dated: 8 June 2011