

DISPUTE RESOLUTION SERVICE

D00009828

Decision of Independent Expert

Barclays PLC

and

Whois-privacy.net

1. The Parties:

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

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

2. The Domain Name(s):

<lbarclays.co.uk>

3. Procedural History:

21 April 2011 10:53 Dispute received
21 April 2011 11:07 Complaint validated
21 April 2011 11:12 Notification of complaint sent to parties
16 May 2011 02:30 Response reminder sent

19 May 2011 10:15 No Response Received
19 May 2011 10:15 Notification of no response sent to parties
25 May 2011 16:21 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 PLC since 1985 (Company number 00048839), prior to which the Complainant traded as Barclays Bank PLC, Barclays Bank Limited 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 the registered proprietor of a number of UK registered and Community registered trade marks incorporating the term BARCLAY and BARCLAYS in a range of classes including UK trademark registration number 2461096 BARCLAYS registered on 24 June 1987 in class 36.

The Complainant is the registrant of a number of Internet domain names that it uses as the address of its web sites including <barclays.co.uk> and <barclays.com>. The domain name <barclays.co.uk> was registered before 1996 and <barclays.com> was registered in November 2003.

The disputed domain name was registered on 12 March 2010.

5. Parties' Contentions

The Complainant submits that it has rights in the BARCLAYS trademark and name through its numerous UK registered trademarks and Community Trademark Registrations. The Complainant submits that in addition to the registered trade marks upon which it relies, it has acquired a significant goodwill and reputation in banking and financial services through its use of the name BARCLAYS over the last 300 years. As such, the name BARCLAYS has become a distinctive identifier associated with the Complainant and the services it provides. The Complainant asserts that the goodwill associated with the name BARCLAYS is the property of the Complainant and cannot pass to any third party without a formal assignment. No such assignment in favour of the Respondent has taken place.

The Complainant submits that the disputed domain name incorporates the word "barclays" which is identical to the trade mark BARCLAYS in which the Complainant has Rights.

The Complainant submits that given the worldwide fame and notoriety of the Complainant's BARCLAYS mark, no trader would choose the domain name < <lbarclays.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 Complainant submits that the disputed domain name < lbarclays.co.uk > is an Abusive Registration in the hands of the Respondent because the disputed domain name is being used as a pay-per-click website. The website to which the disputed domain name resolves displays finance related sponsored links which relate to competitor products and services to those of the Complainant. The Complainant alleges that the disputed domain name is being used to redirect Internet traffic intended for the Complainant, with an intention to generate income for the Respondent.

The Complainant submits that the Respondent is not known by the disputed domain name.

The Complainant further submits that it is clear that the Respondent is not making a legitimate non-commercial or fair use of the disputed domain name.

The content found at the website to which the disputed domain name resolves consists of pay-per-click sponsored links which relate to financial services. Such activity does not qualify as non-commercial or fair use.

The Complainant asserts that 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.

The Complainant's agent wrote a cease and desist letter to the Respondent on 27 August 2010. Reminder letters were sent on 10 September 2010 and 27 September 2010. The Respondent failed to respond to the Complainant's correspondence.

Despite the correspondence the content on the website to which the disputed domain name resolves remains unchanged.

The Complainant submits that given the widespread use and notoriety of the famous BARCLAYS mark, the registrant of the disputed domain name must have been aware that the registration of the disputed domain name amounted to a misappropriation of the valuable intellectual property of the owner of the BARCLAYS trade mark.

The Complainant further 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.

The Complainant submits that 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.

The Complainant submits that the Respondent will never be capable of using the disputed 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.

The Complainant submits that it is reasonably anticipated that the disputed domain name will divert potential custom from the Complainant's business due to the presence of links to competitor websites on the website to which the disputed domain name resolves.

In support of its submissions, the Complainant has submitted the following documents as exhibits:

- A print out of the Complainant's website at <http://www.barclays.co.uk> as of 12 December 2010;
- A schedule of the Complainant's UK registered trademarks and service marks and CTM registrations consisting of or incorporating the words BARCLAYS or BARCLAY;
- WhoIs details for the Complainant's <barclays.com> gTLD domain name registered on 23 November 1993 and its <barclays.co.uk> ccTLD domain name registration created prior to August 1996;
- WhoIs details of the disputed domain name which records that the disputed domain name was created on 12 March 2010 and registered in the name of Whois-privacy.net;
- A print out of a search at Companies House which records that the Complainant was established on 20 July 1896.
- A print-out of the website to which the disputed domain name resolved on 19 April 2011.
- A copy of a cease and desist letter sent by the Complainant's solicitors to Antonia G Holmes on 27 August 2010 and reminder correspondence complaining that there had been no response to the former.

There was no Response or other submissions filed by the Respondent.

6. Discussions and Findings

Paragraph 2 of the DRS Policy requires the Complainant to prove that the Complainant has Rights in respect of a name or mark which is identical or similar to the disputed domain name; and that the disputed domain name, in the hands of the Respondent is an Abusive Registration.

The Complainant has furnished convincing evidence of its Rights in the name mark BARCLAYS in which it has built a substantial international goodwill since at least 1896.

This Expert finds that any comparison of the disputed domain name <lbarclays.co.uk> with the Complainant's mark must lead to the conclusion that they are similar. The single element in the former and the dominant element in the latter being the word BARCLAYS.

The Complainant has furnished evidence that it has established a substantial goodwill in the BARCLAYS name and mark in the field of banking and financial services. The Respondent has caused or permitted the disputed domain name to resolve to a website that on the balance of probabilities has been established with the sole purpose of generating pay-per-click revenue.

Given the similarity of the disputed domain name and the Complainants BARCLAYS name and mark; the fact that the word "lbarclays" has no meaning or significance and was most probably chosen because of its similarity with the Complainants name; the fact that the Respondent has caused or allowed the disputed domain name to resolve to a website that contains links to websites that are offering services in competition with the Complainant, this Expert is satisfied on the balance of probabilities that the disputed domain name was registered and is being used to take predatory advantage of the Complainant's goodwill in its trademark and corporate name. This Expert finds therefore that the disputed domain name, in the hands of the Respondent is an Abusive Registration.

The Complainant has therefore succeeded in proving both elements of the test required by paragraph 2(b) of the DRS Policy and is entitled to succeed in this Complaint.

7. Decision

For the foregoing reasons, this Expert decides that the disputed domain name <lbarclays.co.uk> be transferred to the Complainant.

Signed James Bridgeman

Dated: 30 June 2011