

DISPUTE RESOLUTION SERVICE

D00009997

Decision of Independent Expert

Barclays PLC

and

Barclays Estates

1. The Parties:

Lead Complainant: Barclays PLC
1 Churchill Place
London
G2 5EA
United Kingdom

Respondent: Barclays Estates
2 Stockwell Road
Handsworth
Birmingham
B21 9LR
United Kingdom

2. The Domain Name(s):

barclays-estates.co.uk

3. Procedural History:

17 June 2011 18:31 Dispute received
20 June 2011 12:22 Complaint validated
20 June 2011 12:28 Notification of complaint sent to parties
07 July 2011 06:16 Response reminder sent
12 July 2011 09:18 No Response Received
12 July 2011 09:19 Notification of no response sent to parties
22 July 2011 02:30 Summary/full fee reminder sent
25 July 2011 12:04 Expert decision payment received

4. Factual Background

- 4.1 The Complainant is Barclays Bank plc the well known bank and major global financial services provider.
- 4.2 The Complainant has a number of registered trade marks which include or consist of the name BARCLAYS. Its portfolio includes a number of word mark registrations for the name BARCLAYS the earliest of which dates back to 1986. In addition the Complainant has been using the name BARCLAYS for 300 years.
- 4.3 The Respondent registered the Domain Name on 3 May 2006. It is currently being used to link to a website for a firm of estate agents operating in the Birmingham area called BARCLAYS ESTATES.
- 4.4 The Complainant has written to the Respondent on a number of occasions putting the Respondent on notice of its trade mark registrations and its unregistered rights. There has been no response to any of these letters.

5. Parties' Contentions

The contentions on behalf of the Complainant can be summarised as follows:

5.1 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.
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 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.
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 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.

5.2 The Domain Name is an Abusive Registration because;

1. The Domain Name contains a word which is identical to the word BARCLAYS in which the Complainant has common law rights and for which the Complainant has registered trade marks.
2. Given the worldwide fame and notoriety of the mark BARCLAYS, no trader would choose the domain barclays-estates.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.
3. The Domain Name is being used by the Respondent to advertise offering properties for let and sale in the Birmingham area. In the "Buy to let Landlord Advice" section of the content found at the

Domain Name the following text appears "Barclays Estates will help you sort out your finances". Both the style of the font and colour are very similar to that used by the Complainant. This font colour is highly distinctive of the Complainant. It is clear from the content found at the Domain Name that the Respondent has selected the Domain Name in order to create an air of legitimacy for its company. The Domain Name is being used because of the credibility attached to the Complainant's registered trade mark BARCLAYS. It is apparent that the Respondent is seeking to generate revenue from creating this association.

4. 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 is clearly intended to generate revenue for the Respondent from the Complainant's registered trade mark BARCLAYS. Such activity does not qualify as non commercial or fair use.
5. 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 registered trade marks.
6. The Complainant's solicitors wrote to the Respondent on 27 August 2010. The Respondent failed to respond to this letter so chaser letters were sent on 13 September 2010 and 27 September 2010. The Respondent failed to respond to either of the chaser letters. A final letter was sent to the Respondent on 27 January 2011 requesting a response to the letter of 27 August 2010. No response was received. Despite the correspondence the content on the Domain Name remained unchanged
5. Given the widespread use and notoriety of the famous BARCLAYS mark, the Respondent must have been aware that in registering the Domain Name it was misappropriating the valuable intellectual

property of the owner of the BARCLAYS trade mark. This knowledge is compounded by the Respondent's font colour selection which it is anticipated was selected in an attempt to form an impression of an association between the Complainant and the Respondent.

6. 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.
7. 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.
8. 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.

5.3 The Respondent has not provided a Response so there are no submissions to consider.

6. Discussions and Findings

General

6.1 Under Paragraph 2 of the Dispute Resolution Service Policy ("the Policy") the Complainant is required to show, on the balance of probabilities, that;

(1) it has rights in respect of a name or mark which is identical or similar to the Domain Name; and

(2) the Domain Name in the hands of the Respondent is an Abusive Registration.

Complainant's Rights

- 6.2 The first question I must answer is therefore whether the Complainant has proved on the balance of probabilities that it owns Rights in a name or mark that is identical or similar to the Domain Names.
- 6.3 The Policy defines Rights as, "...rights enforceable by the Complainant, whether under English Law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning". This has always been treated in decisions under Nominet's DRS as a test with a low threshold to overcome and I think that must be the correct approach.
- 6.4 The Complainant has provided evidence of its use of the name BARCLAYS as it owns a number of registered trade marks consisting of or incorporating the name BARCLAYS. The Complainant has also registered and uses a number of domain names incorporating the name BARCLAYS.
- 6.5 In the circumstances, I have no difficulty in finding that the Complainant has rights in the name BARCLAYS.
- 6.6 I must now decide whether the name in which the Complainant has Rights i.e. BARCLAYS is identical or similar to the Domain Name ignoring, as I must do, the first and second levels suffixes i.e. BARCLAYS ESTATES. In relation to this, my very strong sense that it is the name BARCLAYS which is performing the trade mark job here i.e. it is BARCLAYS which is the distinctive part of this name and the name ESTATES is indicating that the business is an estate agents and is serving far more of a descriptive function. For those reasons, I find that on the balance of probabilities that the Complainant has Rights in a name which is at least similar to the Domain Name.

Abusive Registration

6.7 Having concluded that the Complainant has rights in a name which is identical to the Domain Name, I must consider whether the Domain Name constitutes an Abusive Registration. Abusive registration is defined in the Policy as;

“...a Domain Name which either;

(a) was registered or otherwise acquired in the 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

(b) has been used in a manner which took unfair advantage of or was unfairly detrimental to the Complainant’s Rights.”

6.8 This definition allows me to consider whether the Domain Name constitutes an Abusive Registration at any time and not, for example, just the time of the registration/acquisition.

6.9 Paragraph 3a of the Policy is a list of non exhaustive factors which may be evidence that the Domain Name is an abusive registration. It is however also relevant to consider in broader terms whether the Domain Name constitutes an Abusive Registration within the definition set out in the policy.

6.10 In doing this, I have adopted the reasoning of the Appeal Panel in the case of Thomas Cook UK Limited v. WhitleyBayUncovered (DRS00583). The relevant part of that decision is produced below.

"It seems to the Panel that, given the extent and renown of the Complainant's trade mark, it is stretching credulity beyond breaking point to suggest that the Respondent did not know of the trade mark in question when it sought registration of the Domain Names. Indeed, it is

perhaps instructive that there is no suggestion in the communications from the Respondent that it was in fact, unaware of the reputation of the Complainant's trade mark CLUB18-30. Although the Respondent is careful to suggest that the Complainant's proposed use of the Domain Names is open to question (referring to "our concept of the uncovered names") there is no suggestion that the club18-30 part of the Domain Names was chosen by it for any other reason than it was the Complainant's trade mark.

The Panel, therefore, finds that upon the balance of probabilities the Respondent was aware of the Complainant's trade mark at the time of registration of the Domain Names, and consciously chose to use that trade mark."

- 6.11 As in the Whitley Bay case, it seems to me that the mark, "BARCLAYS" is so well known that it is almost inconceivable that the Respondent did not know of the Complainant and its Rights generally when it acquired the Domain Name.
- 6.12 Further, it seems clear that and in the absence of any explanation to the contrary from the Respondent, that the only possible reason for the Respondent acquiring the Domain Name could be to take advantage of the substantial goodwill and reputation in the mark, "BARCLAYS".
- 6.13 In addition and as the Complainant has pointed out the site to which the Domain Name is linked, which is a site for the BARCLAYS ESTATES business, does seem to bear at least a passing resemblance to the appearance of the Complainant's brand in that the words BARCLAYS ESTATES appear in a similar typeface and colour to the word BARCLAYS on the Complainant's sites and its literature generally. The Respondent's site also makes a reference to being able to provide financial advice which is of course the Complainant's core business.

- 6.14 Given these additional points there is an irresistible inference that the Domain Name has been acquired and used to take unfair advantage of the Rights owned by the Complainant.
- 6.15 I therefore find, on the balance of probabilities, that the Respondent must have intended to gain an advantage of some kind by acquiring the Domain Name and using it in this way and it must follow that this advantage was, "unfair". The Complainant has therefore established a prima facie case of Abusive Registration.
- 6.16 This is not of course the end of the story. Having found that the Complainant has, on the balance of probabilities, established a prima facie case of Abusive Registration it is now open to the Respondent to rebut this finding by, for example, establishing any of the non-exhaustive factors found under paragraph 4 of the Policy. In this case no Response has been made and, therefore, such consideration is not possible. Indeed the Respondent has been given a number of opportunities to explain why it chose the Domain Name both in these proceedings and in the pre-Complaint correspondence but it has seemingly chosen to stay silent. It is, however, difficult to think of an argument the Respondent could have advanced given that it has adopted the Complainant's very well known brand.
- 6.17 I should stress that I am not making a finding about trade mark infringement, or passing off as alleged by the Complainant in its letters to the Respondent and this Decision is strictly confined to applying the provisions of the Policy as I am obliged to do.
- 6.18 I therefore find that the Complainant has proved on the balance of probabilities that the Domain Name is an Abusive Registration.

7. Decision

For the reasons set out above I find, on the balance of probabilities, that the Complainant has Rights in a name or mark which is identical or similar to the

Domain Name and that the Domain Name in the hands of the Respondent is an Abusive Registration. I therefore direct that the Domain Name should be transferred to the Complainant.

Signed Nick Phillips

Dated 10th August 2011