

DISPUTE RESOLUTION SERVICE

D00009988

Decision of Independent Expert

Barclays PLC

and

Realm Solutions, Inc

The Parties

Complainant: Barclays PLC
1 Churchill Place
London
G25EA
United Kingdom

Respondent: Realm Solutions, Inc
PO BOX 68229
28 Crowfoot Terrace NW
2
Calgary
ALBERTA
T3G3N8
Canada

The Domain Name

barclaysjobs.co.uk

Procedural History

16 June 2011 15:39 Dispute received
17 June 2011 14:14 Complaint validated
17 June 2011 14:23 Notification of complaint sent to parties
06 July 2011 02:30 Response reminder sent
11 July 2011 11:21 Response received
11 July 2011 11:21 Notification of response sent to parties
14 July 2011 02:30 Reply reminder sent
18 July 2011 10:17 Reply received
19 July 2011 15:51 Notification of reply sent to parties
26 July 2011 11:25 Mediator appointed
26 July 2011 11:25 Mediation started
16 August 2011 15:06 Mediation failed
16 August 2011 15:16 Close of mediation documents sent
19 August 2011 08:26 Expert decision payment received

Factual Background

1. The Complainant is the well-known bank, Barclays. It owns registered UK and Community trade marks in the word 'Barclays' and has traded in the UK since 1896. It has been the registrant of barclays.co.uk since before 1996 and first registered barclays.com in November 2003. The Respondent is a company called Realm Solutions Inc, which uses the domain name barclaysjobs.co.uk ('the Domain Name'), which it first registered on 3 March 2006, to provide information on available jobs, including jobs at Barclays.

The Parties' Contentions

The Complaint

2. 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. It has

traded as Barclays Bank PLC since 1985, and traded as Barclays Bank Limited from 1917-1985 and as Barclay & Company Limited in the period between 1896 and 1917. The Complainant currently operates in over 50 countries and employs approximately 144,000 people, lending, investing and protecting money for more than 48 million customers worldwide.

3. The Complainant is the registered proprietor of a variety of UK registered and Community registered trade marks in the word 'Barclays' in a range of classes. 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.
4. 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.
5. The Complainant is the registrant of a variety of domains including barclays.co.uk and barclays.com. The domain barclays.co.uk was registered before 1996 and barclays.com was registered in November 2003.
6. The Respondent registered the Domain Name on 3 May 2006. The Domain Name contains a word which is identical to the word 'Barclays' in which the Complainant owns common law rights and registered trade marks. Given the worldwide fame and notoriety of the mark 'Barclays', no trader would choose the domain barclaysjobs.co.uk unless it was its intention 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.

7. The Domain Name in the hands of the Respondent is abusive for the following reasons. It is being used as a pay-per-click website. The Domain Name displays job related sponsored links which claim to promote job vacancies with the Complainant. The Domain Name is being used to redirect internet traffic which is allured to the Domain Name simply because of the use of 'Barclays' in the Domain Name, with an intention to generate income for the Respondent.
8. The Respondent is not known by the Domain Name. 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 consists of pay-per-click sponsored links which attempt to generate revenue from the Complainant's registered trade mark 'Barclays'. Such activity does not qualify as non commercial or fair use.
9. 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 registered trade marks. The Complainant's solicitors, Pinsent Masons LLP, wrote to the Respondent on 26 January 2011, pointing out that the Respondent's use of the Domain Name was unlawful and asking for its transfer to the Complainant. The Respondent failed to respond to this letter, so chasing letters were sent on 24 February 2011 and 7 April 2011 to which there was no reply. Despite the correspondence, the content on the offending web site remained unchanged.
10. 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. 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.

11. 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 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.

The Response

12. The BarclaysJobs.co.uk registration is not an abusive registration as it does not infringe the rights that Barclays Bank has in the mark 'Barclays'. The 'BarclaysJobs.co.uk' site offers access to services that assist 'job helpers'. (Although the Response uses the words 'job helpers', the thrust of its case is that it provides information for job seekers; see paragraph 14 below.) The web site does not purport to be published by Barclays Bank, it does not use the Barclays logo, nor does it attempt in any way to be similar in style or appearance to the web sites operated by Barclays Bank.
13. Internet users are sophisticated enough that they are aware of the existence of parked pages, and do not confuse a parked page with an official corporate web site. The Complainant has not provided evidence that there is any initial interest confusion or experience of false designation of origin by any visitor to the barclaysjobs.co.uk web site.
14. The web site does not compete with Barclays as it does not provide banking services. It is purely an informational site, and the use of the Barclays term is a fair use to provide information to job seekers.
15. The barclaysjobs.co.uk web page makes fair use of the Barclays mark, just as other sites do that provide information on jobs available at Barclays Bank. For example, the web site GlassDoor.com has a web page devoted to available jobs at Barclays Bank. The page title is 'Barclays Jobs & Careers',

at <http://www.glassdoor.com/Job/Barclays-Jobs-E3456.htm>. The indeed.com site is similar, with a web page entitled 'Barclays Capital Jobs': <http://www.indeed.com/q-Barclays-Capital-l-New-York-NY-jobs.html>. CareerBuilder offers a page entitled 'Barclays Bank DelawareJobs': <http://www.careerbuilder.com/JobSeeker/Jobs/JobResults.aspx?ncc=%22Barclays+Bank+Delaware%22>.

16. The Domain Name uses the phrase 'Barclays Jobs' in a descriptive sense, just as these other job sites do. Promoting the phrase into the domain name, does not constitute infringement, just as these job sites use the phrase without infringing the Barclays mark.

The Reply

17. The Respondent has confirmed that it is offering services to assist job seekers. This statement is at odds with the content which was displayed on the web site, which included finance-related sponsored links. In any event, the Respondent is mistaken in his belief that he would be entitled to use the 'Barclays' trade marks, provided that he did not offer banking services.
18. The Respondent has indicated that the Domain Name is a 'purely informational site'. However, this is factually incorrect given that the content displayed at the Domain Name includes a list of finance-related sponsored links. The Respondent will generate click-through revenue every time one of these links is clicked by an internet user. Accordingly, the Domain Name does have a commercial purpose and the Respondent is benefitting financially from the use of the 'Barclays' trade marks.
19. It is unclear what the Respondent means by the statement that 'the use of the Barclays term is a fair use to provide information to job seekers'. The Respondent has noted three domain names which display content which relate to job opportunities at Barclays Bank. These domain names are all generic in nature and none includes a trading name or a well known name

of any third party. Given that these domain names are generic in nature they cannot be compared to the Domain Name which includes the Complainant's registered trade mark. Accordingly, if these example web sites are what the Respondent means by fair use, then his use is fundamentally different. If the Respondent means something else such as a right to use the term 'Barclays' to properly describe matters relating to Barclays Bank, then again his use is fundamentally different as this is not what his web site offers.

20. Given the widespread use, reputation 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 those marks. The Respondent has questioned whether initial interest confusion would occur. It is the Complainant's position that, given the notoriety of the 'Barclays' trade marks, it is inevitable and very obvious that given the Domain Name in question initial interest confusion would occur.

Discussion and Findings

21. The Complainant is required under subparagraphs 2a. and 2b. of the Dispute Resolution Policy ("the Policy") to prove to the Expert on the balance of probabilities that: -

- 21.1 it has Rights in respect of a name or mark which is identical or similar to the Domain Name; and

- 21.2 the Domain Name, in the hands of the Respondent, is an Abusive Registration.

Rights

22. By paragraph 1 of the Policy, -

'Rights means rights enforceable by the Complainant, whether under English law or otherwise, and may include rights in descriptive terms which have acquired a secondary meaning.'

23. The Respondent has not disputed the Complainant's evidence of Rights. 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 extracts from the Register at Companies House show that the company, Barclays plc (and not Barclays Bank plc), was first incorporated on 20 July 1896 and that it last changed its name on 1 January 1985, from Barclays Bank plc. The Complainant 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 worldwide.
24. 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 UK marks include 'Barclays', registered on 24 June 1987, and the Community marks include 'Barclays', registered on 26 January 1999. In addition to its registered trade marks, through its use of the name 'Barclays' since 1896 the Complainant has acquired a substantial reputation and goodwill in the areas of banking in which it offers services. The name 'Barclays' has become distinctive of the services provided by the Complainant.
25. Thus, in addition to its trade mark rights, the Complainant owns sufficient goodwill in the name 'Barclays' to support an action for passing off at Common Law. Therefore, the Complainant has established that it owns Rights in the name 'Barclays', which is similar to the Domain Name.

Abusive Registration

26. Paragraph 1 of the Policy states, -

'Abusive registration means a Domain Name which either:

- i. was registered or otherwise acquired in a manner which, at the time when the registration or other 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 states -

'3. Evidence of Abusive Registration

a. A non-exhaustive list of factors which may be evidence that the Domain Name is an Abusive Registration is as follows:-

- i. Circumstances indicating that the Respondent has registered or otherwise acquired the Domain Name primarily:
A....
B. as a blocking registration against a name or mark in which the Complainant has Rights.; or
C. for the purpose of unfairly disrupting the business of the Complainant.*
- 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 to, the Complainant.'*

Paragraph 4 of the Policy states, -

'4. How the Respondent may demonstrate in its response that the Domain Name is not an Abusive Registration.

a. A non-exhaustive list of factors which may be evidence that the Domain Name is not an Abusive Registration is as follows:

i. Before being aware of the Complainant's cause for complaint (not necessarily the 'complaint' under the DRS), the Respondent has:

A. used or made demonstrable preparations to use the Domain Name or a domain name which is similar to the Domain Name in connection with a genuine offering of goods or services;

B. been commonly known by the name or legitimately connected with a mark which is identical or similar to the Domain Name; or

C. made legitimate non-commercial or fair use of it.

.....'

27. Very little is known about the Respondent. It is a non-UK corporation. The registered address provided to Nominet is a P.O. Box in Alberta, Canada. The WHOIS search exhibited to the Complaint shows that the Respondent first registered the Domain Name on 3 March 2006. The Respondent has not challenged the Complainant's assertion of why it chose to include the word 'Barclays' in the Domain Name. The Complaint asserted, -

'Given the worldwide fame and notoriety of the mark BARCLAYS, no trader would choose the domain barclaysjobs.co.uk unless it was its intention 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.'

28. The content of the Response is directed at the current use of the web site and says nothing about why the decision was taken to use the name of a worldwide business, which was and is so well-known internationally that the Respondent must have been aware of it when it registered the Domain Name, particularly in view of the Respondent's silence in the face of the Complainant's assertion.
29. It is important to bear in mind that the Respondent does not assert that there was some independent justification for registering the Domain Name, for example that 'Barclays' was the trading name of an established business. Thus, at the outset the Respondent deliberately chose the name of the well-known business 'Barclays' as part of the Domain Name for its activities. It is clear on the evidence that the web site operated at the Domain Name provides information to job seekers.
30. The Complainant says that 'initial interest confusion' is bound to occur. The Expert finds that the Complainant is not required to provide evidence of 'initial interest confusion', merely to establish on the balance of probabilities that initial interest confusion is likely to have occurred or to occur in the future.
31. The Respondent says that its use of the portmanteau word 'barclaysjobs' is descriptive and by implication that no initial interest confusion would have occurred. However, the Expert finds that initial interest confusion is very likely to have occurred among a substantial number of visitors to the web site hosted at the address www.barclaysjobs.co.uk. It is not difficult to see how a person looking for a job at Barclays would type the words 'Barclays' and 'jobs' into a search engine. The likelihood is that the name of the Respondent's web site would be shown on such a search. The person conducting the search would have believed that the Domain Name

advertised jobs at Barclays, that it was in some way connected to the Complainant, and that the Domain Name was not merely a descriptive term for available jobs at Barclays.

32. Initial interest confusion is arguably sufficient for the Complainant to show confusion within the meaning of the Policy. However, it is worth asking whether that initial interest confusion is likely to have been dispelled once the visitor to www.barclaysjobs.co.uk arrived at the web site?

33. The screen grab of the Respondent's web site exhibited to the Complaint is headed, -

'Barclaysjobs.co.uk

What you need when you need it'.

The web page refers prominently to 'Barclay Banks Jobs'. The only other specific types of jobs offered are 'Nursing Jobs', and there are other job descriptions on the page, such as 'Job Search', 'Find A Job' and 'Part Time Jobs'.

34. The Respondent's web site is very different from the three web sites relied on by the Respondent. None of the three uses 'Barclays' as part of the address of its web site to advertise jobs at Barclays. The fact that each of the three web sites contains the words 'Barclays' and 'job(s)' in a sub-page is irrelevant, as the visitor to each of the three web sites would not have visited the web site under the false impression that any of them was connected to the Complainant.

35. That the Respondent uses neither the Complainant's logo nor the 'look and feel' of the Complainant's web sites is unlikely to have been sufficient to disabuse those visitors to the web site who viewed its contents, having been led to it as a result of their false belief that it was connected to the Complainant (i.e. by their initial interest confusion).

36. While it may be the case that some Internet users are sophisticated enough that they are aware of the existence of parked pages, even they would be likely to confuse a parked page with an official web site if (as is likely to have happened in this case) they had visited this web site as a result of initial interest confusion.
37. Once misled by initial interest confusion, visitors to the site would likely have believed that the Complainant had advertised jobs at Barclays on the Respondent's web site, because the initial interest confusion would have been confirmed by the presence of information about jobs at Barclays. Visitors misled by initial interest confusion would be likely to have concluded that the Complainant had directly sanctioned and authorised the job advertisements on the Respondent's web site or had sanctioned and authorised the business which was advertising them. Hence, the answer to the question posed in the last sentence of paragraph 32 above is, 'No'.
38. For the reasons set out in paragraph 27-37 above, the Expert finds that people are likely to have concluded that the Domain Name was operated or authorised by, or otherwise connected to, the Complainant within the meaning of paragraph 3.a.ii. of the Policy. In reaching this conclusion, the Expert has also taken into account the Respondent's purpose in selecting the name 'Barclays' as part of the Domain Name: to use that name and its association with the internationally well-known bank to drive traffic to its web site.
39. However, the Respondent says it has been making 'fair use' of the Complainant's name by providing information about jobs at Barclays. That is not so. The Respondent's activities are plainly commercial, proving sponsored links for jobs in return for payment. The fact that the service does not compete with Barclays provides no answer, because the Respondent chose to use the Complainant's well-known name to drive internet traffic to its commercial web site, and has deliberately used that

name so as to suggest falsely a connection with the Complainant without its licence or consent so as to make money on the back of it and without paying any financial compensation to the Complainant for doing so.

40. In the circumstances, the Expert finds that the Domain Name has been used in a manner which has taken unfair advantage of, and has been unfairly detrimental to, the Complainant's Rights; and finds that the Domain Name, in the hands of the Respondent, is therefore an Abusive Registration.

Decision

41. The Complainant has Rights in a name or mark, which is similar to the Domain Name, and the Domain Name in the hands of the Respondent is an Abusive Registration. The Expert therefore determines that the Domain Name barclaysjobs.co.uk be transferred to the Complainant.

Signed:

Dated: 8 September 2011

STEPHEN BATE