

DISPUTE RESOLUTION SERVICE

D00010915

Decision of Independent Expert

Barclays PLC

and

James Robinson

1. The Parties:

Lead Complainant: Barclays PLC
Pinsent Masons LLP
123 St Vincent Street
Glasgow
G25EA
United Kingdom

Respondent: James Robinson
Unit 24
Price Street Business Centre
Birkenhead
Wirral
CH41 4JQ
United Kingdom

2. The Domain Name(s):

wwwbarclay-card.co.uk

3. Procedural History:

14 February 2012 16:22 Dispute received
15 February 2012 10:01 Complaint validated
15 February 2012 10:16 Notification of complaint sent to parties
08 March 2012 12:19 No Response Received
08 March 2012 12:19 Notification of no response sent to parties
13 March 2012 10:55 Expert decision payment received

4. Factual Background

The Complainant trades as Barclays Bank plc. It is a major global financial services provider engaged in retail banking, credit cards, corporate banking, investment banking, wealth management and investment management services. It operates in over 50 countries and employs approximately 144,000 people. It has more than 48 million customers and clients across the world. The Barclays trading name is long established. The Complainant has traded as Barclays Bank plc since 1 January 1985. Prior to that it traded as Barclays Bank Limited (since 1917) and Barclay & Company Limited (since 1896).

The Complainant is the registered proprietor of a large variety of UK registered and Community registered trade marks featuring the marks BARCLAYS and BARCLAYCARD. A schedule of trade mark registrations is provided at Exhibit 3 to the Complaint. The registrations include a number of registrations consisting of the word mark BARCLAYCARD (for example UK registrations 1286580 registered on 1 October 1986, 2004486 registered on 8 December 1994 and 2010505 registered on 9 February 1995). These include registrations in class 36 of the Trade Mark Register which covers financial services, banking and the provision of financial information among other services.

The Complainant is the registrant of a number of domain names including www.barclays.co.uk (registered prior to 1996) and www.barclays.com (registered in November 2003). It is also the registrant of the domain names www.barclaycard.com (registered on 6 August 1997) and www.barclaycard.co.uk (registered prior to 6 August 1997). Printouts of the relevant WhoIs records are provided at Exhibit 4 to the Complaint.

The Respondent registered the Domain Name on 7 July 2004. A WhoIs printout is provided at Exhibit 5 to the Complaint showing the Respondent's status as "sole trader". The Respondent has chosen not to file a Response to this complaint and the Expert has no further information concerning his status.

From at least 19 July 2011 the Domain Name has been used for a web site which has all the hallmarks of being generated by a domain name parking service.

A screenshot captured on 19 July 2011, and included in Exhibit 6 to the Complaint, featured listings as follows;

- Free Online Dating
- Free Credit?
- Free Credit?
- Blinkx Video Search
- Abandoned Mental Asylums

To the right of the page were a series of "Related Searches" for;

- Virtual Debit Card
- Virtual Credit Cards
- UK Credit Cards
- Prepaid Visa

A later screenshot captured on 14 February 2012, and included in Exhibit 6, was in the same format as the earlier screenshot but featured different links as follows;

- Visa Credit Card
- I Can't Get a Loan
- Looking for Visa Credit Card?
- Best 5 Visa Credit Card UK ?
- Visa Credit Card

The "Related Searches" were;

- Credit
- Cash Back
- Prepaid Visa Card
- Virtual Credit Cards

On 27 September 2011 the Complainant's solicitors sent a cease and desist letter to the Respondent in respect of the use of the Domain Name. Follow up letters were sent to the Respondent on 4 November and 6 December 2011. No reply was received to any of the letters. Copies of the correspondence are included at Exhibits 7 and 8 to the Complaint.

5. Parties' Contentions

The Complainant

Rights

The Complainant asserts rights in respect of a name or mark which is identical or similar to the Domain Name. In support it relies on its portfolio of registered trade marks included in the schedule at Exhibit 3 to the Complaint.

In addition to its registered rights, the Complainant asserts that it has goodwill and a significant reputation in the areas of business in which it specialises such

that the name BARCLAYS, and trade mark derivatives of that name such as BARCLAYCARD, have become distinctive identifiers associated with the Complainant and the services it provides. It exhibits a screenshot of its web site at Exhibit 1 to the Complaint which demonstrates use of its BARCLAYS and BARCLAYCARD marks.

The Complainant confirms that the goodwill and registered trade marks have not been assigned or licensed to the Respondent.

Abusive Registration

Registration

The Complainant asserts that the Domain Name contains a word which is confusingly similar to the Complainant's BARCLAYS and BARCLAYCARD marks. Given the worldwide fame of these marks, no trader would choose the Domain Name 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 Respondent must have been aware that in registering the Domain Name he was misappropriating the valuable intellectual property of the Complainant.

Use

The Complainant makes the following submissions about the Respondent's use of the Domain Name:

1. The Respondent is not making fair use of the Domain Name.
2. The Domain Name is being used as a holding page containing a number of finance-related sponsored links which relate to products and services offered by the Complainant's competitors. It is being used to redirect internet traffic intended for the Complainant away from the Complainant and to competitor products and services, with the intention of generating income for the Respondent. The Respondent registered the Domain Name knowing that it is likely to attract interest from internet users who are searching for the Complainant. The content on the website at the Domain Name is tailored to match the Complainant's core goods and services. This means that when internet users view the content displayed at the Domain Name and click on one of the sponsored links on the website the Respondent generates revenue directly from the initial interest arising from the use of the name BARCLAY-CARD which is similar to the Complainant's BARCLAYCARD mark. This pay per click income does not qualify as fair use of the Domain Name.
3. There is reference to BARCLAYCARD in the meta tag keyword data for the Domain Name. The inclusion of BARCLAYCARD in the meta tag keywords means that when internet users enter the term BARCLAYCARD into an internet search engine, internet users will be drawn to the website at the

Domain Name, and its links to competitors of the Complainant, and away from the Complainant.

4. The Respondent has therefore intentionally attempted to attract, for commercial gain, internet users to the website by creating a likelihood of confusion with the Complainant's trade marks.
5. It is reasonably anticipated that the Domain Name will divert potential custom from the Complainant's business due to the presence of links to competitor websites via the Domain Name. Despite having been put on notice of the Complainant's objections to the use of the Domain Name in September 2011 the content on the website has remained unchanged.
6. The Respondent is not known by the Domain Name. He will never be capable of using the Domain Name for a legitimate purpose as the notoriety of BARCLAYS and/or BARCLAYCARD 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 BARCLAYS and/or BARCLAYCARD trade marks.
7. The Respondent's registration of the Domain Name has prevented the Complainant from registering a domain name which corresponds to the Complainant's trade marks.

The Respondent

The Respondent has made no submissions.

6. Discussions and Findings

Under Paragraph 2 of the Nominet Dispute Resolution Service Policy (the Policy) In order for the Complainant to succeed it must establish on the balance of probabilities, both:

that it has Rights in respect of 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 as defined in Paragraph 1 of the Policy.

Rights are defined in Paragraph 1 of the Policy as follows;

"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."

If the Complainant satisfies the Expert on the balance of probabilities that it has relevant rights, the Expert must consider whether the registration and/or use of the Domain Name by the Respondent is abusive.

An Abusive Registration is defined in Paragraph 1 of the Policy as follows:

"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 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 took unfair advantage of or was unfairly detrimental to the Complainant's Rights".*

Rights

The Complainant has established that it owns registered trade marks in the BARCLAYS and BARCLAYCARD marks in the UK and EU. These registrations confer rights on the Complainant as defined in the Policy.

In addition to registered rights, the Expert accepts the Complainant's submission that its length and extent of use of the BARCLAYS and BARCLAYCARD marks have conferred unregistered rights on the Complainant in the goodwill that has been generated by those marks. The marks BARCLAYS and BARCLAYCARD are well known marks associated with the Complainant's products and services.

Under Paragraph 2 of the Policy, having established Rights in these marks, the Complainant must establish that the marks are identical or similar to the Domain Name. It is customary to ignore the usual "www" prefix and the ".co.uk" suffix. The Domain Name is unusual because the main component of the name repeats the "www" sequence (wwwbarclay-card.co.uk). However the Expert finds that this repetition is insignificant. The "www" prefix is so commonplace that its appearance in the body of the Domain Name has minimal impact and does not detract from the main BARCLAY-CARD component.

The most obvious similarity between the Complainant's marks and the Domain Name is with the Complainant's BARCLAYCARD mark. This is identical to the Domain Name- save that the Domain Name is hyphenated -"barclay-card". The Expert finds that the addition of the hyphen is insignificant. The marks are phonetically the same and the visual addition of the hyphen does nothing to displace the association that the Domain Name has with the Complainant's mark.

The Expert also finds that the Complainant's BARCLAYS mark is similar to the Domain Name for the purposes of the Policy. Given the well known nature of the mark "BARCLAYS" the word stands out as the dominant feature of the Domain

Name. Its significance is not displaced by the introduction of the extra features into the Domain Name.

It follows that the Complainant has established on the balance of probabilities that it has Rights in respect of names or marks which are identical or similar to the Domain Name. The first element of the criteria under the Policy has been satisfied.

Abusive Registration

The Complainant asserts that both the initial registration of the Domain Name by the Respondent in July 2004 and also its subsequent use amount to an Abusive Registration under the Policy. Considering each of these submissions in turn:

Registration

The issue here is whether the Domain Name was registered in a manner which at the time when the registration took place, took unfair advantage of or was unfairly detrimental to the Complainant's Rights in its BARCLAYS and/or BARCLAYCARD marks.

There is no *direct* evidence before the Expert that the Respondent registered the Domain Name with an intent to take advantage of or unfairly disrupt the business of the Complainant. Instead, the Expert is invited to infer that, given the well known status of the Complainant's BARCLAYS and/or BARCLAYCARD marks, the Respondent must have been aware of the Complainant and/or its marks when he registered the Domain Name in 2004 and to have intended to take advantage of the Complainant's Rights. The Complainant also points out that there is no apparent connection between the Respondent and the BARCLAYS and/or BARCLAYCARD marks which could legitimate the registration.

The Expert finds this submission compelling. In 2004 the Complainant had already secured its trade mark registrations and domain name registrations in the BARCLAYS and BARCLAYCARD marks. It had been a provider of finance-related products for many years. It is improbable that the Respondent would have been unaware of the Complainant at the time he registered the Domain Name.

The Domain Name comprises the mark BARCLAY-CARD. This is not a generic term in everyday use. It is a phrase with trade mark (or brand) significance and a strong association with the Complainant. The Respondent has not offered a credible explanation (or indeed any explanation) for his choice of Domain Name even though he was given opportunity to do so by filing a Response to this Complaint or replying to correspondence from the Complainant's solicitors. In these circumstances, and especially in the light of the well known nature of the Complainant's marks, the Expert infers that the motivation for the registration of the Domain Name was to exploit an association with the Complainant's business. This motivation is inherently unfair to the Complainant because it is parasitical on the success of the Complainant's business and trading reputation..

For these reasons the Expert finds that the registration of the Domain Name by the Respondent was an Abusive Registration.

Use

The Domain Name has, at least since July 2011, been used to link to a "parking page". The content of this pages has varied but on the evidence before the Expert, it has consistently featured links to finance-related products offered by competitors of the Complainant.

The Expert notes that the Policy provides at Paragraph 4e 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 Expert is mindful of the observations of the Appeal Panel in *Oasis Stores Limited v Dale (DRS 06365)* who noted at Paragraph 8.15 of the decision "*In cases such as this, where the behaviour of a "parking page" is involved and an Expert or an Appeal Panel is asked to reach conclusions based on such behaviour, the relevant party would be well advised to provide full and detailed explanations as to exactly what is happening and what is causing the relevant page to behave in the manner concerned.*"

No such explanation has been forthcoming from the Respondent and it is not therefore possible for the Expert to ascertain whether the contents of the parking page have been generated automatically or the extent to which the Respondent has been instrumental in specifying the parameters for its operation. It is however clear that the Domain Name is one with strong associations with the Complainant. It is also clear that most of the links on the parking page to which the Expert has been referred offer products and services which compete with the Complainant. The Respondent has been put on notice of the Respondent's objections to the use of the Domain Name in correspondence between September -December 2011 and yet, at the time of the Complaint in February 2012, had taken no steps to discontinue the link between the Domain Name and the parking page. It is the view of the Expert that the use of the Domain Name in these circumstances amounts to an active exploitation of the Complainant's Rights for which the Respondent is responsible. As with the registration of the Domain Name, this use takes unfair advantage because it is parasitical. It is also probable that the use has caused unfair detriment to the Complainant's Rights in terms of diverted custom and a hindrance to the Complainant's pursuit of its strategy of domain name registrations to complement its trade mark registrations.

The Expert therefore finds that the use of the Domain Name by the Respondent amounts to an Abusive Registration.

For completeness the Complainant submits that there is reference to BARCLAYCARD in the meta tag keyword data for the Domain Name. There is no evidence produced to substantiate this claim and the Expert is accordingly unable to resolve it.

In conclusion, the Expert finds that the Complainant has satisfied the requirements of Paragraph 2 of the Policy and the Complaint succeeds.

7. Decision

The Domain Name to be transferred to the Complainant.

Signed: Sallie Spilsbury

Dated 3 April 2012