

DISPUTE RESOLUTION SERVICE

D00009403

Decision of Independent Expert

Barclays PLC

and

Barclays

1. The Parties:

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

Respondent: Barclays
112 Plymouth Ave
Buffalo
NY
14201
United States

2. The Domain Name:

onlinebarclaysbank.co.uk

3. Procedural History:

A Complaint in respect of the Domain Name under Nominet UK's Dispute Resolution Service Policy ("the Policy") was received from the Complainant on December 20, 2010 and forwarded to the Respondent by Nominet on December 21, 2010. No Response was received from the Respondent.

On January 27, 2011, the undersigned Alan L. Limbury was appointed as Independent Expert to determine the dispute in accordance with Nominet's Procedure for the conduct of proceedings under the Dispute Resolution Service (the "Procedure"). I confirmed to Nominet that I am independent of the parties and know of no facts or circumstances that might call into question my independence or impartiality in the eyes of the parties.

4. Factual Background

In the absence of a Response, I accept the following as established by the Complainant's assertions and its evidence.

The Complainant provides banking and other financial services, including online services, in over 50 countries. Founded in 1896, it has traded as Barclays Bank PLC since 1985. Its reputation and fame are such that it has common law rights in the name BARCLAYS. It is also the registered proprietor of numerous UK and Community trade marks in that name in a range of classes, including UK registered trademark No. 1314306 BARCLAYS in Class 36, registered on June 24, 1987. Its website at barclays.co.uk offering banking and other financial services has a pale blue hue.

Without the Complainant's consent, the Respondent registered the Domain Name on 9 March 2009. It resolves to a pay-per-click website with a pale blue hue featuring sponsored links to banking and other financial services, including those of the Complainant's competitors.

The Respondent failed to reply to several "cease and desist" letters from the Complainant.

5. Parties' Contentions

The Complainant says the Domain Name is confusingly similar to its common law and registered trade mark BARCLAYS and that, in the hands of the Respondent, the Domain Name is an abusive registration because, given the fame and notoriety of that mark, the Respondent must have chosen the Domain Name with the 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.

As mentioned, the Respondent failed to file a Response.

6. Discussions and Findings

Under paragraph 2 of the Policy, a 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.

Rights

“Rights” are defined in the Policy 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”.

The Complainant clearly has rights in the trademark BARCLAYS. I find that the Domain Name is similar to that mark, since the words “online” and “bank” do nothing to detract from the distinctiveness of the BARCLAYS mark but rather serve to reinforce it, by describing the very business that the mark invokes. The Complainant has established this element.

Abusive Registration

Abusive Registration is defined in the Policy as:

“...a domain name which either;

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

Paragraph 3(a) of the Policy provides a non-exhaustive list of factors that may be evidence that a domain name is an Abusive Registration. These include 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.

Given the Complainant's strong reputation in the BARCLAYS mark and the similar get-up of the Respondent's website to that of the Complainant, I have no hesitation in finding that the Respondent must have had the Complainant in mind when registering the Domain Name and that the Respondent has sought to profit from the likely confusion of people seeking the Complainant. Accordingly both the registration and use of the Domain Name have been unfairly detrimental to the Complainant's rights.

The Complainant has established this element.

7. Decision

I find that the Complainant has proved that it has Rights in a mark which is 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 be transferred to the Complainant.

Signed: Alan Limbury

Dated February 1, 2011.