

## DISPUTE RESOLUTION SERVICE

DRS 011897

### Decision of Independent Expert

Barclays PLC

and

Eric Zhang

#### 1. The Parties:

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

Respondent: Eric Zhang  
Tian Hong Shan Zhuang  
Nanjing  
Jiangsu  
210049  
China

#### 2. The Domain Names

barclaycrad.co.uk  
barclaysban.co.uk

#### 3. Procedural History

The Complaint under the Nominet UK Dispute Resolution Service Policy (the "Policy") and the Nominet Dispute Resolution Service Procedure (the "Procedure") was received on September 13, 2012.

Notification of the Complaint was sent to the Parties on September 13, 2012, and the Respondent was advised how to provide a Response. A reminder was sent to the Respondent on October 2, 2012.

No Response was received from the Respondent and on October 5, 2012 a notification to this effect was sent to the Parties.

On October 10, 2012, Clive N. A. Trotman was appointed Independent Expert to decide the dispute in accordance with the Policy and the Procedure. The Expert confirmed his independence and impartiality in the terms of paragraph 9(a) of the Procedure.

#### **4. Factual Background**

According to the Complainant, it is a major British bank and provider of financial services globally. It has traded as Barclays Bank PLC since 1985, and previously as Barclays Bank Limited since 1917 and as Barclay & Company Limited since 1896.

The Complainant holds numerous UK and European Community registered trademarks including BARCLAYS, BARCLAY and BARCLAYCARD, and has been the proprietor of the Barclaycard credit card since 1966. The Complainant's own Domain Names include barclays.co.uk, registered before 1996; barclays.com, registered in November, 2003; barclaycard.com, registered on August 6, 1997; and barclaycard.co.uk, registered prior to August 1996.

Nothing of substance is known about the Respondent except that he appears to be an individual with an address in China. The disputed Domain Name barclaycrad.co.uk was registered in the Respondent's name and address on March 8, 2011, and the disputed Domain Name barclaysban.co.uk was registered in the Respondent's name and address on March 26, 2011.

#### **5. Parties' Contentions**

##### **Complainant**

##### **Complainant's Rights**

The Complainant contends that it has rights in the disputed Domain Names. The Complainant has produced a schedule of its UK and European Community registered trademarks including BARCLAYS, BARCLAY and BARCLAYCARD. The Complainant contends that its stature in the financial services industry, through its predecessors, dates back to 1896, is well known, is major and is global. The Complainant's trademarks and the disputed Domain Names are similar.

##### **Abusive Registration**

The Complainant contends that the disputed Domain Names constitute abusive registration in the hands of the Respondent. There has been no assignment of the Complainant's names or trademarks to the Respondent and he has not been granted any licence to use them. Given the widespread use and notoriety of the famous BARCLAY, BARCLAYS and BARCLAYCARD trademarks, the Respondent must have been aware of them. The Complainant has used its own similar Domain Names including barclays.co.uk, barclays.com, barclaycard.com and barclaycard.co.uk, each registered between 1996 and 2003.

The Respondent's use of the disputed Domain Names is to display sponsored links to other websites at which mainly financial services are offered by competitors of the Complainant. The Respondent's intention is to generate income in return for these referrals. The disputed Domain Names are set up to achieve this by initially directing some Internet users, who are seeking the Complainant, to the Respondent's websites.

The Respondent is not known by the Domain Names. His reliance on the Complainant's name for the attraction of visitors does not qualify as fair use of the Domain Names.

The Complainant's agent sent cease and desist letters to the Respondent on April 23 and 24, 2012, and wrote again on May 15 and July 3, 2012. There has been no reply or action by the Respondent.

The Complainant requests the transfer to itself of the disputed Domain Names.

### **Respondent**

The Respondent has not submitted any contentions.

## **6. Discussions and Findings**

Paragraphs 2(a) and 2(b) of the Policy require the Complainant to prove, on the balance of probabilities, that:

- i. The Complainant has Rights in respect of a name or mark which is identical or similar to the Domain Name; and
- ii. The Domain Name, in the hands of the Respondent, is an Abusive Registration.”

### **Complainant's Rights**

The Complainant has satisfied the Expert that it has the required rights in the names or registered trademarks BARCLAYS, BARCLAY and BARCLAYCARD.

The disputed Domain Names are “barclaycrad.co.uk” and “barclaysban.co.uk”, of which the domain designation “.co.uk” may generally be disregarded in the determination of identity or similarity.

“Barclaycrad.co.uk” fully incorporates and is found to be confusingly similar to the Complainant's trademark BARCLAY, and is found to be a predictable typographical mistake for and confusingly similar to the Complainant's trademark BARCLAYCARD.

“Barclaysban.co.uk” fully incorporates and is found to be confusingly similar to the Complainant's trademark BARCLAYS, and is found to be a predictable typographical mistake for the Complainant's business name BARCLAYS BANK.

Accordingly the Expert finds in respect of each disputed Domain Name that the Complainant has rights in respect of a name or mark that is identical or similar.

### **Abusive Registration**

Under paragraph 1 of the Policy, Abusive Registration means a Domain Name that 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 has taken unfair advantage of or has been unfairly detrimental to the Complainant's Rights.”

Paragraph 3 of the Policy sets out a selection of circumstances that may be evidence that the Domain Name is an Abusive Registration, and reads in part:

#### **“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. for the purposes of selling, renting or otherwise transferring the Domain Name to the Complainant or to a competitor of the Complainant, for valuable consideration in excess of the Respondent's documented out-of-pocket costs directly associated with acquiring or using the Domain Name;

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 with the Complainant;

[.....]"

Paragraph 3(a)(i) of the Policy refers to the primary purpose for which the Domain Name was initially registered. Paragraph 3(a)(ii) of the Policy refers to the use of the Domain Name and is the paragraph primarily applicable to the present dispute.

Paragraph 4 of the Policy provides a non-exhaustive list of factors upon which the Respondent may seek to rely as evidence that a Domain Name is not an Abusive Registration. The Respondent has not made any submission in this respect.

The Respondent's use of the Domain Names, according to screenshots produced in evidence, is a click-through or pay-per-click operation. By this means the proprietor of a website may offer to visitors a selection of links to other websites, which may pay the proprietor a commission in return for successful referrals. Such a business model may be entirely legitimate and is commonly used as an adjunct to a public information or news website as a source of subsidy or as a profit centre, or as a stand-alone business generating income. The model depends, however, on the attraction of Internet visitors, and cannot be legitimate if the means of attraction is the appropriation of another's name or trademark without authorisation or with intent to confuse visitors as to its authenticity.

It may reasonably be concluded from the evidence that the Respondent has used the disputed Domain Names in order to attract visitors who are in fact looking for the Internet presence of the Complainant. Evidently the Respondent expects that a proportion of such users may accidentally type barclaycrad instead of BARCLAYCARD and thus be diverted to the Respondent's website at barclaycrad.co.uk. Similarly the Respondent evidently anticipates that some Internet users may mis-remember or synthesise the Complainant's authentic website as incorporating the expression BARCLAYS BANK, and may in turn fail to type the last letter "k" effectively and in consequence be led to the Respondent's website at barclaysban.co.uk.

Accordingly the Expert finds sufficient evidence to conclude that the Respondent intends to confuse Internet users into believing, at least initially, that the disputed Domain Names are connected with the Complainant, constituting Abusive Registration within the meaning of paragraph 3(a)(ii) of the Policy.

The Expert also finds on the balance of probabilities that the disputed Domain Names were registered primarily for the deceptive purposes for which they have been used, constituting Abusive Registration in the terms of paragraph 3(a)(i)(C) of the Policy.

The Complainant has said that the Respondent's registration of the Domain Names, in effect, has prevented the Complainant from doing so, which would fall under paragraph 3(a)(i)(B) of the Policy. The Expert does not find this to have been the Respondent's primary intention.

## **7. Decision**

The Expert finds that the Complainant has Rights in respect of the names and trademarks BARCLAYS, BARCLAY and BARCLAYCARD; that the disputed Domain Names barclaycrad.co.uk and barclaysban.co.uk are similar to the Complainant's names and trademarks; and that the disputed Domain Names, in the hands of the Respondent, each constitute an Abusive Registration. The Domain Names barclaycrad.co.uk and barclaysban.co.uk are ordered to be transferred to the Complainant.

**Signed** Clive Trotman

**Dated** October 20, 2012